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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208873
Party	Defendant Sunflower Meadows Herb Farm LLC
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Attachments	Motion to Dismiss.pdf (9 pages)(409327 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Serial No. 85/447,463
Filed: October 14, 2011
Published: September 18, 2012

HERB PHARM, LLC.,	:	
Opposer,	:	
v.	:	Opposition No. 91/208,873
SUNFLOWER MEADOWS	:	
HERB FARM LLC.,	:	
Applicant.	:	

MOTION TO DISMISS

Applicant Sunflower Meadows Herb Farm LLC. (“Applicant”), by and through it counsel, hereby requests that the Trademark Trial and Appeal Board (the “Board”) dismiss the Notice of Opposition filed by Opposer Herb Pharm, LLC. (“Opposer”), against Ser. No. 85/447,463 (the “Application”) based on Opposer’s failure to state a claim. *See* Fed. R. Civ. P. 12(b)(6); TBMP 503.

INTRODUCTION

The Application contains a disclaimer of any exclusive right to use the phrase “Herb Farm” – the only element of the composite design mark for various herbal products that bears any similarity to Opposer’s marks. Thus Opposer, relying on its registrations for the phonetic equivalent HERB PHARM marks, *see* Opp. Not. ¶ 1 and 6, seeks to prevent Applicant from registering a composite design mark in which the only objectionable element is conceded to be a descriptive phrase used in a purely descriptive manner. Settled principles of trademark law prohibit this effort. As a matter of law, Opposer cannot prevent Applicant from registering a mark in which the only overlapping element is a merely descriptive phrase that serves to identify and describe its products to consumers.

BACKGROUND

Applicant seeks to register the following composite mark in connection with:
herbal supplements and medicinal herbal preparations, in Class 5;
herbal tea and herbal food beverages, in Class 30; and
herbal juices, in Class 32.



HERB FARM

The "Sunflower Mark"

The composite Sunflower Mark consists of two elements: (i) the stylized and inherently distinct sunflower image (which is not at issue) and (ii) the descriptive phrase "Herb Farm".

In an Office Action dated February 2, 2012,¹ the Examining Attorney required that the Applicant disclaim the exclusive right to use the phrase "Herb Farm" because "such wording merely describes the location where the herbs used in the applicant's herbal goods are grown." In support of this statement, the Examining Attorney then proffered evidence from Wikipedia and websites maintained by Mills Garden Herb Farm, Foxhollow Herb Farm, and Heartsong Farm Healing Herbs, "which indicates that, in the relevant field, the wording 'herb farm' is commonly used to refer to an agricultural location where herbal goods, such as the goods used to produce the applicant's herbal supplements, preparations, beverages and juices, are grown." Noteworthy is that the Examining Attorney did not view the disclaimer as "Herb" and "Farm," but rather as "Herb Farm."

¹ It is "well established" that "matters of public record may be considered in deciding a motion to dismiss under Rule 12(b)(6) . . ." *Pani v. Empire Blue Cross Blue Shield*, 152 F.3d 67, 75 (2d Cir. 1998), *cert. denied*, 525 U.S. 1103 (1999). Indeed, the contents of the Application file are deemed to be part of the record. 37 CFR § 2.122(b). If, however, the Board concludes that the public contents of the Application file cannot be considered on motion to dismiss, Applicant respectfully requests that the Board decide this motion without reference to same, as Applicant does not deem such materials as necessary to this motion.

Applicant entered the requisite disclaimer for the descriptive “Herb Farm” phrase. The Application was subsequently published by the Trademark Office.

In the Notice of Opposition filed on January 16, 2013, Opposer relies on the following two marks it registered:

1. Reg. No. 2,142,522, HERB PHARM - herbal, dietary and nutritional supplements; “Herb” is disclaimed;



2. Reg. No. 2,612,435,  - Herbal, dietary and nutritional supplements; “Herb” is disclaimed.

Despite Opposer’s admission that the term “Herb” is descriptive of its products, and despite Applicant’s entry of the “Herb Farm” disclaimer for the Application, Opposer asserts that Applicant’s Sunflower Mark is likely to cause confusion because it includes the descriptive “Herb Farm” wording. *See* Opp. Not. ¶¶ 4-7.

