

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Matter of

SPARK Brands Trading

Examiner: David A. Brookshire

U.S. Serial No: 87/840232

Law Office 114

Filed: March 19, 2018

Mark: GAIA & Design

NO FEE

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

This is responsive to the Office Action dated February 12, 2019.

REMARKS

The examining attorney has initially refused registration of applicant's GAIA & Design mark under Trademark Act Section 2(d) citing a prior U.S. registration for the mark CULT GAIA, No. 5527912, registered for jewelry in Class 14 and handbags in Class 18. Applicant must respectfully disagree with the examining attorney that its mark GAIA & Design should be viewed as confusingly similar to the cited registration for CULT GAIA for the following reasons.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. In testing for likelihood of confusion under Section 2(d) of the Trademark Act, the similarity or dissimilarity of the marks as compared in their entireties must be considered as to overall appearance, sound, connotation, and commercial impression. *See In re E.I. du Pont & de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant submits in determining whether confusing similarity exists, the marks at issue should not be dissected into their component parts while downplaying or ignoring significant differences that may make the marks distinguishable from one another. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981).

While the registrant's and applicant's marks may share some similarities, the differences between the marks cannot be ignored. It is well-established that a likelihood of confusion analysis must consider the commercial impressions of the respective marks in their entireties and that selected common elements cannot be singled out to the exclusion of distinguishing features, including differences in overall visual appearance of the marks. *See Tricia Guild Assocs. v. Crystal Clear Industries, Inc.*, 38 USPQ2d 1313, 1316 (TTAB 1994) (while the marks DESIGNER'S GUILD and THE DESIGN GUILD share similarities which are too obvious to discuss, nevertheless the differences, however slight, are sufficient to convey different connotations and commercial impressions). *See also United Foods Inc. v. United Airlines Inc.*, 41 USPQ2d 1653, 1663 (TTAB 1995) (no likelihood of confusion between UNITED EXPRESS for transportation and freight by truck and UNITED EXPRESS (Stylized) for air transportation of passengers and freight).

The presence of common words or common lettering in respective marks does not necessarily create a likelihood of confusion because the TTAB and courts "are not concerned with mere theoretical possibilities of confusion, deception or mistake, or with *de minimus* situations, than with the practicalities of the commercial world with which the trademark laws deal".



In this case, a side-by-side comparison of applicant's mark **GAIA** and registrant's mark **CULT GAIA** reveals obvious differences and distinctions between the two marks. It is believed a consumer in this case would clearly distinguish each mark individually when they are compared visually and phonetically to one another. Although in this case, both marks share the term "GAIA," prospective purchasers are likely to encounter the marks visually as well as orally, and the marks differ significantly in overall appearance and pronunciation. *Information Resources Inc. v. X*Press Info. Serv.*, 6 USPQ2d 1034, 1038-39 (TTAB 1988) (No confusion between EXPRESS and X*PRESS due in part to different visual impression between the marks).

While it is believed that a comparison of applicant's mark to the cited registrant's mark does not create a likelihood of confusion simply based on the obvious differences between the marks, it is also

believed that the cited registrant's mark for CULT GAIA is entitled to a narrow scope of protection in this case due to the current numerous coexisting registrations for marks that include the term GAIA as connected to similar or related products or services within proximity of registrant's relevant classes, including the following:

