

ESTTA Tracking number: **ESTTA653616**

Filing date: **02/02/2015**

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

Proceeding	91212477
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Attachments	Opposers_Trial_Brief_Public_Version.pdf(254823 bytes)

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I. INTRODUCTION

Balance Bar Company (“Balance Bar”) was founded over 20 years ago, and since that time has been continuously and extensively using the trademark BALANCE in connection with the sale of snack bars. During this same time, Balance Bar has introduced, used, and continues to use numerous other BALANCE-formative trademarks, including BALANCE BAR, BALANCE GOLD, BALANCE BAR GOLD, and BALANCE BARE. The BALANCE and BALANCE-formative trademark will be hereinafter referred to collectively as “the BALANCE marks”.

Balance Bar has, over the years, invested substantial amounts of time, money and effort in promoting and protecting its BALANCE marks. As a result of these efforts, the BALANCE marks have gained significant goodwill among the purchasing public, resulting in sales of more than [REDACTED] since 1992. Balance Bar is the owner of numerous federal trademark registrations for its BALANCE marks, and has and continues to police the marketplace to protect its brand.

Applicant GFA Brands, Inc. (“Applicant”) recently filed an intent-to-use trademark application (Serial No. 85/751,520) for the mark EARTH BALANCE for use in connection with, among other goods, nut and seed-based snack bars. Applicant is thus attempting to register a mark which i) incorporates the entire BALANCE trademark; ii) for substantially identical, if not identical, goods; iii) which will be marketed to the same consumers; iv) in the same channels of trade; and v) for products which are relatively inexpensive and often the focus of an impulse purchase. As a result, confusion between these marks is not only likely, but inevitable. Accordingly, this opposition should be sustained, and Applicant’s application to register the

mark EARTH BALANCE should be refused under section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

II. DESCRIPTION OF THE RECORD

A. Balance Bar's evidence¹

Balance Bar has made the following deposition testimony of record:

1. Erin Lifeso, Senior Director of Marketing for Balance Bar, taken on April 30, 2014 in Proceeding No. 91196954 and filed per the parties' stipulation (including public and confidential portions), and including Opposer's Exhibits 1-32 and Applicant's Exhibits 1-3.
2. Patrick Cornacchiulo, Vice-President of Marketing, taken on May 1, 2014 in Proceeding No. 91196954 and filed per the parties' stipulation (including public and confidential portions), and including Opposer's Exhibits 33-49.
3. Patrick Cornacchiulo, Vice-President of Marketing, taken on July 30, 2014 (including public and confidential portions), and including Opposer's Exhibits 50-51 and Applicant's Exhibits 1-10.
4. Erin Lifeso, Senior Director of Marketing for Balance Bar, taken on July 30, 2014 (including public and confidential portions), and including Opposer's Exhibits 52-73 and Applicant's Exhibits 11-12.

Balance Bar filed the following Affidavit testimony (per the parties' Stipulation):

1. Affidavit of Jacob Jacoby, Ph.D, Jacob Jacoby Research, Inc., including the deposition testimony taken on August 27, 2014 in Proceeding No. 91196954, and accompanying exhibits.

¹ References to deposition testimony will be designated as, for example "____ Dep. at __, Exh. __."

Balance Bar filed the following Notices of Reliance during its testimony periods:²

1. Notice of Reliance No. 1, dated August 19, 2014, containing copies of TSDR records for nine (9) of Balance Bar's valid and subsisting pleaded US trademark registrations.
2. Notice of Reliance No. 2, dated August 19, 2014, containing copies of select pages from the website balance.com.
3. Notice of Reliance No. 3, dated August 19, 2014 (filed Confidentially), containing a copy of GFA Brands, Inc.'s Responses to Opposer's First Set of Requests for Admission.
4. Notice of Reliance No. 4, dated August 19, 2014 (filed Confidentially), containing a copy of GFA Brands, Inc.'s Responses to Opposer's First Set of Interrogatories Nos. 4-5, 14-17, 20 and 26.
5. Notice of Reliance No. 5, dated August 19, 2014, containing copies of documents obtained from the USPTO's TTABVUE system.
6. Notice of Reliance No. 6, dated August 19, 2014, containing a copy of a document obtained from the USPTO's TTABVUE system.
7. Notice of Reliance No. 7, dated August 19, 2014 (filed Confidentially), containing a copy of pages 1-11, 29-31 and 49-56 of the Rule 30(b)(6) discovery deposition of Adriane E. Little.
8. Notice of Reliance No. 8, dated December 3, 2014, containing a copy of an article entitled "Likelihood of Confusion Studies and the Straitend Scope of Squirt" authored

² Notices of Reliance and accompanying exhibits filed during Balance Bar's testimony period are designated "BB Not. of Rel. __, Exh. __."

by Jerre B. Swan and published in the May-June 2008 edition of The Trademark Reporter (Vol. 98, No. 3).

B. Applicant's evidence

Applicant has made the following deposition testimony of record:

1. Howard Seiferas, Senior Vice President Sales Services and Logistics, taken on September 19, 2014 (including public and confidential portions), and including Applicant's Exhibits 13-15.

2. Adrian Little, Category Manager Earth Balance, taken on October 15, 2014 (including public and confidential portions), and including Applicant's Exhibits 16-49.

Applicant filed the following Affidavit testimony (per the parties' Stipulation):

1. Affidavit of William B. Shanks
2. Affidavit of Kiersten P. Horne
3. Affidavit of Michael L. Suskind
4. Affidavit of Chris Rodermond
5. Affidavit of Marie Flemmings

6. Affidavit of Philip Johnson, JJG Group, LLC, including the deposition testimony taken on July 21, 2014 (including public and confidential portions), and accompanying exhibits.

