

Serial No.: 88/307,474

AT Ref. No.: 38055-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: 1220 Spirits, LLC
Serial No.: 88/307,474
Filed: February 19, 2019
International Class: 33
Examiner: Robert N. Guliano, Law Office 105
Mark: FLORA

REQUEST FOR RECONSIDERATION

In response to the Office Action issued on March 30, 2020, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal. For the reasons stated herein, Applicant's mark FLORA is not confusingly similar to the marks that are the subject of the cited registrations and pending applications, namely, U.S. Registration Nos. 4641075, 5558067, and 2709565 (the "Cited Marks").

LIKELIHOOD OF CONFUSION

Prior Registrations Relied upon by the Office Action

The Office Action refuses registration of Applicant's mark FLORA on the basis of likelihood of confusion with the Cited Marks under The Trademark Act, §2(d), 15 USC §1052(d). The details of the marks at issue are set forth as follows:

| Mark / Reg. No. | Owner | Goods / Class | Filing Date Reg. Date |
|---|----------------------------------|---|--|
| Applied-For Mark: FLORA Serial No. 88307474 | 1220 Spirits, LLC | <i>Spirits and liqueurs; Aperitifs</i> in Class 33 | February 19, 2019 |
| NATIVE FLORA Reg. No. 4641075 | Flora Vineyards & Winery | <i>Grape wine; Natural sparkling wines; Red wine; Rose wine; Sparkling grape wine; Sparkling wines; Still wines; White wine; Wine; Wines; Wines and sparkling wines</i> in Class 33 | April 16, 2014 November 18, 2014 |
| VILLA FLORA Reg. No. 5558067 | BADET CLEMENT ET COMPAGNIE | <i>Alcoholic beverages except beers; wines</i> in Class 33 | February 8, 2018 September 11, 2018 |
| FLORA SPRINGS Reg. No. 2709565 | Flora Springs Wine Company | <i>Wines</i> in Class 33 | July 18, 2002 April 22, 2003 |

See **Exhibit A** for copies of the full USPTO records for these applications and registrations.

There is no Likelihood of Confusion When the Relevant *DuPont* Factors are Considered.

Applicant and the Examining Attorney agree that the relevant *DuPont* factors must be considered but disagree as to whether the weighing of such factors leads to a conclusion that a likelihood of confusion exists between Applicant's mark and the Cited Mark. In determining whether a likelihood of confusion exists between two marks, *In re E.I. DuPont de Nemours & Co.* sets forth a number of factors that must be considered, including without limitation, (1) the similarity of the marks in appearance, sound, connotation, and overall commercial impression; (2) the similarity and nature of the goods and services; (3) the similarity of established, likely-to-continue channels of trade; (4) the number and nature of similar marks in use in connection with similar goods or services; (5) the sophistication of the respective purchasers; and (6) the extent of potential confusion.¹ Based on the facts of this case, Applicant respectfully submits that the following relevant *DuPont* factors weigh in Applicant's favor:

- (1) When comparing the Applicant's mark in its entirety to the Cited Marks in their entirety, the distinguishing elements of Applicant's Mark serve to sufficiently differentiate the marks to avoid a potential likelihood of confusion among consumers;
- (2) The differences between Applicant's goods and the goods associated with the Cited Mark are sufficient to avoid a likelihood of confusion;
- (3) The widespread concurrent use, application, and registration of other similar marks for identical or closely related goods indicates that consumers are able to distinguish marks that contain the term FLORA in connection with alcoholic beverages;
- (4) The sophistication of Applicant's consumers and the purchasing conditions the goods will serve to obviate any likelihood of confusion between the marks;
- (5) Applicant's goods have been sold in commerce for over a year without any evidence of actual consumer confusion; and
- (6) Any potential confusion between Applicant's mark and the Cited Mark would be *de minimus*.

For these reasons, which are set forth in detail below, Applicant respectfully requests that the Section 2(d) refusal be withdrawn.

