

July 3, 2019

U.S. Application Serial Number: 88316525

Applicant's Mark: Joey's Mountaintop

Applicant: Luttmann Marketing & Ventures LLC

Examining Attorney: Gene V.J. Maciol, II

RESPONSE TO OFFICE ACTION OF MAY 13th, 2019

The Examining Attorney rejected Application Serial Number 88316525 based on Section 2(d) of 15 U.S.C. 1052(d) finding a likelihood of confusion between applicant's word mark, "Joey's Mountaintop" for "Coffee; Coffee drinks; Coffee-based iced beverages; Iced coffee; Prepared coffee and coffee-based beverages" ("Applicant's Mark") and Registrant's design mark comprised of a sun and the word "Joey's" for "Beverages made of tea; Beverages with a coffee base; Beverages with a tea base; Flavorings for beverages; Flavorings for beverages, other than essential oils; Herbal flavourings for making beverages; Herbal food beverages; Mixes in the nature of concentrates, syrups or powders used in the preparation of tea based beverages; Prepared coffee and coffee-based beverages; Scented water for flavoring beverages; Tea-based beverages; Tea-based beverages with fruit flavoring" ("Registrant's Mark").

ANALYSIS OF THE DU PONT FACTORS WEIGHS IN FAVOR OF REGISTRATION

The seminal case of *E. I. du Pont de Nemours* 177 USPQ 563 (CCPA, 1973) lists twelve specific relevant factual inquiries. The Court of Appeals for the Federal Circuit acknowledged the role of the *duPont* factors in *Specialty Brands v. Coffee Bean Distributors, Inc.*, 798 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) as mandating review of marks in their entirety to reflect the marketplace where confusion can occur. Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. Furthermore, the significance of a particular factor may differ from case to case.

Addressing the relevant *duPont* factors in turn, Applicant respectfully submits that no likelihood of confusion is apparent and hereby respectfully requests reconsideration and withdrawal of the rejection under § 2(d).


FACTOR ONE

THE DISSIMILARITY OF THE MARKS IN THEIR ENTIRETIES AS TO APPEARANCE, SOUND, AND COMMERCIAL IMPRESSION

The first factor, of course, is the marks themselves. The Examining Attorney's May 13th Office Action stated that the respective marks are comprised in whole or significant part of the term "Joey's" and that consequently, the marks share the same over-all sound, appearance and

commercial impression. It was further stated that adding a term to a registered mark generally does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section 2(d). However, it is well settled that similarity as to one aspect of the sight, sound and meaning trilogy does not automatically result in a finding of likelihood of confusion. In comparing the two marks in their entirety, Applicant contends that confusion as to source between Applicant’s mark and Registrant’s Mark is not likely based upon the difference in the appearance, sound, and commercial impression of the marks.

APPEARANCE:

Registrant’s Mark	Applicant’s Mark
	<p data-bbox="880 737 1360 800">Joey's Mountaintop</p>

Here, the similarity in the appearance of one word, “Joey’s” is hardly cause to determine that consumers would make a mistake as to the source of the Registrant’s and Applicant’s respective products and services. Visually, the marks appear entirely different in a side by side comparison. Registrant’s Mark is a design mark which includes a pictorial representation of a sun with rays and the word “Joey’s” in a distinct stylized font, with the sun design being a pronounced, centered, and dominant feature of the mark, as is customary when highlighting the prominence of a product’s source identifying logo.

Applicant’s mark consists two words displayed in standardized font with no claim to color or font style. Although the Examining Attorney stated that adding a term to a registered mark generally does not obviate the similarity between the compared marks, the word “Mountaintop” is certainly a visual distinction to be taken into consideration when reading the marks, as it significantly differentiates and lengthens Applicant’s mark and invokes an entirely different image in the mind of the average consumer, and so, visually, the marks appear quite different.

SOUND:

When read aloud in their entirety, “Joey’s” sounds markedly different from “Joey’s Mountaintop”. Although Applicant concedes that the word “Joey’s” is likely to be pronounced identically, the difference in pronunciation between the marks when read aloud in their entirety is vast. Additionally, when read aloud, Applicant’s Mark has five syllables that are stressed while Registrant’s Mark only has two syllables.

