

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: YEN & BROTHERS ENTERPRISE CO., LTD.  
APPL. NO.: 88560162  
MARK: BLUE DIAMOND  
EXAMINER: Doritt Carroll

RESPONSE

In response to the Examining Attorney's Office Action dated October 29, 2019, the following documentation, amendments and remarks are respectfully submitted in connection with the above-identified application.

REMARKS

Applicant thanks the Examining Attorney for the very thorough consideration given the present application.

IN THE APPLICATION

Please adopt the amended Identification of Goods as follows in International Class 29:

Fish fillets; fish, not live; shrimp, not live, none of the above goods related to live oysters

SECTION 2(D) LIKELIHOOD OF CONFUSION

The Examining Attorney is respectfully requested to reconsider the refusal to register the present application based on the arguments and remarks as set forth herein below.

The present application has been refused registration on the contention that the Applicant's mark would be likely to be confused as compared with the registered mark as set forth in U.S. Registrations 4707221 and 4631692.

This refusal is respectfully traversed.

A. Registration No. 4707221

1. Third Party Registrations Showing a Diluted Term

The Examining Attorney has refused registration of Applicant's mark based on the assertion that U.S. registration 4707221 ("BLUE DIAMOND OYSTER") for "live oysters" in Class 31 is similar.

As an initial matter, Applicant respectfully submits that the wording "BLUE DIAMOND" is a diluted term due to the existence of numerous third-party registrations with the wording "BLUE DIAMOND" used for goods in the same class as well as similar goods. Third-party use of a term in the marketplace may be offered as evidence of a term's weakness and dilution with respect to a particular field and weighs in favor of narrowing the scope of its protection against subsequent applications. *See Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Therefore, EVO is entitled to a narrow scope of protection.

It is well-established that when a term is used and registered by several different parties, the term is considered weak and the likelihood of confusion with other marks is minimized. See e.g., *Duluth News-Tribune v. Mesabi Publ. Co.*, 38 USPQ2d 1937, 1942 (8th Cir. 1996) (no likelihood of confusion between DULUTH NEWS-TRIBUNE and SATURDAY DAILY NEWS & TRIBUNE for newspapers because the commonly used words "news" and "tribune" were "relatively weak"); *Gruner+ Jahr USA Publishing, Div. of Gruner + Jahr Printing & Publishing Co. v. Meredith Corp.*, 26 USPQ2d 1583, 1587 (2d Cir. 1993) (no likelihood of confusion between PARENTS and PARENTS DIGEST for magazines for parents because "parents" portion of mark is "extremely weak").

Evidence of third-party use also 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 goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 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”); see also TMEP § 1207.01(d)(iii).

Based on a trademark search for the word “BLUE DIAMOND”, in addition to the cited mark “BLUE DIAMOND OYSTER”, there are at least 20 applications and registrations containing the term “BLUE DIAMOND” in connection with food, showing the term is very weak and diluted in the field of food and beverages. See Exhibit A. More specifically, below, and attached, are at least thirteen (13) sample live, federal registrations for marks for food goods containing BLUE DIAMOND:

<b>MARK</b>	<b>Reg. No.</b>	<b>Identification of Goods</b>
BLUE DIAMOND	4686851	Vegetables, namely, frozen fried potatoes, namely, frozen french fried potatoes, frozen shredded hash brown potatoes, and frozen chopped and formed potato products, sold only to food service distributors
BLUE DIAMOND BEEF	4374512	Beef
BLUE DIAMOND	4893904	Mono Sodium Glutamate (MSG) an ingredient used in the food industry as a flavor enhancer; Amino acids for use in the manufacture of sports nutrition products; Artificial sweeteners for use in beverages; Preservatives for use in beverages; Acidulants, namely, citric acid, malic acid, lactic acid, tartaric acid for use in the manufacture of beverages; Excipients for use in the manufacture of beverages; Gums, for ingredients used in the manufacture of nutraceuticals, namely, gellan gum and xanthan gum, guar gum, stabilizers, namely, hydroxypropylmethylcellulose (HPMC), Micro Crystalline Cellulose (MCC), carboxymethylcellulose (CMC), chemical preparations for