¹ See *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

I. The Differences Between Applicant's Mark and the Cited Mark are Sufficient to Avoid a Likelihood of Confusion.

The Office Action concedes *DuPont* factor no. 1 requiring the marks to be compared in their entireties: “When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.”²

Agreeing with the Office Action, Applicant further submits that “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”³ The comparison of marks must be done on a case-by-case basis without reliance on mechanical rules of construction. *See e.g., Spice Islands, Inc. v. Frank T. & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE (and Tree Design) held not confusingly similar to SPICE ISLANDS (and Tree Design), both or spices). The use of identical words, or even dominant words in common, does not automatically mean that two marks are similar.⁴

While the courts tend to look to the overall impression created by the marks and do not merely compare individual features, the Office Action seems to briefly highlight the similar terms of each mark, namely FLORA, and concludes that the marks are therefore confusingly similar without providing any evidence as to how such a conclusion was reached. However, Applicant respectfully disagrees and submits that the marks at issue are, in fact, distinctive.

The Office Action states that “incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d).” Applicant agrees with this statement, but notes that in determining whether a likelihood of confusion exists between two marks, *all* relevant factors that must be considered and weighed accordingly. Therefore, although Applicant's mark contains the term FLORA and the Cited Marks all contain the term FLORA, Applicant is not claiming that the incorporation of additional terms in the Cited Marks automatically negates a likelihood of confusion, but rather weighs the overall assessment of likelihood of confusion in Applicant's favor.

The Office Action also cites the following case law as support for the assertion that Applicant's mark is confusingly similar to the Cited Marks:

- *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar);

² *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b).

³ *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920).

⁴ *Intellectual Property Law for Business Lawyers*, Kinney & Lange, P.A. West Publishing, §10.4, 300 (1996).

- In this case, the court found that the term CONCEPT when applied to hair products was arbitrary, affording the mark the highest level of trademark protection. The court stated that the “inclusion of a **merely suggestive or descriptive element**, of course, is of **much less significance** in avoiding a likelihood of confusion.” (emphasis added) In the present case, the term FLORA is not arbitrary when applied to alcoholic beverages, as even the Office Action has stated that the term gives off the commercial impression of “plants of a region,” which alcoholic beverages commonly contain for flavor and aroma. At best, the term is suggestive and therefore much less significant in the likelihood of confusion analysis.
- *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL LANCER and design and BENGAL confusingly similar);
 - In this case, the court found that the term BENGAL when applied to alcoholic beverages was arbitrary, affording the mark the highest level of trademark protection. The court stated that “when one incorporates the entire **arbitrary** registered mark of another into a composite mark, inclusion in the composite mark of a **significant nonsuggestive element** does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion.” (emphasis added) In the present case, the term FLORA is not arbitrary when applied to alcoholic beverages, as even the Office Action has stated that the term gives off the commercial impression of “plants of a region,” which alcoholic beverages commonly contain for flavor and aroma. At best, the term is suggestive and therefore much less significant in the likelihood of confusion analysis.
- *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar);
 - In this case, the TTAB found that the applied-for mark BARR GROUP was primarily merely a surname. Additionally, the TTAB found that because the term BARR was the first term in both marks, “it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered.” In the present case, the term FLORA appears as the second term both in VILLA FLORA and NATIVE FLORA. Accordingly, consumers of products bearing those marks would be most likely to recall the first terms in the marks, VILLA and NATIVE. Accordingly, Applicant’s mark FLORA presents a distinct commercial impression, as FLORA clearly differs in sight, sound, and meaning from the terms VILLA and NATIVE.
- *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar);

- In this case, the TTAB found that the mark JAWS was **famous** for the summer blockbuster movie from 1975. Additionally, the TTAB found that the applied-for mark JAWS DEVOUR YOUR HUNGER contained an “explanatory slogan” and therefore the primary portion of the mark was the term JAWS. In the present case, the Office Action suggests that had Applicant’s mark contained additional terms, the mark would have distinguished itself enough from the other FLORA-formative marks on the register to avoid likelihood of confusion. However, even though the Office Action relies on this cited case, it is clear that occasionally the addition of terms does not necessarily obviate likelihood of confusion. Furthermore, the shared term JAWS in the cited case was deemed famous, which is not the case here. The term FLORA is not famous, or even arbitrary, in connection with alcoholic and related beverages. Accordingly, this case bears little support for the Office Actions assertion that Applicant’s mark and the Cited Marks are confusingly similar.