COMMERICAL IMPRESSION:

The commercial impression of a trademark can be analyzed in a number of ways to determine whether it's likely to create confusion. Commercial impression may be based not only on the similarity of appearance, but also on the similarity of meaning. The significance of the Applicant's mark is a factor to consider when determining whether the mark serves a trademark function. The word "Mountaintop" is not just an additional meaningless word added to obviate the similarity of the word "Joeys", but rather, it adds contextual distinctness in the minds of the average consumer, invoking the image of mountaintops owned by Joey, and further, when used on products, coffee growing at high altitudes in mountainous regions. Registrant's Mark, "Joey's," invokes no similar image or impression in the minds of consumers. At best, Registrant's Mark invokes the image of a sun with rays or a sunflower but leaves consumer's guessing as to what types of products or services "Joey's" identifies. The commercial impression of a mountainous region robust with coffee plantations elicited from Applicant's Mark is entirely different from that of a sun or sunflower elicited from Registrant's mark.

FACTOR TWO

THE DISSIMILARITY AND NATURE OF THE GOODS OR SERVICES

The second factor is telling in the instant case. As discussed herein, Applicant maintains that the marks involved are not so highly similar that the burden would be lessened with respect to showing the relatedness of the involved goods. Applicant fully appreciates that in assessing the similarity of goods and services of the two marks at issue, the Examining Attorney will look to the Registrant's description of goods and services as well as the international class for which registration was obtained. However, it should be noted that actual use of Registrant's Mark has been limited to juice and flavored cold tea products as evidenced by specimens attached hereto as Exhibit A¹. In contrast, Applicant has narrowly applied for "Joey's Mountaintop" to be used on coffee products and coffee related services only. Juice and botanical cold teas and coffee are completely different products with the only commonality being that they are all beverages.

Botanical cold teas, juices and coffee have entirely different methods of manufacture and contain markedly different ingredients. Tea is an aromatic beverage commonly prepared by pouring hot or boiling water over cured leaves of the *Camellia sinensis*, an evergreen shrub (bush) native to East Asia². Juice is a drink made from the extraction or pressing of the natural liquid contained in fruit and vegetables. It can also refer to liquids that are flavored with concentrate. Juice is commonly consumed as a beverage or used as an ingredient or flavoring in foods or other beverages, as for smoothies³. Coffee is a brewed drink prepared from roasted coffee beans, the seeds of berries from certain *Coffea* species. The genus *Coffea* is native to tropical Africa, specifically having its origin in Ethiopia and Sudan. Dried coffee seeds (referred to as "beans")

¹ Please see attached as Exhibit A specimens of Registrant's juice and tea products and services.

² <https://en.wikipedia.org/wiki/Tea>

³ <https://en.wikipedia.org/wiki/Juice>

are roasted to varying degrees, depending on the desired flavor. Roasted beans are ground and then brewed with near-boiling water to produce coffee⁴.

Accordingly, the vast differences in the products themselves, as evidenced in the methods of manufacture and ingredients in tea, juice, and coffee weigh against finding a likelihood of confusion.

FACTOR FOUR

SOPHISTICATION OF CONSUMING POPULATION

The fourth *duPont* factor to consider in determining whether consumer confusion is likely is the expected care and attention of consumers when purchasing a product with both Applicant's and Registrant's respective marks. This factor involves consideration of the price of the products at issue, the sophistication of the segment of the market purchasing the products at issue, and/or other evidence suggesting a heightened level of scrutiny by a purchaser.

Both Registrant's juice and cold tea products and Applicant's coffee products are geared towards sophisticated consumers, or connoisseurs of high-end organic beverages. Consumers looking for specialized or high-quality botanical juices, cold teas, and organic coffees are especially careful in their product selection; they do their research before purchasing and rarely engage in "impulse buying". The consumer base for botanical teas, health juices, and organic coffee is sophisticated enough not to assume that entirely different products, with different and distinct label information, label designs and logos, packaging and brand names originate from the same source simply because their marks share one common word.

As the Examiner may well be aware, there has been an explosion in consumer awareness and sophistication in the coffee industry. Coffee culture has evolved drastically over the last decade and the rise in consumers who considers themselves coffee connoisseurs suggests a higher level of purchasing scrutiny. Consumers pay attention to coffee purchasing factors such as country of origin, bean type, farming practices, variety, blend, acidity, roast profile, brew, etc., and are loyal to specific brands of coffee that they have been exposed to over time. With such scrutiny in purchasing decisions, impulse buys are rare, equating to a high unlikelihood of confusion as to the source of "Joey's Mountaintop" coffee products and the "Joey's" sunshine design mark on botanical teas and juices.

Further, consumers are also inundated with advertising for teas, juices, and coffees which emphasize their respective advertisers' trademarks, logos, and branding, causing consumer familiarity with the source and brand names of a wide variety of beverage products. Consumers of these types of lifestyle products are quite aware of what they are buying and are relatively sophisticated, as compared to e.g., a purchaser of toys, novelties, clothing, house paint or other non-lifestyle products. Accordingly, this factor weighs against finding a likelihood of confusion.

