In re Application of:	)	
Mirabeau SAS	)	Law Office: 127
Serial No.: 88/302,857	)	
Filed: February 15, 2019	)	Examining Attorney: Carolyn Detmer
Mark: FOREVER SUMMER	)	

RESPONSE TO THE OFFICE ACTION

This is in response to the Office Action dated April 29, 2019, regarding the above-referenced application. In the Office Action, the Examining Attorney rejected the applied-for-mark FOREVER SUMMER for "wines" in Class 33 (the "Applicant's Mark") as likely to cause confusion with the mark FOREVER SUMMER for "frozen confections; ice cream" in Class 30, U.S. Registration No. 4,436,784 (the "Cited Mark") owned by Societe des Produits Nestle S.A. (the "Registrant"). The Applicant respectfully disagrees and requests that the Examining Attorney reconsider the Section 2(d) refusal because: (1) the goods are distinguishable; (2) the channels of trade are different; and (3) the consumers are different.

A. There Is No Likelihood of Confusion Between The Applicant's Mark And The Cited Mark

1. The Goods Are Distinguishable.

Consumer confusion is not likely where, as here, the goods in question are not related. This is so even if the marks are identical. *See, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (finding no likelihood of confusion between LITTLE PLUMBER for liquid drain opener and LITTLE PLUMBER & Design for advertising services); *Quartz Radiation Corp. v. Comm/Scope Co.,* 1 U.S.P.Q.2d 1668 (T.T.A.B. 1986); *see also* Trademark Manual of Examining Procedure ("TMEP") § 1207.01(a)(i).

In *Borg-Warner Chemicals, Inc. v. Helena Chemical* Co., the Trademark Trial and Appeal Board (the "Board") held that:

> The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.

225 U.S.P.Q. 222, 224 (T.T.A.B. 1983).

Here, Applicant has applied to register the mark for "wine" while the Cited Mark is used in connection with "frozen confections; ice cream." Although the goods may be, in the broadest sense, both be categorized within the food and beverage category, the goods are very

different.

Wine is an alcoholic beverage consumed by adults, while frozen confections and ice cream are desserts consumed by children and adults. Further, there is no evidence to establish that a that the respective goods as identified by their marks would be encountered by the same purchaser because the goods at issue are neither competitive nor a substitute for one another.

In effort to conflate the goods at issue and establish evidence that the respective goods would be encountered by the same purchaser, the Examining Attorney cited to wine flavored ice cream, alcohol-infused ice cream, and frozen wine products sold by three separate companies, Quality Dairy Farms, Inc. d/b/a Mercer's Dairy, Tipsy Scoop LLC and The Frozen Frogs LLC. These cited goods fail to establish that the goods at issue are the same or related.

First, the cited wine flavored ice cream and alcohol-infused ice cream are merely ice creams flavored by wine and alcohol. Although they may include wine and/or alcohol, they would not be a substitute to a bottle of wine. Second, the cited frozen wine product is not a frozen confection or ice cream, instead it is wine consumed in a less conventional way. In fact, this product is more akin to frozen alcoholic drinks such as a margarita, daiquiri, pina colada, *etc*. Thus, these citations only reinforce Applicant's position that the goods are clearly different and would not be encountered by the same purchaser.

To bolster this position, there is no *per se* rule that certain goods or services are related to other goods or services. TMEP § 1207.01(a)(iv). Instead, it is important to compare the respective goods and services based on the identification in the application and in the registration. In fact, it is inappropriate to deny registration merely because the goods belong to the same general, broad field. *Astra Pharm. Prods. v. Beckman Instruments*, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983) (holding that use in the same broad field "is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion").

2. The Goods and Services Are Sold Through Different Channels of Trade.

The Examining Attorney erroneously concluded that the respective goods are routinely manufactured and sold by the same companies and that their channels of trade are therefore the same. Instead of providing evidence that there are wine makers who also make ice cream or there are ice cream makers who also make wine and how prevalent such dual manufacturing is, the Examining Attorney provided evidence that there are ice cream makers and retailers that sell wine flavored ice creams as alleged proof that the respective goods, channels of trade, and customers are the same:

> The attached Internet evidence establishes that the same entity commonly manufactures and provides wine ice cream and other wine frozen confections and markets the goods under the same mark. See attached evidence from Mercer's Ice Cream, Tipsy Scoop, and The Frozen Frogs. Further the attached evidence also shows that the relevant goods are sold and provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant's and registrant's goods are considered related for likelihood of confusion purposes.