Furthermore, the Office Action states that “although [A]pplicant’s mark does not contain the entirety of the registered marks, [A]pplicant’s mark is likely to appear to prospective purchasers as a shortened form of the registered mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)).”

Applicant notes in that case, Mighty Leaf Tea filed an application to register the mark ML on the Principal Register in Class 003, for “personal care products and skin care preparations, namely, skin soap, body wash, foam bath, body lotion, body scrub, bath salts and massage oil; potpourri; incense.” The Examining Attorney rejected the application under Section 2(d) of the Lanham Act, finding likelihood of confusion with the mark ML MARK LEES registered in Class 003, for “skin care products, namely, skin cleanser, skin toner, skin cream, skin lotion, skin mask gel, make-up foundation, powder and blush.” The Board found that the presence of the name MARK LEES in the registered mark did not diminish the likelihood of confusion, because consumers familiar with the registered mark are likely to assume that applicant's ML is merely a variation or shortened version of the registered mark.⁵

It is clear that the letters ML in the mark ML Mark Lees are initials, which are typically the first letters of the name of a person, by definition a shortened version of a name. In the present case, if Applicant’s mark appeared as a shortened form of the Cited Marks, as stated in the Office Action, Applicant’s Mark would be VF for VILLA FLORA, or NF for NATIVE FLORA, or FS for FLORA SPRINGS. However, Applicant’s mark is FLORA, which clearly does not give off the impression of a shortened version of the Cited Marks.

⁵ *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010).

In this case, the overall cumulative differences in sound, appearance, and commercial impression between the Cited Marks and Applicant's FLORA mark far outweigh the similarities when the marks are considered in their entirety, especially bearing in mind the relative weakness of the term FLORA in the alcoholic beverage industry, as discussed herein.

Applicant submits that the overall visual, phonetic, and connotative differences between the applied-for mark and the Cited Marks sufficiently distinguish the marks such that there is no likelihood of confusion, especially considering the volume of registered marks containing the term FLORA. Thus, Applicant respectfully requests that the Section 2(d) refusal be withdrawn.

II. The Differences Between Applicant's Goods and the Goods Associated with the Cited Mark Are Sufficient to Avoid a Likelihood of Confusion.

DuPont factor no. 2 requires consideration of the nature of and similarities between the goods at issue.⁶ Even where identical marks are used, differences between the parties' respective goods and services may be sufficient to avoid a likelihood of confusion. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (finding no likelihood of confusion between RITZ for cooking classes and RITZ for kitchen utensils, because of the differences between the goods and services and the weakness of the mark). When comparing the parties' goods and services, the relevant consideration is whether consumers would perceive the goods and services as originating from the same source. *Id.* at 1355-56.

Applicant's goods are identified as "*Spirits and liqueurs; Aperitifs*"

The Cited Marks' goods are primarily identified as "*wines.*"

The Federal Circuit has held that there is no per se rule that holds that all alcoholic beverages are related. *See G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635 (Fed. Cir. 1990) (RED STRIPE and design for beer was not confusingly similar to a design of a red stripe for wines and sparkling wines); *National Distillers and Chemical Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (DUET for prepared alcoholic cocktails, some of which contained brandy, and DUVET for French brandy and liqueurs not confusingly similar); *In re National Distillers & Chemical Corp.*, 297 F.2d 941, 132 U.S.P.Q. 271 (C.C.P.A. 1962) ("MERITO" for rum and "MARQUES DEL MERITO" for wines held not confusingly similar.). *See also* TMEP §1207.01(a)(iv) ("there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto").

