

## **RESPONSE TO OFFICE ACTION**

Applicant filed Application Serial No. 88/237,157 (“the Application”) for the mark SEASONS Stylized Design for “Retail Kosher supermarket services; online retail Kosher supermarket services” in International Class 35 (“Applicant’s Mark”). On March 21, 2019, the Examining Attorney issued an Office Action with a Section 2(d) refusal, citing a likelihood of confusion between the Applicant’s Mark and Registration No. 4,252,606 for the mark SEASONS OLIVE OIL & VINEGAR TAPROOM owned by Aguibal Incorporated, dba TA Seasons Olive Oil & Vinegar Taproom (“Registrant”), for “Retail and on-line grocery store services featuring home delivery service; Retail grocery stores” in International Class 35 (“Cited Mark”).

For the reasons below, Applicant respectfully requests that the Examining Attorney’s refusal be withdrawn and that the Application be approved for publication.

### **I. DISCUSSION**

#### **A. There is No Likelihood of Confusion Between Applicant’s Mark and the Cited Mark.**

An otherwise viable trademark application should not be refused under Section 2(d) unless a potential consumer is likely to be confused or mistaken about whether the applicant’s goods or services and those of a senior registrant emanate from the same source. *See* 15 U.S.C. § 1052(d); *Paula Payne Prods. Co. v. Johnson’s Pub’g Co.*, 473 F.2d 901, 902, 177 U.S.P.Q. 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.”).

The court in *In re E. I. DuPont de Nemours & Co.* (“*In re DuPont*”), 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), provided a list of principal factors to be considered in

determining whether there is a likelihood of confusion between marks under Section 2(d). These factors are evaluated case by case—not all of them are important for every analysis. *In re DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. While no one factor is determinative, any one of them may control a particular case. *Id.* at 1362, 177 U.S.P.Q. at 567.

Here, it is unlikely that a potential consumer would confuse the source of Applicant's Kosher supermarket services with the source of Registrant's general grocery services because (1) the parties' services differ meaningfully, target different purchasers and are marketed and sold through distinct and different channels of trade; (2) the term "SEASONS" is weak for general grocery store services in Class 35; and (3) the differences in the parties' marks sufficiently distinguish the marks in a relevant purchaser's mind.

**1. The Parties' Services Differ Significant and Meaningfully, Target Different Purchasers and are Marketed and Sold Through Distinct and Different Channels of Trade.**

The services identified and offered in connection with Applicant's Mark and the Cited Mark differ significantly and meaningfully. They target different customers and are marketed and sold through distinct and different channels of trade. As such, relevant purchasers will not be confused between Applicant's Mark and the Cited Mark. *See e.g., In re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (holding no likelihood of confusion between application for "CANYON" for candy bars and prior registration of "CANYON" for fresh citrus fruits and allowing application to register).

Applicant respectfully disagrees with the Examining Attorney's determination that the Kosher supermarket services identified for Applicant's Mark are a subset of the grocery services identified for the Cited Mark. Rather, Applicant maintains that the services encompassed are different because the Cited Mark identifies general grocery services, whereas Applicant's Mark covers a type of specialized supermarket services. In addition, while the identification of the

Cited Mark describes general grocery services, what Registrant actually offers in connection with the Cited Mark is very niche, specialized retail services, namely, retail services selling primarily olive oil and vinegar, not a comprehensive, general grocery store.<sup>1</sup> As such, the parties' marks as applied for -- and as actually used -- do not target the same purchasers, and are not marketed or sold through the same trade channels.

Specifically, Applicant identifies in the Application and offers in commerce retail and online Kosher supermarket services, meaning that every ingredient in every product offered in connection with Applicant's Mark meets the requirements set forth in Jewish dietary law that detail the types of food that an observant Jewish person may eat and the ways in which it may be prepared, and must be approved and supervised by nationally recognized Rabbinic Kashruth organizations. Ex. A. For example, every single product sold through Applicant's services must have on the product a stamp of a Rabbinic Kashruth symbol provided by a nationally recognized Rabbinic Kashruth organization to show that the product complies with the Kashruth laws and is approved and supervised Rabbinically. In addition to having the Kashruth stamps on all products sold, all the meat, chicken, and meat and chicken derived products offered through Applicant's services are double sealed—in fact, a Kosher observant person will not buy from a non-Kosher store any meat, chicken, or meat and chicken derived products that are not double sealed with stamps on even though the ingredients in the products are Kosher compliant.

