

To: USPTO

From: Satinder Singh, California Legal Corp.

Re: Memo – Response to Office Action – ARIES – 88212606

Summary of Issues

- Section 2(d) Likelihood of Confusion for Certain Goods in Class 30 Only

Section 2(d) Refusal – Likelihood of Confusion for Certain Goods in Class 30 Only

The stated refusal refers to the following goods and/or services and does not bar registration for the other goods and/or services: “grain-based snack foods; multigrain-based snack foods.”

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4417606. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 et seq.

Applicant’s mark is ARIES for, in part, “grain-based snack foods; multigrain-based snack foods.”

The cited registration is “TORTILLAS ARIES” (Reg. 4417606) for “Tostadas; Corn chips; Salsa; Tortilla chips; Tortilla.”

Trademark act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont factors*”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (*citing Shen Mfg. Co. v. Ritz hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); *see In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2019)

Although not all *du Pont factors* may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (*quoting Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Here, respectfully, the Examiner has erred in its conclusion that the Applicant’s registration to the USPTO should be refused because it has not taken into consideration the entirety of the marks, the distinct differences in the registrant and the applicant’s goods and/or services, as well as the existence of substantially similar third party marks that are already on the USPTO register. Furthermore, the Examiner must consider the target audience and the proposition provided by each mark. The Applicant’s marks and the referred to marks attract different consumers as the Applicant’s mark focuses on those who believe in Zodiac calendar. Furthermore, the likelihood of confusion is minimal as the marketing will contain distinct references alluding to only one interpretation, the zodiac calendar.

Comparison of the Marks / Entirety of the Marks

Here, respectfully, the Examiner has erred in its analysis of the two marks by not taking into consideration the entirety of each mark. The Applicant's entire mark is "ARIES" and the Registrant's entire mark is "TORTILLAS ARIES"

It is well-established that it is improper to dissect a mark and the marks must be viewed in their entireties. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) ("The marks must be viewed in their entireties, words and design."); *see also Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 U.S.P.Q.2d 1782, 1792 (T.T.A.B. 2002) (same). In some circumstances however, "one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1905; *see also In re Dat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark provided the ultimate conclusion rests on consideration of the marks in their entireties.")

The Examiner in its Office Action Letter dated February 12, 2019 does not take into consideration the differences of the marks in its analysis, and therefore has not compared the goods in their entirety. The Applicant's entire mark is "ARIES" and the registrant's mark is "TORTILLAS ARIES". The descriptor "TORTILLAS" describes the goods that the mark represents. Tortillas are a small corn based flat bread that originated in Latin and South America. (<https://en.wikipedia.org/wiki/Tortilla>). This descriptor creates a distinct commercial impression by describing the goods as represented by the Registrant's Mark, in this case tortillas. Although the word "TORTILLAS" is only a descriptor and is not the more dominant feature of the Registrant's Mark, "ARIES", the addition of a descriptor creates a substantial difference in the commercial impression of the marks.

Therefore, the significant difference in commercial impression caused by the descriptor alleviates any possible likelihood of confusion as to the origin of the goods to a reasonable purchaser.

Comparison of the Goods

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (*quoting 7-Eleven Inc. v. Wechsler*, 83 USPQ2 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i). In the present case, the marketing of the products focuses on two different things, the zodiac calendar and the one is simply a name that the Registrant uses. The commercial impression is clearly unique and distinct.

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.* 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (*citing In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers."

In Viterra Inc. 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Here, respectfully the Examiner has erred in its conclusion that there would be a likelihood of confusion between the goods that are represented by the Registrant and Applicant's Marks. The goods represented by the Applicant's Mark are listed as "grain based snack foods; multigrain-based snack foods" and goods represented by the Registrant's Mark listed as "Tostadas; Corn chips; Salsa; Tortilla Chips; tortillas."

The substantial difference between these two set of goods is that the goods represented by the Registrant's Mark are all corn-based goods and the goods represented by the Applicant's Mark are grain and multigrain based foods. Although sometimes mistaken for a grain, corn is actually also a vegetable and a fruit, depending on what part is harvested.

"Answering the question of whether or not corn is a vegetable sounds like it would be simple. In fact, it's a little more complicated than it appears. Whole corn, like you eat on the cob, is considered a vegetable. The corn kernel itself (where popcorn comes from) is considered a grain. To be more specific, this form of corn is a "whole" grain. To complicate things a little more, many grains including popcorn are considered to be a fruit. This is because they come from the seed or flower part of the plant. So, corn is actually a vegetable, a whole grain, and a fruit. But no matter what form it comes in or what category it falls into, corn is good for you and can be part of a healthy diet. Even plain popcorn can be healthy when prepared without oil, butter, or salt. In contrast, vegetables are from the leaves, stems, and other parts of a plant. This is why several foods people think of as vegetables are actually fruits, like tomatoes and avocados." (<https://www.healthline.com/health/food-nutrition/is-corn-a-vegetable#1>)

