

**In response to the substantive refusal, please note the following:**

APP. SERIAL NO. 88322028

In response to the Office Action dated, May 10, 2019 Applicant submits the following arguments in support of registration of its mark GREEN GODDESS.

Introduction

The Trademark Office (the “Office”) has refused registration of Applicant’s mark GREEN GODDESS (“Applicant’s Mark”) under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) because of a likelihood of confusion with U.S. Registration No. 5473745 for THE GREEN GODDESS SHOP for use in connection with on-line retail store services featuring natural and organic makeup and cosmetic preparations for skincare (the “Cited Mark”). The Office has taken the position that because the respective marks are similar and the goods/services are related there is a likelihood of confusion.

Applicant respectfully disagrees with the Office’s likelihood of confusion assessment. Applicant’s Mark is not likely to be confused with the Cited Mark. The unlikely prospect of confusion is manifest for the following reasons: (1) the Cited Mark and Applicant’s Mark are dissimilar in appearance, sound, and corresponding commercial connotation, (2) even where goods are related there is no per se likelihood of confusion rule, (3) in classes 035 and 03 there are many similar marks that are for the same or related goods/services yet have different registrants/owners, (4) sophisticated buyers in this marketplace can easily distinguish different marks, and (5) the Cited Mark is weak in view of other “GREEN” and “GODDESS” marks. Thus, Applicant submits that when its mark is considered in its entirety and compared to the Cited Mark, there is no likelihood of confusion.

Section 2(d) Refusal

The determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), therefore, the following, when of record, must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity/dissimilarity and nature of the goods or services;

- (3) The similarity/dissimilarity of trade channels;
- (4) The conditions under which sales are made, i. e. sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions of use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used;
- (10) The market interface between applicant and the owner of a prior mark:
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion; and
- (13) Any other established fact probative of the effect of use.

See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

*a. Factor 1: The marks should be properly compared as a whole.*

Even though the marks comprise the terms GREEN and GODDESS there is no rule that a likelihood of confusion conclusion is automatic. See, e.g., *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (CCPA 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (CCPA 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (CCPA 1972) (ALL CLEAR not confusingly similar to ALL); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK); *In re Merchandising Motivation, Inc.*, 184 U.S. P.Q. 364 (TTAB 1974) (no absolute rule against incorporating the total mark of another into one's own mark; MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (TTAB 1975) (PROTEIN PLUS and PLUS not confusingly similar).

First, on its face Applicant's Mark has a different appearance and a different sound than the Cited Mark. The visual appearance and the sound of the marks are both distinctive. We

must compare them [the marks] “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

As detailed below when the marks are *properly* compared as a whole there is no likelihood of confusion. The Office has taken the position that simply because the Cited Mark and Applicant’s Mark contain GREEN GODDESS the marks are similar. The Cited Mark contains the words “the” and “shop” – these additional and different terms are enough to distinguish the Cited Mark and Applicant’s Mark. These visual difference between Applicant’s Mark and the Cited Mark means they also sounds differently- 5 syllables is more like a phrase versus 3 syllables. As a whole, the respective marks are not similar in appearance or sound.

The differences in appearance together with the difference in pronunciation give the Cited Marks and Applicant’s Mark different overall commercial impressions. Even when marks are identical in sound and/or appearance the Board has found there is no likelihood of confusion when marks that are create sufficiently different commercial impressions when applied to the respective parties’ goods or services. See, e.g., *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312, 1987 WL 123813 at \*3 (TTAB 1987) (holding that CROSS-OVER for bras is not likely to be confused with CROSSOVER for ladies’ sportswear because the term concerning the bras was suggestive of the bras’ construction while the term concerning the sportswear would be perceived by purchasers as either arbitrary or suggestive of sportswear that “crosses over” from informal to more formal wear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854, 1984 WL 63176 at \*3 (TTAB 1984) (holding that PLAYERS for men’s underwear is not likely to be confused with PLAYERS for shoes because the term when applied to shoes implies fit, style, color and durability adapted to outdoor activities while the term when applied to men’s underwear “implies something else, primarily indoors in nature”); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629, 1977 WL 22667 at \*2 (TTAB 1977) (holding that BOTTOMS UP for ladies’ and children’s underwear is not likely to be confused with BOTTOMS UP for men’s clothing because the term suggests the drinking phrase “drink up!” when applied to men’s clothing but does not have this

connotation when applied to ladies' and children's underwear). In this context the Cited Mark would indicate that it is a store- that offers goods or services. Applicant's Mark when used in connection with cosmetics could be interpreted as imparting a type of makeup palette, style, or appearance- see