Notably, Applicant's Mark is used in connection with the services offered in six Kosher supermarkets located in only Orthodox Jewish neighborhoods in New York and New Jersey, and offered online services to people who live in such areas. Ex. B. In other words, Applicant

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<sup>1</sup> In fact, the identification of the Cited Mark is overbroad and it is surprising that Registrant was able to register the Cited Mark with such a broad description, given that the actual retail services offered by Registrant, as shown in the specimen Registrant provided on July 26, 2012 for its use-based application filed on December 4, 2012 and on Registrant's website that is accessible at <http://seasonstaproom.com/>, are very narrowly tailored retail services that sell specifically and only olive oils, vinegars, and related derivative products.

identifies and offers the kind of supermarket services that, while feature a wide range of products including fruits, vegetables, meat, fish, sushi, deli, baked goods, grocery products, dairy products, and frozen items, target a very niche market that is comprised of a small, sophisticated and very discreet group of relevant purchasers. *See id.* This **very** targeted market for Applicant's services, as applied for or as actually used, are customers who observe Kosher practice (generally or on occasions), purchase only products that are Rabbinically Kosher approved and supervised, and reside in the Orthodox Jewish neighborhoods where Applicant's supermarkets are located. *See Ex. C.* They are a sophisticated and discreet group of consumers who use great care in making sure to purchase Kosher products from Kosher services, because of the fundamental importance of this practice to their religious belief and the strict and complicated rules that must be followed to insure that a grocery store meets the Kosher standard. *Id.* According to Applicant, the purpose of Applicant's services is to assist the relevant purchasers in this painstaking process of selecting Kosher compliant products, so that these purchasers can enjoy more convenience, ease, comfort and options in their Kosher practice. *Id.*

On the other hand, the Cited Mark (1) identifies non-specialized grocery services that target general consumers and (2) is actually used in connection with a different kind of specialized and different niche of boutique retail services that feature olive oil, vinegar and related derivative products and target the relevant customers who look for those products. As shown in the specimen that Registrant provided on July 26, 2012 to support its use-based application for the Cited Mark that was filed on October 3, 2011, the retails services offered by Registrant focus on only olive oil, vinegar and related products. *Ex. D.* Today, Registrant is still providing such specialized services as shown on its website. *Ex. E.* As shown on Registrant's website, the services offered in connection with the Cited Mark feature oils, vinegars, jam,

canned olives, salts and seasonings, pasta, and oil-based skincare products.<sup>2</sup> Ex. F. The Cited Mark is used in connection with services offered at four boutique stores located in Annapolis, MD, Bethlehem, PA, Lancaster, PA and Morristown, NJ. Ex. G. As stated by Registrant itself, the Registrant's business goal is to "educat[e] the public about the culinary and health benefits of fresh super premium extra virgin olive oil and balsamic condimento vinegars," and Registrant's vision is to sell "product[s] based on quality, objective testing and winning international awards," and partners with local restaurants or chef driven cooking demonstrations in its marketing. Ex. H. Therefore, the services actually offered by the Cited Mark target customers who look for niche products of high quality olive oil, vinegar and related products and are also highly sophisticated customers who take great care in purchasing.

In *In re Shipp*, an application for PURITAN & Design for the service of "laundry and dry-cleaning services" was refused based on a registration of PURITAN for commercial dry cleaning machine filters and parts, and another registration of PURITAN for a variety of cleaning preparations including dry cleaning preparations. 4 U.S.P.Q.2d 1174, 1174 (T.T.A.B. 1987). In reversing the refusal, the Board determined while the applicant's services and the goods in the cited registrations are all in the laundry and dry cleaning industry, confusion is not likely because the applicant's services are offered to the general public while the goods in the cited registrations are for use by owners or operators of laundries or dry cleaning establishments. *Id.* at 1175. The Board held the applicant's customers would unlikely encounter any of the goods sold under the registered PURITAN marks, and to the extent a limited group of customers in the dry cleaning industry do encounter both the applicant's services and the registrant's goods,

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<sup>2</sup> While the products sold by Registrant may be available in general grocery stores, the retail services offered by Registrant are not as broad in nature as the identification of goods and services in the Cited Mark presents.

“this narrow group is believed to be sufficiently sophisticated such that confusion is unlikely.”

*Id.*

Likewise, here, the parties’ services, as applied for and actually offered, have very different functions and purposes and are marketed and sold to completely different sophisticated and discreet groups of consumers. Applicant offers Kosher supermarket services that feature a broad range of products but target a niche group of customers who only purchase Kosher products that are rabbinically approved and supervised and are mostly residents in the Orthodox Jewish neighborhoods where Applicant’s supermarkets are located, while Registrant offers broadly defined general grocery services that target the general public but are actually focused on a specific group of niche products and target the discreet consumers who look for those products. Given the niche market that Applicant targets, Applicant’s customers are unlikely to encounter the services offered by Registrant in connection with the Cited Mark, and Registrant’s customers are unlikely to encounter the services offered in connection with Applicant’s Mark.