"When you picture corn in your head, you likely imagine fresh, yellow, corn on the cob. This type of corn, also called sweet corn, belongs in the vegetable food group. Scientifically, because corn is a structure to bear seeds, corn is a fruit. However, in agriculture, corn is called a cereal grain. This is because corn is a grass harvested for its kernels. Most corn is field corn and, unlike sweet corn, is harvested after it is fully mature and had time to dry out. Field corn is soaked and milled so the germ, oil, starch, and hulls can be separated. These items are then made into cornstarch, cooking oil, sweeteners, cereal, beverages, and over 4,000 other products we use every day. When we eat dried corn, like corn meal, cereal, corn flour, or popcorn, it falls in the grains part of our diet. So...corn is a vegetable, fruit and a grain!" (<http://www.agintheclassroom.org/TeacherResources/AgMags/Corn%20Ag%20Mag%20Smartboard.pdf>)

Therefore, this substantial difference in the goods represented by the Registrant and Applicant's Marks, grains versus corn, is more likely to create a commercial distinction and eliminate any likelihood of confusion among purchasers as to the origin of the products. Also, the fundamental difference would still remain, the commercial impression would be distinct.

Third Party Marks

It appears that the Examiner has also not considered the third-party use of other substantially similar registered marks that are considered by the USPTO not likely to cause confusion.

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to

deceive. *E.g., In re Max capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.* 91 USPQ2d 1266, 1272 (TTAB 2009). However, active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See e.g., In re i.am.symbolic, llc* 886 F.3d 1315, 123 USPQ 2d 1744 (Fed. Cir. 2017); *Jack Wolfskin Ausrustung Fu Daussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.* 797 F.2d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters, LLC*, 794 F.3d 1334 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Primrose Ret. Cmtvs., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. V. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registration similar to dictionaries showing how language is generally used. *See, e.g. Tektronix, Inc. v. Daktronics Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694095 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987). However, cancelled or expired third-party registrations for similar marks are not probative evidence of a mark's descriptiveness, suggestiveness, or strength. *See Bond v. Taylor*, 119 USPQ2d 1059, 1054 n. 10 (TTAB 2106).

Third-party registrations that cover a number of different goods or services may have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. *Hewlett-Packard Co. v. Packard Press, Inc.* 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)(evident that “a single company sells goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Mucky Duck Mustard Co.* 6 USPQ2d 1567, 1470 n.6 (TTAB), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988); *see also In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509, 1511 (TTAB 2010) (“While third-party registrations can play an important role in establishing that the types of goods at issue are related, examining attorneys must review the review the registrations carefully to ensure that each registration presented is probative and that the number of registrations is sufficient, along with other types of evidence, to establish that the types of goods at issue are related.”) Third-party registrations that are not based on use in commerce, such as those registered under §66 of the Trademark Act. (15 U.S.C. §1141f(a)), or those registered solely under §44 of the Trademark Act (15 U.S.C. §1126(e)), and for which no §8 or §71 affidavits or declaration of continuing use have been filed (15 U.S.C. §1058), have very little, if any persuasive value. *See Calypso Tech. Inc. v. Calypso Capital Mgmt, LP*, 100 USPQ2d 1213, 1221 n.15 (TTAB 2011); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

A list of registrations or a copy of a search report is not proper evidence of third-party registrations. *See, e.g. In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); 78 USPQ2d 1301, 1304 (TTAB 2006); *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2. (TTAB 1998); TBMP §1208.02. To make registration of record, copies of the registrations or the electronic equivalent thereof (i.e. printouts or electronics copies of the registrations taken from the electronic database of the USPTO) must be submitted. *In re Ruffin Gaming, LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); TBMP §1208.02; TMEP §710.03.

Evidence of third-party use falls under the sixth *du Pont factor* – the “number and nature of similar marks in use on similar goods.” *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar, it “is relevant to show that the mark is relatively weak and entitles to only a narrow

scope of protection. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772* 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1683 (Fed. Cir. 2005); *see also In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (finding the component term SMOKING HOT in the marks I'M SMOKING HOT and SMOKIN' HOT SHOW TIME to be "somewhat weak" based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses "tend to show consumer exposure to third-party use of the term on similar goods"); *Mini Melts, Inc. v. Reckitt Benckiser LLC* 118 USPQ2d 1454, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak"); but *see Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("the existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark.")

Currently, there are SIXTY-FOUR (64) registered marks on the USPTO TESS database with the mark or a substantially similar mark to "ARIES" (See attached as "Exhibit A"). The large number of these marks registered to the USPTO register weakens the protections for these registered marks on the register. The existence of these marks on the USPTO register weakens the Examiner's conclusion to refuse the applicant's ability to register its mark on the USPTO.

Conclusion

Respectfully, the conclusion that there would be a likelihood of confusion between the registrant's mark and the applicant's mark is incorrect. Although the two marks are similar, the other *du Pont factors* including the differences in the goods, marketing, target consumers and the additional third-party marks that have been registered all weigh against any likelihood of confusion between the two marks.