

SERVICE MARK

In re Application of: Elior, Inc.
Serial No.: 88/039,781
Filed: July 16, 2018


Mark:  (Int. Class 43)

Trademark Examining Attorney: Christina Calloway
Trademark Law Office: 122

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE


Madam:

In response to the Office Action dated September 4, 2015, Applicant respectfully requests that the Examining Attorney give this matter favorable reconsideration and withdraw the refusal to register Applicant's  mark in view of the remarks provided below.

REMARKS

Refusal to Register under Trademark Act § 2(d)



The Office Action initially refuses registration of Applicant's mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d), asserting that there is a likelihood of confusion between Applicant's

 mark for "contract food and beverage services; services for providing food and drink without delivery; restaurant services; snack-bar services; self-service restaurant services; cafeteria services; services for providing food and drink; gastronomic catering, catering, and canteen services; bar services; snack-bars services; café services; catering" in Int. Class 43 and the

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mark BE WELL MEALS (“Cited Mark”) for “catering; catering of food and drinks; catering services; consulting in the field of menu planning for others; food preparation services featuring fresh, properly proportioned, healthy meals designed to fuel metabolism and burn fat and made to order for delivery or pick up; food preparation services featuring healthy foods, low-fat and low-sodium meals; outside catering services; providing a website featuring information in the field of recipes and cooking; providing personalized meal planning services via a website” in Int. Class 43, which mark is the subject of Registration No. 4,870,544 owned by Leslie O’Neill (“Cited Registrant”).

Applicant respectfully traverses and submits that there is no potential for confusion between Applicant’s use and registration of its  mark and the cited BE WELL MEALS mark. First, Applicant’s mark can be distinguished from the Cited Mark based upon the narrow scope of protection properly accorded the Cited Mark and other third-party marks comprising the terms BE WELL. Additionally, the differences in the appearance, sound, connotation, and commercial impression between the respective marks are sufficient to distinguish Applicant’s mark from the Cited Mark such that no likelihood of confusion exists. These distinctions are the basis for Applicant’s contention that its  mark is suitable for registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney reconsider its application based upon the comments contained hereinbelow.

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1. Applicant’s mark and the Cited Mark should be viewed narrowly.

A significant factor in the determination of likelihood of confusion is the strength of the cited mark. *Mile High Upholstery Fabric Co. v. General Tire & Rubber Co.*, 221 U.S.P.Q. 217 (N.D. Ill. 1983); *see also In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (holding that consideration must be given to “[t]he number and nature of similar marks in use on similar goods”). In this regard, evidence that a term is used within other marks or in multiple markets is evidence that the term should be viewed narrowly. *Cutter Laboratories, Inc. v. Air Products & Chemicals, Inc.*, 189 U.S.P.Q. 108 (T.T.A.B. 1975) (concluding that the term FLEX is somewhat descriptive in nature from evidence of third-party registrations for marks containing the suffix FLEX for flexible plastic products). As with the term FLEX for flexible plastic products, the webpage from the online *The Free Dictionary by Farlex* attached hereto at Exhibit A evidences that the combined terms BE WELL mean “be healthy; feel good” and, thus, are also somewhat descriptive in nature when used in connection with food- and/or drink-related goods and/or services.

Applicant directs the Examining Attorney’s attention to the status pages of the following eight (8) U.S. registrations, attached hereto at Exhibit B, for marks comprising the combined terms BE WELL for food- and/or drink-related goods and/or services.

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| Mark | App. or Reg. No. | Date(s) | Goods and/or Services | Owner |
|--|------------------|----------------------------------|--|---------------------------------|
| BE WELL RED <u>Disclaimer:</u> No claim is made to the exclusive right to use "RED" apart from the mark as shown. | 3,269,578 | Registered: July 24, 2007 | Class 30: Tea. | The Republic of Tea, Inc. |
| BE WELL | 3,499,846 | Registered: September 9, 2008 | Class 43: Hotel and motel services. | Wyndham Hotels and Resorts, LLC |
| BE WELL FED | 4,716,991 | Registered: April 7, 2015 | Class 5: Protein dietary supplements. Class 29: Beef jerky. Class 30: Cookie and protein bars. | John Welbourn |
| BE WELL. DRINK LIVE | 4,769,064 | Registered: July 7, 2015 | Class 30: Beverages, namely, kombucha tea. | Live Soda LLC |
| BE WELL | 5,000,103 | Registered: July 12, 2016 | Class 30: Tea, herbal teas for non-medicinal purposes, tea-based beverages. | The Republic of Tea, Inc. |
| BE WELL BITES <u>Disclaimer:</u> No claim is made to the exclusive right to use | 5,181,939 | Registered: April 11, 2017 | Class 29: Blanched nuts; flavored nuts; fruit-based organic food bars, also containing nuts, brown rice syrup, spices; nut and seed-based snack bars; nut- and dried fruit-based snack bars; nut-based snack bars; nut-based snack foods; nut-based snack foods, namely, nut | Be Well Connections |

