"**BROWN SUGAR"** Serial Number 85-898166
Claim of Ownership of Prior Registration and
Response to Office Action Dated 09/23/2013 issued by
Trademark Examining Attorney Jennifer Hazard Dixon
Law Office 110

CLAIM OF OWNERSHIP

Applicant for the application bearing Serial Number 85-898166 is the owner of U.S. Registration No. 2778073.

MEMORANDUM OF POINTS & AUTHORITIES IN RESPONSE TO OFFICE ACTION

Examining Attorney Dixon:

In your Office Action dated July 26, 2013, you previously refused the application of our mark BROWN SUGAR bearing Serial Number 85-898166 stating that "the applied-for mark merely describes a feature, ingredient and/or characteristic of applicant's goods and/or services." More specifically, "[i]t appears from the applicant's specimens that the applicant's *flavoring* goods are the flavor of BROWN SUGAR.." In light of Applicant's response to your first Office Action you withdrew this objection and have now issued a new Office Action dated September 23, 2013 stating that the mark is deceptively misdescriptive because the goods bearing the mark do *not* contain or taste like brown sugar.

For the same reason the mark BROWN SUGAR was not merely descriptive, it is similarly not deceptively misdescriptive. That is, it is not correct that the mark BROWN SUGAR describes goods bearing the mark. No claim is made, and the mark does not signify that any good bearing the mark contains or has the flavor of the sweetener brown sugar. Instead, as stated in the response to the initial Office Action, BROWN SUGAR is the name of the cartoon woman in the BROWN SUGAR logo, and the marketing saying "Brown Sugar Sweetness In Every Drop" refers to the fictional cartoon character Brown Sugar herself being metaphorically included in the product. The application for the mark BROWN SUGAR bearing Serial Number 85-898166 is neither merely descriptive nor deceptively misdescriptive and should be approved for publication and ultimately registration on the Principal Register.

I. BROWN SUGAR IS NOT MERELY OR DECEPTIVELY MISDESCRIPTIVE.

A. "Brown Sugar" is the Name of the Cartoon Women Who Appears in the Logo Indicating the source of the Goods Branded BROWN SUGAR.

In the second and currently pending Office Action you recognize that "[t]he applicant asserts that the proposed mark "BROWN SUGAR" refers to "the name of the cartoon woman in the BROWN SUGAR logo. . ." Office Action (Citing: Response to [First] Office Action, dated 9/2/13). However, you go on to state that "the examining attorney is not convinced by this argument. There is nothing

on the packaging to suggest that BROWN SUGAR refers to the cartoon woman featured on the logo . . .” Id. To the contrary, the logo and Mark in historical context more than suggest that BROWN SUGAR is Brown Sugar, the cartoon woman on the logo identify the goods braded with the Mark.

The mark BROWN SUGAR, as used in conjunction with Registration Number 2778073 since 1996, is meant to denote the cartoon character in the logo that identifies the source of goods featuring the brand. It is our position that as Examining Attorney you can take notice of the fact that Brown Sugar is an attractive women of African heritage simply by viewing the specimen provided in conjunction with the Application.

Brown Sugar’s name comes from a slang term for an attractive women of African heritage. This slang term was most famously memorialized by Mick Jagger who wrote the song “Brown Sugar” and performed it with his band the Rolling Stones, the song appearing as the opening track on their 1971 album “Sticky Fingers” and spending two weeks as the number one single in the United States. http://en.wikipedia.org/wiki/Brown_Sugar_(song). Though full of double entendres and innuendo, there is no one that believes that the song “Brown Sugar” refers to the incompletely refined sweetener. It is widely understood Jagger was inspired to write the song by singer Marsha Hunt, the mother of his first child. *Id*. Hunt herself gained fame for being a member in the cast of the musical “HAIR” in London in the 1960s, and caused a stir with her nude photograph which appeared on materials promoting HAIR – a photograph that shows the resemblance of our Mark’s Brown Sugar to Hunt’s iconic African-American image. http://en.wikipedia.org/wiki/Marsha_Hunt_(singer_and_novelist); http://www.npg.org.uk/collections/search/portrait/mw115504/Marsha-Hunt. The original opening lines of “Brown Sugar” are as follows:

> Gold coast slave ship bound for cotton fields,
> Sold in a market down in new orleans.
> Scarred old slaver know he's doin alright.
> Hear him whip the women just around midnight.
> Ah brown sugar how come you taste so good
> (a-ha) brown sugar, just like a young girl should

http://www.lyricsfreak.com/r/rolling+stones/brown+sugar_20117857.html.

