

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Examining Attorney
United States Patent & Trademark Office
Law Office 101

In re Application of :
APPLICANT : Carrot, LLC
MARK : CARROT
SER. NO. : 88408086

APPLICANT'S RESPONSE TO EXAMINER'S NON FINAL OFFICE ACTION

The Examining Attorney has refused registration of the proposed mark Application No. 88408086 CARROT (Real Estate Carrot) on the grounds of likelihood of confusion with Registration Nos. 4454893, 4962283, 4295877, 4295877, 5266325, and 4429071 for CARROT and CARROT CREATIVE (collectively "Virtue"). Notably, Registration No. 4295877 has been cancelled and maintenance filings for Registration Nos. 4454893 and 4429071 have not been timely made (grace period ends 6/24/2020 and 5/5/2020, respectively).

Applicant respectfully submits that due to the status of 3 of 5 marks, it appears that the cited marks have been abandoned. An announcement on the website "carrot.is" (an excerpt of which was used as a specimen for Registration No. 4962283) announces that "Carrot Creative" has joined "Virtue". The announcement links to the Virtue website (virtueworldwide.com). *See attached* Virtue - The Creative Agency by VICE 051019. Furthermore, the most recent post on the blog page of carrot.is was updated on November 29, 2016. *See attached* Carrot Creative - Blog. This evidence should demonstrate that the marks are not in use in commerce and are subject to cancellation. The TTAB has recognized that over half of active registrations include some goods or services for which the registered mark is not actually in use in commerce. *See*

attached Expedited Cancellation Pilot Program _ USPTO. If necessary, Applicant intends to file a Petition for Cancellation against the remaining Registration Nos. 4962283 and 5266325.

Even if Virtue was in use in commerce, there is no likelihood of confusion. Many factors are to be considered in a likelihood of confusion analysis, including whether the buyers are sophisticated. Sophisticated purchasers exercise greater care in purchasing services which tends to minimize the likelihood of confusion. TMEP 1207.01(d)(vii); *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016).

In this case, Virtue clients are sophisticated multi-national manufacturers and service providers, such as Coca-Cola, Unilever, Anheuser Busch (AB-InBev), Google, Park MGM, and lululemon. *See attached* VIRTUE - The Creative Agency by Vice linked page 051019; VIRTUE - The Creative Agency by Vice 010720. Real Estate Carrot's services are purchased by sophisticated, quasi-professional real estate professionals, including investors and agents. *See attached* Real Estate Investor Websites _ Real Estate Agent Websites - Carrot 051019. Neither of these categories of buyers is likely to be impulsive in making a buying decision and both will use care in purchasing, thus minimizing any likelihood of confusion.

In addition, the trade channels between the two services are different. If the services are not related or marketed in a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012). As previously discussed, Real Estate Carrot's services are provided to the real estate industry. *See attached* Real Estate Investor Websites _ Real Estate Agent Websites - Carrot 051019. In

contrast, Virtue is a brand development creative agency that provides services to large, sophisticated companies. *See attached VIRTUE - The Creative Agency by Vice linked page 051019; Services description 051019.* Both companies may use websites to advertise their services but virtually all businesses use websites. Websites today are akin to periodical or yellow page advertisements of the past. Websites are not in and of themselves “trade channels”. It is inconceivable that Virtue’s clients would believe they were interacting with a high-end, multinational, advertising agency from a visit to the carrot.com website: *compare attached Done For You Services At Carrot – InvestorCarrot to attached VIRTUE - The Creative Agency by Vice 010720.* Like the targeted, sophisticated purchasers, the two trade channels are radically different.

Not only are the buyers sophisticated and the trade channels different, but the cost of the services are significantly different too. Virtue’s branding services are purchased by large, publically traded, multinational companies. The budget for these services is in the millions of dollars. Fortune reports that lululemon, Nike, and other large retailers spend approximately 30% of their net revenue on advertising spending, which equates to millions, in some case, billions of dollars. *See attached Lululemon Turns To Vice Media For Big Ad Push _ Fortune.* Due to the cost and the potential business impact of the services, Virtue’s services will be selected with great care.

In contrast, Real Estate Carrot services are purchased by real estate investors or real estate brokers. *See attached Real Estate Investor Websites _ Real Estate Agent Websites - Carrot 051019.* Real Estate Carrot services may be purchase for an annual fee as low as \$49 a month. *See attached Pricing & Plans _ Carrot Services.* It is virtually inconceivable that Virtue’s buyers (the marketing departments of large companies) would believe they were purchasing a

sophisticated branding campaign for \$149 a month. (Real Estate Carrot's premium package price).

Virtue's services and Real Estate Carrot's services are not related. When the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087. In this case, the evidence to demonstrate that the services are related consists of printouts from two websites. The record does not include any registered marks (or even applications) where the two different types of services are offered by the same provider.

In re Shell Oil Co. is offered to support likelihood of confusion, but the opinion was split and Judge Michel expressed that the "conclusion of likelihood of confusion was erroneous on the evidentiary record before it." *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Judge Michel further explains that the Board's finding that the identity of registrant's customer base was based upon pure speculation. *Id.*

Like the evidence in *Shell*, the evidence in the present case is not sufficient to demonstrate the relatedness between the services. The evidence does not amount to "something more" to demonstrate the relatedness between Virtue's branding services and Real Estate Carrot's platform as a service services. There is no evidence in the record that the buyers of the respective services would be confused as to the source of goods.

Applicant respectfully requests that the Examining Attorney allow registration of Applicant's mark.