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

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Applicant	Soccer Grass Sport Turf, LLC
Applied for Mark	TERRA TURF
Correspondence Address	MARK D. BOWEN MALIN HALEY DIMAGGIO & BOWEN, P.A. 4901 NW 17TH WAY FORT LAUDERDALE, FL 33309 UNITED STATES info@mhdpatents.com 9547633303
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Filer's Name	Kristina M. DiMaggio
Filer's email	info@mhdpatents.com
Signature	/Kristina M. DiMaggio/
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: Soccer Grass Sport Turf, LLC

Serial No.: 88234940

Filed: December 19, 2018

Mark: **TERRA TURF**

Examining Attorney: Daniel Capshaw

Law Office: 110

APPLICANT'S BRIEF ON APPEAL

Mark D. Bowen
Kristina M. DiMaggio
MALIN HALEY DIMAGGIO & BOWEN, P.A.
4901 NW 17th Way, Suite 308
Fort Lauderdale, FL 33309
Email: Info@mhdpatents.com
Tel: (954) 763-3303

Attorneys for Applicant

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INTRODUCTION

Pursuant to the Notice of Appeal filed with the Trademark Trial and Appeal Board on November 7, 2019, Applicant, Soccer Grass Sport Turf, LLC, appeals from the Examining Attorney's final refusal to register the mark **TERRA TURF** in connection with the "Installation, maintenance and repair of artificial sport fields" in International Class 037.¹ The Examining Attorney has refused registration on the basis of likelihood of confusion under § 2(d) of the Lanham Act with Registration No. 4604077, see mark depicted below.



Applicant requests the refusal to register be reversed because there is no likelihood of confusion between Applicant's mark and the cited mark when applied to their respective services, channels of trade, target consumers and based on the differences in the marks' appearance, sound, meaning and commercial impressions.

DESCRIPTION OF THE RECORD

The record consists of the original application papers and subsequent prosecution history including Applicant's Response to Office Action dated April 18, 2019 and Applicant's Request for Reconsideration and amended identification of services dated November 7, 2019 which the Examining Attorney has not responded to yet.

¹ Applicant amended the identification of goods to delete "synthetic lawns" with its request for reconsideration in response to the Examining Attorney's final office action.

PROSECUTION HISTORY

Applicant filed its application for the mark **TERRA TURF** on December 19, 2018 in connection with “Installation, maintenance and repair of artificial sports fields and synthetic lawns” in International Class 037. On March 18, 2019, the Examining Attorney issued an initial Office Action on the basis of § 2(d) likelihood of confusion with Registration No.



4604077 for the mark (the “cited mark”) in connection with “installation of synthetic lawns; consultation services relating to landscape renovation and minimizing the impact on lawns, plants and trees; repair and maintenance of irrigation systems” in International Class 037. Note, the registration also covers comprehensive landscape and tree care services and landscape gardening consulting and design services in International Class 044. While these services in Class 044 are not the basis for refusal, they are relevant to further distinguish the respective services. The Examining Attorney also required a disclaimer for the term “TURF.”

On April 18, 2019, Applicant filed its response to the initial office action complying with the disclaimer for the term “TURF” and replied with supporting arguments and evidence that there is no likelihood of confusion with the cited mark. Applicant argued the marks differ in appearance, sound, meaning and commercial impression. Additionally, Applicant argued that the marks cover different services which are sold through different trade channels, marketed to different consumers, sophisticated consumers, resulting in no likelihood of confusion. Applicant submitted third party registered marks sharing the term TERRA in connection with related services as evidence the term is diluted in the marketplace. Based on its arguments, Applicant requested that

the Examining Attorney withdraw the refusal to register and allow the mark to proceed to publication.

On May 10, 2019, the Examining Attorney issued a Second and Final Office Action maintaining the refusal to register on the basis of § 2(d) with Registration No. 4604077 for the mark TERRA LANDSCAPE and Design. On November 7, 2019, Applicant filed its Notice of Appeal and simultaneous Request for Reconsideration in response to the Final Office Action where Applicant amended its services to delete “synthetic lawns,” resulting in the identification of services as “installation, maintenance and repair of artificial sport fields” in Class 037. Applicant incorporated its original arguments and further argued that the amended services clarify the differences between the services and marketing of such services, and that the respective marks when viewed in their entireties are sufficiently dissimilar and create different commercial impressions thereby avoiding any likelihood of confusion. As of yet, the Examining Attorney has not responded to Applicant’s Request for Reconsideration. Therefore, Applicant is timely filing this appeal brief.