Following the Federal Circuit's holding in *G. H. Mumm & Cie*, the Board looks to the record evidence to determine whether the alcoholic beverages in question are sufficiently related as to support a likelihood of confusion. *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009). In *In re White Rock*, the Board held that the record evidence submitted by the Examining Attorney was insufficient to find that applicant's "energy vodka infused with caffeine" was

⁶ *See E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, at 1361.

related to “wines.” *Id.* at 9. The Examining Attorney had submitted internet evidence of vodka and wine offered on the same websites. *Id.* at 8. The Board rejected this evidence as being “hardly sufficient to convince us that applicant’s energy vodka infused with caffeine and registrant’s wines are related.” *Id.* The Board concluded: “There is no evidence that vodka, much less applicant’s specific type of vodka, and wine emanate from a single source under a single mark.” *Id.*

Similarly, in trademark infringement cases, federal courts frequently reach the conclusion that wine and spirits are not related based on the evidentiary record. See, e.g., *Peyrat v. L. N. Renault & Sons, Inc.*, 247 F. Supp. 1009, 148 U.S.P.Q. 77 (S.D. N.Y. 1965) (Concurrent use of “RENAULT” on wines and brandy not likely to cause confusion); *Buitoni Foods Corp. v. Gio. Buton & C. S.p.A.*, 680 F.2d 290, 291 (2d Cir. 1982) (holding that use of the BUITONI trademark on table wines created no likelihood of confusion with the senior BUTON trademark on brandies, liqueurs, and aperitifs). In a recent case, the court concluded that California red zinfandel and Kentucky bourbon are not sufficiently related that a consumer would likely conclude they came from the same source:

“Both Sazerac's Buffalo Trace bourbon and Fetzer's 1000 Stories wine participate in the same general alcoholic beverage industry. And Sazerac presented evidence that the products are advertised and marketed in overlapping channels. But they are nonetheless very distinct products. They have different alcohol contents and social uses, and they occupy different sections of the stores where they are offered for sale. Sazerac produced no evidence that a consumer is likely to associate a California red zinfandel with a Kentucky bourbon whiskey.”

Sazerac Co., Inc. v. Fetzer Vineyards, Inc., 265 F. Supp. 3d 1013, 1035 (N.D. Cal. 2017), aff'd, 786 F. App'x 662 (9th Cir. 2019) (emphasis added).

As in *In Re White Rock*, the Examining Attorney here has offered insufficient evidence to show that wines and spirits emanate from a single source under a single mark. In the present office action, the Examining Attorney submitted evidence of third party websites purportedly showing that wine and spirits may emanate from a single source. Further, a review of a sampling of these third party websites illustrates why such evidence should lack probative value. Website evidence reveals that the different marks are used for wines and spirits, but not both. (See **Exhibit B** for a screenshot from <https://nashobawinery.com/> and <https://nashobadistillery.com/> last accessed on September 28, 2020)

The issue in this case is not whether a single company makes and sells wine and spirits. Rather, as the Board recognized in *In Re White Rock*, the issue is whether wine and spirits “emanate from a single source under a single mark.”⁷ The Examining Attorney’s internet evidence fails to show that they do. In fact, this evidence actually proves Applicant’s point that wine and spirits do not emanate from a single source under a single mark. Of the five different businesses represented in the Examining Attorney’s internet examples, there is but one example of the same mark being used on the labels of wine and spirits, namely, “Fiore” from Maryland.

⁷ *In Re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282 (T.T.A.B. 2009).

The evidence provided by the Examining Attorney reveals four other businesses using one mark for their wines and a different mark for their spirits. For example, Nashoba Valley in Massachusetts does not use the Nashoba Valley Winery design mark for its spirits; rather, it uses a distinct design mark containing an image of a distillery. (See **Exhibit B**.) Similarly, Charbay in California uses a distinct design mark for its vodka, and uses a different design mark for its wine. (See **Exhibit C** for a screenshot from <https://www.charbaywinery.com/our-wines> and <https://charbay.com/vodka/>, last accessed on September 28, 2020). Thus, the present evidence in the record supports the conclusion that wines and spirits do not emanate from a single source under a single mark, and thus consumers do not expect wines and spirits to come from the same source.

Considering the differences between Applicant’s goods and Registrant’s goods, this *DuPont* factor weighs against a likelihood of confusion. Applicant respectfully submits that consumers in the alcoholic beverage industry will not be confused when confronted with the Cited Mark versus the Applicant’s Mark.

