

In re: the Trademark Application of
Seawalker Charters LLC
Serial No.: 86/876,134
Filed: January 14, 2016

FREE RANGE

Mark:

Yatsye I. Lee
Examining Attorney
Law Office 107

RESPONSE TO OFFICE ACTION MAILED APRIL 30, 2016

Amendment to Identification of Services in International Class 43

Applicant hereby amends the identification of service in International Class 43 to “Mobile restaurant services; catering services; restaurant services; providing of food and beverage via pop-up restaurants; **all of the aforementioned services featuring free-range poultry.**”

Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney issued a refusal of Applicant's **FREE RANGE** mark (“Applicant’s Mark”) for “*Mobile restaurant services; catering services; restaurant services; providing of food and beverage via pop-up restaurants*” in International Class 43 under 15 U.S.C. § 1052(d), because of an alleged likelihood of confusion with U.S. Registration No. 4,737,715 for FREERANGE CONCEPTS covering “*Business consulting in the area of restaurant concept development in the nature of assessing operational viability, analyzing business plans, analyzing the restaurant markets, and analyzing market research*” in Class 35 (the “Cited Mark”). For the reasons articulated herein, Applicant respectfully requests the withdrawal of the Section 2(d) refusal and publication of Applicant’s Mark in the *Official Gazette*.

A likelihood of confusion may be said to exist only where: (1) an applicant's mark is similar to the cited mark(s) in terms of sight, sound, or commercial impression; and (2) the applicant's goods/services are so related to the goods/services associated with the cited mark(s), or the activities surrounding their respective marketing efforts are so similar, that confusion as to the source of the goods/services is likely. *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Telephone & Telegraph Co.*, 197 USPQ 910 (TTAB 1978).

There is no mechanical test for determining likelihood of confusion. The question to be determined is not whether the actual goods/services are likely to be confused but rather, whether there is a likelihood of confusion as to the *source* of the goods/services because of the marks used in connection therewith. *See In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Similarity of the Marks

Applicant's Mark imparts a unique and humorous commercial impression due to the disarming and offbeat appearance of the font. On the other hand, the Cited Mark is a standard character word mark comprised of the wording FREERANGE CONCEPTS. While the marks share similar wording, the term CONCEPTS further differentiates the marks. Even though the wording CONCEPTS is disclaimed in the Cited Mark, marks are compared in their entireties, and the additional wording in the Cited Mark helps to differentiate the marks.. *See In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012).

Similarity of the Services

Applicant's services and the services identified in the recitation of services associated with the Cited Mark are unrelated and non-competitive. Moreover, the evidence provided by the Examiner is insufficient to show that Applicant's restaurant services and the consulting services identified in the Cited Mark are a kind that emanate from the same source. A diversity of goods identified in a third-party registration diminishes the probative value of the registration to show the relatedness of goods or services. *See In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1203, (TTAB 2009). Registrations with a "laundry list" of goods and services are given little consideration to determine whether goods and/or services are related. *See n re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010); *In re Tomberlin Prod. Group, LLC* Serial No. 78734308 (TTAB 2007).

The Examining Attorney provided third-party Reg. Nos. 3,435,789; 3,577,601; 3,436,098; and 4,774, 051. These registrations are all owned by the same entity, cover a diverse "laundry list" of services, and are redundant for the purposes of exemplifying the goods registered by that entity. Similarly, Reg. Nos. 4,166,476 and 4,166,477 are owned by the same entity and cover the same "laundry list" of services, and are also redundant for the purposes of exemplifying the goods registered by that entity. Registration No. 4,543,836 also includes a "laundry list" of services. Thus, these seven registrations are minimally probative of the question whether restaurant services and restaurant consulting services are related. They only demonstrate that two entities happen to offer the services set forth in Applicant's application as well as those set forth in the Cited Mark amongst a long list of other collateral services. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *see also In re The Orvis Co., Inc.*, Serial No. 78276739 (TTAB 2007).