		stabilizing neutrac
BLUE DIAMOND	3262159	Vodka
BLUE DIAMOND	2131725	rice, but not rice flour
BLUE DIAMOND	1817006	onion rings, zucchini sticks, zucchini slices, mushrooms and cheese, all of which are breaded and frozen
BLUE DIAMOND ALMONDS	5746503	Processed almonds; seasoned almonds, roasted almonds
BLUE DIAMOND ALMONDS CRAFTED	5746502	Processed almonds; seasoned almonds; roasted almonds
BLUE DIAMOND ALMONDS	4845991	Almond flour; Nut flour
BLUE DIAMOND ALMONDS	4047454	Almond paste; wafers with almonds or other nuts as an ingredient; grain-based snack foods; snack foods, namely, wafers made of grains and nuts; candy-coated nuts
BLUE DIAMOND	3131688	processed nuts [ ; dried fruits; and dried fruit mixes with nuts ]
BLUE DIAMOND	2001151	processed edible nuts, except walnuts unless in mixed nuts
BLUE DIAMOND	1271989	SHELLED ALMONDS; [ ALMOND OIL AND ALMOND BUTTER; SHELLED ] [ HAZLENUTS ] [ * HAZELNUTS * ; PISTACHIOS; MACADAMIAS; AND ALL OTHER EDIBLE NUTS, EXCEPT WALNUTS UNLESS IN MIXED NUTS; NUT OILS AND NUT BUTTERS * EXCEPT WALNUT OIL AND BUTTER * ; DRIED FRUITS - NAMELY, RAISINS AND PRUNES; SHELLED SUNFLOWER AND OTHER PROCESSED EDIBLE SEEDS; AND ] ALMOND PASTE

See submitted attachments.

The evidence shows that consumers regularly encounter a variety of marks containing the term BLUE DIAMOND or variations thereof for food goods, including BLUE DIAMOND combined with a generic or descriptive term (e.g., the cited mark BLUE DIAMOND OYSTER; BLUE DIAMOND BEEF; BLUE DIAMOND ALMONDS). Consumers will therefore not distinguish the source based on the term BLUE DIAMOND or variations thereof; instead, consumers will distinguish the source based on other, even subtle differences between the marks (e.g., design elements) and the goods. Due to this

“crowded field,” the term “BLUE DIAMOND” should be afforded a narrow scope of protection, thereby weighing heavily against a finding of likelihood of confusion. See *In re Hartz Hotel Services Inc.*, 102 U.S.P.Q.2d 1150 (TTAB 2012) (“Because of the highly suggestive nature of the mark 'Grand Hotel,' the proliferation of registered 'Grand Hotel' marks and the unregistered uses of 'Grand Hotel' marks, the mark 'Grand Hotel,' itself, is entitled to only a very narrow scope of protection or exclusivity of use”).

Based on the above, it is sufficient to recognize that consumers will be able to distinguish the source of the goods.

2. The Dissimilarity of the Respective Marks

Applicant finds that the marks should be considered sufficiently dissimilar since they differ in appearance, sound, meaning and commercial impression so as to not cause consumer confusion. In determining a likelihood of confusion under § 2(d), the principal factors as set forth in *In re E.I. DuPont de Nemours & Co.*, 476F.2d 1357,177 USPQ 563 (CCPA 1973) should be considered. The Trademark Examining Attorney quotes *du Pont* in support of the assertion that the marks must be compared with respect to their “appearance, sound, meaning or connotation and commercial impression.” In fact, the Applicant submits that the Trademark Examining Attorney should “not consider the similarity of the marks in the abstract, but rather in the light of the way the marks are encountered in the marketplace and the circumstances surrounding the purchase” *Reno Air Racing Ass’n, Inc. v. McCord*, 452 F.3d 1126, 1137, 79 U.S.P.Q.2d 1431 (9th. Cir.2006); accord *In re Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 538, 76 U.S.P.Q.2d 1852 (2d Cir. 2005); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744, 48 U.S.P.Q.2d 1503 (2d Cir.1998) (holding that even “though STREETWISE and STREETSMART sound alike, they are not confusingly similar