ARGUMENT

A. The Marks When Viewed in Their Entireties are Sufficiently Dissimilar and Create Different Commercial Impressions Rendering Confusion Unlikely

When analyzing the first factor under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), the similarities or dissimilarities of the marks must be considered based on the marks in their entireties. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985); TMEP § 1207.01(b). As a general rule, conflicting marks are to be looked at as a whole rather than dissecting the marks into individual components. It is the overall impression that the mark as a whole creates on the average person, rather than the parts thereof, that is important. *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 38 U.S. P.Q.2d

1937 (8th Cir. 1996); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 273 (CCPA 1974).

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); TMEP § 1207.01(b)(iii).

In this case, considering the marks as a whole it is apparent they look different, sound different and create different meanings and commercial impressions due to the variations in additional terms and design elements. Both marks are composite marks and as such comparison must be done on a case by case basis without reliance on mechanical rules of construction. *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion); TMEP § 1207.01(c)(ii).

Here, the Applicant's mark **TERRA TURF** is horizontal in stylized font with design elements in the letter "T" and consists of the additional term TURF. Whereas, the cited

mark is vertical and consists of a prominent design element of two suns, stylized font and the additional term LANDSCAPE as depicted below.



The marks are visually dissimilar and phonetically different as the additional terms change the overall pronunciation of the marks.

While both marks share the term TERRA, the differences in the respective composite marks are obvious and the additional terms in each mark create separate and distinct commercial impressions such that consumers will not be confused as to the source of services. The term TURF as used in Applicant's mark conveys the impression of a layer of grass and also cleverly suggests "territory" in the context of Applicant's services for artificial sport fields, i.e. a team's territory. See slang definition in Applicant's response to office action as well as the definition from Bing search engine provided herein:

Turf

[tɜrf]

NOUN

turfs (plural noun) · **turves** (plural noun) · **the turf** (noun)

1. grass and the surface layer of earth held together by its roots.
"they walked across the springy turf"
2. (the turf)
horse racing or racecourses generally.
"he spent his money gambling on the turf"
3. informal
an area regarded as someone's personal territory; one's home ground.
"the team will play Canada on their home turf this summer"

In contrast, the additional term “LANDSCAPE” and design of two suns as used with Registrant’s synthetic lawns, landscape and gardening services clearly conveys the idea of natural scenery, and maintaining the appearance of such trees, plants and lawns. The design of two suns in Registrant’s mark is prominently featured and may be considered the dominant portion of the mark. Thus, the additional use and placement of the words with the additional terms and designs as used in connection with the respective services create differences in the marks overall and create unique commercial impressions which suggest different meanings to buyers so there is no likelihood of confusion. *See Taj Mahal Enterp. Ltd. v. Trump*, 745 F. Supp. 240, 15 USPQ2d 1577 (D.N.J. 1990) (the mark TAJ MAHAL for an Indian restaurant and the mark TAJ MAHAL for a casino-hotel held not confusingly similar because the former suggests Indian food whereas the latter suggests opulence); 4 *McCarthy on Trademarks and Unfair Competition*, § 23.30 (4th ed.); *See, e.g., In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); TMEP § 1207.01(c)(ii).

B. The Shared Term “TERRA” is Diluted in the Marketplace such that Consumers Will Not View the Term as Dominant, but Instead Will Look to the Differences Between the Marks and Will Not be Confused

Additions or deletions to marks may also be sufficient to avoid a likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase “City Bank” is frequently used in the banking

industry and that “CAPITAL” is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks); TMEP § 1207.01(b)(iii). If the common element of two marks is “weak” it is unlikely that consumers will be confused unless the overall combinations have other commonality. *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); TMEP § 1207.01(b)(viii).

Here, the only common matter between the composite marks is the shared term “TERRA” and this term is diluted in connection with earth, land, lawns, and related goods and services. Applicant previously provided numerous third-party registrations including the term “TERRA” for such goods and services as evidence the term is weak and entitled to limited scope of protection. See Applicant’s Response to Office Action, Exhibit A. Therefore, consumers will notice the differences between the marks such that the additional terms and design elements will distinguish the marks in their entirety and there is no likelihood of confusion. *See, In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I’M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN’ HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions).