See Office Action at 2.

As stated above, the three cited instances only establish that ice cream makers do not sell wine and vice versa. Tipsy Scoop sells its alcohol-infused ice cream through its "barlour" locations, supermarkets, and online retail shipment. Tipsy Scoop does not sell wine and does not sell ice cream through liquor stores. Wine-flavored ice cream sold by Mercer's Dairy is also sold in its own flagship store in upstate New York, ice cream parlors, and through the Internet. Mercer's Dairy does not produce or sell wine. In contrast, the Frozen Frogs product is frozen wine. The Frozen Frogs does not sell ice cream or frozen confections. The Frozen Frogs sells its wine through liquor stores and online.

Even if one could find a company that sells both ice cream and wine, the question here is whether the companies at issue, the Applicant and the Registrant, are likely to sell both. As the Registrant's website and long history teaches us, Registrant is a food company that did not and does not offer wine. In fact, a search for the word "wine" on nestleusa.com did not return any offerings for wine. In contrast, the Applicant only produces wines in Provence, France. Thus, the companies at issue are not going to sell the other company's products.

Moreover, the Examining Attorney has not cited a single wine maker who also sells ice cream or a single dairy farmer who produces and sells wine. Thus, the channels of trade for ice cream and wine are different and these products would not be encountered by the same consumers in situations that would create the incorrect assumption that they originate from the same source. Consumers therefore are unlikely to be confused.

3. The Consumers For Both Products Are Radically Different.

Another important factor to consider in determining whether or not there is a likelihood of confusion is the sophistication of the consumers and differences between consumers for both products. *In re E.I. DuPont de Nemours &* Co., 476 F.2d at 1361. In *Dynamic Research Corp. v. Langenau Mfg.* Co., the Federal Circuit affirmed the Board's conclusion that "because the marks are used on goods that are 'quite different' and sold to different, discriminating consumers, there is no likelihood of confusion," even though the marks were identical. 704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983).

By state law, wine is only sold to adults carrying identification to prove that they are older than 21 years old. Wine is not and cannot lawfully be marketed or sold to children or even young adults. Thus, consumers of the Applicant's wine are entirely different from consumers of the Registrant's ice cream and frozen confections. In fact, consumers of wine are sophisticated, upscale, educated individuals. They exercise a high degree of care and diligence when selecting wines and would not be confused by ice cream or frozen confections.

Ice cream and frozen treats, are marketed to the general public, primarily for children. Children cannot and do not buy wine. Children and adults buying for children would not be confused by a wine maker's product. This factor weighs against a finding of a likelihood of confusion.

B. Conclusion

There is no likelihood of confusion between the Applicant's Mark and the Cited Mark because the respective goods are distinguishable, the channels of trade are different, and the purchasers are different.

The Applicant has demonstrated herein that there is no likelihood of confusion between

the Applicant's Mark and the Cited Mark. Based upon the foregoing, the Applicant respectfully requests that the Examining Attorney withdraw the refusal under Lanham Act Section 2(d) and approve this application for publication in the *Official Gazette.*

C. Letter of Protest

On August 5, 2019, the United States Patent and Trademark Office entered into the record herein a letter of protest memorandum which suggested possible likelihood of confusion with U.S. Registration No. 5,475,683 for the ETERNAL SUMMER mark for "beer" owned by Funky Buddha Brewery LLC. We respectfully submit that there is no likelihood of confusion and no office action need be issued in this regard.

The appearance, sound, connotation, and commercial impressions of the two marks considered in their entireties are very different. In fact, their first words FOREVER and ETERNAL are different. This strongly weighs against any likelihood of confusion.

Moreover, the goods associated with the two marks are not the same. The ETERNAL SUMMER mark is, as far as we can tell, used in connection with beer sold on tap only at the Funky Buddha microbrewery.

The Applicant's Mark, conversely, is not used on or in connection with beer, but rather, only with wine. More specifically, it is used only in connection with rosé wine produced in the Provence region of France. The consumers of the respective products are sufficiently sophisticated to distinguish between the on-tap beer at a microbrewery bar and bottled wine in liquor stores. There is no likelihood of confusion between the respective marks.

Dated: October 29, 2019

Respectfully submitted,

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