

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Trademark Application:
Serial No.: 87767116
Applicant: Peach Labs, Inc.
Trademark: PEACH
Filing Date: January 23, 2018

Trademark Law Office: 126
Attorney: Joanna Han

RESPONSE TO OFFICE ACTION

I. Introduction.

The Examining Attorney has refused to register Applicant's mark **PEACH** ("Applicant's Mark") for an online service for ordering from restaurants under Lanham Act Section 2(d) on the ground of likelihood of confusion with two registered marks: **PEACH**, No. 4620676, owned by UsePeach LLC dba Peach (the "UsePeach Mark") for an online marketplace for business and consumer products and **PEACH DISH and Design**, No. 4627302, owned by PeachDish LLC (the "PeachDish Mark") for online food store, food delivery, and food preparation services. As explained below, the Examining Attorney should withdraw the refusal because:

- UsePeach's registration for PEACH has been cancelled.
- Applicant's Mark does not give rise to a likelihood of confusion with the Peach Dish Mark because the marks make different commercial impressions and because the "crowded field" of PEACH-formative marks narrows the protection afforded to any one such mark.

II. Argument.

A. The PTO Has Cancelled the Registration for the UsePeach Mark, and Thus it is No Longer an Obstacle to Registration of Applicant's Mark.

The registration for the UsePeach Mark is no longer a bar to registration of Applicant's Mark because the U.S. Patent and Trademark Office cancelled it on October 12, 2018 pursuant to a judgment by default in Cancellation Proceeding No. 92068732 before the Trademark Trial and Appeal Board. As such, the Examining Attorney should withdraw the refusal based on this registration.

B. There is No Likelihood of Confusion Between Applicant's Mark and the PeachDish Mark.

Trademark Manual of Examining Procedure section 1207.01 states that although the weight to be given to the factors for determining likelihood of confusion *In re E. I. DuPont DeNemours & Co.* 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567-68 (C.C.P.A. 1973) may vary, the following two factors are "key considerations" in any likelihood of confusion determination:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in the application and registration(s).

Section 1207.1 also states that other *DuPont* factors may also be relevant in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record, including:

- The number and nature of similar marks in use on similar goods.

As explained below, there is no likelihood of confusion between Applicant's Mark and the

PeachDish Mark because (1) the marks differ in appearance, sound, connotation, and commercial impression, (2) evidence shows that there is a crowded field of PEACH-formative marks for broadly related goods or services, and (3) Applicant's and Peach Dish's services meet different consumer needs and desires and thus are not closely related.

1. Applicant's Mark Makes a Different Commercial Impression from the Peach Dish Mark.

Applicant's Mark and the PeachDish Mark make different commercial impressions from one another due to the differences between them in appearance, sound, and overall meaning. The design portion of PEACH DISH and Design is distinctive and serves to distinguish it from the word mark PEACH, and the addition of the term "dish" further differentiates it from the Applicant's Mark, which is the word PEACH without any stylization. The PEACH DISH and Design mark is depicted below:



When comparing the similarity of the marks, "[t]he marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. [L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). Commercial impression of a trademark is "derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). Also, as stated above, "[t]he use of identical, even dominant words in common does not automatically mean that the two marks are similar." *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442 (8th Cir. 1987). "Rather, in analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features." *Id.*

The Examining Attorney points to the common use of the word "peach" in both marks, stating that it is the "dominant feature" of the PEACH DISH and Design, and that the mark "also contains design elements that reinforces the overall commercial impression of the mark as PEACH because the mark is made of an image of a peach." However, the marks must be considered as a whole and in the context of how consumers encounter them. For example, in *Presto Products v. Nice-Pak Product, Inc.* the Board noted that "the significance of a mark must be determined not in the abstract, but rather in relation to the goods or services to which it is applied, and the context in which it is used, because that is how the mark is encountered by purchasers." 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988).

The Examining Attorney contends that the omission of the word "dish" "fails to obviate the confusingly similar nature of the marks" but Applicant respectfully disagrees. Here, the words and meanings of "peach" and "peach dish," as well as the design elements of the PEACH DISH and Design mark, are immediately distinguishable from one another. The term peach by itself can refer to the fruit or have different connotations, such as the laudatory term "peachy" (meaning "fine" or "excellent") or an allusion to the state of Georgia, whose nickname is "The Peach State" and which is often associated with peaches. See Wikipedia entry regarding Georgia, attached as **Annex A**.

