

BACKGROUND

The Trademark Examining Attorney has raised several issues in this matter.

The first issue is the conclusion that Applicant Field Botanicals LLC (“Applicant”) mark FIELD for

“Body oils, facial oils, lip balm, non-medicated skin toners, body sprays, foot deodorant spray, and body spray used as a personal deodorant and as fragrance,”

is likely to be confused with FIELD, Registration No. 4,535,314 covering products and services in Classes 5, 41, and 42. The Examining Attorney believes that similarities exist between Registrant’s lip balms for the treatment of dermatological disorders and Applicant’s lip balms. There is no indication from the Examiner’s Office Action that Registrant’s Class 41 gymastic services and Class 42 pharmaceutical research services are considered related to Applicant’s products. In order to clarify the differences between Applicant’s products and Registrant’s dermatological preparations, Applicant has amended its description of goods to refer to body oils, facial oils, lip balm, and body sprays as being for non-medical use.

Applicant respectfully urges the Trademark Attorney to reconsider the refusal, and to approve its application for publication because cosmetic oils, balms, toners and sprays under the FIELD marks in Class 3, are unlikely to be confused with dermatological preparations in Class 5 based on the diluted nature of the English term “FIELD,” and the differences in the products identified under the marks.

Channels of trade and evidence of similar marks used on similar goods are factors used to determine whether there is a likelihood of confusion between two marks. *E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Even where marks are identical, the weakness of shared terms is a significant factor in avoiding a likelihood of confusion. *See In re Complementary Solutions Inc.*, (TTAB September 5, 1997) (holding TELEMATE for computer software reporting information about telecommunications was not confusingly similar to TELEMATE (stylized) for a telephone headset, modular amplifier box, even though both marks were used in connection with telecommunications applications); *In re Agdata* 2001 TTAB LEXIS 817 (TTAB 2001) (holding MEDDATA for, among other things, providing an on-line database in the field of managed health care insurance coverage not found confusing with MEDDATA for "providing personal and medical information to medical professionals in emergency situations.").

Complementary Solutions and *Agdata* found no confusion between identical marks in related fields, and in both instances, the shared terms, MEDDATA and TELEMATE are invented terms. In this case, the common term FIELD, which is also used for different products and services, has multiple definitions and connotations. Exhibit A. With regard to Applicant's products, "field" is used to evoke its natural products. Exhibit B. Registrant's use of FIELD refers to the group study for its dermatological preparations. Exhibit C. This type of distinct commercial meaning can alone be enough to foreclose a finding of likelihood of confusion. *Revlon, Inc. v. Jerrell, Inc.*, 713 F. Supp. 93, 98 (S.D.N.Y. 1989).

Due to the word's multiple meanings, "field" is commonly used for a variety of products and services. The Trademark Trial and Appeal Board has indicated that "evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to

suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field." *In re Broadway Chicken*, 38 USPQ2d 1559 (TTAB 1996).

For example, "field" is used in the following marks in Class 3:

- LAVENDER FIELDS, covering, soaps, lip balm, cosmetics, and scrubs;
- ORGANIC FIELDS OF HEATHER, covering, cosmetic body scrubs, face and body creams;
- FIELD OF GLORY, covering, lotions, balms, creams;
- FIELD TO FRAGRANCE, covering, cosmetics in general;
- FIELDS OF HOPE, covering, skin lotions, soaps, body creams and scrubs;
- FIELD DAY, covering, body lotion, creams, and scrubs;
- FIELD TO FACE, covering, non-medicated skin preparations; and
- FIELDWORKS SUPPLY COMPANY, covering, hand scrubs and non-medicated balms.

Exhibit D.

These co-existing registrations, detailed above, serve as evidence that "FIELD" is commonly used for soaps, creams, balms, and lotions, and the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

In *Miss World (UK) Ltd. v. Mrs. America Pageants*, 856 F.2d 1445 (9th Cir. 1988), the Ninth Circuit and Central District Court of California stated that:

“in a crowded field of similar marks, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd...a mark which is hemmed in on all sides by similar marks on similar goods cannot be very distinctive. In such a crowd, consumers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.” *Id.*

Although all of these registrations feature the singular term “FIELD” as the mark and are in the same class of goods, the PTO has allowed these registrations to coexist. These marks all involve non-medicated lotions, balms and creams in some way and yet they are not confusingly similar, even with the shared use of “FIELD”.