Applicant filed the following Notices of Reliance during its testimony period:

1. Notice of Reliance No. 1, dated October 20, 2014, containing copies of TSDR records for fifteen (15) of Applicant's US trademark registrations.

2. Notice of Reliance No. 2, dated October 20, 2014, containing photographs of third party product packaging.

3. Notice of Reliance No. 3, dated October 20, 2014, containing copies of webpages depicting third party products.

4. Notice of Reliance No. 4, dated October 20, 2014, containing copies of webpages depicting third party cookbooks.

5. Notice of Reliance No. 5, dated October 20, 2014, containing copies of third party trademark registrations.

6. Notice of Reliance No. 6, dated October 20, 2014 (filed Confidentially), containing a copy of Opposer's Objections and Responses to Applicant's First Set of Interrogatories Nos. 7-8, 12 and 16-17 and Opposer's Objections and Responses to Applicant's Second Set of Interrogatories No. 26.

7. Notice of Reliance No. 7, dated October 20, 2014, containing copies of webpages from Applicant's Smart Balance and Earth Balance websites.

8. Notice of Reliance No. 8, dated October 20, 2014 (filed Confidentially), containing copies of the testimony depositions of William Hooper and Timothy Kraft from Proceeding No. 91196954, and all accompanying exhibits.

9. Notice of Reliance No. 9, dated October 20, 2014 (filed Confidentially), containing a copy of the 30(b)(6) discovery deposition of Patrick Cornacchiulo, and all accompanying Exhibits.

C. The application file and pleadings

Pursuant to 37 C.F.R. § 2.122(b), the file of the trademark application (U.S. Serial No. 85/751,520) and the pleadings in this opposition are deemed to be of record.

III. STATEMENT OF THE ISSUES

Whether Applicant's proposed use and registration of the EARTH BALANCE mark in connection with nut and seed-based snack bars is likely to cause confusion, mistake or deception under section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), in view of the valid and subsisting BALANCE marks.

IV. STATEMENT OF FACTS

A. Balance Bar is the owner of the BALANCE trademark and numerous BALANCE-formative trademarks

1. Balance Bar has continuously used the BALANCE marks in commerce for many years

Balance Bar was founded in the early 90's in Santa Barbara, California by individuals working with 40-30-30 diet-based nutrition.³ Snack bars were developed based on this 40-30-30 nutrition principle, and sold to the consuming public under the BALANCE and BALANCE BAR trademarks.⁴ In 2000, a new snack bar product was launched under the BALANCE GOLD trademark, and Balance Bar was purchased by Kraft Foods that same year.⁵ Following Kraft's purchase of the company, new snack bar products were launched under the BALANCE BAR GOLD and BALANCE BARE trademarks.⁶ Kraft Foods then sold Balance Bar to Brynwood Partners at the end of 2009.⁷ In late 2012, NBTY purchased Balance Bar from Brynwood Partners, and remains the owner of the company today.⁸ During this entire period, one or more of the BALANCE marks has been in use in the marketplace.⁹ These various BALANCE marks

³ Lifeso April 30 Dep. at 7:6-10, Exh. 1.

⁴ Lifeso April 30 Dep. Exh. 1.

⁵ Lifeso April 30 Dep. at 7:13-14, Exh. 1, 12.

⁶ Lifeso April 30 Dep. Exh. 12.

⁷ Lifeso April 30 Dep. at 7:15-17.

⁸ Lifeso April 30 Dep. at 7:22-23.

⁹ Lifeso April 30 Dep. at 11:2-13.

are shown in the photographs comprising Opposer's Exhibits 9, 56 and 57, such photographs depicting various product packaging for Balance Bar's products.¹⁰

The BALANCE marks have gained significant goodwill among the purchasing public, resulting in sales of more than [REDACTED] since 1992, and sales of more than [REDACTED] [REDACTED] from 2007 through the end of 2013.¹¹ Moreover, Balance Bar has developed a loyal base of consumers, who account for a significant percentage of overall sales.¹²

2. Balance Bar has extensively advertised and promoted its BALANCE marks

Balance Bar's historic documents demonstrate extensive advertising and promotion of its Balance marks at least as far back as the late 1990s.¹³ In fact, Balance Bar won an Effie Award in 2000 for its Never Be Out of Balance advertising campaign.¹⁴ Since 2007, Balance Bar has expended over [REDACTED] in its advertising and marketing efforts, with over [REDACTED] being spent in the last two years.¹⁵ Balance Bar expends about [REDACTED] in trade spend per year on the brand as well.¹⁶

Following the purchase of Balance Bar in 2010 by Brynwood Partners, Balance Bar's advertising and marketing efforts have included the distribution of national Free Standing Inserts (FSIs), the distribution of products and coupons at public events, the redesign of the balance.com website, the launch of social media tools such as Facebook, Twitter and Pinterest, national print

¹⁰ Lifeso April 30 Dep. Exh. 13; Lifeso July 30 Dep. Exhs. 56-57.

¹¹ Lifeso April 30 Dep. Exh. 30-32; Lifeso July 30 Dep. Exhs. 71-71; GFA Not. of Rel. 6, Exh. F-1 at 10-12.

¹² Cornacchiulo May 1 Dep. at 39:3-22.

¹³ Lifeso April 30 Dep. at 11:15-32:19, Exh. 1-9.

¹⁴ Lifeso April 30 Dep. at 13:8-17, Exh. 1.

¹⁵ Lifeso April 30 Dep. at 128:4-137:9, Exhs. 28-29; Lifeso July 30 Dep. at 28:6-29:15, Exh. 68.