The slang brown sugar also appears prominently in another hit song two years later: “Brother Louie” by the band Hot Chocolate which was a hit in the United Kingdom in 1973, with a cover of the song by the band the Stories quickly following suit in the United States. http://en.wikipedia.org/wiki/Brother_Louie_(Hot_Chocolate_song) The song is about an interracial love affair, and there is no one that believes that the term brown sugar as used in “Brother Louie” refers to the incompletely refined sweetener. *Id*. The lyrics of “Brother Louie” begin as follows:

> She was black as the night
> Louie was whiter than white
> Danger, danger when you taste brown sugar
> Louie fell in love over night
> Hey man, what's wrong with that?

Nothing bad, it was good
Louie had the best girl he could
When she took him home to meet her mama and papa
Louie knew just where he stood

http://www.metrolyrics.com/brother-louie-lyrics-hot-chocolate.html

Urbandictionary.com recognizes Brown Sugar to be defined, *inter alia*, as a "an attractive black woman." http://www.urbandictionary.com/define.php?term=brown+sugar

Author Donald Bogle has written a book titled "Brown Sugar: Over 100 Years of America's Black Female Superstars." http://www.amazon.com/Brown-Sugar-Americas-Superstars-Updated/dp/0826416756.

Further evidence that BROWN SUGAR does not describe the goods branded as such is the independent flavor identification on each bottle of BROWN SUGAR branded flavoring. BROWN SUGAR flavoring comes in six different flavors: apple; blueberry; chocolate; grape; strawberry; and vanilla with each bottle labeled as such. Applicant understands that alternative explanations on the labeling of the product cannot overcome consumer belief of a true misrepresentation in a more ordinary context, but the special and peculiar meaning of the mark BROWN SUGAR being the name of the cartoon women on the logo takes away any customer confusion given the immediate association of BROWN SUGAR with cartoon Brown Sugar, combined with the clear labeling of each of the six – not brown sugar – flavors on each bottle. Thus decisions addressing customer misunderstanding are distinguishable. This is addressed in Section I.B., immediately *infra*.

B. Application of the Law.

Now that we understand what is signified by the applied for mark BROWN SUGAR, let us review how that intended, and perceived, meaning fits with the law, particularly 15 U.S.C. § 1502(e)(1). You have correctly outlined that "The test for determining whether a mark is deceptively misdescriptive has two parts: (1) whether the mark misdescribes the goods and/or services; and if so, (2) whether consumers are likely to believe the misrepresentation." Section I.A., *supra*, explains that BROWN SUGAR is not descriptive of the goods bearing the Mark, but instead is the name of the cartoon women in the logo identifying such goods. This should end the analysis right there, as if an applied for mark does not meet part one of the test – *and BROWN SUGAR does not* – then there is no reason to move to the second prong. That leaves us – for the sake of argument and only in the event you disregard the argument set forth in Section I.A, *supra* - to the second prong of the two-part test: whether consumers are likely to believe the *alleged* misreprentation.

As addressed in Section I.A, *supra*, BROWN SUGAR flavoring comes in six different flavors: apple; blueberry; chocolate; grape; strawberry; and vanilla with each bottle labeled as such. While in an ordinary context, alternative explanations on the labeling of the product cannot overcome consumer belief of a true misrepresentation, the special and peculiar meaning of the mark BROWN SUGAR being the name of the cartoon women on the logo takes away any