There are many examples of common words being used for multiple registered marks in the same class. In *H. Lubovsky, Inc. v. Esprit de Corp*, 228 USPQ 814 (SDNY 1986), the Court found no confusion between ESPRIT for wearing apparel and ESPRIT for shoes, finding that the word “esprit” was not particularly strong, and the Court considered the third party uses of this term as a factor which weakened the Plaintiff’s mark. In *In re Agdata*, the Board specifically stated that "we consequently are constrained to agree with applicant that, if such third-party registrations could coexist with the cited registration, then applicant's highly suggestive MEDDATA mark for its various on-line database services in the field of managed health care coverage should also be registered inasmuch as confusion with the cited registrant's identical, and likewise weak, MEDDATA mark." *In re Agdata* 172001 TTAB LEXIS 817 (TTAB 2001). Applicant believes its application should involve the same analyses used in *H. Lubovsky, Inc.* and *Agdata* to support a finding of no potential confusion.

Case law has consistently held that consumers typically will be able to avoid confusion with regard to commonly used marks or portions of marks. See *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging

reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); See also *United States Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for laboratory reagents held not likely to be confused with QUANTUM 1 for laboratory instrument for analyzing body fluids). These cases are all very similar to the issue here because of the shared use of a common term which results in dilution of that term preventing confusion among consumers.

In considering the similarity of products for a likelihood of confusion analysis, “the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties.” *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975). In this case, it is clear from the cited registration and Registrant’s website that Registrant’s consumers are in need of dermatological creams and lotions, not cosmetics. Therefore, the ultimate use of these goods does not lead to a finding of likely confusion.

Nevertheless, the Trademark Attorney has contended that non-medical and medical balms and creams are occasionally provided by the same entity. However, although third party use can show similarities between goods and services in the marketplace, it does not always hold that consumers will associate other marks which share those goods and services. *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998), *In re Donnay International, Societe Anonyme*, 31 USPQ2d 1953 (TTAB 1994). [Although acknowledging some probative value of third party use,

both cases indicate that third party references are not evidence that it is the norm for companies to provide the same products under a single mark, or that customers would be aware of such a practice, that they would assume that the products emanate from the same source if they were sold under the same or similar marks].

Ultimately, even if products or services are sold in the same field or industry, the more appropriate test would be the primary function of each party's business. *CBS, Inc. v. Liederman*, 886 F. Supp. 763 (S.D.N.Y. 1994). In this case, it is clear that Registrant is selling products pertaining to dermatological conditions (Exhibit C), while Applicant's products have no medical application. (Exhibit B).

When determining the relatedness of products, the Board and its reviewing Court are more concerned with the practicalities of the commercial world, with which the trademark laws deal. *Witco Chemical Co., Inc., v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969). In this case, it is simply not practical that consumers with dermatologic conditions will be confused by lip balms and lotions that are not designated for medical use. *Simon Says Enterprises, Inc. v. Milton Bradley Company*, 522 F. Supp. 986 (SDNY 1981) [No confusion between SIMON for entertainment services and electronic games. "The products of each party are obviously different."] *Simon Says*, at 988. See also *In re Quadram Corp.*, 228 U.S.P.Q. 863 (TTAB 1985).

The second issue raised by the Examining Attorney is that the prior pending application for CAMPI, covering, essential oils, cosmetics, and non-medicated soaps in Class 3 is potentially likely to lead to confusion with Applicant's mark.

The Examining Attorney has likely determined potential confusion based on the foreign translation of CAMPI as related to “field,” so that the similar translated meaning is sufficient to lead to confusion. Yet, there can be no doubt that the marks do not look or sound alike.

Although both marks can be translated the same way in English, it is unlikely that consumers would encounter FIELD, and then associate that mark with a translated version of CAMPI. Although some foreign equivalent terms might look and sound alike in more than one language, the doctrine of foreign equivalents is not an absolute rule in cases like this. The doctrine of foreign equivalents only applies in those situations where the ordinary American consumer would stop and translate the mark into English. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (finding no confusion because it was improbable that the ordinary American purchaser of wine would stop and translate VEUVE into “widow,” thus finding no confusion between VEUVE ROYALE and THE WIDOW for wine.).

Specifically in Applicant’s field, the Federal Circuit has found no confusion in marks where the overall appearance and pronunciation of non-English marks were sufficiently dissimilar, even with similar translations. *See In re Sarkli Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) (REPECHAGE for various skin care products held not likely to be confused with SECOND CHANCE for face creams and other toiletries). *See also In re Tropicana Las Vegas, Inc.*, TTAB June 4, 2013 (No confusion between BACIO (translated in Italian as “kiss” and KISS both for identical services. “Considering that the marks are different in appearance and sound, albeit similar in literal meaning, we find that the marks are dissimilar in overall

commercial impression...”); *See also In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (PALOMA, translated as “dove” or “pigeon” was not confusingly similar to DOVE).