“given the context in which a purchaser sees them). Therefore, when comparing trademarks, one has to look at the marks in their entirety. In applying the aforementioned so called “trilogy” test, one must follow the anti-dissection rule, that is, not to dissect the marks into its component parts but rather to make a comparison by analyzing them as a whole. Under the anti-dissection rule, a composite mark should be viewed in its entirety rather than being dissected into its components, since the commercial impression of a trademark is derived from it as a whole. *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, 810. (9th Cir. 1985). *In Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 345-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920), the Supreme Court stated that “conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison.” The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. In addition, conflicting marks consisting of both words and pictorial symbols must be compared in their entireties to determine likelihood of confusion. *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 51 U.S.P.Q.2d 1349 (10th Cir. 1999).

When viewed in their entirety, the respective marks differ in appearance, sound, meaning, and commercial impression.

a. Dissimilar Appearance and Sound

Applicant's mark is different in its visual appearance and sound from U.S. registration 4707221.

The cited mark comprises the additional wording “OYSTER”, while Applicant’s mark consists of only the wording BLUE DIAMOND in stylized, italicized style lettering. Furthermore, Applicant’s mark includes a design of two diamonds, one large and the other small, above the word “Blue”, with

the wording and design all set into an opaque background. Usually, special form/non standard character marks leave a deep impression on a consumer's mind since the stylization is distinctive visually. This is the case with Applicant's mark which leaves a distinctive visual impression, especially in view of the literal wording "Diamond" that is represented in the design of the two diamonds.

Applicant further contends that the respective marks are dissimilar in sound. The above cited mark includes additional wording, "Oyster", that is missing from Applicant's mark.

Therefore, source confusion is unlikely to occur.

b. Dissimilar Meaning and Commercial Impression

The respective parties' marks convey a very different commercial impression and connotation. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. See, e.g., *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel*

*Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes 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).

Here, the cited mark "BLUE DIAMOND OYSTER", used in connection with live oysters, may be perceived as a geographical indication or an invented eye-catching name by consumers, for example on a restaurant menu, in the seafood section at the grocery store, or by wholesalers and retailers ordering from a live oysters catalog. Traditionally, oysters were named after their location (e.g., Blue Point Oysters from Blue Point, Long Island), rather than the source manufacturer/purveyor. See Exhibit B: [URL: <https://www.elementseafood.com/the-appellation-trail-whats-in-an-oyster-name/>] The average consumer, when encountering the cited mark in the context of the retail or restaurant environment, would reasonably understand the wording BLUE DIAMOND to refer to the location where registrant's live oysters are from, rather than referring to the seafood manufacturer/company that is selling the oysters.

Moreover, an Internet search for live oyster names reveals that the wording "Blue" is a commonly used word for naming oysters due to its association with the ocean. See Exhibit C: [URL: <http://themagiccoyster.com/oyster-info/#1448232996120-7b479eca-98b6>] The list includes: Blue Diamond (Washington State), Blue Island (Long Island Sound), Blue Pool (Washington State), Blue Whale (Long Island Sound), Blue Yonder (Long Island Sound), and Bluepoint (Long Island Sound). In light of this, consumers are more likely to associate the word "Blue" with seafood, specifically, live oysters with the ocean, clear blue waters, and freshness.



In contrast, Applicant's mark BLUE DIAMOND, used in connection with "fish fillets; fish, not live; shrimp, not live" (i.e., frozen fish and shrimp) does not convey the above connotation. Consumers may perceive the wording to refer to a high class of goods or sought-after goods, like blue diamonds are in the jewelry industry. Accordingly, the marks are not similar in appearance, sound, meaning, or overall commercial impression, thus weighing against a finding of likelihood of confusion.

Therefore, a customer confronting the respective marks, in their respective contexts, will understand that the Applicant's mark is not similar to the cited marks in connotation and commercial impression. Based on the above comparison, it is sufficient to recognize the differences of the respective marks.

