



**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

LAW OFFICE No. 110
In re Application of: **Bayer S.A.S. (France)**
To Register the Mark: **BALANCE**
Serial No. **88138233**
Office Action Mailing Date: **January 14, 2019**

RESPONSE

This Response is submitted on behalf of Bayer S.A.S. (France) (“Applicant”) in response to the Office Action dated January 14, 2019 (the “Office Action”) preliminarily refusing registration of application Ser. No. 88138233 for the BALANCE mark (the “Mark”) for “Agricultural grains for planting; Agricultural seeds; Seeds for horticultural purposes” in Class 31.

In the Office Action, registration of the Mark was refused on grounds of likelihood of confusion under Section 2(d) of the Trademark Act based on the following registrations (the “Cited Marks”) in the name of Nachurs Alpine Solutions, LLC:

Reg. No.	Mark	Goods
3324044 App. Filing Date: Jan. 19, 2006 Reg. Date: Oct. 30, 2007		Class 1: Fertilizers; Fertilizers for agricultural use; Fertilizers for domestic use
4613613 App. Filing Date: Mar. 03, 2014 Reg. Date: Sep. 30, 2014	BALANCE	Class 1: Fertilizers; Fertilizers for agricultural use
4654376 App. Filing Date: Mar. 03, 2014 Reg. Date: Dec. 09, 2014		Class 1: Fertilizers; Fertilizers for agricultural use

Registration of the Mark was also refused as a varietal name under Sections 1, 2, and 45 of the Trademark Act and information regarding the Mark was requested.

With respect to the Cited Marks, Applicant respectfully disagrees with the Examining Attorney's analysis and conclusion. With this response, Applicant requests that the Examining Attorney reconsider the refusals and accept the application for publication.

BACKGROUND

Applicant received approval in October 2015 of the BALANCE mark in Class 31 for "Grains and agricultural, horticultural and forestry products, namely, agricultural seeds excluding alfalfa and barley," as Ser. No. 85801669, filed December 13, 2012, over the cited Reg. No. 3324044. See **Exhibit A**. Applicant is also owner of Reg. No. 2171534 for the BALANCE mark for "herbicides for agricultural use" in Class 5, with the registration date of July 7, 1998. See **Exhibit B**. Applicant's earlier registered Reg. No. 2171534 was not cited as an obstacle to registration of the cited Reg. No. 3324044, nor was Applicant's Reg. No. 2171534 cited as an obstacle to cited Reg. Nos. 4613613 and 4654376. Likewise, Applicant's earlier-filed Ser. No. 85801669 was not noted as a potential obstacle for the applications filed in 2014 which issued as cited Reg. Nos. 4613613 and 4654376.

Applicant filed timely extensions to file a Statement of Use for Ser. No. 85801669 until April 2018 when no further extensions were permitted. The Office listed Ser. No. 85801669 as abandoned on November 19, 2018. Applicant filed the current application for the Mark on October 1, 2018.

The Office determined that the Mark could coexist in the Register with cited Reg. No. 3324044 before, just as all of the Cited Marks coexist with Applicant's Reg. No. 2171534.

Similarly, cited Reg. Nos. 4613613 and 4654376 were deemed able to coexist with Applicant's earlier-filed Ser. No. 85801669. As discussed in more detail below and as no circumstances have changed against continued coexistence at present, Applicant submits that subject Mark should be deemed able to coexist with Reg. No. 3324044 and the other Cited Marks again.

RESPONSE TO INFORMATION REQUEST / VARIETAL NAME REFUSAL

Applicant's BALANCE mark is not a varietal name for the identified goods. Applicant intends to use the BALANCE mark as a brand name for an herbicide-tolerant trait system incorporated into seeds, e.g., soybean seeds and cotton seeds. In this way, goods under the BALANCE mark are similar to ROUNDUP READY, LIBERTYLINK, or any of the other trait packages currently in existence. *See, e.g., **Exhibit C***, "Roundup Ready," https://en.wikipedia.org/wiki/Roundup_Ready (accessed July 9, 2019) ("Roundup Ready is the Monsanto trademark for its patented line of genetically modified crop seeds that are resistant to its glyphosate-based herbicide, Roundup."); **Exhibit D**, "LibertyLink (gene)", [https://en.wikipedia.org/wiki/LibertyLink_\(gene\)](https://en.wikipedia.org/wiki/LibertyLink_(gene)) (accessed July 9, 2019) ("LibertyLink provides an herbicide resistance system that is still effective in the presence of glyphosate resistant weeds ... The LibertyLink gene is available in a variety of crops including corn, cotton, canola, sugarbeet and soybean."); **Exhibit E**, "LibertyLink®," <https://agriculture.basf.com/us/en/Crop-Protection/LibertyLink.html> (accessed July 9, 2019) ("The LibertyLink trait is widely available in high yielding, high-quality [] cotton seed varieties.").