¹⁶ Lifeso April 30 Dep. Exh. 31; Cornacchiulo May 1 Dep. at 20:19-21:25.

media campaigns, trade show attendance, distribution of product displays and POS materials, online promotions, and PR outreach programs.¹⁷

More recently, and following NBTY's purchase of the company in late 2012, Balance Bar continued with its national print campaigns,¹⁸ trade ads,¹⁹ and FSIs,²⁰ and also created and ran national TV spots.²¹ Balance Bar continues to regularly update and refresh its balance.com website.²²

3. Balance Bar owns numerous registrations for its BALANCE marks

Balance Bar is the owner of the following trademark registrations: Registration No. 2,745,850 for the mark BALANCE for protein-based, nutrient-dense snack bars in Class 29; Registration No. 2,659,753 for the mark BALANCE BAR for nutritional food supplements in Class 5; Registration No. 2,636,101 for the mark BALANCE GOLD for snack bars in Class 30; Registration No. 3,937,988 for the mark BALANCE for nutritional supplements and dietary food supplements in Class 5; and cereal-based, rice-based, or granola-based snack bars and snack foods in Class 30; Registration No. 2,999,244 for the mark BALANCE BAR GOLD for protein-based, nutrient-dense snack bars in Class 29; Registration No. 3,036,771 for the mark BALANCE BAR for protein-based, nutrient-dense snack bars in Class 29; Registration No. 3,436,917 for the mark BALANCE BARE for protein-based, nutrient-dense snack bars in Class 29; and grain-based food bars also containing fruits and nuts in Class 30; and Registration No. 4,062,171 for the mark BALANCE BAR for cereal-derived, rice-based and granola-based snack bars in Class 30.

¹⁷ Lifeso April 30 Dep. at 38:2-92:22, Exh. 10; Lifeso July 30 Dep. at 11:10-24:18, Exhs. 58-65.

¹⁸ Lifeso April 30 Dep. Exh. 17-21; Lifeso July 30 Dep. Exhs. 52, 69-70.

¹⁹ Lifeso April 30 Dep. Exh. 22-24.

²⁰ Lifeso April 30 Dep. Exh. 25; Lifeso July 30 Dep. Exhs. 54-55, 69-70.

²¹ Lifeso April 30 Dep. Exh. 15-16; Lifeso July 30 Dep. Exhs. 53, 69-70.

²² BB Not. of Rel. 2, Exhs. B1-B2.

These registrations are all valid and subsisting, and have properly been made of record via Balance Bar's First Notice of Reliance.²³

4. Balance Bar diligently polices its BALANCE marks

Balance Bar has and continues to diligently police its BALANCE marks.²⁴ These policing activities include a watch of newly-filed and published trademark applications, the preparation of cease-and-desist letters, and the filing of oppositions with the United States Trademark Office. In addition to the present proceeding, Balance Bar has initiated at least 16 opposition proceedings in the United States Trademark Office as part of these policing activities.²⁵ Balance Bar has also had numerous cease-and-desist letters prepared on its behalf.²⁶ Together, these policing activities have resulted in settlement agreements with numerous parties involving marks containing the term "balance".²⁷ When asked about Balance Bar's policing activities, Mr. Cornacchiulo testified that "[t]he Balance Bar Company polices very close into the bar category. So, obviously, you know that's the category Balance Bar stands in. So, they were very strong on anybody infringing in the bar category, highly. And they reviewed a lot of close in categories or products that would, you know, infringe on that; from vitamins to supplements to drinks or anything that would be in that category."²⁸ Mr. Cornacchiulo also confirmed that, going forward, Balance Bar will continue its policing activities.²⁹

²³ BB Not. of Rel. 1, Exh. A1-A9.

²⁴ Cornacchiulo May 1 Dep. at 17:2-18:2.

²⁵ BB Not. of Rel. 5, Exh. E1-E16.

²⁶ Cornacchiulo May 1 Dep., Exh. 45-48; Cornacchiulo July 30 Dep., Exh. 51.

²⁷ Cornacchiulo May 1 Dep. Exh. 33-44; Cornacchiulo July 30 1 Dep., Exh. 50.

²⁸ Cornacchiulo May 1 Dep. at 17:3-20.

²⁹ Cornacchiulo May 1 Dep. at 17:21-18:2.

B. Applicant seeks to register the confusingly similar mark EARTH BALANCE for identical goods offered to the same consumers through the same trade channels

On October 11, 2012, Applicant filed an intent-to-use application for the mark EARTH BALANCE for use in connection with nut and seed-based snack bars. The foregoing goods are substantially identical to, if not identical to, the products sold by Balance Bar under its BALANCE marks, and recited in Balance Bar's pleaded trademark registrations. The opposed application does not contain any restrictions on the trade channels associated with the recited goods, and therefore it must be presumed that the recited goods will travel in the same channels of trade as the goods recited in Balance Bar's pleaded registrations. In fact, the evidence of record in this case confirms that both Balance Bar and Applicant sell products through many of the same retail outlets.³⁰ There can be no doubt but that Applicant is attempting to register a mark which incorporates Balance Bar's entire trademark for identical goods sold to the same customers through identical channels of trade.

V. ARGUMENT

Section 2(d) of the Lanham Act prohibits the registration of marks that consist of or comprise a mark that "so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive" 15 U.S.C. § 1052(d). In view of the facts set forth above, as well as the evidence of record, it is apparent that confusion, mistake, or deception would be likely, and that Balance Bar would be damaged, if registration of Applicant's EARTH BALANCE mark were permitted in connection with the identified goods. Therefore, Balance Bar requests

³⁰ Lifeso April 30 Dep. Exh. 26; Lifeso July 30 Dep. Exhs. 66-67; BB Not. of Rel. 4, Exh. D at 13; Little Dep. Exh. 32.

that Opposition No. 91212477 be sustained and that registration of the EARTH BALANCE mark in connection with nut and seed-based snack bars be refused.