[https://www.google.com/search?q=green+goddess+makeup&rlz=1C1CHBF\\_enUS798US798&sxsr=ACYBGNSicYvtSk9RutTUdAPs0SAN4T81Kw:1573064062707&source=lnms&tbn=isch&sa=X&ved=0ahUKEwjzggqqlmNblAhUMsJ4KHXRMAAnUQ\\_AUIEygC&biw=1706&bih=918](https://www.google.com/search?q=green+goddess+makeup&rlz=1C1CHBF_enUS798US798&sxsr=ACYBGNSicYvtSk9RutTUdAPs0SAN4T81Kw:1573064062707&source=lnms&tbn=isch&sa=X&ved=0ahUKEwjzggqqlmNblAhUMsJ4KHXRMAAnUQ_AUIEygC&biw=1706&bih=918).

As a whole the marks are not phonetically similar, appear differently and have completely different meanings. For all the reasons set forth above, the respective marks are not confusingly similar in appearance, sound, meaning, or commercial impression.

*b. Factor 2: No "per se rule" for related or similar goods/services.*

The Office Action contends that the goods are "similar" because they both involve cosmetics. Even when goods are related, no per se rule exists with respect finding a likelihood of confusion. For instance, in *Lloyd's Food Products, Inc. v. Eli, Inc.*, the Court found no confusion between the marks LLOYD'S for restaurant services and LLOYD'S and design for barbecue food products. (*Lloyd's Food Products, Inc. v. Eli, Inc.* (Fed. Cir. 1993) 25 U.S.P.Q. 2d 2027.) The Court found that the petitioner had not introduced enough evidence to establish that it was probable that consumers who saw the packaged LLOYD'S product would believe that petitioner's restaurant was branching out into packaged foods sales. (*Id.* at 2029.) The Court stated that the petitioner needed to show something more than similar or even identical marks being used for food products and for restaurant services. (*Id.* at 2030.)

The cosmetic industry generates at least 60 billion dollars in revenue in the United States alone. See <https://www.franchisehelp.com/industry-reports/real-estate-franchise-industry-report/>. This market comprises a plethora of companies from salons and laser hair removal and to lipstick specialty companies. The sheer size of this industry means there is likely an overlap in the way in which entities choose to name their companies, goods, and services. The Cited Mark is a store. On the other hand Applicant's Mark is for cosmetics. The goods and services are not the same, are not used for the same purpose and are only related inasmuch as they both attempt involve beauty products. Applicant submits that the differences in the marks coupled with the differences in the goods/services are enough to prevent any likelihood of confusion.

c. *Similar marks with different owners for the same and/or similar services can coexist.*

There are 401,869 live marks in class 035 and 134836 live marks in class 003. The table below demonstrates that consumers can differentiate marks for the same or similar services. A search of the USPTO database also unveiled that different entities have registered marks with very similar or the same word components in classes 03 and 035. In *In re Thor Tech*, the Board held that evidence of dozens of third-party registrations for the same or very similar marks, owned by different entities, for different goods suggested that "businesses in these two industries believe that their respective goods are distinct enough that confusion between even identical marks is unlikely." *In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546 (T.T.A.B. 2015) [precedential]. In the table below is a sample of trademark registrations, for the same or similar marks for classes 003 and 035 with different owners.

<b>CLASS 035 MARKS</b>	<b>CLASS 003 MARKS</b>
SHOP FLOW Reg. No. 5901264 Karla Dascal Retail store offering cosmetics	FLOW Reg. No. 5211461 Cwachsberg Holdings Inc. Cosmetics
BEAUTY'S TOUCH Reg. No. 5898578 Beauty's Touch, Inc. Online store offering cosmetics	BEAUTITOUCH Reg. No. 2594951 AKI, Inc. Cosmetics
MODERN ALCHEMY Reg. No. 4812069 DL & Company, LLC Online store offering perfumes	MODERN ALCHEMIST Reg. No. 5607379 Monica Bejar Skin care preparations
AMORE Reg. No. 5882311 AmorePacific Corporation Retail store featuring cosmetics	AMORE COLORE Reg. No. 5047049 Greggs Beauty Distribution, LLC Hair products

#BEAUTYADDICT Reg. No. 5442574 Henkel AG & Co. KGaA Advertising services hair industry	BEAUTYADDICTS Reg. No. 3613821 Beauty Addicts, LLC Cosmetics
EMMA BEAUTY Reg. No. 5867218 TNG Worldwide, Inc. Online retail store nail polish	EMMA S. Reg. No. 4883672 Affine AB Cosmetics

If the Office wants copies of these registrations now, Applicant will provide them. Please call the undersigned. Otherwise if the Office does not agree with Applicant's position, Applicant will submit copies of these registrations for purposes of appeal. The analysis of the relatedness of the goods and services by the Office is clearly one sided and ignores that for the Trademark Office allows substantially the same or similar marks for classes 035 and 003 with different owners, and the public is not confused as a result. The above table demonstrate this.