III. The Widespread Concurrent Use, Application, and Registration of Other Similar Marks for Identical or Closely Related Goods Indicates that Consumers Are Able to Distinguish Marks that Contain Some Version of the Term FLORA.

a. Third Party Applications

Applicant is aware of at least five additional pending applications for trademarks **filed after Applicant’s FLORA mark**, containing the term FLORA and used in connection with identical or closely related goods, including, without limitation, the following:

| Mark | Status/Key Dates | Relevant Goods/Services | Owner Information |
|---|---|---|--|
| FLORA SN: 88491496 | Pending - Suspended, June 3, 2020 Int'l Class: 33 First Use: March 28, 2016 Filed: June 27, 2019 | (Int'l Class: 33) Alcoholic beverages, except beer; Alcoholic fruit beverages; Dry cider; Hard cider | Graft Cider, LLC (New York Limited Liability Company) 218 Ann Street Newburgh New York 12250 |
| FLORA and Design SN: 88638546 | Allowed - Intent to Use Notice of Allowance Issued, August 25, 2020 Filed: October 2, 2019 | (Int'l Class: 32) Non-alcoholic cocktail mixes | Reddi Beverage Company (Illinois Limited Liability Company) 500 S. Clinton Apt 341 Chicago Illinois 60607 |

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| Mark | Status/Key Dates | Relevant Goods/Services | Owner Information |
|---|---|--|--|
| <u>FLORA ROSA</u> SN: 88691446 | Allowed - Intent to Use Notice of Allowance Issued, May 26, 2020 Filed: November 13, 2019 | (Int'l Class: 33) Spirits | Flora Spirits LLC (Delaware Limited Liability Company) 212 Hommocks Road Larchmont New York 10538 |
| <u>FLORA & FARM</u> SN: 88461224 | Allowed - Intent to Use 1st Extension of Time Granted, April 9, 2020 Filed: June 5, 2019 | (Int'l Class: 33) Alcoholic beverages except beers; Wine | The Wine Group LLC (Delaware Limited Liability Company) 4596 S. Tracy Blvd. Tracy California 95377 |
| <u>FLORA CULTURE</u> SN: 79268353 | Pending - Final 2(e)(1) Refusal, June 11, 2020 Filed: May 29, 2019 Int'l Reg Date: May 29, 2019 | (Int'l Class: 32) Beers; syrups for making beverages; vegetable drinks and vegetable juices, namely, vegetable based nutritional drinks and juices; fruit flavoured drinks; vegetable flavoured drinks; non-alcoholic fruit-flavoured beverages being punches and aides; sports drinks; bottled drinking water; fruit juice concentrates; vegetable juice concentrates; fruit and vegetable juice beverages in this class containing vitamins, minerals or other nutritional foodstuffs including probiotics; mineral and aerated waters; non-alcoholic beverages other than for medical use containing nutritional foodstuffs including probiotics and including coconut water beverages containing nutritional foodstuffs; protein enriched sports beverages; non-alcoholic beverages, namely, fermented non-alcoholic beverages, non-alcoholic beverages containing coconut water and beverages made from super foods and including probiotics; beverages consisting of a blend of fruit and vegetable juices; non-alcoholic beverages and fruit juices; coconut-based beverages not being milk substitutes; grain based non-alcoholic beverages; fruit beverages and fruit juices including fruit based nutritional drinks and juices | The Beauty Chef Pty Limited (Australia) 55 Sir Thomas Mitchell Rd Bondi Beach Nsw 2026 Australia |

See **Exhibit D** for copies of the full USPTO records for these applications.

- **FLORA**
 - SN: 88491496
 - This mark has been suspended due to a potential likelihood of confusion with Applicant's mark FLORA. Applicant notes that the Examining Attorney did **not** cite any of the present Cited Marks, VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS, as a basis for a 2(d) likelihood of confusion refusal. If this third party FLORA mark is not confusingly similar to the marks VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS, then Applicant's FLORA mark is logically not confusingly similar to those marks either.

- **FLORA and Design**
 - SN: 88638546
 - This mark has been approved for publication. Applicant notes that this mark contains the single term FLORA, and incorporates images of flowers in the mark. Furthermore, the goods for this mark are described as "Non-alcoholic cocktail mixes," which are highly related to alcoholic beverages and are sold in the same channels of trade. Applicant notes that the Examining Attorney did **not** cite any marks for a 2(d) likelihood of confusion refusal. If this FLORA mark is not confusingly similar to the present cited marks VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS, or even Applicant's FLORA applied-for mark, then Applicant's FLORA mark is logically not confusingly similar to those marks either.