To the extent a limited group of customers do encounter both parties’ services, these customers are highly sophisticated consumers (by virtue of the nature of the products they are purchasing) who will easily be able to distinguish the parties’ marks from each other, particularly given the specialized nature of both parties’ services. As such, there is no likelihood of confusion between Applicant’s Mark and the Cited Mark. *See also, In re The W.W. Henry Company, L.P.*, 82 U.S.P.Q.2d 1213, 2007 WL 186661 (T.T.A.B. 2007) (No conflict between cited PATCH ‘N GO for chemical filler to repair polyolefin sold to plastic manufacturers and applicant's PATCH & GO for cement patch for drywall, concrete and the like, sold to do-it-yourselfers and contractors in hardware stores because the products would be sold “to different classes of purchasers through different channels of trade.”).



**2. The Term “SEASONS” is Weak for General Grocery Store Services in Class 35.**

As mentioned, while the Cited Mark broadly identifies general grocery services, it is actually used in connection with a very specialized retail services that feature only high quality olive oil, vinegar and related products. In light of the apparent actual use of the Cited Mark, the identification for the Cited Mark appears to be overbroad and not to accurately describe the actual services offered by Registrant.

However, even setting aside the fact that the Cited Mark does not accurately reflect Registrant’s services and considering only the broad general grocery services identified in connection with the Cited Mark, registration of Applicant’s Mark will cause no likelihood of confusion on the Principal Register because the term “SEASONS” is weak and entitled to only a narrow scope of protection on the Register for broadly defined general grocery services.

There is a significant coexistence of registrations of marks containing “SEASONS” or “SEASON” in Class 35 on the Principal Register for vaguely worded “[r]etail grocery store[.]” services, and many of them have coexisted for years. Specifically, a sample of the other “SEASONS” formative marks on the Principal Register in Class 35 is as follows:

App./Reg. No.	Mark	Owner	Class 35 Services	First Use Date
5421751	PEAK SEASON PICKS	Save Mart Supermarkets	Retail grocery store services	March 2013 (no day listed)
5741368	FULL SEASON	Full Season AG Inc	Farmers' markets; retail and on-line grocery store services featuring home delivery service; wholesale food distributorship services.	April 28, 2018
5613202	IT’S ALWAYS THE SEASON TO EAT	Puget Consumers Co-Op DBA	Retail grocery stores	September 2017 (no

	PEAK SEASON	PCC Community Markets and PCC Natural Markets		day listed)
4761135	EAT WITH SEASONS	Puget Consumers Co Op	Retail grocery stores	January 1, 2014
4457919	SOUTHERN SEASON	Southern Season, Inc.	Mail order services featuring foods, specialty groceries, candy, beverages, coffee, wine, books, kitchen appliances, kitchen gadgets, housewares, kitchen accessories including cookware and utensils and gift items; retail and online store services featuring foods, beverages, books and gift items.	June 1, 2012
4252606	SEASONS OLIVE OIL & VINEGAR TAPROOM	Aguibal Incorporated TA Seasons Olive Oil & Vinegar Taproom	Retail and on-line grocery store services featuring home delivery service; Retail grocery stores	April 20, 2009
4004898	NEW SEASONS MARKET 	New Seasons Market LLC	Retail grocery stores	October 10, 2001
3112257	NEW SEASONS MARKET	New Seasons Market LLC	Retail grocery store services	October 10, 2001
3112256	NEW SEASONS	New Seasons Market LLC	Retail grocery store services	February 29, 2000
3483308	HY-VEE SEASONS 	Hy-Vee, Inc.	Online catalog in the field of family lifestyles featuring tips on the use of and offering products for seasonal indoor and outdoor furniture and furnishings, seasonal	November 24, 2006



			<p>recipes and tips on preparation of the recipes, seasonal grocery items for indoor and outdoor cooking and offering tips for use of the grocery items in indoor and outdoor cooking, tips on the use of and offering products for seasonal floral and decorating ideas for the home both indoors and outdoors, tips on the use of and offering products for seasonal lawn and garden care, tips on the use of and offering products for seasonal cleaning for both the indoors and the outdoors, tips on the use of and offering products for seasonal home entertaining for use both indoors and outdoors, seasonal tips on the use of and offering products for planning vacation road trips, and seasonal tips on the use of and offering product for living a healthier lifestyle.</p>	
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True and correct copies of the Registration Certificates for the registrations listed are attached hereto as Exhibit I.