customer confusion given the immediate association of BROWN SUGAR with cartoon Brown Sugar, combined with the clear labeling of each of the six – *none brown sugar* – flavors on each bottle. No case cited in the Office Action addresses this unique situation, *e.g.*, none of the following decisions rely upon facts involving visual cultural references which exampled a lack of descriptiveness akin to the term BROWN SUGAR being identified with an attractive woman of African heritage: ***In re White Jasmine LLC***, 106 USPQ2d 1385 (TTAB 2013); ***In re Schniberg***, 79 USPQ2d 1309 (TTAB 2006); ***In re Phillips-Van Heusen***, 63 USPQ2d 1047 (TTAB 2002); ***In re The Chamber of Commerce of the U.S.***, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012); ***In re Andes Candies Inc.***, 178 USPQ 156 (C.C.P.A. 1973); ***In re Int'l Salt Co.***, 171 USPQ 832 (TTAB 1971); ***A. J. Canfield Co. v. Honickman***, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986); ***In re Quady Winery Inc.***, 221 USPQ 1213 (TTAB 1984).

However, the T.M.E.P. § 1209.04 cites decisions that although not directly on point, offer assistance in clarifying customer perception. After presenting the rule that "[a] mark is deceptively misdescriptive, within the meaning of Section 2(e)(1) of the Trademark Act of 1946 [15 U.S.C. § 1052(e)(1)], if it misdescribes the goods or services to which it is applied and purchasers are likely to believe the misrepresentation," and involving facts that included the opposer of the mark in question selling a patented single-step golf club shaft, the TTAB ruled the singular form mark POWER-STEP not deceptively misdescriptive of applicant therein's multi-step golf club shaft, stating:

> In the present case, we are not convinced that purchasers would necessarily construe the word "STEP" in applicant's mark as signifying that applicant's golf club shaft has but a single step. It seems to us that they might just as readily believe that the word "STEP" is used in the mark as a synonym for "step pattern." In any event, it is very difficult to see how purchasers could be deceived by the mark into believing that the shaft has but one step *when even a quick glance at the golf club will reveal that it has a multi-step shaft construction*, and purchasers are not likely to purchase golf clubs without looking at them first. Under the circumstances, we conclude that applicant's mark, as applied to its golf clubs, is neither deceptively misdescriptive nor deceptive.

Northwestern Golf Co. v. Acushnet Co., 226 USPQ 240, 242-243 (TTAB 1985) (citations omitted) (emphasis added). While ***In re Phillips-Van Heusen***, 63 USPQ2d 1047, 1048 (TTAB 2002) disregarded applicant therein's argument that the deception wrought by SUPER SILK used on shirts not made if silk was overcome by the mandatory labeling of the actual material content of said shirts, both ***Phillips-Van Heusen*** and ***Northwestern Golf*** inform us regarding the instant analysis, where the facts involve BROWN SUGAR being the name of Brown Sugar the cartoon character.

Phillips-Van Heusen distinguishes itself from the instant matter when it cites ***In Re Budge Manufacturing Co., Inc.*** as follows:

> *Misdescriptiveness of a term may be negated by its meaning in the context of the whole mark inasmuch as the combination is seen together and makes a unitary impression*. The same is not true with respect to explanatory statements in

advertising or on labels which purchasers may or may not note and which may or may not always be provided.

Phillips-Van Heusen at 1057 (citing ***In re Budge Manufacturing Co. Inc.***, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988) (emphasis added). While something such as a list of ingredients on a bottle of BROWN SUGAR flavoring would not sufficiently inform consumers in the absence of the peculiar facts of the Brown Sugar cartoon present in the instant matter, it can be seen that the second prong of the deceptively misdescriptive test, "whether consumers are likely to believe the misrepresentation," has not been met once one considers the ***Budge Manufacturing*** language cited by ***Phillips-Van Heusen*** in light of decision such as in ***Northwestern Golf*** where a mark was deemed not to be deceptive when a consumer could so easily see the true nature of the branded product, "in the context of the whole mark inasmuch as the combination is seen together and makes a unitary impression" which in the case where BROWN SUGAR incorporates the cultural significance and recognizability of Brown Sugar the cartoon character, combined with the clear labeling of each of the six – *none brown sugar* – flavors on each bottle of BROWN SUGAR flavoring.