Furthermore, the word “balance” has many common meanings, including “equilibrium” and to “bring into harmony,” which could be perceived as suggestive by the consumers of the agricultural-related goods.

The Examining Attorney inquired as to:

- (1) Whether BALANCE has ever been used or will be used as a varietal or cultivar name; and
- (2) Whether BALANCE has ever been used or will be used in connection with a plant patent, utility patent, or certificate for plant-variety protection.

The response to both inquiries from Applicant is “no.”

To clarify the nature of the goods to exclude any varietal names, Applicant amends the identification of goods. This is consistent with Applicant’s prior Ser. No. 85801669 for the BALANCE mark which excluded alfalfa and barley and was allowed for “Grains and agricultural, horticultural and forestry products, namely, agricultural seeds excluding alfalfa and barley.”

After amendment, the goods for the current application shall read: “Genetically-modified agricultural grains for planting excluding alfalfa, barley, and leek; Genetically-modified agricultural seeds excluding alfalfa, barley, and leek; Genetically-modified seeds for horticultural purposes excluding alfalfa, barley, and leek.”

Accordingly, Applicant respectfully requests withdrawal of the refusal under Sections 1, 2, and 45 of the Trademark Act.

RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL

Dissimilarity of the Respective Goods and Trade Channels

“This factor considers whether ‘the consuming public may perceive [the respective goods] as related enough to cause confusion about the source or origin of the goods[.]’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)). This determination is based on the goods as identified in the application and the cited registration. *See Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Although the identification of goods for Applicant’s Mark and the Cited Marks are both related to “agriculture” that alone is not sufficient to show that the products are so related to cause confusion as to source. *See Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983) (“the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required ‘relatedness.’”). By categorization in different International Classes, as is the case here with the marks at issue, the presumption is that there are significant differences between the relevant goods. One must go beyond the fact that the marks involve the same general broad field of “agriculture” and evaluate instead the particular sub-market served by each good. *See Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992) (citing *Astra Pharmaceutical Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983) (finding no likelihood of confusion between ASTRA blood analyzing machine and ASTRA pharmaceutical products, even though they both were being sold to the same hospitals). Even if, unlike the current case, goods are somewhat

related in that they serve the same general market, the fact that these goods serve distinct sub-markets can sufficiently negate a likelihood of confusion. *Id.*

Applicant's goods are genetically-modified grains and seeds excluding alfalfa, barley, and leek. The goods for the Cited Marks are fertilizers. The goods for the Cited Marks do not include Applicant's goods. Likewise, Applicant's goods do not include the goods for the Cited Marks. As the goods are not identical, the Office Action relies on Internet evidence to attempt to show that the respective goods are complementary and/or manufactured by the same entity.

The Internet evidence relied upon in the Office Action does not show that the respective goods are related. Applicant respectfully submits that this evidence is not probative of relatedness of the respective goods, and reliance on this evidence is misplaced. The farmfert.com excerpt may indicate that an entity has used the trade name "Farm Fertilizers & Seeds, Inc." However, the screenshot does not indicate that that entity still uses that trade name, that the entity markets both genetically-modified seeds and fertilizer, or that consumers would recognize that genetically-modified seeds and fertilizer are purportedly complementary based on this excerpt. Merely including two terms in a trade name is insufficient to show that the relevant goods are complementary in terms of use and function.

Similarly, the excerpts from agriculture.basf.com and basf.com do not show that the same entity manufactures genetically-modified seeds and fertilizer under the same mark. The relevant test for relatedness is not that an entity may manufacture both products (which is not shown in the excerpts for BASF or Corteva, in any event), but that consumers would believe that the goods originate from the same source as shown by evidence that both products are offered by a single producer under the same trademarks.

Neither excerpt shows this for BASF or Corteva. The first excerpt shows that BASF markets its products under *specific brand names*, such as Sepiret® and Flo Rite® for seed coatings, Integral® and Velondis™ for biofungicides, or Systiva® and Insure® for fungicides and insecticides. There is no indication in the excerpt that consumers would recognize BASF as the brand name or that BASF markets both genetically-modified seeds and fertilizer under the BASF mark. Instead, the excerpt shows the opposite: that consumers would recognize specific brand names under which BASF markets its products.

The second excerpt is an article which indicates that BASF supplies a polymer to the Florikan company and that Florikan markets a fertilizer with this polymer as FlorikanCRF. There is no indication in the excerpt that consumers would recognize BASF as the source of a *component* of the FlorikanCRF brand fertilizer.