C. Applicant’s Services and Channels of Trade are Sufficiently Dissimilar and Marketed Differently than Those Covered by the Cited Mark Therefore Confusion is Unlikely

Continuing with the *Du Pont* factors, the relatedness of the goods or services and similarity or dissimilarity of established and likely to continue channels of trade must be considered. 476 F.2d at 1361. The nature and scope of the goods or services must be determined by the identification of goods listed in the application or registration. *Coach Servs., Inc. v. Triumph*

Learning LLC, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); TMEP § 1207.01 (a)(iii). If the goods or services are unrelated or marketed in such a way that consumers are not likely to confuse the source of the products, then even if the marks are identical, which here they are clearly not, there is no likelihood of confusion. *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by); TMEP § 1207.01 (a)(i).

Here, the identification of services in the application and cited registration clearly differentiate the services so confusion is unlikely. Applicant's services are listed as "installation, maintenance and repair of artificial sport fields" in Class 037, narrowly tailored to its niche market. In contrast, Registrant's services are listed as "installation of synthetic lawns; consultation services relating to landscape renovation and minimizing the impact on lawns, plants and trees; repair and maintenance of irrigation systems" in Class 037 and also "comprehensive landscape care, namely, mowing, fertilization and aeration of lawns, pruning, fertilization and aeration of shrubs; landscape gardening services in the nature of planting of lawns, shrubs and trees; comprehensive tree care, namely, thinning, cabling, surgical corrective pruning, shaping, planting and removal of trees; landscape gardening consulting services relating to disease and pest control strategies for turf, plants and trees, namely, diagnosis, developing integrated control strategies, planting, and long range planning for the care of trees and landscape gardens; landscape design" in Class 044.

While the Examining Attorney based the refusal on Class 037 specifically the installation of "synthetic lawns," Applicant's services are narrowly listed to clarify its market for sport fields, soccer and football fields for example, and are not related to the lawn care, landscaping and

gardening services of Registrant for maintaining, the appearance and pruning and fertilizing of trees, plants and shrubs such as in a garden, yard or park. Applicant's consumers are sporting facilities, specifically for the actual field of play, and Applicant's services for artificial sport fields serve a functional purpose for a niche market, for sport fields to withstand team games. Whereas Registrant's consumers are distinct as its services are primarily intended for aesthetic purposes, for the appearance of nature and surrounding scenery. Thus, the respective services are not related and are not marketed to the same consumers, nor provided through the same trade channels such that consumers will not be confused as to the source of services. *See Dynacolor Corp. v. Beckman & Whitely, Inc.*, 134 USPQ 410 (TTAB 1962) (sales to photo-finishers in different channel of trade from sales of expensive cameras); *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 209 USPQ 936 (S.D.N.Y. 1980) (use of similar titles both containing the term "find" on magazines held not likely to cause confusion where one was directed to specialized business clients and the other to consumer families).

D. Purchasers of Applicant's Services are Sophisticated and Will Not be Confused as to the Source of its Services

Lastly, in this case it is necessary to give weight to the sophistication of purchasers due the nature and expense of Applicant's services. *In re E. I. du Pont*, 476 F.2d at 1361 (CCPA 1973). Applicant's consumers are sophisticated commercial purchasers in the sporting industry with knowledge about sport fields and the complex installation for large fields. Such professional buyers are less likely to be confused than the average consumer. *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed. Cir. 1983). Moreover, Applicant's services are expensive due to the nature of installing large and complex artificial sport fields for commercial buyers. Thus, the expensive nature of Applicant's services would require consideration before purchase. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ

969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006); TMEP § 1207.01(d)(vii). Thus, because of the expense of the services and the fact that Applicant's consumers are commercial customers with knowledge in their field, purchasers will think before buying and make informed decisions so there is no likelihood of confusion as to the source of products. The decision to purchase a product made only after careful examination of the product tends to negate a likelihood of confusion. *Stouffer Corp. v. Health Valley Natural Foods, Inc.*, 1 USPQ2d 1900 (TTAB 1986); *In re Software Design, Inc.*, 220 USPQ 662 (TTAB 1983).

CONCLUSION

Due to the differences in the overall impressions of the marks, non-competitive services, unrelated channels of trade and sophisticated purchasers, it is respectfully submitted that there is no likelihood of confusion between Applicant's mark and the cited mark. Applicant respectfully requests that the Board reverse the refusal to register and allow Applicant's mark to proceed through the registration process.

Dated: January 6, 2019

Respectfully submitted,

MALIN HALEY DIMAGGIO & BOWEN, P.A.
By: /Kristina M. DiMaggio/
Mark D. Bowen
Kristina M. DiMaggio
4901 NW 17th Way, Suite 308
Fort Lauderdale, FL 33309
Email: Info@mhdpatents.com
Tel: (954) 763-3303

Attorneys for Applicant