- **FLORA ROSA**
 - SN: 88691446
 - This mark has received a Notice of Allowance. Applicant notes that this mark contains the term FLORA, and uses the term as the first term, which makes it the primary term. Furthermore, the owner disclaimed the second term ROSA, further indicating that the primary term in the mark is FLORA. Applicant notes that the Examining Attorney did **not** cite any marks for a 2(d) likelihood of confusion refusal. Again, if this FLORA formative mark is not confusingly similar to the present cited marks VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS, or even Applicant's FLORA applied-for mark, then Applicant's FLORA mark is logically not confusingly similar to those marks either.

- **FLORA & FARM**
 - SN: 88461224
 - This mark has received a Notice of Allowance. Applicant notes that this mark contains the term FLORA, and uses the term as the first term, which makes it the primary term. Applicant notes that the Examining Attorney did **not** cite any marks for a 2(d) likelihood of confusion refusal. Again, if this FLORA formative mark is not confusingly similar to the present cited marks VILLA FLORA, NATIVE

FLORA, and FLORA SPRINGS, or even Applicant's FLORA applied-for mark, then Applicant's FLORA mark is logically not confusingly similar to those marks either.

- **FLORA CULTURE**
 - SN: 79268353
 - This mark has been refused registration under Section 2(e)(1) as merely descriptive. Applicant notes that this mark contains the term FLORA, and uses the term as the first term, which makes it the primary term. Applicant notes that the Examining Attorney did **not** cite any marks for a 2(d) likelihood of confusion refusal. Again, if this FLORA formative mark is not confusingly similar to the present cited marks VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS, or even Applicant's FLORA applied-for mark, then Applicant's FLORA mark is logically not confusingly similar to those marks either.

Clearly, alcohol-related marks that contain the term FLORA are commonly used in the alcoholic beverage space, and as a result, consumers are already alerted to distinguish one provider from another when viewing the marks in their entirety. Furthermore, the Trademark Office itself has not refused registration for five additional FLORA formative marks, filed after Applicant's FLORA mark, under Section 2(d) likelihood of confusion.

Applicant understands that the Examining Attorney is not bound by the decisions of other Examining Attorneys. However, if "the overriding concern is...to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer" as stated in the present Office Action, then the Trademark Office has failed its responsibility to protect the owners of the VILLA FLORA, NATIVE FLORA, and FLORA SPRINGS marks from adverse commercial impact by the approval of the aforementioned FLORA marks. Merely paying lip service to registrants, who ultimately are not even made aware of the Trademark Office's citation of the marks in office actions, should not reverse the favor that Applicant is rightly due under the law.⁸

b. Third-Party Registrations and Concurrent Use

"[E]xtensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established."⁹ Similar to cases in which extensive evidence of third-party registration and use of similar marks was found to be "powerful on its face" inasmuch as "a considerable number of third parties['] use [of] similar

⁸ In re Shell Oil Co., 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); In re G.B.I. Tile & Stone, Inc., 92 USPQ2d 1366, 1372 (TTAB 2009); see also In re C.H. Hanson Co., 116 USPQ2d 1351 (TTAB 2015) (noting that to the extent that the punctuation in registrant's identification of goods created ambiguity as to the scope of the identification, any doubt must be resolved in favor of the registrant).

⁹ *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 982 (2016) (citing *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674)

marks was shown,”¹⁰ Applicant previously presented extensive evidence of third-party use, and over fifteen (15) third-party registrations of probative value.