Similarly, the corteva.us excerpt shows that Corteva markets its products under *specific brand names*, such as Instinct® for a chemical for controlling nitrification process (which is, notably, not fertilizer), and numerous seeds brands, like Mycogen Seeds, AgVenture, Inc., Alforex Seeds, and Dairyland Seed. There is no indication in the excerpt that consumers would recognize Corteva as the brand name or that Corteva markets both genetically-modified seeds and fertilizer under the Corteva mark. Again, the excerpt shows the opposite: that consumers would recognize specific brand names, not that consumers would recognize Corteva as the source of both fertilizers and seeds.

Finally, the lowes.com excerpt is not relevant as the product is not an herbicide-tolerant trait system incorporated into, e.g., soybean seeds and cotton seeds.

It is well-settled that even where marks are identical in appearance, confusion is deemed unlikely if the goods or services bearing the marks are not advertised or sold in such a way that

purchasers would be inclined to erroneously believe the services come from the same source. *See, e.g., Dynamics Research Corp. v. Lengenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed. Cir. 1983) (DRC for gauges for press brakes sold to sheet metal fabrication shops held not confusingly similar to DRC for sheet metal fabric); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1143 (TTAB 2009) (finding no likelihood of confusion despite nearly identical marks, stating “the dissimilarity of the goods due to their nature, the manners in which they are sold or distributed, and the circumstances under which consumers would encounter them, is a dispositive factor in this case”); *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for preparation of plumbing advertising copy and literature); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ 2d 1668, 1669 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for photocopiers and blueprint machines).

Going further, numerous cases have found no likelihood of confusion even where the parties’ goods or services were somewhat related. *See, e.g., In re Parfums Schiaparelli, Inc.*, 37 USPQ2d 1864 (TTAB 1995) (overruled on other grounds) (finding no confusion between SCHIAPARELLI for fragrances and SCHIAPARELLI for clothing and fashion accessories, despite frequent crossover in the fragrance and fashion industries); *In re Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988) (finding no likely confusion between PALM BAY for women’s shoes and the cited PALM BAY for shorts and pants); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused with PLAYERS for shoes); *In re Massey-Ferguson, Inc.*, 222 USPQ 367 (TTAB 1983) (finding no likelihood of confusion between marks ECOM and E-COM where the goods and services of the applicant and

registrant were not marketed in such a way that purchasers would likely be confused); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (holding no likelihood of confusion between BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing).

The differences in Applicant's goods and those of the Cited Marks are quite distinct such that no confusion is likely.

Sophisticated Consumers

Likelihood of confusion is minimized where circumstances suggest care in purchasing. TMEP §1207.01(d)(vii), citing *In re N.A.D., Inc.*, 224 USPQ 969, 971 (Fed. Cir. 1985). And where a purchaser is buying a sophisticated product, he or she is likely to be deliberate in his or her product selection and therefore in his or her differentiation between trademarks. *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1076 (9th Cir. 2006) ("Confusion is less likely where buyers exercise care and precision in their purchases, such as for expensive or sophisticated items.").

Consumers purchasing Applicant's genetically-modified seeds are sophisticated and must carefully consider the type of product needed for its particular purpose and what is appropriate under specific circumstances. This consumer must take into consideration many factors when choosing a particular type of the genetically-modified seed for its highly specialized and particular needs. For example, the consumer must be informed as to what result the genetically-modified seeds would achieve because the consumer would have a particular goal in mind, such as a seed that is especially tolerant of a particular chemical, for example. As emphasized by the Federal Circuit, the weight to be given the sophistication of buyers is "important and often dispositive." *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d

1388, 1392 (Fed. Cir. 1992) (holding that the Board placed too much weight on the mere identity of the marks and had failed to give due weight to holding that the Board placed too much weight on the mere identity of the marks and had failed to give due weight to the purchaser sophistication factor); *Hewlett-Packard Company v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1992) (stating even when the goods went to potentially the same purchasers their sophistication weighed against a likelihood of confusion).

As illustrated above, Applicant's goods are highly specialized and the purchasing decision must take into consideration many factors. These sophisticated consumers would not likely confuse Applicant's genetically-modified seeds with the fertilizers of the Cited Marks.