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| <p>"BITES" apart from the mark as shown.</p> | | | <p>clusters; organic nut and seed-based snack bars; seasoned nuts; snack mix consisting of dehydrated fruit and processed nuts; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; snack mix consisting primarily of processed nuts, and also including dehydrated fruit, brown rice syrup, spices.</p> <p>Class 41: Direction of making radio or television programs; distribution of radio programs for others; editing of radio and television programmes; educational and entertainment services, namely, a continuing program about lifestyle and wellness accessible by means of internet, internet radio, radio, television, satellite, audio, video, web-based applications, mobile phone applications, computer networks,; educational and entertainment services, namely, a continuing program about lifestyle and wellness accessible by radio, television, satellite, audio, video and computer networks; educational and entertainment services, namely, programs about plastic surgery services combining traditional western medicine practices with holistic therapies, accessible by radio, television, satellite, audio, video and computer networks; entertainment and educational services, namely,</p> | |
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| | | | the presentation of seminars, lectures, workshops and panel discussions, and ongoing television and radio talk shows all in the field of public interest concerning lifestyle and wellness; entertainment and educational services, namely, the presentation of seminars, workshops and panel discussions, and ongoing television and radio shows all in the field of lifestyle and wellness; entertainment services, namely, providing an ongoing radio program in the field of food; entertainment services, namely, providing an ongoing radio program in the field of health, life and wellness. | |
| BE WELL SMOOTHIE <u>Disclaimer:</u> No claim is made to the exclusive right to use "SMOOTHIE" apart from the mark as shown. | 5,420,946 | Registered: March 13, 2018 | Class 43: Providing information in the nature of recipes for drinks. | Kelly LeVeque |
| BE WELL | 5,527,356 | Registered: July 31, 2018 | Class 5: Dietary supplement drink mixes; dietary supplemental drinks; dietary supplemental drinks in the nature of vitamin and mineral beverages; dietary supplements; nutritional supplement shakes; nutritional supplements; powdered nutritional supplement drink mix; powdered | Be Well Health & Wellness LLC |

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| | | | <p>nutritional supplement drink mix and concentrate.</p> <p>Class 29: Shakes.</p> <p>Class 35: Computerized on-line retail store services in the field of health and wellness products; On-line retail store services featuring nutritional and dietary supplements.</p> <p>Class 44: Consulting services in the field of health; consulting services in the field of women's health; consulting services in the fields of health and nutrition; health assessment services; health care services, namely, wellness programs; health counseling; holistic health services; providing health information; providing a website featuring information about health, wellness and nutrition; providing a website featuring information concerning alternative health and healing; wellness and health-related consulting services; consulting in the field of health and wellness to bring about personal happiness; counseling services in the fields of health, nutrition and lifestyle wellness; internet-based health care information services; providing a web site featuring information on health and nutrition; providing information in the fields of health and wellness.</p> |
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The above-referenced marks are **peacefully coexisting** with each other and with the Cited Mark, all of which are owned by different third parties with the exception of U.S. Registration Nos. 3,269,578 (BE WELL RED) and 5,000,103 (BE WELL), which are commonly owned by The Republic of Tea, Inc. More specifically, in the field of beverages, the marks BE WELL RED and BE WELL (for tea), BE WELL. DRINK LIVE (for kombucha tea), BE WELL SMOOTHIE (for drink recipes), and BE WELL (for drink mixes and shakes) are all peacefully coexisting based on relatively incremental differences between the marks and/or goods and/or services recited in the registrations. Likewise, in the field of food, the marks BE WELL FED (for protein snacks and beef jerky) and BE WELL BITES (for snacks) are peacefully coexisting, again, based on relatively incremental differences between the marks and/or goods recited in the registrations. Lastly, in the field of food services, the mark BE WELL (for hotel and motel services (which includes food services)) and the cited mark BE WELL MEALS (for catering and food preparation services) are peacefully coexisting based on the differences between the marks and/or services recited in the registrations. For the same reasons that the BE WELL-formative marks for beverages, the BE WELL-formative marks for food, and the BE WELL-formative marks for food services, in each case, peacefully coexist within specific product categories and all peacefully coexist together within the broader field food and beverage industry more generally, Applicant submits that its

 mark is as distinguishable from the above-referenced marks as they are from each other.

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It is well recognized that evidence of third-party usage in the marketplace strongly suggests that consumers are conditioned by the number of similar marks to differentiate between the marks and the sources from which the marks emanate based upon other distinctions, including the differences between the marks and/or the goods/services offered by the respective parties. *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 U.S.P.Q.2d 1477 (T.T.A.B. 1987) (concluding that the numerous third-party uses of STEVE-formative marks for restaurants and food stores demonstrate that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store businesses use the term and that the purchasing public is able to distinguish between these businesses based on small distinctions among the marks). Given the narrow scope of protection properly accorded the Cited Mark, Applicant respectfully submits that its  mark is equally capable of distinction from the Cited Mark based on the differences between the respective marks discussed below.