A. Balance Bar has standing to oppose the EARTH BALANCE application and has priority of use

Balance Bar has a legitimate interest in preventing the registration of Applicant's EARTH BALANCE mark because Balance Bar is the owner of the BALANCE marks and reasonably (and correctly) believes that it will be damaged by the registration of the EARTH BALANCE mark given the similarity of the marks, and the similarity of the respective goods, relevant consumers, and channels of trade.

Balance Bar has filed a notice of reliance including copies of its U.S. federal trademark registrations for the BALANCE marks, which establish the valid and subsisting status of the registrations, Balance Bar's exclusive ownership of the marks, and Balance Bar's priority in the BALANCE marks (the effective dates of which all predate the opposed application). *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008); *Saul Zaentz Co. v. Bumb*, 2010 TTAB LEXIS 236, *9 (TTAB June 28, 2010); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008).

B. Applicant's proposed EARTH BALANCE mark is likely to cause confusion with Balance Bar's BALANCE marks

In determining likelihood of confusion, the Board should consider evidence relating to the thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). The Board need not consider each and every *DuPont* factor. *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Rather, the Board is required only to consider those factors that are most relevant in the instant case. The most relevant factors in this case are: (1) the identical nature of the goods; (2) the presumption of identical channels of trade

and classes of consumers; (3) the similarity of the marks; (4) the unsophisticated consumers of inexpensive products and services; (5) the absence of evidence of third-party use of marks similar to the BALANCE marks; (6) the absence of both scientifically and legally recognized survey evidence showing non-confusion; (7) the prior dealings between the parties; and (8) Applicant's effective admission that confusion is likely.

The evidence of record leaves no room for doubt that Applicant's EARTH BALANCE mark, when used and/or registered in connection with identical goods, so resembles one or more of the BALANCE marks that confusion as to source, sponsorship or affiliation is highly likely to result.

1. The goods identified in the EARTH BALANCE application include goods identical to the goods registered and sold under the BALANCE marks

The determination of similarity or relationship between the goods of the parties must be made on the basis of the goods identified in the respective application and registrations.

Octocom Systems, Inc. v. Houston Computer Services, Inc., 16 USPQ2d 1783,1788 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") Neither the Board nor the courts will read limitations into an identification of goods and services. *Squirtco v. Tomy Corp.*, 216 USPQ 937, 940 (Fed. Cir. 1983).

Here, the opposed EARTH BALANCE application recites nut and seed-based snack bars. There can be no doubt but that the foregoing goods are substantially identical to, if not identical to, the products recited in Balance Bar's pleaded trademark registrations.

Thus, this factor weighs heavily in favor of a likelihood of confusion.

2. Applicant's proposed goods will be marketed and sold in the same trade channels and to the same consumers as Balance Bar's goods

Because the parties' respective application and registrations are unrestricted, and cover the identical or virtually identical goods, the Board must presume that the goods of the parties are offered in the same channels of trade and to the same class of consumers. *CBS Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983); *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”); *Kangol Ltd. v. KanqaRoos U.S.A.*, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

The evidence of record also confirms that Applicant's proposed EARTH BALANCE products will be sold in the same channels of trade as Balance Bar's products. In particular, the parties have many of the same retail customers so that it is more than likely that such products will be sold in the exact same stores, and likely even compete for the same shelf space.³¹ Further, both parties target health conscious end consumers, making confusion even more likely.³²

Thus, this factor weighs heavily in favor of a likelihood of confusion.

3. The proposed EARTH BALANCE mark is similar to Balance Bar's registered BALANCE trademarks

To gauge their similarity, the marks must be compared in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir.

³¹ Lifeso April 30 Dep. Exh. 26; Lifeso July 30 Dep. Exhs. 66-67; BB Not. of Rel. 4, Exh. D at 13; Little Dep. Exh. 32.

³² Cornacchiulo May 1 Dep. at 37:5-7; Little Dep. Exh. 34.

2005), *quoting du Pont*, 111 USPQ at 567; *see also Abita Brewing Co. v. Mother Earth Brewing, LLC*, Opposition No. 91203200 (September 11, 2014). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012), *citing Leading Jewelers Guild v. JLOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007). Moreover, in comparing the marks, where, as here, Applicant's goods are identical to Opposer's goods in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The marks at issue are sufficiently similar in sight, sound and meaning to cause confusion. First, Applicant's proposed EARTH BALANCE mark incorporates Balance Bar's entire BALANCE trademark. As discussed by the TTAB in *In re Stript Wax Bar*, the scenario of one party seeking to register a mark that incorporates the entirety of a previously-registered mark has been addressed by the Board on numerous occasions. Indeed, there is a line of cases holding that, in situations where a proposed mark incorporates the entirety of another mark, additional matter added to the proposed mark will not necessarily be sufficient to distinguish the marks as a whole. *In re Stript Wax Bar*, Serial No. 77706198, *5 (TTAB November 16, 2012). The TTAB has addressed this same subject in at least the following recent decisions: *In re Carman, Amber R. dba Tangled Tantrum*, Serial No. 85758055 (TTAB August 27, 2014)(TANGLED

TANTRUM and design refused over TANTRUM); *In re Griffin and Grossman*, Serial No. 77850840 (TTAB September 20, 2012)(MAJOR MOJO refused over MOJO); *In re RiseSmart*, Serial Nos. 85050089 and 85075422 (TTAB November 27, 2012)(TALENT ASSURANCE and JOB ASSURANCE refused over ASSURANCE); *In re Stript Wax Bar*, Serial No. 77706198 (TTAB November 16, 2012)(STRIPT WAX BAR and design refused over THE WAX BAR). In all of these cases, “[t]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that [the] ultimate conclusion rests upon a comparison of the marks in their entireties. *In re Carman, Amber R. dba Tangled Tantrum*, Serial No. 85758055, at *5 (citing *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Ms. Lifeso addressed this same point when she testified that use of the EARTH BALANCE mark on nutrition bars would cause confusion in the marketplace because “[t]hey would be using our full trademark Balance within their trademark in their products and they would be selling bars which we directly would be competing with then....”³³