The registration of these “SEASONS” or “SEASON” formative marks on the Principal Register indicates that the USPTO believes marks containing “SEASONS” or “SEASON” may coexist with each other in Class 35 for general grocery services without the likelihood of consumer confusion, and is evidence that that the term “SEASONS” is entitled to only a narrow scope of protection with respect to the general, non-specialized grocery store services ***identified*** in the Cited Mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2015) (“Evidence of third-party use of similar marks on

similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). This peaceful coexistence of “SEASONS” and “SEASON” formative marks is also evidence that the public are used to and experienced at distinguishing among various “SEASONS” formative marks for general grocery services. *See In re Hartz Hotel Services Inc.*, 102 U.S.P.Q.2d 1150, 1156 (T.T.A.B. 2012) (reversing a refusal to register GRAND HOTELS NYC for hotel services, holding that “consumers are able to distinguish between different GRAND HOTEL mark based on small differences in the marks, including the addition of a geographic term”). Therefore, particularly considering the specialized nature of Applicant’s services and the niche market in which Applicant’s Mark is used, there is no likelihood of confusion between Applicant’s Mark and the Cited Mark. *See In re Hartz Hotel Services Inc.*, 102 U.S.P.Q.2d 1150, 1156 (T.T.A.B. 2012) (reversing a refusal to register GRAND HOTELS NYC for hotel services based on third party coexistence of “GRAND HOTEL” marks for hotel services, finding that “in this case, the strength of weakness of the mark in the cited registration is the most important factor”).

### **3. The Differences in the Parties’ Marks Sufficiently Distinguish the Marks in a Relevant Purchaser’s Mind.**

Applicant’s Mark and the Cited Mark are not identical; rather, they are readily perceived to be different because of the design element in Applicant’s Mark and additional words in the Cited Mark, particularly given that the term “SEASONS,” although a weak term with respect to general grocery services, has gained significant market recognition and become a strong mark for Applicant’s niche services. *See 2 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition* § 11:77 (5th ed. 2019) (a mark can be weak in one market but strong in a different market).

When analyzing the similarities between two marks, one must look to the overall impression created by the marks and not merely compare individual features. *See e.g., Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974). In considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000). "[E]ach case must be decided on its own facts and the differences are often subtle ones." *In re St. Helena Hosp.*, 774 F.3d at 753, 113 U.S.P.Q.2d at 1087).

Besides the word "SEASONS," Applicant's Mark and the Cited Mark share no similarities in appearance. The distinct design element in Applicant's Mark distinguishes it from the Cited Mark. Although the words "OLIVE OIL & VINEGAR TAPROOM" in the Cited Mark are disclaimed, they make the two marks look and sound differently. *See e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (finding that "[t]he difference in appearance and sound of the marks [PEAK and PEAK PERIOD] is too obvious to render detailed discussion necessary. In their entireties, they neither look nor sound alike.").

Moreover, the design element in Applicant's Mark and the other words in the Cited Mark make the two marks engender completely different commercial impressions. The design element in Applicant's Mark consists of drawings of a fish, loaf of bread, cuts of meat and artichoke, which highlight the seafood, staples, meat and vegetables offered through Applicant's services. Meanwhile, the words "OLIVE OIL & VINEGAR TAPROOM" in the Cited Mark emphasize the olive oil and vinegar products provided through Registrant's services. Thus, just because the

two marks share the same “SEASONS” word, the two marks are readily perceived differently in relevant customers’ minds.

Besides, while “SEASONS” is weak with respect to general grocery services, it is strong and well-recognized with respect to Applicant’s specialized supermarket services. *See* Exs. A & J (Applicant’s Mark is recognized as the mark for the largest Kosher supermarket chain in the country). The fact that Applicant has managed to develop market distinction in “SEASONS” with respect to Applicant’s Kosher supermarket services is further evidence that relevant purchasers perceive Applicant’s Mark very differently from “SEASONS” formative marks used for general grocery services.

As such, and considering the other important factors discussed above, there is no likelihood of confusion between the parties’ marks. *See also, In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238, 1239 (Fed. Cir. 1992) (reversing refusal to register VARGA GIRL (“GIRL” disclaimed) for calendars on the basis of prior mark VARGAS for calendars, and chastising the Board for “inappropriately chang[ing] the mark” by “stressing the portion ‘varga’ and diminishing the portion ‘girl’” as “[t]he appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component ‘girl’”).

## **II. CONCLUSION**

Based on the foregoing reasons, Applicant hereby submits that the application is in condition for publication and respectfully requests action consistent therewith. Applicant requests that the Examining Attorney contact the Attorney of Record for Applicant if a telephone conference might be of assistance in resolving any remaining issues.