<u>Mark</u>	<u>Registration No.</u>	<u>Class/Goods</u>
GAIA	4730020	Cl. 3: herb or organic based cosmetic preparations, namely, skin and body lotions, creams and oils
GAIA HERBS	4718773	Cl. 3: herb-based cosmetic preparations, namely, skin and body lotions, creams and oils
GAIA	3291704	Cl. 3: cologne, perfume, eau de toilette, eau de perfume, talcum powder, deodorant for personal use, antiperspirant, body lotion
OPUS GAIA (Stylized w/Design)	4550340	Cl. 3: essential oils for personal and aromatherapy use
GAIA	4722198	Cl. 3: herb-based breath freshener; herb-based cosmetic preparations, namely, oil or wax body care products, namely, lotions, salves, and balms Cl. 5: organic or herb-based energy and antioxidant aids in the form of dietary supplements; organic or herb-based cough syrup; organic or herb-based digestive aids in the form of dietary supplements; organic or herb-based ear drops; organic or herb-based diuretics; botanical derived iron in the form of a liquid dietary supplement
SMILING GAIA	5316717	Cl. 24: burp cloths; swaddling blankets; towels; washcloths
GAIA GIRLS	5811604	Cl. 25: apparel, namely, tops, pants, jackets, coats, dresses, and skirts
GAIA CONCEPTIONS & Design	4894563	Cl. 25: organic clothing for women, children, and men, namely, dresses, pants, shirts, skirts, jackets, sweaters, leggings, shawls, gauchos, shorts, under garments

<u>Mark</u>	<u>Registration No.</u>	<u>Class/Goods</u>
PANGAIA	5859508	Cl. 25: footwear; caps being headwear; boots; half- boots; lace boots; neck scarves; underwear, underclothing; hoods; cap peaks; belts for clothing; sweaters, pullovers, jumpers; hats; headwear; suits; ready-made clothing, namely, ready-made linings being parts of clothing; babies' pants; outer clothing, namely, puffer jacket, vest, puffer vest, coats, hats, gloves as clothing; scarfs, scarves; knitwear, namely, sweaters, dress, girdles; vests, waistcoats; coats; waterproof clothing, namely, waterproof jackets and pants, waterproof t-shirt, waterproof shirt; leggings; jerseys; skirts; sports jerseys; aprons; . . .
GAIA REPOSSI	4838851	Cl. 3: perfumes; toilet water, eau de cologne, essential oils, oils for cosmetic use, oils for toilet use, oils for perfumes and scents, cosmetics, cosmetic creams for skin care, cosmetic preparations for skin tanning, cosmetic creams, . . Cl. 14: precious metals and their alloys other than for dental use and goods in these materials or coated therewith, namely, rings, earrings, charms, brooches, jewelry chains, watch chains, necklaces, pins, ornaments, . . . Cl. 25: clothing, namely, shirts, tights, underwear as lingerie, suits, neckties, skirts, trousers, dresses, headgear in the nature of hats, scarves, headbands, hosiery, caps, collar protectors, sashes for wear, stoles, shawls, belts, gloves, footwear, socks Cl. 35: advertising, dissemination of advertising matter, publication of advertising texts, business management, business management and organization consultancy
GAIA FORGIVE US!	3600466	Cl. 16: posters, postcards, photographic prints, picture postcards, merchandise bags, greeting cards, art pictures, decals, stickers Cl. 21: cups; mugs Cl. 25: clothing, namely, jackets, shirts, t-shirts, sweatshirts, shorts, pants, sweatpants, caps

Status copies of the registrations as obtained from the USPTO TSDR database are attached as Exhibit A.

In addition, a collection search in the USPTO registration records revealed seventy-two (72) issued registrations that include the term "GAIA" alone or "GAIA" with additional wording for a range of products and services.

In this case, due to the current coexistence of so many marks that include the term "GAIA," it is believed that the cited registrant and its mark CULT GAIA are entitled to a narrow scope of protection as it relates specifically to Class 14 jewelry and Class 18 handbags. While applicant concedes that some of its products under its GAIA & Design mark are leather bags in Class 18, it is believed that the analysis in connection with confusing similarity and a comparison of the respective marks negates any likelihood of consumer confusion in this case.

For the foregoing reasons, it is requested the examining attorney withdraw the refusal to register applicant's GAIA & Design mark and allow the application to proceed to publish for opposition purposes at the earliest possible date.

If any further amendments are required, the Examining Attorney is encouraged to contact the undersigned by telephone.

Respectfully submitted,

SPARK Brands Trading

/JHD/

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Dated: November 8, 2019.