Next, Applicant’s proposed EARTH BALANCE mark is sufficiently similar in sight, sound, and meaning to Balance Bar’s BALANCE BAR, BALANCE GOLD, BALANCE BAR GOLD, and BALANCE BARE trademarks as to cause confusion. The evidence of record establishes that both parties target health conscious end consumers and use the term “balance” to convey a substantially similar message to its consumers.³⁴ These facts, together with the number of BALANCE-formative marks owned by Balance Bar, each typically associated with a different product line, will likely cause a consumer to conclude that Balance Bar has launched a new product line, if such consumer were to encounter Applicant’s EARTH BALANCE mark on a nut

³³ Lifeso July 30 Dep. at 37:15-24.

³⁴ Cornacchiulo May 1 Dep. at 37:5-7; Little Dep. Exh. 34.

and seed-based snack bar. *See In re Randolph Leonard Spencer Churchill*, Serial No. 85446588, at *7, (TTAB August 19, 2014); *Caterpillar Inc. v. Big Cat Energy Corporation*, Opposition No. 91193704, at *32, (TTAB September 3, 2014). Mr. Cornacchiulo confirmed during his testimony that consumers could view an EARTH BALANCE snack bar as an extension of the Balance line.³⁵ Ms. Lifeso, when explaining why she believed that an EARTH BALANCE nutrition bar would cause confusion in the marketplace, testified that “if consumers were looking for Balance products and, of course, we launch new Balance products within our space, as well, and that would, I think, add confusion at the shelf for consumers.”³⁶

Along these same lines, Mr. Cornacchiulo testified that Balance Bar’s most loyal customers tend to “be the first to try anything within our category or within the brand...”³⁷ More particularly, when asked how a loyal consumer might react upon seeing a nutrition bar including the term “balance” in its name, Mr. Cornacchiulo testified that “they would be the most exposed to trying that new product if the perception in their mind is it was similar or close into what they thought was a Balance product.”³⁸

The foregoing arguments are further supported by Applicant’s own admission that the term “balance” has “trademark and market significance,” a position it has taken before this Board in pending opposition proceeding 91194974 (a proceeding involving the marks SMART ONES and SMART BALANCE).³⁹ In fact, Applicant repeatedly stressed the trademark significance of the term “balance” during the oral hearing conducted in that pending proceeding.

³⁵ Cornacchiulo July 30 Dep. at 14:10-15:12.

³⁶ Lifeso July 30 Dep. at 37:25-38:5.

³⁷ Cornacchiulo May 1 Dep. at 40:3-5.

³⁸ Cornacchiulo May 1 Dep. at 40:6-12.

³⁹ BB Not. of Rel. 6, Exh. F at 22.

Applicant's testimony suggests that its EARTH BALANCE trademark is intended to communicate the right balance of great taste and good health, with a primary emphasis on heart health.⁴⁰ In other words, its EARTH BALANCE trademark communicates "balance" to the purchasing public. The BALANCE marks also communicate a sense of "balance" to the purchasing public and in fact, many of Balance Bar's advertising campaigns over the years have been centered around this same concept.⁴¹ The similar, if not identical connotation, of the term "balance" in both party's marks certainly increases the similarity between these marks. Mr. Cornacchiulo confirmed this point when he testified that loyal consumers would likely be confused when seeing a nutrition bar including the term "balance" in its name "because of the perception of what we stand for and our healthy life style perception, and what the brand image has been over the years."⁴²

Thus, this factor weighs heavily in favor of a likelihood of confusion.

4. The level of care exercised in purchasing the goods at issue is relatively low

The exercise of a low level of care by consumers in purchasing the goods at issue supports a determination of a likelihood of confusion. *See In re Martin's Famous Pastry Shoppe*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir 1984). If the goods are of relatively low cost, purchasers are less likely to use a great deal of care when buying the goods. *Nike, Inc. v. WBNA Enterprises, LLC*, 2007 WL 763166, at *9, 85 USPQ2d 1187, 1196 (TTAB 2007) (holding goods in the range of \$15-\$100 were "relatively inexpensive" such that "[i]t is unlikely that these products would be purchased with the exercise of a great deal of care."); *see also Specialty Brands*

⁴⁰ Little Dep, Exhs. 34, 36.

⁴¹ Lifeso April 30 Dep. Exh 4-9, 15-21.

⁴² Cornacchiulo May 1 Dep. at 40:18-25.

v. Coffee Bean Distrib., Inc., 748 F.2d 669, 672, 223 USPQ 1281, 1282 ("Purchasers of [relatively inexpensive] products have been held to a lesser standard of purchasing care.").

The evidence of record suggests that a not-insignificant portion of the purchases of snack bars are impulse-type purchases, and that they typically are not attended by great care and deliberation. For example, snack bars are often located at the check-out counter or along the check-out aisle of the retailer - making such an impulse-type of purchase more likely. Mr. Cornacchiulo, when specifically asked about the front counter product location, testified that "I think you have impulse buys in this category because it is -- it's an on-the-go nutrition. So, you'll see some impulse purchasing. There is no doubt about that."⁴³ The products are relatively inexpensive, and normally sell in the range of \$1.00-\$3.00.⁴⁴ And although Applicant will attempt to argue that its products are sold to health conscious consumers who may even read labels, such products are also sold to the public at large. So even assuming "some of the parties' more health-conscious consumers may be more careful in their purchase, [the Board] must base [its] decision on the least sophisticated potential purchasers." *General Mills, Inc. v. Fage Dairy Processing S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011); *see also Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301,1306 (TTAB 2004) (holding that the standard of care to be exercised is "equal to that of the least sophisticated consumer in the class"). Here, the least sophisticated potential purchasers would be members of the public at large who exercise a low degree of care when purchasing snack bars from an ordinary retail store.