3. The Dissimilarity of the Respective Goods

As an initial matter, Applicant has amended the Identification of Goods to exclude "live oysters".

The goods in question are not related in such a way that consumers expect them to originate from the same source. As detailed above, oysters are traditionally named after a geographical location, or a made-up name that does not have any relation to the seafood purveyor. Applicant's fish fillets and frozen shrimp and fish, as can be seen in the specimen of use submitted with the original application, are sold in boxes, fit for frozen transport and storage, and generally sold in the frozen foods section of a grocery store. The wording refers to the seafood manufacturer. As a result, consumers are not likely to be confused as to source or origin because it is unlikely that consumers encountering the respective goods will interpret their meanings in the same manner. In the event that Applicant's customers came across the registrants' goods, there is not likely to be any confusion in that registrants' live oysters will

be perceived as oysters originating from a location called Blue Diamond. By contrast, consumers encountering Applicant's fresh and frozen fish and shrimp would not make this same association.

Because of the fact that the Applicant's and registrants' products are different in nature and source names are perceived by consumers in different ways, a purchaser would not normally expect the various different products to emanate from the same producers.

B. Registration No. 4631692

1. Third Party Registrations Showing a Diluted Term

As above, Applicant respectfully submits that the wording "BLUE", and variations thereof including the cited mark's "BLU", is a diluted term due to the existence of numerous third-party registrations with the wording "BLUE" used for goods in the same class as well as similar seafood and fish goods.

Based on a trademark search for the word "BLU\*", in addition to the cited mark "BLU", there are at least 70 applications and registrations containing the term "BLUE" or "BLU" in connection with seafood or fish showing the term is very weak and diluted in the field of seafood. See Exhibit D. More specifically, below, and attached, are at least seventeen (17) live, federal registrations for sample marks for fresh, frozen, and processed seafood goods containing BLUE or BLU:

<b>MARK</b>	<b>Reg. No.</b>	<b>Identification of Goods</b>
BLUE ISLE PREMIUM GRADE	5888287	Frozen fish; Frozen seafood
BLUE VENTURE	5824691	Seafood, not live; Frozen seafood
BLUE CREST	5325564	Crabs, not live; Frozen fish; Seafood, namely, fresh and frozen seafood, not live; Seafood, not live; Processed seafood; Processed seafood, namely, fish
BLUE SEA	5562037	Seafood, namely, frozen seafood
BLUE MAX	5408216	Seafood, not live
BLUE SHORE	5300866	Seafood, not live

BLUE SAGE	5718666	Raw, fresh, frozen, chilled, smoked, dried, processed, canned and cooked fish and seafood; frozen prepared meals consisting primarily of meats, fish, seafood, poultry, vegetables, rice, potato and pasta
BLUE ANCHOR	5341072	Fresh, processed and frozen and not live fish and shrimp
BLUE CIRCLE	4831352	Processed seafood; Processed seafood, namely, fish; Seafood, namely, salmon, tuna, cod, swordfish, not live; Seafood, not live
BLUE NORTH	4917070	Processed fish
BLUEFIN SEAFOODS	4436039	Services, namely, in the nature of [mail order catalog and] wholesale distributorship services featuring seafood products in the nature of Bluefin tuna, fish, scallops, oysters, crab meat, clams, mussels, lobster, and shrimp
NATURAL BLUE	4105536	Processed seafood, namely, fish
BLUE FJORD	4286240	Seafood
DEEP BLUE	4171676	Canned Fish and Canned Shell Fish, Canned Lobster, Canned Crabmeat, Canned Tuna Fish, Canned Oysters
BLUE GOOSE	4991005	organic and all natural fish
BLUE AMERICA	4675888	Seafood; Import/Export agencies featuring seafood; wholesale distributorships featuring seafood
BLUE MADE	4580903	Dried seafood, namely, sea cucumber, shark fin, abalone, fish maw. Frozen seafood, namely, fish, lobster, geoduck, shrimp, crab; Live seafood for food purposes, namely, fish, crabs, lobsters

See submitted attachments.