Dissimilarities of Respective Marks

The points of comparison for a mark are appearance, sound, meaning or connotation and commercial impression. Similarity of the marks in one respect will not automatically result in a finding of likelihood of confusion, even if the goods are identical or closely related. *See In re Software Design, Inc.*, 220 USPQ 662, 663 (TTAB 1983) (finding no hard and fast rule that likelihood of confusion must automatically be found to exist if there is a similarity in any one of the elements; each case must be decided based on consideration of the nature of, and any similarities or differences between, the goods or services to which they are applied). No *per se* rule exists that two marks are likely to be confused due to appearance or sound just because each mark includes a shared term or lettering. Countless cases have found no likelihood of confusion between marks that shared the same or nearly-identical terms, even when the common words were the dominant terms. In *In re the Hearst Corp.*, 982 F.2d 493 (Fed. Cir.

1992), the Federal Circuit reversed the Board and held that VARGA GIRL was not confusingly similar to VARGAS. In reversing the Board, the Federal Circuit noted:

The Board, analyzing the marks for confusing similarity, found that ‘varga’ was the dominant element of the VARGA GIRL mark, and that ‘girl’ was merely descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with VARGAS. The Board erred in its analytic approach. Although undoubtedly ‘varga’ and ‘vargas’ are similar, *the marks must be considered in the way they are used and perceived. . . . Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight. . . .* The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component ‘girl’. By stressing the portion ‘varga’ and diminishing the portion ‘girl’, the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word ‘girl’. When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

Id. at 494 (emphasis added) (internal citations omitted).

A host of other cases support such a conclusion. *See, e.g., Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993) (finding PARENTS not confusingly similar to PARENT’S DIGEST, because, *inter alia*, “the only similarity concerned the use of the word “parent”); *The Conde Nast Publ’ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (affirming the TTAB’s holding that VOGUE and COUNTRY VOGUES were not confusingly similar, noting “COUNTRY VOGUES and VOGUE do not look or sound alike. The only similarity between them is that VOGUE is part of the mark COUNTRY VOGUES, and the dissimilarities between the marks, viewed in their entirety, outweigh this similarity sufficiently to leave no doubt.”); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402 (2d Cir. 1970) (holding PEAK not confusingly similar with PEAK PERIOD, because, *inter*

alia, “the difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entirety they neither look nor sound alike.”).

The Office has already deemed that the numerous marks with BALANCE concurrently exist on the Register without likelihood of confusion for goods and services closer in nature (*i.e.*, fertilizers) to those of the Cited Marks than with Applicant’s goods. These include:

Mark	Reg. No.	Goods
EASYBALANCE	2705013	Chemical preparations for aquarium and garden ponds, namely water conditioners, plant growth regulating preparations and fertilizers; water conditioners for the treatment of aquarium and garden ponds, in Class 1
NUTRIBALANCE	2687046	Fertilizers for agricultural, horticultural, and domestic use, fertilizers for use in gardening, greenhouses, tree nurseries, and golf courses, in Class 1
MICRO-BALANCE	2800126	Fertilizers for agricultural and domestic use, in Class 1
EQUI-BALANCE	2957555	Animal feed, in Class 31
CARBON BALANCED	4567923	Fertilizers and soil amendments, in Class 1
MAGNACAL BALANCE	4275920	Plant food and plant growth nutrients containing magnesium and calcium, in Class 1
CARBONWORKS BALANCE	4533527	Fertilizers, in Class 1

Copies of TESS records are included as **Exhibit F**.

As Applicant’s goods are quite distinct from those of the Cited Mark—more distinguishable from any of the referenced third-party registrations—Applicant submits that its mark may also concurrently exist on the Register without likelihood of confusion with the Cited Marks.

For these reasons, Applicant’s Mark is not likely to be confused with the Cited Marks.

Any Potential Confusion Would Be Purely *De Minimis*

As demonstrated throughout this response, any potential confusion that might occur would be purely *de minimis* in nature.

It is well-established that any mere theoretical possibility of consumer confusion is not enough to refuse registration. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 1210 (Fed. Cir. 1993) (“Because assumptions can skew the legal analysis, the law is well settled that the Board’s legal conclusion of likelihood of confusion must be based on more than just theoretical possibilities and speculation.”). Indeed, the Board stated in *Massey-Ferguson* that the Lanham Act “supports refusal of registration only where confusion, mistake or deception is likely.” *In re Massey-Ferguson, Inc.*, 222 USPQ at 367 (emphasis added). Such confusion with respect to the marks at issue here is not at all likely.

The Board is “not concerned with mere theoretical possibilities of confusion, deception or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Id.* (quoting *Whitco Chem. Co. v. Whitfield Chem. Co., Inc.*, 418 F.2d 1403, 1405 (CCPA 1969)). Applicant submits that the “practicalities of the commercial world” dictate that the cumulative differences among the goods, the marks, and the trade channels, all militate against any likelihood of consumer confusion.

CONCLUSION

For all of the reasons stated herein, Applicant respectfully requests that the application be approved for publication in the Official Gazette.