⁴ <https://en.wikipedia.org/wiki/Coffee>

FACTOR FIVE

THE FAME OF THE PRIOR MARK

In addressing the fame of the Registrant's Mark, one has to address the extremely limited use of the Registrant's Mark. Upon information and belief, it appears that Registrant no longer uses the "Joey's" design mark in commerce, nor did Registrant use the mark in a continuous and bona fide manner as to achieve consumer recognition, notoriety, or acquired distinctiveness on goods and services in the stream of commerce. Registrant's website, advertising, and social media appear to have been inactive since at least 2015.⁵

FACTOR SIX

THE NUMBER AND NATURE OF SIMILAR MARKS IN USE ON SIMILAR GOODS.

Common expressions, symbols and phrases are normally not perceived as trademarks. However, they can be used to show the sense in which a mark is used in ordinary parlance, and thereby prove that a mark or portion thereof has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that it is relatively weak⁶. Here, the term "joe" or "cup of joe" is a commonly used expression meaning coffee⁷. Although there are several theories that have been put forth as to the nickname's origins, most consumers are familiar with variations of the word "joe" to mean coffee. Due to the popularity and widespread use of the term over the years, the term has been diluted significantly in reference to coffee related products and services. Popular terms used often on certain products are usually denied registration so that other members of the public are afforded the opportunity to also use the term on their respective products and services. The use of the term "joe" in reference to coffee is so widespread that it would seem unfair to deprive all coffee related companies use of the term or variations of the term "joe" or "cup of joe" when referring to coffee because of Registrant's prior registration⁸.

It is true that Applicant's mark includes a variation of the word "joe" in order to invoke an image of coffee in a consumer's mind, but "Joey's Mountaintop" invokes a much more distinct image in the mind of a consumer, such as coffee beans growing on mountaintops, making the mark a strong source identifier.

FACTOR TWELVE

POTENTIAL CONFUSION AS TO SOURCE OF GOODS HIGHLY UNLIKELY

⁵ Please see Registrant's last known social media /advertising post in 2015 attached hereto as Exhibit B.

⁶ See *Juice Generation, Inc. v. GS Enters. LLC*, __F.3d__, 115 USPQ2d 1671, 1675 No. 2014- 1853 (Fed. Cir. July 20, 2015)

⁷ https://en.wiktionary.org/wiki/cup_of_joe

⁸ Please see attached webpages documenting examples of the voluminous amount of coffee related products and services using variations of the term "joe", attached hereto as Exhibit C.

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon⁹. For that reason, the test of likelihood of confusion is whether the marks create the same overall impression¹⁰. The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks¹¹. The mistaken belief that a good is manufactured or sponsored by the same entity as another good is precisely the mistake that §2(d) of the Lanham Act seeks to prevent¹².

Here, this type of actual confusion between Registrant's Mark and Applicant's Mark is unlikely. Most notably and of greatest weight, Registrant's Mark is a design mark consisting of a sun/sun flower and the word "Joey's" in a stylized font written across the middle of the sun design. Regarding the design element in the Registrant's mark, Applicant acknowledges that when words and design elements are used together, the words are generally considered the dominant element of the mark. However, third-party evidence in the record, attached hereto as Exhibit B, shows that the dominant element of the mark is weak or diluted, causing the design element take on a more significant role in distinguishing the mark. Applicant's Mark is a word mark which contains no design or pictorial representations and consists of a completely different term, thereby eliciting a completely different image in the mind of the consumer. It is difficult to imagine a consumer who would make the mistaken assumption that, out of all of the coffee brands in existence using a variation the term "joe", Registrant's juice company is also the source of "Joey's Mountaintop" coffee products, or visa versa. That would mean that the consumer would have to also assume that Registrant decided to arbitrarily remove its source identifying brand logo, change the font of the word "Joey's" and add on the word "Mountaintop". To make such an attenuated assumption would appear to be a leap in logic on the part of a consumer. Accordingly, this factor weighs against finding a likelihood of confusion.

CONCLUSION

As discussed above, Applicant's Mark is not confusingly similar to the Registrant's Mark with respect to appearance, sound, commercial impression, similarity of goods, consumer sophistication, fame of the prior mark, and most importantly, as to the source of goods. Applicant respectfully requests reconsideration and withdrawal of the rejection under § 2(d) and that the subject application be approved for publication without further delay.

⁹ See, e.g., *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.").

¹⁰ See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980).

¹¹ See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

¹² See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

Respectfully Submitted,

Ryan Malkin
Malkin Law, P.A.
260 95th Street
Suite 206
Miami Beach, FL 33154