

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **88457723** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant BECAUSE BABIES, LLC (“Applicant”) responds as follows to the Non-Final Office Action, issued in connection with Application Serial No. **88457723** for the mark EARTHLY.

LIKELIHOOD OF CONFUSION REFUSAL

The Examining Attorney has refused registration of applicant’s standard character EARTHLY mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with these marks in Registration No. U.S.3632781, 4015117, 4390882, 4728187, 4974535 and 5626465. For the following reasons, applicant respectfully disagrees with this finding and requests that the Examining Attorney reconsider the statutory refusal and allow registration of applicant’s mark.

Likelihood of confusion between two marks at the USPTO is determined by a review of all of the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, “there is no mechanical test for determining likelihood of confusion and ‘each case must be decided on its own facts.’” TMEP § 1207.01 (*citing du Pont*, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen du Pont factors may be considered in weighing likelihood of confusion, if raised, and anyone may be dispositive. *See* TMEP § 1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, the existence of a valid

consent agreement between the parties, or another established fact probative of the effect of use. *Id.*

Here, applicant seeks registration of the standard character mark EARTHLY for providing baby wipes specifically.

There is no likelihood that consumers will be confused as to the source of goods in connection with each of these marks because applicant's mark is different in appearance, meaning, and commercial impression. In addition, the nature of compared goods is totally different. Finally, compared with goods of cosmetics, soap, and hair care goods by cited marks' owners, wipes for babies by applicant is specialized and purchased for specialized consumers, being noncompetitive with cited mark. Therefore, applicant respectfully requests the Examining Attorney withdraw the refusal and permit applicant's mark to be published on the Principal Register.

The Similarities of the Marks

Of the those cited registered marks by the Examining Attorney, "EARTHLY HERBALS", U.S. Registration No. 4390882 and "EARTHLY HEALTHY", U.S. Registration No. 4728187, have different drawing types with applicant's marks, where the two registrations have the design element, differing from standard characters mark applied by applicant. The design and stylized elements in the cited marks and design marks arguably contain an additional point of difference with applicant's mark. Customers of registrations who are exposed to the mark's design and model in their products, are likely to distinguish the design marks from applicant's mark because the elements involving a flower between words and leaves combined with words impressed in customers' minds.

Of the those registered marks by the examining attorney, "EARTHLY BOTANICALS", U.S. Registration No. 3632781, "EARTHLY BODY", U.S. Registration No. 4015117, "EARTHLY AROMAS", U.S. Registration No. 4974535, and "EARTHLY SUDS CO.", U.S. Registration No. 5626465, have additional typed words compared to the applicant's mark, while they comprise the identified word in marks, "EARTHLY". Customers who are sensitive to products and brands in cosmetics industry are less likely to confuse source with different marks.

Differences in Nature of the Goods and Channels of Trade

"A wide variety of products, not only from different manufacturers within an industry

but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed". See *Canada Dry Corp. v. American Home Products Corp.*, 468 F.2d 207, 175 USPQ 557 (Cust. & Pat.App.1972). The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks. Applicant's goods is restricted to wipes, but other registrant's goods are cosmetics. Undeniably, wipes and cosmetics hold strikingly dissimilarities in nature. First, they associate with different goods categories and industries. For example, they are located in different shelves in merchandise. Secondly, the chemical composition between two products are remarkably distinguishable. Thirdly, the reusable function of applicant's wipes renders applicant's goods disparate from other cosmetics. Consumers would likely fail to adduce any evidence of a nexus between two types of products in the mind of the consumers which would negate the above-noted obvious dissimilarities. To sum up, the cumulative differences between the respective goods and the respective marks are sufficient to preclude likelihood of confusion or mistake.

In addition, there are distinctive dissimilarities in channels of trade. In assessing the similarity of channels of trade and classes of consumers or users, courts must determine whether there is likely to be an overlap between the respective purchasers/users of the goods and services of the parties to confuse actual and potential purchasers/users. *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992); see also TMEP §1207.01(a)(iii): [W]here both applicant's goods and opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because "applicant' sells some of its goods in some of the same fields in which opposer provides its services," without determining who are the "relevant persons" within each corporate customer. This is especially true where, as here, the Board acknowledged that "applicant's goods are specifically different and noncompetitive." The respective products and services of applicants and other registrants are different and noncompetitive. applicant's shipment services are marketed towards "baby or young child". In contrast, registrant's cosmetics and soaps are marketed toward "adults" who are pursuing beauty or paying attention on their appearance. Likewise, the same individuals who use registrant's cosmetics are not confused with the applicant's mark. There is no basis to presume that the same individuals who use applicant's goods are also the same individuals who purchase and use registrant's

goods. None of the markets for the respective goods overlap, and thus the parties' channels of trade are separate, noncompetitive and distinct.