The Office Action also states that “[A]pplicant’s evidence of dilution does not obviate confusion in this case. Each of the third party registrations and uses submitted by [A]pplicant show the term “flora” used in connection with additional wording or design elements, but [A]pplicant’s mark is for the standard character word “flora” alone. Since [A]pplicant’s mark **does not add anything to the word “flora” to distinguish it from the registered marks**, the third party registrations and use submitted by [A]pplicant fail to show that consumers would be able to differentiate [A]pplicant’s mark from other “flora” formative marks used in the field of alcoholic beverages.” (emphasis added)

However, the Office Action relied on *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) to support the argument that Applicant’s mark is confusingly similar to the Cited Marks. In this case, the TTAB found that the applied-for mark JAWS DEVOUR YOUR HUNGER inclusion of additional terms did not obviate a likelihood of confusion with the mark JAWS.

Accordingly, the Office Action has inconsistently applied the law, stating on one hand that had Applicant’s mark FLORA contained additional terms, it would be distinguishable from the Cited Marks, and concurrently that the addition of extra terms would not have distinguished Applicant’s mark FLORA from the Cited Marks.

As discussed further herein, consumers are used to seeing a multitude of marks that contain the term FLORA for products in the alcoholic beverage industry and understand their implied obligation to consider any distinguishing characteristics including additional terms and syllables in order to differentiate one source from the other. Therefore, Applicant’s use of the term FLORA is not confusingly similar to the Cited Marks’ use of same, particularly within the crowded alcoholic beverage industry where these terms have a limited scope of protection.

The widespread concurrent use and registration of so many marks containing a version of the term FLORA for use in connection with identical or closely related goods strongly supports a decision to withdraw the Section 2(d) refusal in this case.

IV. The Purchasers of Applicant’s Goods are Highly Sophisticated Consumers Not Likely to be Confused by the Coexistence of the Cited Mark, Especially When Considering the Purchasing Conditions for the Respective Goods.

It is well settled under the 4th *DuPont* factor that a likelihood of confusion analysis cannot be made in a vacuum, and must instead be made with reference to the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.”¹¹ Where the relevant purchaser is rather sophisticated, it is appropriate to apply an elevated

¹⁰ *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674

¹¹ *See E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, at 1361.

standard when determining whether a likelihood of confusion exists.¹² Sophistication of the respective purchasers is important and often dispositive because “[s]ophisticated consumers may be expected to exercise greater care.”¹³ Thus, the 4th *DuPont* factor is clearly meant to address the consumer’s ability to understand with whom they are dealing and from whom they are making a purchase.

Under this factor, the courts generally hold that if a consumer can be expected to exercise a high degree of care, he or she will be less likely to be confused by any connection between a senior and junior trademark.¹⁴ A sophisticated consumer is expected to act not on “impulse,” but on the basis of “a careful consideration of the reliability and dependability of the manufacturer and seller of the product.”¹⁵ In other words, a sophisticated consumer is one who is likely to spend more time, attention, and care in making a purchasing decision--and who is deemed less likely to be confused as to the source of the trademarked goods and/or services he or she buys.

Unsophisticated consumers, by contrast, are “the ignorant, the unthinking[,] and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearance and general impressions.”¹⁶ The typical unsophisticated consumer is the person who “undergo[es] . . . an experience not unlike that of hypnosis,” in which purchases are made impulsively and thoughtlessly.¹⁷

A key threshold question is then how to distinguish the sophisticated consumer from the unthinking one. Although courts have not yet articulated a list of factors for assessing consumer sophistication, a few key factors can be considered in the consumer sophistication analysis, including the price, length and complexity of the purchase transaction; infrequency of purchase; education, age, gender, and income; and the notion that professional buyers are more sophisticated.

The perceived degree of sophistication is often the factor that dictates the degree of protection afforded by law to a trademark holder. Some courts have gone so far as to suggest that a high degree of consumer sophistication in a target market may “trump” all other factors, virtually eliminating the likelihood of consumer confusion in the case of a professional or highly sophisticated buyer.¹⁸

Here, the Cited Mark’s goods are most likely available for purchase at large online retail stores or traditional big box retail stores. Conversely, Applicant’s goods are only available for purchase at Applicant’s website or Applicant’s physical retail store location. Therefore, a

¹² See *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 14 U.S.P.Q.2d. 1840 (Fed. Cir. 1990).

¹³ See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482,489 212 USPQ 246, 252 (1st Cir. 1981).

¹⁴ *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 975 (10th Cir. 2002).

¹⁵ *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983).