Indeed, PeachDish's registration shows that the company is based in Georgia, and its website touts the service bringing customers "a diverse mix of flavors and cuisines, rooted in the South" and how the kitchen "creates a menu to satisfy our customers' desires for fresh, delicious Southern cooking." See screenshot of PeachDish's website attached as **Annex B**. "Peach dish" on its face refers to a plate or platter that contains peaches, a plate or platter that is a yellow-pink color, or a food item containing the fruit. The different meaning is particularly relevant in light of the fact that PeachDish provides meal kits to customers that the customers then cook for themselves.

Further, the marks look and sound different. The addition of the design elements helps to distinguish it from the PEACH word mark. The PEACH DISH and Design mark features “peach dish” in a lowercase, serif font on a circle that is divided in two, calling to mind a highly stylized split view of a peach. The left side resembles the outside of a peach with a single leaf at the top and the right side resembles the interior of a peach with the pit in the middle. The design overall also resembles a circular plate. It is not merely an ordinary image of a peach, but a unique depiction of the fruit.

By contrast, Applicant’s Mark has no design elements and therefore customers will immediately distinguish it from PEACH DISH and Design. See specimen submitted on January 23, 2018, showing how the mark is in use; there is no circular design element, only the word “peach” in black font and an image of a peach on wheels, which is immediately distinguishable from PEACH DISH and Design. These stark visual differences eliminate any likelihood of confusion between the marks.

The marks are phonetically distinguishable as well. Even when customers refer to PEACH and PEACH DISH and Design in conversation, without any reference to the design elements, it is clear that they are two different entities due to the addition of distinct word “dish” to the PEACH DISH and Design mark.

Finally, Applicant notes that the wording “peach dish” is disclaimed in the PEACH DISH and Design registration. While the wording must still be taken into account in evaluating the marks for a likelihood of confusion, the disclaimer means that PeachDish has no exclusive rights to the wording apart from as shown in the trademark. Indeed, the disclaimer was entered pursuant to an Office Action issued during the examination of that application; the examining attorney stated:

The term PEACH refers to “a round, sweet fruit that has white or yellow flesh, soft yellow or pink skin, and a large, ha<http://www.merriam-webster.com/dictionary/peach> seed at the center.” See the attached from a Merriam-Webster.com search of “PEACH,” (12/18/13). The word DISH refers to “food that is prepared in a particular way.” See the attached from a Merriam- Webster. com search of “DISH,” <http://www.merriam-webster.com/dictionary/dish> (12/18/13). The meaning of the wording as combined is the applicant’ services feature food in which peach is an ingredient. See the attached sampling of registrations demonstrating use of the terms descriptively to identify food made from peaches. Hence, the wording is descriptive and a disclaimer is required.

The disclaimer of “peach dish” and the descriptive nature of the wording further reduce the practical risk of consumer confusion between PeachDish’s use of and registration for its PEACH DISH and Design mark and Applicant’s Mark, because consumers are inherently unlikely to view the “peach dish” component as a strong source identifier in PeachDish’s trademark.

Because of the distinguishable commercial impressions made between Applicant’s Mark and PEACH DISH and Design, consumers are unlikely to be confused between them.

2. There is a Crowded Field of PEACH Marks in Class 35, Which Indicates That Each Mark is Entitled to a Narrow Scope of Protection

The PEACH DISH and Design mark exists in a crowded field of closely similar marks. It is well settled that where marks are in a crowded field, each mark is entitled only to a narrow scope of protection. See, e.g., *Miss World (UK), Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (“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 In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.”) (citation and internal quotation marks omitted). The law recognizes the marketplace reality that, where the same and similar marks are widely used, consumers are able to differentiate among them. *Id.*

As such, the fact that Applicant’s Mark also includes the term “peach” is not determinative of a

likelihood of confusion. A brief search of the USPTO Trademark Electronic Search System (TESS) reveals 42 active filings for PEACH in connection with class 35, including for retail and food services. See search results attached as **Annex C**. Further, the term “peach” in connection with food services is inherently weak because it refers to a type of food, therefore it is a suggestive mark and also not entitled to a broad scope of protection on that basis.

In light of these numerous uses of PEACH, consumers are unlikely to be confused between Applicant's use of PEACH and PeachDish's use of PEACH DISH and Design.

3. The Services Covered by Applicant's Mark and the Peach Dish Mark Are Not Closely Related.

Although the services respectively covered by Applicant's Mark and the Peach Dish Mark both pertain to ordering food, they serve different consumer needs and preferences – food from various restaurants on demand as opposed to subscription-based delivery of prepared food from one particular provider – and thus are not closely related.