STANDARD OF REVIEW

The Board must dismiss an opposition notice under Rule 12(b)(6) if it fails to state a claim that is “plausible on its face.” T.B.M.P. § 503.02, *citing Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *see also Advanced Cardiovascular Sys Inc. v. SciMed Life Sys. Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). The purpose of Fed. R. Civ. P. 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys.*, 26 USPQ2d at 1041, *citing Neitzke v. Williams*, 490 U.S. 319, 326-27 (1989).

When ruling on a motion to dismiss, the Board must accept the factual allegations pleaded in the complaint as true, but “[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim.” *Bradley v. Chiron Corp.*, 45 USPQ2d 1819, 1822 (Fed. Cir. 1998).

Matters of public record also may be considered on motion to dismiss. *See* n.1, *supra*; *see also Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (the Federal Circuit stated that the prosecution history of a patent application constitutes a public record of the applicant's representations).

When tested against these established standards for deciding a Rule 12(b)(6) motion to dismiss, Opposer's allegations fail as a matter of law.

ARGUMENT

This proceeding should be dismissed in its entirety because there exists no actionable likelihood of confusion between the parties' respective marks as a matter of law. The source of confusion relied upon by Opposer is the disclaimed "Herb Farm" wording in the Application, as to which it is clear on its face that "Herb Farm" merely describes and identifies Applicant's goods as coming from or being grown on an herb farm (as opposed to being produced synthetically or artificially). This use is not objectionable as a matter of law.

Trademark law cannot be stretched in ways that "deprive commercial speakers of the ordinary utility of descriptive words." *KP Permanent Make-Up Inc. v. Lasting Impression I Inc.*, 543 U.S. 111, 121-22 (2004) ("If confusion results, that is a risk the [senior user] accepted when it decided to identify its product with a mark that uses a well-known descriptive phrase."); *see Universal Money Centers v. AT&T*, 22 F.3d 1527, 1533 (10th Cir. 1994) (affirming judgment for defendant where electronic banking services provider that used "Universal" on its plastic debit cards failed to show likelihood of confusion caused by telephone company's use of "universal" to describe its combination of telephone and retail credit card).

Here, the inclusion of “Herb Farm” as part of the composite Sunflower Mark is clearly descriptive of the goods provided, namely herbal supplements and medicinal herbal preparations, herbal tea and herbal food beverages, and herbal juices. When the Sunflower Mark is viewed in connection with the aforementioned goods, a consumer will immediately understand that “Herb Farm” describes the Applicant’s products, and that such use is laudatory and descriptive. *See e.g., In re The Place Inc.*, 76 USPQ2d 1467, 1468 (T.T.A.B. 2005) (the Board determined that the phrase “The Greatest Bar” was laudatory and merely descriptive of applicant’s “restaurant and bar services” as the phrase added no source-indicating significance to the mark as a whole). Indeed, that Applicant included a disclaimer of any exclusive right to use “Herb Farm” is an admission that this phrase is merely descriptive. *See Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (T.T.A.B. 2008) (the disclaimer of language during the prosecution of an application is considered an admission by that party that the language is merely descriptive).

In this sense, the descriptive phrase “Herb Farm” is no different than “Pumpkin Patch” or “Apple Orchard” – consumers readily understand that these phrases are used to identify the associated product and its qualities or characteristics. This term enables consumers to readily identify and understand that Applicant’s herbal supplements and medicinal herbal preparations, herbal tea and herbal food beverages, and herbal juices emanate from an actual herb farm.²

² In fact, the Examining Attorney assigned to review the Application identified and presented numerous descriptive uses of the phrase “Herb Farm” in connection with the same types of goods covered by the Application; and in response, Applicant identified numerous other descriptive uses of the phrase “Herb Farm”. In view of the proliferation of the use of the phrase “Herb Farm”, it is hard to imagine consumers seeing those words as identifying a single source of origin, let alone Opposer, as they are used time and time again in connection with herb farms. *See also* n.1, *supra*.