It is requested that the Office recognize that there is no easy way to conduct a search to find the same or similar marks being used for different services within one class or on the Internet. It is very painstaking and costly process, requiring printing out the many registrations and performing a manual comparison. These are just representative of the overlap. Certainly based on the number of live marks noted above and the size of the cosmetic industry, there is likely a much larger number of the same or very similar mark being used for both goods in class 003 and services in class 035 by different entities.

*d. Factor 4: Makeup and cosmetics are purchased with care.*

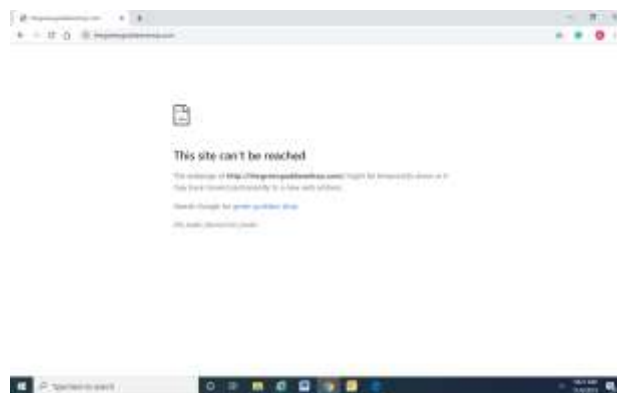
Consumer sophistication refers to the care and attention a consumer takes in making a purchase. Consumer sophistication is sufficient to negate a finding of confusion. People wear makeup for many different reasons- to improve their appearance, for fun or artistic expression, to camouflage insecurities, instant glam, or to attract the opposite sex- whatever the reason one thing is true makeup and cosmetics purchases are done so with care and attention. A visit to the cosmetic counters of a department store reveals the truth of this statement. Often time people are

loyal to particular products and certain brands. Cosmetic purchases are carefully thought and the consumer is usually educated on why they are purchasing a particular product.

*e. Factor 5: The Cited Mark is weak.*

Applicant submits the Cited Mark is weak for at least two reasons. First, there are 579 live mark comprising the term “green” in class 3. There are 57 live marks comprising “goddess”. The Board has consistently held that confusion is not likely if the matter common to the marks is merely descriptive or diluted and, thus, not likely to be perceived by purchasers as distinguishing source. See *In re Farm Fresh Catfish Co.*, 231 U.S.P.Q. 495, 1986 WL 83716 at \*1 (TTAB 1986) (holding that CATFISH BOBBERS (with “CATFISH” disclaimed) for fish is not likely to be confused with BOBBER for restaurant services). Moreover, dilution and descriptiveness of a common element can be shown by the existence of several third-party registrations, or by evidence of actual third party use. *AMF Inc. v. American League Products, Inc.*, 474 F.2d 1403, 1406, 177 U.S.P.Q. 268, 269-7- (CCPA 1973). Applicant submits that due to the extremely high number of marks containing or comprising the word “green” or “goddess” (a.) the Cited Mark is weak and (b.) consumers can differentiate “green” or “goddess” trademarks based on minor differences.

Finally, and most noteworthy, Applicant has evidence that the Registrant is not using the Cited Mark in commerce nor does the Registrant intend to use the Cited Mark in commerce in connection with cosmetics. Below is screenshot of Registrant’s current website.



Attached as Exhibit 1, is a prior screenshot from Registrant’s website stating the following, “Look for our focus to shift from makeup to more holistic health.” This is further evidence of the weakness of the cited mark.

The Office bears “the burden of proving that a trademark falls within a prohibition of § 1052.” *In re Mavety Media Group Ltd.*, 31 U.S.P.Q.2d 1923, 1925 (Fed. Cir 1994); see also *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 U.S.P.Q. 563 (C.C.P.A. 1967). Applicant submits this burden has not been met. In light of all of the facts of record and the *DuPont* factor analysis, it is clear that there are serious questions whether there could be any likelihood of confusion. The respective marks are not the same in appearance, sound or meaning. These differences alone are enough to distinguish the Cited Mark and Applicant’s Mark. The overall commercial impression for Applicant’s Mark and the Cited Mark will not create a likelihood of confusion, the Cited Mark is weak and similar marks for similar or related goods/services can coexist.

### **Conclusion**

For the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the Section 2(d) refusal and approve the applied-for mark for publication.