Applicant's application identifies the following services: “on-line and text message ordering services featuring meals prepared by third-party restaurants; electronic processing of restaurant and food orders for others; online and text message ordering services in the field of restaurant take-out and delivery” As such, Applicant's services meet the needs of consumers who seek to order takeout or delivery of food from a variety of different restaurants. Thus when they interact with Applicant, they understand Applicant's PEACH service to be an online platform for ordering on a one-time basis from third party restaurants.

The registration for the PeachDish Mark identifies something quite different: “online retail store featuring food,” “subscription-based food delivery,” and “food preparation services featuring fresh, properly proportioned, healthy meals and made to order for delivery; food preparation services; contract food services.” This is not a platform for ordering food from various different vendors like Applicant's service. When customers interact with PeachDish, they understand that they are dealing with an entity that actually creates the recipes and prepares the ingredients for the meal kits that are designed to meet consumer desires for healthy cuisine and offered on a subscription basis.

The two types of services may be superficially related, but they meet very different needs. Applicant's satisfies the need of a consumer who wants food delivered now and wants a choice from different restaurants. PeachDish's satisfies the need of a consumer who wants, perhaps on a subscription basis the particular types of healthy meals that PeachDish itself creates. Considering the differences in these services, the different commercial impressions the marks make, and the fact that PEACH-formative marks are common for goods or services relating to food, ordinarily prudent consumers are not likely to confuse one for the other.

III. Conclusion.

The registration for the UsePeach Mark has been cancelled and is no longer an obstacle. As for the PeachDish Mark, when one considers the context in which consumers will encounter Applicant's and PeachDish's marks and use their services, there is no likelihood of confusion. Because the marks make different commercial impressions, the marks exist in a crowded field of PEACH-formative marks, and the services on which they are used meet different consumer needs and desires, ordinarily prudent consumers will distinguish the two. For these reasons, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal and approve this application for publication.

Annex A

Georgia (U.S. state)



From Wikipedia, the free encyclopedia

Coordinates: 33°N 83.5°W﻿ / ﻿33°N 83.5°W﻿ / 33; -83.5﻿ / 33; -83.5

This article is about the U.S. state. For the country, see [Georgia \(country\)](#). For other uses, see [Georgia](#).

"State of Georgia" redirects here. For the TV series, see [State of Georgia \(TV series\)](#).

Georgia is a *state* in the [Southeastern United States](#). It began as a British colony in 1733, the last and southernmost of the original [Thirteen Colonies](#) to be established.^[5] Named after King [George II of Great Britain](#),^[6] the [Province of Georgia](#) covered the area from [South Carolina](#) down to [Spanish Florida](#) and [New France](#) along [Louisiana \(New France\)](#), also bordering to the west towards the [Mississippi River](#). Georgia was the fourth state to ratify the [United States Constitution](#), on January 2, 1788.^[7] In 1802–1804, western Georgia was split to the [Mississippi Territory](#), which later split to form [Alabama](#) with part of former [West Florida](#) in 1819. Georgia declared its [secession](#) from the Union on January 19, 1861, and was one of the original seven [Confederate states](#).^[7] It was the last state to be restored to the Union, on July 15, 1870.^[7] Georgia is the [24th largest](#) and the [8th most populous](#) of the [50 United States](#). From 2007 to 2008, 14 of [Georgia's counties](#) ranked among the nation's 100 fastest-growing, second only to [Texas](#).^[8] Georgia is known as the *Peach State* and the *Empire State of the South*.^[7] [Atlanta](#), the state's capital and most populous city, has been named a [global city](#).

Georgia is bordered to the north by [Tennessee](#) and [North Carolina](#), to the northeast by [South Carolina](#), to the southeast by the [Atlantic Ocean](#), to the south by [Florida](#), and to the west by [Alabama](#). The state's northernmost part is in the [Blue Ridge Mountains](#), part of the [Appalachian Mountains](#) system. The [Piedmont](#) extends through the central part of the state from the [foothills](#) of the Blue Ridge to the [Fall Line](#), where the rivers cascade down in elevation to the [coastal plain](#) of the state's southern part. Georgia's highest point is [Brasstown Bald](#) at 4,784 feet (1,458 m) above sea level; the lowest is the Atlantic Ocean. Of the states entirely east of the [Mississippi River](#), Georgia is the largest in land area.^[9]

Contents [hide]

- History
- Geography
 - Boundaries
 - Geology and terrain
 - Ecology
 - Flora

State of Georgia



Flag



Seal

Nickname(s): Peach State, Empire State of the South

Motto(s): Wisdom, Justice, Moderation

State song(s): "Georgia on My Mind"



Official language	English
Spoken languages	English, Spanish (7.42%)
Demonym	Georgian
Capital (and largest city)	Atlanta

[Main page](#)
[Contents](#)
[Featured content](#)
[Current events](#)
[Random article](#)
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[Permanent link](#)
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Annex B



PeachDish Culinary Team

Our chefs are committed to creating delicious, wholesome meals every season of the year. By putting farmers first, the focus is on always fresh, quality, seasonal ingredients as the basis for recipe development.