Given that the phrase “Herb Farm” is a descriptive use of a descriptive phrase by Applicant, no actionable consumer confusion can be found. Were the allegations in Opposer’s Notice of Opposition sufficient to state a claim under Section 2(d), then no other party would be permitted to use the descriptive wording “Herb Farm” as part of its mark to identify itself as an herb farm or its products as coming from an herb farm. Further, no third party would be permitted to use the phrase “Herb Farm” as it would presumably conflict with Opposer’s HERB PHARM mark, even if those users were indeed describing themselves as herb farms or their products as being grown on an herb farm.

The Supreme Court has opined on this very issue in *KP Permanent Make-Up*, by stating that when a senior user adopts a descriptive term as its mark and a junior user uses the descriptive term in a descriptive sense, a “possibility of consumer confusion” is tolerated by the Lanham Act and common law so to allow the junior user the ability to describe its own product. *KP Permanent Make-Up*, 543 U.S. at 121-22 (noting “the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.”). The Supreme Court added:

The common law’s tolerance of a certain degree of confusion on the part of consumers followed from the very fact that in cases like this when an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first. The Lanham Act adopts a similar leniency, there being no indication that the statute was meant to deprive commercial speakers of the ordinary utility of descriptive words. *Id.* at 122.

In this regard, it is important to emphasize that it was Opposer that decided to adopt a mark – “Herb Pharm” – that barely differs from the commonly used descriptive phrase “Herb Farm.” As stated by the Second Circuit, “If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well-known descriptive phrase.” *Cosmetically Sealed Industries Inc. v. Chesebrough-Pond's USA Co.*, 43 USPQ2d 1956, 1958 (2nd Cir. 1997); *see also Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 201 (1985) (noting safeguards in Lanham Act to prevent commercial monopolization of language); *Car-Freshner Corp. v. S. C. Johnson & Son, Inc.*, 36 USPQ2d 1855, 1856 (2nd Cir. 1995) (it is of great importance to protect the right of society at large “to use words or images in their primary descriptiveness sense, as against the claims of a trademark owner to exclusivity.”); *Hygrade Food Prods. Corp. v. H.D. Lee Mercantile Co.*, 46 F.2d 771, 772 (10th Cir. 1931) (even if a word has acquired secondary meaning, it still belongs to the public in its primary descriptive sense); *US Shoe Corp. v. Brown Group Inc.*, 15 USPQ2d 1138, 1139 (S.D.N.Y. 1990) (citation omitted) (fair use doctrine recognizes that a senior user “cannot altogether exclude some kinds of competing uses,” particularly those which use words in their primary descriptive and non-trademark sense), *aff'd without op.*, 923 F.2d 844 (2nd Cir. 1990).

Indeed, by Opposer’s theory, presumably a party could then prevent others from using the phrase “Orange Juice” by registering the misspelled mark ORANJE JUICE. However, the Opposer’s position has been rejected by the courts based on the policy of free competition. *Car Freshner Corp.*, 36 USPQ2d at 1856 (“The principle is of great importance because it protects the right of society at large to use words or images in their primary descriptive sense, as against the claims of a trademark owner to exclusivity.”)

In sum, Opposer's attempt to prevent registration of the Sunflower Mark based on its inclusion of the disclaimed, descriptive wording "Herb Farm" is not plausible on its face, and is contrary to longstanding precedent protecting parties to freely use descriptive terms and phrases.

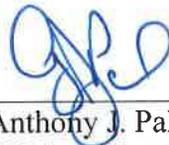
CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board dismiss Opposer's notice of opposition in its entirety. Further, as this is a dispositive motion, Applicant requests a suspension of the proceeding pending the determination of this motion, pursuant to 37 C.F.R. § 2.127(d) and T.B.M.P. § 510.

Respectfully submitted,

SUNFLOWER MEADOWS HERB FARM

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Motion to Dismiss Opposer's Notice of Opposition was served on Opposer's counsel at the following address of record by First Class Mail, postage prepaid, this 25th day of February 2013:

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