2. Applicant's mark is different in terms of appearance, sound, connotation, and commercial impression when compared to the Cited Mark.

Whether the subject marks are similar in appearance, sound, and meaning are material considerations in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The Examining Attorney must compare the allegedly conflicting marks as a whole, rather than breaking up marks into their component parts for comparison. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir.

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1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”). This is the “anti-dissection” rule. *Id.* The rationale for the rule is that the commercial impression of a composite mark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. *See McCarthy on Trademarks and Unfair Competition*, § 23:41, p. 23-227:

The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole.

Similarity as to one aspect of the sight, sound, and meaning trilogy does not itself automatically create a likelihood of confusion between two marks. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1988). As shown by the following cases, courts have rejected the contention that there was likelihood of confusion even when one mark has contained, in part, the whole of another mark:

- “**DOMAINE PINNACLE & Design**” (apple-based beverages) v. “**PINNACLES**” (wine) – *Franciscan Vineyards, Inc. v. Domaines Pinnacle, Inc.*, 2013 TTAB LEXIS 553 (T.T.A.B. 2013);
- “**DISRUPT**” (prophylactic and desiccant powder to prevent growth of microorganisms) v. “**DISRUPT MICRO-FLAKE**” (insecticide and pesticide) – *In re DGR Associate LLC*, 2013 TTAB LEXIS 297 (T.T.A.B. 2013);
- “**QUICK-KILL**” (mousetrap) v. “**AMDRO QUICK KILL**” (insecticide) – *In re Woodstream Corp.*, 2013 TTAB LEXIS 16 (T.T.A.B. 2013);
- “**PARENTS**” (magazine) v. “**PARENT’S DIGEST**” (publication of magazines) – *Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 26 U.S.P.Q.2d 1583 (2d Cir. 1993);

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- “**VARGA GIRL**” (calendars) v. “**VARGAS**” (calendars) – *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992);
- “**FINAL**” (pesticide) v. “**FINAL FLIP**” (pesticide) – *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F. Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986); and
- “**ROMAN**” (cereal breakfast food, bread) v. “**ROMANBURGER**” (specially prepared carry out foods-namely, sandwiches sold for consumption on or off the premises) – *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986).

Considering the Cited Mark in its entirety, Applicant’s  mark is distinctly different in appearance, sound, connotation, and commercial impression from the Cited Mark. In this regard, the prominent aspect of Applicant’s mark is the blueberry design in the first part of the mark. In this regard, courts recognize that the first part of a mark is the part of the mark that is most likely to be impressed upon the mind of a purchaser and remembered. *See Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (“It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”). Additionally, after the prominent and distinctive blueberry design, Applicant’s mark comprises a single, unitary term BEWELL with no space between the terms BE and WELL and with the term WELL emphasized with bolded text. When used in connection with its services in Class 43, Applicant’s mark creates the commercial impression of extending to another person an inspirational wish or message about the person’s health.

In contrast, the Cited Mark is a multi-word mark that contains three (3) **separate terms** “BE”, “WELL”, and “MEALS”. The separation between each of the terms in the Cited Mark and

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addition of the term MEALS creates a distinct commercial impression that “BE WELL” modifies “MEALS” and that the connotation of the mark is akin to “comfort-food” meals. As shown on the Cited Registrant’s website at <https://shopbewellmeals.com/>, a screenshot of which is attached hereto at Exhibit C, the Cited Registrant primarily offers online meal ordering. While Applicant’s mark creates the commercial impression of an inspirational wish to another about his or her health, the Cited Mark creates a distinctly different commercial impression of comfort-food when used in connection with services in Class 43.

For these reasons, Applicant respectfully submits that the differences in the appearance, sound, connotation, and commercial impression created by the Cited Mark and Applicant’s

 mark makes clear that consumer confusion as to source is very unlikely.

3. The totality of the evidence demonstrates the complete absence of any danger of purchaser confusion in this matter.

When making a final determination as to likelihood of confusion, the Examining Attorney must consider *all* of the evidence bearing on the question of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Applicant submits that in light of the narrow scope of protection properly accorded the Cited Mark and the differences in appearance, sound, connotation, and commercial impression of the respective marks, there is **no** danger of consumer confusion as to source under these circumstances.

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Applicant respectfully requests that the Examining Attorney give favorable reconsideration to its application in light of the remarks submitted herewith directed to the issues of likelihood of confusion. Applicant submits that its mark is not likely to cause confusion with the Cited Mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw this rejection and pass its application to publication at the earliest possible date. Such favorable action on the part of the Examining Attorney is respectfully solicited.