The evidence shows that consumers regularly encounter a variety of marks containing the word BLUE or variations thereof for food goods, including BLUE or BLU combined with a generic or descriptive term (e.g., the cited mark BLU; BLUE SEA; BLUE ANCHOR; BLUE NORTH). Moreover, in a predominance of these marks, the wording BLUE appears as the first portion of the mark, and importantly, as a descriptive term. Consumers will therefore not distinguish the source based on the diluted and descriptive term BLUE or variations thereof; instead, consumers will distinguish the source based on other, even subtle differences between the marks (e.g., design elements) and the goods. Due to this “crowded field,” the term “BLUE” should be afforded a narrow scope of protection, thereby weighing heavily against a finding of likelihood of confusion. Based on the above, it is sufficient to recognize that consumers will be able to distinguish the source of the goods.

## 2. The Dissimilarity of the Respective Marks

Applicant finds that the marks should be considered sufficiently dissimilar since they differ in appearance, sound, meaning and commercial impression so as to not cause consumer confusion.

a. Dissimilar Appearance and Sound

The cited mark comprises an intentionally misspelling of the word “Blue”, BLU. While a phonetic equivalent as the first word in Applicant’s mark only, no other similarities are present. Applicant’s mark consists of BLUE DIAMOND in stylized, italicized style lettering. Furthermore, Applicant’s mark includes a design of two diamonds, one large and the other small, above the word “Blue”, with the wording and design all set into an opaque background. Usually, special form/non standard character marks leave a deep impression on a consumer’s mind since the stylization is distinctive visually. This is the case with Applicant’s mark which leaves a distinctive visual impression, especially in view of the literal wording “Diamond” that is represented in the design of the two diamonds. Moreover, consumers are more likely to remember an intentional or creative misspelling of a word, and are thus more likely to remember and distinguish the mark “BLU” from other marks containing the correct spelling of BLUE.

Applicant further contends that the respective marks are dissimilar in sound. The Applicant’s mark includes additional wording, “e Diamond”, that is missing from the cited mark.

Therefore, source confusion is unlikely to occur.

b. Dissimilar Meaning and Commercial Impression

Additional matter to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entirety convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See TMEP 1207.01(b)(iii). Here, the cited

mark “BLU”, may be understood by consumers to mean the color blue. The mark then, when used in connection with registrant’s fish fillets, frozen and processed fish, may be understood by consumers as having a general association with blue ocean waters, in other words, as coming from the ocean, and connote a sense of freshness. Apart from this association, there is no specific meaning to the wording “BLU”.

In contrast, Applicant’s mark BLUE DIAMOND, used in connection with “fish fillets; fish, not live; shrimp, not live” (i.e., frozen fish and shrimp) does not just convey the above connotation of the color blue. Consumers may perceive the wording to refer to a high class of goods or sought-after goods, similar to blue diamonds in the jewelry industry, and thus regard the Applicant’s seafood goods as of the highest quality. Therefore, the respective marks convey very different commercial impressions.

Moreover, as discussed previously, the matter common to the marks – the wording “BLU” – is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. As previously shown, the adjective “Blue” is highly descriptive of seafood goods, as in, describing their source, the ocean. Therefore, consumers are more likely to focus on the additional matter in Applicant’s mark and interpret the meaning of Blue Diamond, rather than focusing on “Blue”.

Accordingly, the marks are not similar in appearance, sound, meaning, or overall commercial impression, thus weighing against a finding of likelihood of confusion.

#### CONCLUSION

In view of the documentation and arguments, it is respectfully submitted that the Applicant’s mark is not likely to cause confusion, or to cause mistake, or to deceive. In fact, Applicant has shown

that the marks cited as an obstacle to the registration of its mark are distinguishable in appearance, sound, and overall commercial impression, as well as the difference in the goods and the weakness of the cited marks. Therefore, it is respectfully requested that the Examining Attorney withdraw the refusal to register the Applicant's mark.

It is believed that the present application is in condition for publication. An early Notice of Publication is respectfully requested.

Respectfully submitted,

Muncy, Geissler, Olds & Lowe, P.C

By:                     /Simone Chen/                    

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