⁴³ Cornacchiulo May 1 Dep. at 38:5-13.

⁴⁴ Lifeso April 30 Dep. at 146:4-16

Given the low degree of care and the relatively low price of the goods, consumers are more likely to be confused when they encounter Balance Bar's BALANCE marks and Applicant's EARTH BALANCE mark in the marketplace for the same or closely related goods.

Thus, this factor weighs heavily in favor of a likelihood of confusion.

5. There is no evidence that the BALANCE marks have been diluted by third-party use of similar marks

Applicant, by way of Notices of Reliance and certain affidavit testimony, has made of record a large number of third-party webpages and third-party products, which purportedly show third-party usage of trademarks including the term "balance". Applicant has also made of record a large number of trademark registrations including the term "balance".

"The probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports*, 396 F.3d at 1373, 73 USPQ2d at 1693. Here, there is no evidence of record showing the extent of usage, if any, of a BALANCE-formative mark by a third party in connection with snack bars. Balance Bar's use of its BALANCE marks is, without question, exclusive for the goods for which it is registered. Mr. Cornacchiulo, when asked whether any of Balance Bar's current competitors use the term "balance" in their trademarks, responded "No".⁴⁵

Third-party registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Accordingly, the TSDR pages submitted by Applicant for various third-party registrations do not prove that the marks identified therein are in use, or that the public is familiar with them. Similarly, neither the website excerpts nor the product packaging samples offered by Applicant establish that Balance Bar's rights in its BALANCE marks are in any way diminished.

⁴⁵ Cornacchiulo May 1 Dep. at 35:24-36:2; Cornacchiulo July 30 1 Dep. at 12:22-24 .

Balance Bar has used one or more of its BALANCE marks continuously and extensively for more than 20 years. As discussed herein, Balance Bar actively polices its BALANCE trademarks and takes appropriate action to stop third parties from using trademarks that it believes are confusingly similar. The record shows that Balance Bar consistently polices and opposes applications for "BALANCE" marks for use in connection with snack bars, supplements and related products.⁴⁶ The absence of any federal trademark registrations for similar marks on snack bars, indicates that Balance Bar's policing efforts have been successful.

Thus, for all of the foregoing reasons, this factor favors a finding of likelihood of confusion.

6. Applicant's likelihood of confusion study is entitled to little to no weight

Applicant has made of record in this proceeding a likelihood of confusion study prepared by Mr. Philip Johnson, an expert witness retained by Applicant. Applicant has also made of record the deposition testimony of Mr. Johnson taken in Proceeding No. 91196954 (per the parties' Stipulation). In sum, Mr. Johnson concluded that the measured level of confusion was 4.0% - thus leading to the conclusion that "use of the Earth Balance name in connection with all natural snack bars causes no likelihood of confusion with Balance Bar."⁴⁷ For the reasons discussed below, this conclusion is entitled to little to no weight.

Balance Bar retained Jacob Jacoby, Ph.D. to review and critique the Johnson study. Dr. Jacoby is a leading survey expert, who is well known in the field. In fact, among the entire field of survey experts, the American Bar Association selected Dr. Jacoby to author its recently-

⁴⁶ BB Not. of Rel. 5; Cornacchiulo May 1 Dep. Exh. 33-48; Cornacchiulo July 30 Dep. Exh. 50-51.

⁴⁷ Johnson Affidavit, Exh. 1 at ¶ 34, ¶36.

released handbook entitled Trademark Surveys. Although Dr. Jacoby noted and discussed a number of criticisms in his rebuttal reports, Dr. Jacoby's main criticism of the Johnson study is that Mr. Johnson used an improper survey format, thus ensuring a finding of little to no likelihood of confusion.⁴⁸

In particular, Mr. Johnson utilized what is referred to as the "Eveready" format in conducting his survey. Dr. Jacoby testified that use of the Eveready format is only appropriate in cases where the senior mark is highly accessible. Dr. Jacoby makes reference to an influential article by Jerre B. Swan entitled "Likelihood of Confusion Studies and the Straitened Scope of Squirt published in the May-June 2008 addition of The Trademark Reporter."⁴⁹ In particular, Mr. Swan states:

If, however, the senior mark is not accessible, it obviously cannot be cued irrespective of mark and product similarity. "When an open-end question [is] used [in connection with] a mark that is not particularly well known, it needs to be understood that the 'top-of-mind' awareness of the brand ... required [by the Eveready format] may significantly underestimate [likelihood of] confusion".⁵⁰

As explained further by Dr. Jacoby, unless a mark is readily accessible in memory (i.e., can easily be recalled by respondents without being aided or cued), there is little chance that when exposed to the allegedly infringing mark, the first-comer's mark will come to the fore in respondents' minds.⁵¹ The Swann article relied has now been cited by Prof. McCarthy for the same proposition. In particular, Prof. McCarthy states that "Swan has opined that: 'the squirt format is the alternative for testing the likelihood of confusion between marks that are weak, but are simultaneously or sequentially assessable in the marketplace for comparison.'" J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 32.173.50 (4th). Moreover, at

⁴⁸ Jacoby Affidavit, Exh. 1 at ¶¶ 9-12.

⁴⁹ BB Not. of Rel. 8, Exh. H.

⁵⁰ Id. at 745.