Registration No. 4,586,651 was also provided by the Examining Attorney as evidence of relatedness. This registration is not based on use in commerce. It is therefore irrelevant to the question of whether Applicant's services are related to those set forth in the Cited Mark's registration. *See, e.g., In re 1st USA Realty Professionals Inc.*, 84 U.S.P.Q.2d 1581, 1583 (TTAB 2007).

While the Examining Attorney provided nine registrations to show relatedness, only one of the registrations is probative of the same. The Examining Attorney has not met the PTO's burden in showing relatedness because the number of probative third-party registrations is insufficient to demonstrate that consumers are likely to view the services as emanating from the same source.

Channels of Trade

The Examining Attorney appears to have ignored the obvious, which is that the consumers of Applicant's services and consumers of the services set forth in the Cited Mark are entirely

different. The services set forth in the Cited Mark are targeted towards current and prospective restaurant owners, who are a relatively limited group of specialized and sophisticated consumers. On the other hand, Applicant's services are targeted towards ordinary consumers who buy meals at restaurants or from mobile food trucks. Applicant's services are not targeted towards restaurateurs. Thus, at best, the only overlapping group of consumers is restaurateurs familiar with the registrant's services who eat at Applicant's establishment. This very small overlapping group of consumers is also very likely to be sophisticated and highly capable of distinguishing between Applicant's Mark and the Cited Mark.

Merely Descriptive Refusal

Applicant does not concede that its mark lacks inherent distinctiveness. The evidence provided by the Examining Attorney does not meet the PTO's burden in demonstrating that the wording FREE RANGE is merely descriptive of the applied-for services. Moreover, consumers are likely to view Applicant's Mark as a double entendre and therefore not merely descriptive. FREE RANGE is a reference to Applicant's unconfined and free-spirited mobile restaurant services. The whimsical and offbeat lettering further underscores this point of view, which is recognized by Applicant's consumers. Where a mark has a dual meaning and is an obvious play on a known term or terms, it is not merely descriptive. *See In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008). Thus, Applicant does not concede that its mark lacks inherent distinctiveness.

Applicant submits in the alternative that its mark has acquired distinctiveness through its substantially exclusive and continuous use in commerce for more than five years, and requests that the mark be permitted registration under Section 2(f).

Section 2(a) and Identification of Services

Applicant has amended its identification of services to specify that its restaurant services feature food made from free-ranging animals. Thus, Applicant respectfully requests that the Examiner withdraw the refusal based on Section 2(a).

Requirement for Additional Information

In response to the Examiner's question, Applicant responds as follows:

1. Applicant's services feature free-range poultry.
2. Applicant submits herewith as Exhibit A a menu downloaded from its website as a sample promotional item featuring the services
3. Applicant is engaged in the restaurant services business, offering comfort food and house-made beverages prepared and served from its mobile food trucks, at catered events, and in temporary "pop-up" restaurant settings. Applicant caters to a wide variety of customers who visit Applicant's food trucks, catered events, and pop-up restaurants from throughout the United States and abroad. The purpose of Applicant's services is to elevate the street dining experience and reflect the grace and enthusiasm of California's farm and market culture. Applicant seeks to honor food and community with innovation, style, and dignity.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the refusals and approve Applicant's Mark for publication in the *Official Gazette*. The Examining Attorney is invited to contact the undersigned with any questions or concerns.

DECLARATION OF LINDSAY J. HULLEY

I, Lindsay J. Hulley, declare as follows:

1. I am a partner with the law firm of Rutan & Tucker, LLP, counsel for applicant Seawalker Charles, LLC (“Applicant”). I am admitted to practice in the State of California. I make this Declaration in support of Applicant’s response to the Office Action issued on April 30, 2016 against Serial No. 86/876,134. I make this declaration based on my own personal knowledge, and if called upon as a witness, I could and would competently testify thereto.

2. Attached hereto as Exhibit A is a true and correct copy of a menu from Applicant’s website, which I caused to be downloaded from www.freerangela.com on October 31, 2016.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 31th day of October, 2016, at Costa Mesa, California.

/Lindsay J. Hulley/
Lindsay J. Hulley