In *In re Lettuce Entertain You Enterprises, Inc.*, TTAB May 17, 2013, the Board held that STELLA ROSA and RED STAR were not confusingly similar, even though they shared the same meaning. As the Board stated in that case,

“...even to the extent that potential purchasers would translate STELLA ROSSA as “red star,” it is important to note that the doctrine of foreign equivalents is not conclusive. It is just one way of understanding the meaning of a mark, which is in turn only one of the considerations used in determining the similarity of the marks as a whole. “[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source...” *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (quoting *Sure-Fit Prods. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295, 297 (CCPA 1958)).”

The Board has determined that the doctrine of foreign equivalents is only part of the test for determining whether marks are confusingly similar. *In re Les Collines, LLC*, TTAB August 19, 2011 (LES COLLINES (translated to “the hills”) found not confusingly similar to HILLS VINEYARD, both for vineyard and winery services.). In *Les Collines*, the Board found that the differences between the marks in sound, appearance and overall commercial impression clearly outweighed any similarity in meaning.

The marks at issue in this matter do not look or sound alike in any way, and as stated in *Les Collines* and other cases *supra*, aural and visual differences are enough to avoid confusion. In evaluating likelihood of confusion, it is often stated that commercial impressions are

determined by similarities in sound, appearance, and meaning, and that no one factor should dominate. TMEP Section 1207.01(b)(i). Two of those factors, sound and appearance, are very different, and the other one, meaning, can only be determined after translation, thereby eliminating a substantial number of consumers who only speak English. *In re Modern Italian Bakery of West Babylon, Inc.*, 2001 TTAB LEXIS 88 (T.T.A.B. 2001) (“[E]ven if the non-English word and its English counterpart have a similar meaning and connotation, this is only one prong of the sight, sound, and meaning trilogy of analysis. Thus, similarity in meaning may be outweighed by differences in appearance, sound or other factors in reaching the final conclusion on likelihood of confusion.”). Here, CAMPI and FIELD plainly do not sound alike.

Furthermore, given that the public will encounter the marks in written as well as spoken form, it is essential to consider the marks' visual characteristics in analyzing likelihood of confusion. *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964 (10th Cir. 2002) (finding that GENERIC VALUE PRODUCTS is not visually similar to GENERIX, even though the marks begin with the same six letters). CAMPI and FIELD are not similar in spelling or visual appearance.

Additionally, the PTO has already permitted multiple “field” marks to coexist with CAMPI in Class 3. Exhibit D. These coexisting registrations and pending application demonstrate that consumers have already been considered unlikely to translate CAMPI into English, thereby causing confusion among other “field” marks. The CAMPI application was not refused based on any “field” mark. In light of these coexisting registrations, Applicant requests the Examining Attorney withdraw the potential refusal to register CAMPI based on likelihood of confusion.

SPECIMEN- RESPONSE

The final issue is the Examiner's claim that its FIELD mark differs from the specimen, which adds the word "botanicals".

In response to this refusal, Applicant contends that the word "botanicals" is generic and has no source indicating capability. The PTO has required a disclaimer of the word in Supplemental Registrations, and Office Actions have noted that the word is generic. Exhibit E. Furthermore, the wording "field" and "botanicals" are not connected, as "botanicals" is on the line below "field" on Applicant's specimen.

The seminal case regarding differences in drawings and specimens ("mutilation" of a trademark) is *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989), where the Board indicated that even where a generic term is connected to part of a trademark by a hyphen, the generic term is not considered part of the mark shown in the drawing. ["The generic term "RING," although connected to the model number and the source-identifying term, "TINEL LOCK," by a hyphen, nonetheless plays no integral role in forming the portion of applicant's mark which distinguishes applicant's goods from those of others. Applicant therefore need not include either the part number or the generic term in the drawing, because neither is essential to the commercial impression created by the mark as shown in the specimens."]

In this case, the word "botanicals" is clearly generic, as set forth in *Raychem*, and unlike *Raychem*, the word is separated from FIELD by being placed on a separate line.

Under TMEP Section 807.12(d), "an applicant has some latitude in selecting the mark it wants to register...an applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any

other matter with which the mark is or will be used on the specimen." See also *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446 (TTAB 2006). As the generic term "botanicals" added to Applicant's mark has no source indicating significance, it is easily separable from FIELD. *Institut National des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992). [finding that the addition of descriptive matter in a specimen is acceptable and is not a mutilation of the mark shown in the drawing].

Based on the foregoing, Applicant Field Botanicals, respectfully requests the Trademark Attorney withdraw the refusal to register FIELD.