⁵¹ Jacoby Affidavit, Exh. 1 at ¶¶ 9-12.

least one court has also recognized the significance of the Swann article. Specifically, the Court in *Akiro LLC v. House of Cheatham*, 946 F. Supp. 2d 324, 339 (SDNY 2013) noted that “while the Eveready format is generally accepted and represents the ‘gold standard’ for cases involving strong marks, by design it will underestimate confusion for marks that are not highly accessible in a consumer's memory.” *Akiro*, 946 F. Supp.2d at 339.

As noted by Dr. Jacoby, Mr. Johnson never supplied any data to support the contention that the BALANCE marks are truly famous in the minds of consumers.⁵² In other words, Mr. Johnson never performed any independent tests to confirm that the BALANCE marks are truly famous prior to his choice of survey format. Nor apparently did Mr. Johnson inquire with Applicant's counsel regarding whether any documentation to this effect had been produced by Balance Bar. This point is particularly relevant because Balance Bar had produced documentation directed to brand awareness, including an April 2013 Tracker showing an unaided awareness level of approximately [REDACTED]⁵³, and an August 2013 Tracker also showing an unaided awareness level of approximately [REDACTED]⁵⁴ This documentation was in the hands of Applicant's counsel, but was never provided to Mr. Johnson, nor apparently requested by Mr. Johnson.⁵⁵

Dr. Jacoby explained during his testimony that because the BALANCE marks have a low level of unaided awareness, it would be inappropriate to use the Eveready format to measure confusion because doing so “will underestimate likely confusion.”⁵⁶ Rather, Dr. Jacoby testified

⁵² Jacoby Affidavit, Exh. 1 at ¶ 11.

⁵³ Cornacchiulo May 1 Dep., Exh. 49 at 5.

⁵⁴ Johnson Affidavit, Exh. 2 (See Applicant's Exh. 28 attached to Johnson Dep.).

⁵⁵ Jacoby Affidavit, Exh. 1 at ¶¶ 11-12; Johnson Affidavit, Exh. 2 at 51:5-2:22.

⁵⁶ Jacoby Affidavit, Exh. 2 at 17:22-19:3.

that a modified squirt format would be appropriate in this type of scenario.⁵⁷ Dr. Jacoby also testified that he most certainly would have wanted to review the brand awareness documents produced by Balance Bar, and that it has become his practice to request any such documents at the beginning of a new proceeding.⁵⁸

For all the foregoing reasons, the likelihood of confusion study and testimony offered by Applicant should be given little to no weight, and this factor should be considered as neutral.

7. These same issues have already been disputed by the parties

The final enumerated *du Pont* factor permits consideration of any other established fact probative of the effect of use. Here, the parties have already disputed these same issues. Back in August 12 of 1999, Balance Bar filed an intent-to-use trademark application (Serial No. 75/774,542) for the mark BALANCE for use in connection with a variety of goods including butter and butter substitutes, cheese and cheese foods, dairy-based dips and breakfast cereals. The mark was published for opposition on August 8, 2000. Following publication of the mark, a letter dated August 25, 2000 was sent on behalf of GFA Brands (the Applicant herein) to Balance Bar stating that “use by Balance Bar of the BALANCE mark would cause confusion, deception or mistake among consumers.”⁵⁹ GFA also stated that “use and registration of this name tends to dilute the distinctiveness of GFA Brands’ BALANCE marks.”⁶⁰ It is noteworthy that GFA believes it owns a group of “BALANCE” marks. (In fact, even today GFA refers internally to its Smart Balance and Earth Balance brands as its “Balance Brands”.⁶¹) Balance

⁵⁷ Jacoby Affidavit, Exh. 2 at 42:7-24.

⁵⁸ Jacoby Affidavit, Exh. 2 at 20:18-21:3.

⁵⁹ BB Not. of Rel. 3, Exh. B.

⁶⁰ Id.

⁶¹ BB Not. of Rel. 7, Exh G1 at 11:7-10, Exh. G2; Little Dep. at 89:21-90:4.

Bar subsequently agreed to delete the foregoing mentioned goods from its application, and GFA agreed not to oppose such application.

Several years later in 2005, GFA filed a first trademark application (Serial No. 78/554,482) for the mark EARTH BALANCE in connection with dried, ready-to-eat fruit and vegetable bars, and a second trademark application (78/725,472) for the mark FRUIT BALANCE in connection with dried, ready-to-eat fruit and vegetable bars. By letter dated July 12, 2006, Balance Bar's counsel at that time contacted GFA objecting to the registration of these two marks in connection with fruit and vegetable bars, and to the appearance in the marketplace of a fruit bar product bearing the EARTH BALANCE mark.⁶² Balance Bar's counsel reminded GFA of the earlier dispute occurring in 2000, and noted that “there is no legitimate basis to take a contrary position now that it is GFA that is the second-comer to the marketplace for Kraft’s core product for the BALANCE® brand, namely, food bars.”⁶³ Approximately one month later, on August 14, 2006, GFA expressly abandoned both of these applications. Sales of fruit bars in the marketplace under the EARTH BALANCE mark were subsequently discontinued.

In an attempt to explain away the outcome of this earlier dispute, Applicant has offered testimony from Howard Seiferas that sales of the EARTH BALANCE fruit bars were discontinued due to a failure to meet the company's sales goals.⁶⁴ However, Mr. Seiferas also testified that he was not directly involved in the decision to discontinue sales of the product⁶⁵, that the owner of the company would have made such a decision⁶⁶, that he was not aware of the

⁶² BB Not. of Rel. 3, Exh. R.

⁶³ Id.

⁶⁴ Seiferas Dep. at 11:24-22.

⁶⁵ Seiferas Dep. at 12:8-13; 19:5-9.

⁶⁶ Seiferas Dep. at 19:10-20.