¹⁶ *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910).

¹⁷ *Pikle-Rite Co. v. Chi. Pickle Co.*, 171 F. Supp. 671, 676 (N.D. Ill. 1959).

¹⁸ *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 467 (4th Cir. 1996) (holding that the “relative sophistication of the market may trump the presence or absence of any other factor”).

consumer in the general public who wishes to purchase Applicant's goods would not be able to make a purchase from any online store, such as Amazon.com, or a large physical big box retail store, like Wal-Mart. A consumer would likely be required to conduct thorough research into specialty liquors, including the desired flavor notes, such as sweet, bitter, herbal, citrus, alcohol percentage, and accompanying cocktails. This type of purchase would be time-consuming, as consumers who are interested in this type of product are highly knowledgeable about how to select high-end liquors, the price points for such beverages, and the cocktail combinations for each. Again, the average consumer in the general public would not be interested in making such a purchase on a whim. Therefore, the overlap between the Cited Mark's consumers and Applicant's consumers would be quite narrow, and these consumers would be able to recognize that Applicant's goods, and the Cited Mark's goods do not emanate from the same source.

Additionally, Applicant's consumers are all sophisticated and highly knowledgeable about the types of high end liquors, and are looking for the best quality, with the desired flavors, in the alcoholic beverage industry. Thus, Applicant's customers are extremely discriminating purchasers, well aware of the top providers of such liquors; as such, these are not impulse "buys", but rather well-researched purchases. Thus, customers pay careful attention to the source of these types of products. Such consumers are not likely to assume that such disparate goods as Applicant's spirits and liquors and the Cited Marks' wines emanate from the same source merely because they are offered under marks containing the term FLORA. As such, customers will not likely be confused when confronted with the Cited Mark.

V. Applicant's Goods Have Been Sold in Commerce for over a Year without Any Evidence of Actual Consumer Confusion.

Although it is well settled that the relevant test in this case is likelihood of confusion, not actual confusion, it remains pertinent to Applicant's arguments contained herein that to date, no evidence of actual consumer confusion has arisen. As previously stated, consumers are used to seeing a multitude of marks that contain the term FLORA for products in the alcoholic beverage industry and understand their implied obligation to consider any distinguishing characteristics including additional terms and syllables in order to differentiate one source from the other. Therefore, Applicant's use of the term FLORA, coupled with no evidence of actual confusion to date, weighs heavily in favor of Applicant's arguments that its mark FLORA is not confusingly similar to the Cited Marks, particularly within the crowded alcoholic beverage industry where these terms have a limited scope of protection.

VI. Any Potential Confusion between Applicant's Mark and the Cited Mark Would Be de Minimus.

Assuming, *arguendo*, that confusion was possible, the 12th *DuPont* factor requires consideration of the extent of such potential confusion (e.g., whether *de minimus* or substantial).¹⁹ Here, the overall visual, phonetic, and connotative differences between the applied-for mark and the Cited Mark create substantially different commercial impressions.

¹⁹ See *E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, at 1361.

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Both the alcoholic beverage industry and the U.S. Trademark Register are flooded with the coexistence and concurrent registration of alcoholic beverage products and bearing marks that contain the term FLORA. Considering this, should it ever occur, the potential for any confusion would be *de minimus* at best and would be easily resolved by the “confluence of facts” set forth herein.

VII. Doubt as to Registrability Should be Resolved in Favor of the Applicant.

“Any doubt in determining the registrability of [the mark] is resolved in the favor of applicant.” See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (citing *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (T.T.A.B. 1972)) (“any doubt in determining the registrability of [the mark] is resolved in the favor of applicant on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect”). While all of the *DuPont* factors addressed herein weigh heavily against a conclusion that confusion would be likely, Applicant respectfully requests that any doubt, if such doubt exists, be resolved in its favor and that the 2(d) refusal be withdrawn.

CONCLUSION

Having responded to the Examining Attorney’s Office Action, Applicant respectfully submits that the Application is now in proper condition for publication, notification of which Applicant requests at the Examining Attorney’s convenience. If it would advance the prosecution of this Application, Applicant invites the Examining Attorney to telephone the undersigned.