The Degree of Care and Sophistication of Consumers in the Relevant Goods

Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *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); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). "In a market with extremely sophisticated buyers, the likelihood of consumer confusion cannot be presumed on the basis of similarity in trade name alone." *Perini Corp. v. Perini Const., Inc.*, 915 F. 2d 121, 128 (4th Cir. 1990).

Similar to *Primrose*, for cosmetics questers, those purchasers would focus on the quality in beauty aspect for themselves. For example, they focus on the ingredient of cosmetics and the beauty effect, which makes customers look good.

Unlike the owners of those registration, applicant provides its goods to parents who have a baby or child with a young age in creating or building a health safely environment for their babies. On the other hand, the customers of applicant would like to invest more time on investigating the purchasing goods. As such, applicant's customer base is more sophisticated and likely to pursue a high degree of care in connection with baby products; and thus, this factor heavily weighs against a likelihood of confusion refusal.

The Shared Term in Marks is Commercially Weak

"Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights." *Sure-fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158 (CCPA 1958). Widespread use of those registrations of the shared term for purchasing and delivering services have weakened the trademark significance of the term and the scope of protection afforded to the cited registrant's mark. Evidence establishing that the consuming public is exposed to use of similar marks on similar goods "is relevant to show that a mark is relatively weak and **entitled** to only a narrow scope of protection." *Palm Bay Imports*, 396 F.3d at 1373. If the common element of two marks, here referring to

“EARTHLY”, is “weak”, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *see also* TMEP §§1207.01(b)(iii), (b)(ix). In *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, No. 2014-1789 (Fed. Cir. 2015), the Circuit noted that, “extensive evidence of third party use and registration is ‘powerful on its face’ even where the specific extent and impact of the usage has not been established.”

Here, there are at least six live use-based registered marks on the Principal and Supplemental Registers that include the term of “EARTHLY” of purchase and delivery services in International Classes 03, or other related electronic commerce Classes. For example, the cited marks having “EARTHLY BOTANICALS”, U.S. Registration No. 3632781, “EARTHLY BODY”, U.S. Registration No. 4015117, “EARTHLY HERBALS”, U.S. Registration No. 4390882, “EARTHLY HEALTHY”, U.S. Registration No. 4728187, “EARTHLY AROMAS”, U.S. Registration No. 4974535, and “EARTHLY SUDS CO.”, U.S. Registration No. 5626465, coexist on the trademark registration.

These registered live marks demonstrate that there is a crowded field of marks that combine the terms “EARTHLY” or similar terms. As a result, the term “EARTHLY,” as used in the cited marks, is commercially weak and diluted, and entitled to a narrower scope of protection.

Since “EARTHLY” are both conceptually and commercially very weak, the mere fact that applicant’s mark shares this term with the cited marks is not sufficient to support a likelihood of confusion refusal. Rather, more weight must be accorded to the differences between the relevant goods and services and any unshared elements of the marks, such as unshared/missing terms. *See Continental Grain Company v. Central Soya Company Inc.*, 69 F.3d 555 (Fed. Cir. 1995) (holding that “where the mark is a composite of a weak common part and a modifying phrase ... the common portion of the composite mark is to be given less weight on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar”). In light of the relative weakness of the cited marks, and the limited significance of the only term shared between the relevant marks, this

modifying, missing, or adding weighs against the likelihood of confusion refusal.

WEBPAGE SPECIMEN NOT ACCEPABLE FOR GOODS

The examining attorney points out that Registration is refused because the webpage specimen in International Class 003 is not an acceptable display associated with the goods and appears to be mere advertising material. See TMEP §904.07(a). The specimen, thus, fails to show the applied-for mark in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.56(a).

To overcome this refusal, applicant submit a substituted specimen. The specimen includes a way of ordering the goods in that there is a shopping cart function for placing an order.

The specimen shows the applied-for mark in use in commerce for each international class of goods identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.56(a).

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call [COUNSEL'S TELEPHONE NUMBER].

Respectfully submitted,

By: Elizabeth Yang, Esq.

LAW AND MEDIATION OFFICES OF ELIZABETH YANG

Applicant: BECAUSE BABIES, LLC.

199 W. Garvey Ave., Suite 201

Monterey Park, CA 91754

Tel: (909)996-5906

Email: elizabeth@yanglawoffices.com