2006 letter sent to GFA by Balance Bar⁶⁷, and that he was not aware that GFA had expressly abandoned the 2005 EARTH BALANCE application.⁶⁸ Looking at all the facts, it seems highly implausible that GFA's decision to discontinue sales of its EARTH BALANCE fruit bars (and expressly abandon its two pending applications) was due solely to a failure to meet sales goals.

Following this last dispute between the parties in which Balance Bar objected to both the use and registration of a trademark including the term "balance" for use in connection with snack bars, and GFA's abandonment of its two pending applications and its discontinuance of sales of fruit bars under the EARTH BALANCE mark, it is difficult to understand why Applicant now believes it is entitled to use its EARTH BALANCE in connection with the sale of similar, if not identical, products.

Thus, this factor weighs heavily in favor of a likelihood of confusion.

8. Applicant's prior actions and statements amount to an admission that confusion is likely

Balance Bar submits that Applicant's enforcement strategy as to its SMART BALANCE and EARTH BALANCE marks is highly probative, and essentially an admission, of a likelihood of confusion between Balance Bar's BALANCE marks and Applicant's EARTH BALANCE mark for directly overlapping goods.

Applicant has long taken the position that third parties should not be permitted to register marks containing the term "BALANCE" for use in connection with various food products in view of its SMART BALANCE trademarks for buttery spreads and related goods. For example, Applicant has objected to the registration of third-party applications such as NEW BALANCE, IDEAL BALANCE, DAILY BALANCE, TODAYS BALANCE, CARB BALANCE, SARGENTO BETTER BALANCE, HEALTHY BALANCE, PERFECT BALANCE, LEAN

⁶⁷ Seiferas Dep. at 18:25-19:4.

⁶⁸ Seiferas Dep. at 20:18-22.

BALANCE, NATURE'S BALANCE, TRUE BALANCE, EPA-DHA BALANCE, PERFORMANCE BALANCE, RIGHT BALANCE, and SALT BALANCE.⁶⁹ In each of these instances, Applicant objected to the third-party application, arguing that its registrations for SMART BALANCE and EARTH BALANCE should bar registration of such third-party application.⁷⁰ In fact, Applicant repeatedly refers to its SMART BALANCE and EARTH BALANCE registrations as its "BALANCE marks".⁷¹ Applicant filed formal oppositions against many of these applications.

Thus, Applicant has, for many years, used its own SMART BALANCE registrations to prevent others from registering a mark containing the term "balance", even though such applications did not include the term "smart". In other words, Applicant has argued for years that it has trademark rights in the term "balance" when used on or in connections with buttery spreads and related goods. It now tries to distance itself from its own prior course of conduct by having its in-house counsel testify that the company's enforcement policies have evolved over time to reflect current market realities.⁷² Whether Applicant has or has not changed its enforcement policy over the years is irrelevant to the argument that Applicant has repeatedly taken the position (including in pending Opposition No. 91194974 discussed hereinabove in Section V.B.3.) that it has trademark rights in the term "balance" when used on or in connection with buttery spreads and related products. But now when it is Applicant being challenged about use of the term "balance" on goods other than buttery spreads, its response is that you cannot consider the term "balance" alone, but must consider the EARTH BALANCE mark as a whole,

⁶⁹ BB Not. of Rel. 3, Exh. A, C-Q.

⁷⁰ Id.

⁷¹ Id.

⁷² GFA Not. of Rel. 8, Kraft Dep. at 11:13-12:11.

together with other alleged third party uses of “balance” in the marketplace. Of course, Applicant never raised such arguments in any of its prior disputes.

Thus, this factor weighs heavily in favor of a likelihood of confusion.

9. An analysis of the relevant factors indicates that confusion is likely

In sum, the evaluation of all the evidence of record demonstrates the existence of a likelihood of confusion between Balance Bar’s BALANCE marks and Applicant's EARTH BALANCE mark, when that mark is used in connection with nut and seed-based snack bars. In short, consumers familiar with Balance Bar’s BALANCE goods, who then encounter Applicant's EARTH BALANCE mark being used on identical and closely related goods, are likely to be confused as to the source of the goods.

D. Applicant's affirmative defenses are without legal or evidentiary support

Applicant's Answer sets forth two purported affirmative defenses, namely: that Balance Bar’s claims are barred by laches or acquiescence; and that confusion is unlikely due to the difference between the parties' marks, the lack of actual confusion, and the co-existence of Applicant's existing EARTH BALANCE registrations with Opposer’s marks. Neither of these so-called defenses is tenable.

As to Applicant's first Affirmative Defense that Opposer's claims are barred, in whole or in part, by the doctrines of laches and acquiescence, it is well-settled that there can be no laches or acquiescence with respect to the applications at issue because Balance Bar timely and properly opposed registration of the intent-to-use applications during the opposition period following publication. See TBMP § 311.02(b). Applicant’s second affirmative defense is nothing more than a denial of Balance Bar’s pleaded claim, and thus does not amount to an affirmative defense.

Accordingly, both of Applicant's purported affirmative defenses fail.

VI. CONCLUSION

For 20 years prior to Applicant's filing of the application at issue, Balance Bar has been continuously using one or more of its BALANCE marks in connection with the sale of snack bars. Allowing Applicant to register the EARTH BALANCE mark for nut and seed-based snack bars would create a likelihood of confusion, mistake, or deception, would erode the distinctiveness of the BALANCE marks as a unique identifier of the source of the products sold by Balance Bar, and would injure both Balance Bar and the consuming public.

Accordingly, Balance Bar respectfully requests the Board to sustain this opposition proceeding and refuse registration of Applicant's application.

Respectfully submitted,

Dated: 2 February 2015

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **OPPOSER'S TRIAL BRIEF** has been served via US mail and email this 2nd day of February 2015 upon the following:

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