Culinary Director

Recipe Contributors

Guest Chefs

Our award-winning chefs come from all walks of life, through the American South and beyond. We strive to bring together a diverse mix of flavors and cuisines, rooted in the South.

Annex C



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Nov 13 03:47:02 EST 2018

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **42 Records(s) found (This page: 1 ~ 42)**

Refine Search ("peach")[BI] and ("035")[GS] and ("live")[Id] Submit

Current Search: S3: ("peach")[BI] and ("035")[GS] and ("live")[Id] docs: 42 occ: 136

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88028394		PEACHES AND CHEEKS	TSDR	LIVE
2	88142092		THE FLOSSY PEACH	TSDR	LIVE
3	87952617		PEACH COUNTRY	TSDR	LIVE
4	87937322		RUBY PEACH	TSDR	LIVE
5	87932379		PEACH GOODS	TSDR	LIVE
6	87343275		PEACH JOHN	TSDR	LIVE
7	87828086		PEACH & LILY	TSDR	LIVE
8	87828082		PEACH SLICES	TSDR	LIVE
9	87487098		GPEACH	TSDR	LIVE
10	87767116		PEACH	TSDR	LIVE
11	87326943	5399759	GEORGIA PEACH WORLD	TSDR	LIVE
12	87326865	5399758	GEORGIA PEACH WORLD	TSDR	LIVE
13	87419509	5394606	PEACH VALLEY	TSDR	LIVE
14	87391872	5315894	PEACHES	TSDR	LIVE
15	87276997	5245833	THE BEJWELED PEACH	TSDR	LIVE
16	87190750	5204329	LOVELL'S PEACH COBBLER	TSDR	LIVE
17	86414379	4751448	PEACH THREADS	TSDR	LIVE
18	86742361	4955486	PEACHPIT	TSDR	LIVE
19	86054967	4627302	PEACH DISH	TSDR	LIVE

19	86054967	4627302	PEACH DISH	TSDR	LIVE
20	86892096	5053418	THE ECLECTIC PEACH	TSDR	LIVE
21	86706760	4908551	PEACH CURVES	TSDR	LIVE
22	86402797	4747035	PEACHES GIFTS	TSDR	LIVE
23	86254432	4655738	PEACH POP	TSDR	LIVE
24	86195350	4605280	THE PICKLED PEACH	TSDR	LIVE
25	86006206	4606853	PEACH	TSDR	LIVE
26	86121451	4560053	PEACHES EN REGALIA	TSDR	LIVE
27	85429572	4296265	THE FUZZY PEACH FROZEN YOGURT BAR	TSDR	LIVE
28	85803239	4716890	PEACH AND LILY	TSDR	LIVE
29	85550795	4217473	PEACH SUITE	TSDR	LIVE
30	85505320	4190389	PEACHSTAFF	TSDR	LIVE
31	79211442		PEACH	TSDR	LIVE
32	79166993	4887368	NEMIROFF PEACH FLAVOURED VODKA DISTILLED UNDER THE LICENSE AND CONTROL OF NEMIROFF PREMIUM BRAND N 1872	TSDR	LIVE
33	78406599	2951696	THE PEACH TREE	TSDR	LIVE
34	77738391	3762512	GREAT SEAL OF HUALAPAI TRIBE PEACH SPRINGS ARIZONA 1883	TSDR	LIVE
35	77937671	3975474	PEACH'S CORNER CAFÉ	TSDR	LIVE
36	77744066	3782646	PEACHVIEW DRUGS THE PHARMACY YOU KNOW AND TRUST	TSDR	LIVE
37	77706881	3698678	PEACHTREE WOODWORKING SUPPLY	TSDR	LIVE
38	76534694	2873913	PEACHTREE	TSDR	LIVE
39	76354984	2651853	PEACHES'	TSDR	LIVE
40	75811494	2355427	DAS PEACH HAUS	TSDR	LIVE
41	75293391	2417823	PEACHTREE	TSDR	LIVE
42	89001401		GREAT SEAL OF HUALAPAI TRIBE PEACH SPRINGS, ARIZONA 1883	TSDR	LIVE