Just as the ***Northwestern Golf*** decision noted that "it is very difficult to see how purchasers could be deceived by the mark into believing that the shaft has but one step when even a quick glance at the golf club will reveal that it has a multi-step shaft construction," and "that they might just as readily believe that the word "STEP" is used in the mark as a synonym for 'step pattern'" it is similarly difficult to see – in light of the likelihood of a consumer's initial association of the brand BROWN SUGAR with Brown Sugar the cartoon character who is in turn based upon the slang term brown sugar referring to an attractive woman of African heritage – that consumers of BROWN SUGAR flavorings could be deceived into thinking the branded product was brown sugar flavored when even a quick glance at the bottles reveal the true flavor of the product: apple; blueberry; chocolate; grape; strawberry; or vanilla.

Finally, Applicant recognizes that ***In re White Jasmine LLC***, 106 USPQ2d 1385 (TTAB 2013) tells us that "[t]he examples of competitors' use of the term "White Jasmine" as the name of their goods is persuasive evidence that the relevant consumers perceive the term as the name of a type of tea," *i.e*. examples of competitors' use of the applied for mark as the name of their goods is evidence that relevant customers perceive the applied for mark as the name of a type of the good in questions. ***Id***. at 1391. However, none of the attachments to the Office Action show evidence of a product or good similar to the goods at issue in the instant Application that is *actually named Brown Sugar*. *See* Almonillabacco; Big Tobacco; 'Ol River Tobacco; and Caramel. As such, Applicant argues that in the instant context the attachments are not effective evidence regarding a BROWN SUGAR consumer failing to recognize that BROWN SUGAR is Brown Sugar the cartoon character associated with the brand.

The mark BROWN SUGAR does not mean "unrefined or incompletely refined sugar that still retains some molasses, which gives it a brownish color," as proposed in the Office Action. Rather BROWN SUGAR is the name of the cartoon character associated with the brand, and as such BROWN SUGAR is not merely or deceptively misdescriptive of the goods bearing the mark and the Application bearing Serial Number 85898166 should be moved on to publication and registration on the Principal Register.

II. ALTERNATIVELY, THE MARK BROWN SUGAR HAS ACQUIRED DISTINCTIVENESS AND SHOULD BE REGISTERED ON THE PRINCIPAL REGISTRY.

As a clarification matter, Applicant notes that you have not refused registration of the mark BROWN SUGAR based on it being "deceptive" as that term is contemplated in 15 U.S.C. § 1502(a) and the decisions interpreting that statutory provision. As a result, you have suggested the option of amending the Application to move it from the Principal Register to the Supplemental Register or making a showing of acquired distinctiveness as contemplated in 15 U.S.C. § 1502(f) so that they mark can move forward toward registration on the Principal Register.

The law is that "[u]nlike marks that are deceptive under Section 2(a), deceptively misdescriptive marks under §2(e)(1) may be registrable on the Principal Register with a showing of acquired distinctiveness under Section 2(f)." *See* ***In re White Jasmine LLC***, 106 USPQ2d 1385, 1395 (TTAB 2013). The T.M.E.P. similarly says that "Marks that have been refused registration pursuant to §2(e)(1) on the ground of deceptive misdescriptiveness may be registrable under §2(f) upon a showing of acquired distinctiveness, *or* on the Supplemental Register." T.M.E.P. § 1209.04 (citing 15 U.S.C. § 1502(f), 15 U.S.C. § 1091) (emphasis added). Thus, the mark BROWN SUGAR may be registered on the Principal Register following a showing of acquired distinctiveness and does not have to move to the Supplemental Register.

Therefore, if and only if you as Examining Attorney refuse to accept the arguments set forth by Applicant in Section I, *supra*, and refuses to register BROWN SUGAR pursuant to 15 U.S.C. § 1502(e)(1), Applicant wishes to make the following statement and seek registration on the Principal Register under 15 U.S.C. § 1502(f):

> **The mark has become distinctive of the goods and/or services through applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.**

In support please refer to Registration Number 2778073 which show Applicant has used the BROWN SUGAR mark in commerce since June of 1996.

Dated this 20th day of March, 2014.

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