

DESIGNED BY NATURE

Classes 3, 5, 29, 30, 31, 32, and 34

Application No. 88/425688

Office Action Response

I. Amendment of Listed Goods

The Examiner requested amendment to the listed goods in within the Application. In response, Applicant has amended the goods recited in the Application, as set out herein.

Classes 3

Bath additives, namely, bath herbs, bath oils, bath oils for cosmetic purposes; beauty care cosmetics; beauty creams for body care; beauty gels; beauty lotions; body and beauty care cosmetics; body creams; body oils; cosmetic creams; cosmetic oils; cosmetics and make-up; face and body lotions; face and body milk; face lotion; hair care preparations; hair styling preparations; hand cream; hand lotions; non-medicated lip care preparations; lip conditioners; lip glosses; non-medicated liquid soaps; massage creams; massage oils; non-medicated bubble bath preparations; non-medicated preparations for the care of hair; non-medicated preparations for the care of skin; non-medicated preparations for the care of the scalp; non-medicated skin care preparations; oils for toiletry purposes; skin care preparations; skin creams; skin emollients; skin lotions; skin soap; soaps for body care, namely cream soaps, bath soaps, bar soaps, paper soaps; soaps for personal use namely, cream soaps, bath soaps, bar soaps, paper soaps; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 5

Hemp cannabidiol derived products, namely, oils, salves, concentrated pastes, topical tinctures; oils, salves, concentrated pastes, topical tinctures, each containing resins and oils derived from hemp or derivatives thereof and for medical use; topical skin creams, bar and liquid soaps, bath additives in the nature of bath melts, bath herbs, and bath oils; body creams, body oils, face and body lotions, face and body milk, face lotion, and skin care preparations for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, and as a sleep aid; personal sexual lubricants; transdermal patches for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; hemp cannabidiol or derivatives thereof for topical medicinal use; hemp cannabidiol derived product, namely, oils for topical medicinal use for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; oils derived from hemp for topical medicinal use for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 29

Oils and resins derived from hemp for use as comestibles; hemp or cannabidiol related product, namely, oils for use as comestibles; oils derived from hemp or cannabidiol for use as comestibles; food products

containing hemp, cannabidiol, resins and cannabidiol oils, namely, butter; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 30

Food products containing hemp, cannabidiol or derivatives thereof, namely, chocolates, cookies, brownies, candy and food energy bars; tea, namely, teas containing hemp, cannabidiol or derivatives thereof, and teas containing hemp, cannabidiol or derivatives thereof; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 31

Live hemp plants; hemp seeds; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 32

Smoothies, fruit beverages and fruit juices, carbonated soft drinks, and energy drinks each containing hemp, cannabidiol or derivatives thereof; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 34

Smokers' articles, namely, grinders for use with hemp; dried hemp; derivatives of hemp, namely, resins and oils, not for medical use; hemp cannabidiol and hemp for recreational use; smokers' articles, namely, smoking pipes, pouches for use with hemp, lighters for smokers, oral vaporizers for smokers, each of the foregoing for use with articles containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

II. Controlled Substances Act / Cannabis Related Goods Refusal

The Examiner has refused registration on the basis that the Applicant cannot have a bona fide intent to lawfully use the applied-for mark in commerce with respect to the listed goods. Applicant respectfully asserts that this basis for refusal is moot in light of the amended recitations of goods adopted herein.

III. FDCA Refusal

The Examiner alleges that the Applicant does not have a bona fide intent to lawfully use the applied-for mark in commerce with relation to the goods identified in Classes 5, 29, 30 and 32 because pursuant to the FDCA it is unlawful to introduce food or beverages containing added CBD into interstate commerce or to market CBD as, or in, dietary and nutritional supplements, regardless of whether the substances are hemp-derived. However, applicant notes that it has a bona fide intent to lawfully use the applied-for mark in commerce because it is authorized to import products containing CBD into the United States in furtherance of one or more FDA-approved clinical trials.

IV. Drug Paraphernalia Refusal

The Examiner has refused registration for certain goods in Class 34 because Applicant allegedly does not have a bona fide intent to lawfully use the applied-for mark in commerce. However, Applicant respectfully asserts that this basis for refusal is moot in light of the amended recitations of goods adopted herein.

V. Request for Additional Information

The Examiner has requested additional information regarding the Applicant's applied for goods. Applicant submits the following responses to the posed questions and inquiries.

1. Do or will the goods include cannabidiol (CBD)?

None of the listed goods identified in the application include cannabidiol (CBD), beyond any legally permissible level, as a component or ingredient, except those goods in Class 31.

2. If so, will there be more than a trace amount of CBD in the goods, e.g., more than 50 parts per million (PPM)?

None of the listed goods identified in the application include cannabidiol (CBD), beyond any legally permissible level, as a component or ingredient, except those goods in Class 31.

3. Do or will applicant's identified goods include CBD which is derived from, oils, extracts or ingredients from plants other than *Cannabis sativa L* (also known as hemp, marijuana or cannabis)?

No.

4. Is applicant currently seeking FDA approval of the marketing of its goods identified in the application?

Applicant is not directly seeking FDA approval of the marketing of any of its goods identified in the application.

5. If the answer to Question 4 is "yes," please provide a copy of such application.

The answer to Question 4 was "no," therefore this question is moot.

VI. Varietal Name Inquiry

1. Whether DESIGNED BY NATURE has ever been used or will be used as a varietal or cultivar name.

The wording "DESIGNED BY NATURE" has never been used as a varietal or cultivar name for any plant.

2. Whether DESIGNED BY NATURE has ever been used or will be used in connection with a plant patent, utility patent, or certificate for plant-variety protection.

The wording "DESIGNED BY NATURE" has never been used and will not be used in connection with a plant patent, utility patent or certificate for plant variety protection for any plant.

VII. Likelihood of Confusion Refusal

The Examining Attorney has refused registration in connection with Class 31 goods based on a likelihood of confusion with the registration DESIGNED BY NATURE (Reg. No. 5450020) (the "Cited Mark"). For the reasons discussed herein, Applicant asserts that there is no likelihood of confusion.

A. The Applicant's Underlying Goods Are Dissimilar From The Cited Mark's Such That A Likelihood Of Confusion Will Not Occur

The goods contained in the Application and the goods found in Cited Mark are different, such that a likelihood of confusion will not occur. Applicant respectfully notes that the nature of the goods offered under Applicant's Mark, as amended, are related to separate and distinct fields of activity. In particular, Applicant's field is highly regulated and its products can only be found legally in establishments enforcing and adhering

to these strict regulations. Thus, the goods do not lend themselves to uninformed consumer decisions that could lead to confusion.

Finally, the goods at issue are not and cannot be substitutes for each other, and Applicant and the owner of the Cited Mark are not in competition with each other. Given Applicant's goods are sold in a specialized store for a distinct consumer base, the relevant consumers are highly unlikely to encounter Applicant's goods at the same time or in the same context as the goods and services offered under the Cited Mark or replace with the other as they both serve different purposes.

Thus, the goods at issue are distinguishable such that there is no likelihood of confusion.

B. Applicant's Mark and the Cited Mark Are Used In Connection With Goods and Services That Travel Through Distinct Channels Of Trade Such That There Is No Likelihood Of Confusion

The Class 31 goods offered by Applicant and the Class 31 goods offered under the Cited Mark are different, such that a likelihood of confusion will not occur. The nature of the goods offered by the parties relate to separate and distinct spaces, and the goods at issue travel through distinct channels of trade. Importantly, it is well settled that "if the goods or services in question are not related or marketed in such 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 TMEP § 1207.01(a)(i) citing *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d (Fed. Cir. 2004) (holding that cooking classes and kitchen textiles were not related) and *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (determining that "QR" for coaxial cable was not confusingly similar to "QR" for various products such as lamps and tubes, related to the photocopying field).

Here, Applicant's Mark is, as shown in the amended identification, evidently intended to be used in connection with highly regulated goods that have a productive use and a distinct consumer base, namely those looking for a productive use of such goods. Moreover, the goods sold under Applicant's Mark would be sold in a specialized store enforcing particular age requirement. On the other hand, the Cited Mark covers goods that are decorative and are directed towards consumers searching for decoration for their homes, offices or similar, not a productive use of the goods. Further, the Cited Mark's goods are sold in a nursery, gardening shop, or similar, as opposed to a specialized store. Finally, entities that provide Applicant's goods do not also provide the Cited Mark's goods, and vice versa.

Thus, because Applicant's goods are distinct from the goods offered under the Cited Mark, and because these types of goods are targeted at distinct groups of consumers, are sold in different locations, and are in different channels of trade, the goods at issue must be considered different. Moreover, a possibility of confusion is not enough to support a refusal, and Applicant has discussed why there is no likelihood of confusion in the present case.

C. The Meaning of each Mark in the Respective Contexts are Different Leading to an Overall Distinct Commercial Impression

The meaning or connotation of a mark must be determined in relation to the named goods and services. TMEP § 1207.01(b)(v). Moreover, the touchstone of a likelihood of confusion determination is the impression created by the proposed mark upon the general purchasing public when buying under normal market conditions and exercising the usual amount of care associated with a purchase within the class of goods or services. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81, 92 (2d Cir. 1979). The essential determination is whether or not the ordinary consumer is likely to conclude that an applicant's product or

service and the goods or services sold under a registered mark come from the same source. *Am. Optical Corp. v. Siemens Aktiengesellschaft*, 213 U.S.P.Q. 510, 516 (TTAB 1982); *In re Whittaker Corp.*, 200 U.S.P.Q. 54, 55 (TTAB 1978).

In this case, Applicant's Mark refers to the chemical properties of the goods as being naturally occurring. Conversely, the Cited Mark's use of DESIGNED BY NATURE refers to the exterior appearance of the goods. This distinction in meaning and overall commercial impression is further magnified by the realities surrounding the goods' differing channels of trade and consumer base and the differences between the goods themselves, as more fully discussed above. Thus, all factors considered, the marks at issue yield different overall commercial impressions such that confusion is unlikely.

In light of the above, because Applicant's Mark and Cited Mark differ in overall meaning and commercial impression, Applicant respectfully requests that the Examiner withdraw the likelihood of confusion refusal.