

RIFF (AND DESIGN) (White Background)



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

Application No. 88/425741

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. Significance of the Mark

The Examiner has requested additional information regarding the Applicant’s applied-for mark. Applicant submits the following responses to the posed inquiries.

1. Whether RIFF has ever been used or will be used as a varietal or cultivar name


The wording “RIFF” has never been used as a varietal or cultivar name for any plant.

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

The wording “RIFF” 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.

V. Likelihood of Confusion Refusal

The Examiner has refused Applicant’s Mark for use in connection with goods in Class 30. Specifically, the Examiner has refused Applicant’s Mark based on a likelihood of confusion with two registrations (collectively, the “Cited Marks”), as depicted below:

Reference	Cited Mark	Owner	Cited Goods/Services
Cited Mark #1	RIFF (Reg. No.5228052)	RIFF LLC	Class 30: Coffee
Cited Mark #2	RIFF and Design  (Reg. No. 5469446)	Riff LLC	Class 30: Coffee

For the reasons discussed herein, Applicant asserts that there is no likelihood of confusion and requests that the Application proceed to publication.



A. The Cited Mark Are Dissimilar Such That There Is No Likelihood Of Confusion

When considering the similarity of the marks, all relevant facts pertaining to the appearance, sound, meaning, goods and services at issue, and overall commercial impression must be considered. TMEP § 1207.01. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of the marks. *Id. See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975). Furthermore, under the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace. *Official Airline Guides, Inc. v. Goss*, 6 F.3d at 1392; *California Cooler, Inc. v. Loretto Winery Ltd.*, 774 F.2d 1451, 1455 (9th Cir.1985). *See also 2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition*, Sec. 23.15[a], at 23-82, 83.

i. Appearance

Applicant notes that the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a

likelihood of confusion as to the source of the goods or services, see *Zheng Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018). The marks at issue are the following:

Applicant's Mark	Cited Mark #1	Cited Mark #2
	<p data-bbox="618 432 678 457">RIFF</p>	

Significantly, Applicant's Mark consists of highly stylized block font with the "RI" stacked on top of "FF," forming a square, whereas Cited Mark #1 is in standard characters. Applicant's Mark utilizes the four characters in its mark to create a distinctive box-like design without a separate line outlining the shape of the square. As such, all of these differentiating elements create clear differences with respect to appearance of the marks.

Likewise, Applicant's Mark differs from Cited Mark #2. In particular, Cited Mark #2 consists of a cursive font which links the four characters within the mark together. Its cursive font, in combination with the lack of sharp 90 degree angles, creates a fluid and softened appearance. On the other hand, Applicant's Mark incorporates a number of sharp 90 degree angles both in its block lettering and its overall square appearance. Further, Applicant's Mark spaces out each of the four characters in such a way that prevent the letters from touching one another. Applicant's Mark's sharpness and spacing directly contrasts with the fluidity utilized by Cited Mark #2's stylized elements. Thus, this polarity between the Applicant's Mark and Cited Mark #2 create clear differences with respect to appearance of the marks. Even if Applicant or the owner of Cited Mark #2 were to engage in a brand refreshment, it is highly unlikely that their respective marks would resemble one another because the design elements are so distinctive that they have likely become part of their respective brand identities.

ii. Overall Commerical Impression

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 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).

The mere possibility of confusion is not enough to justify a refusal to register Applicant's Mark. In a Section 2(d) determination, the concern is not "with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Witco Chem Cp. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (CCPA 1969); see also *GAF Corp. v. Tappan Co.*, 197 U.S.P.Q. 696, 701 (TTAB 1977). Therefore, the Lanham Act precludes registration of a mark only where confusion as to source or origin is likely, not where merely a possibility of such confusion exists. *In re Hughes Aircraft*, 222 U.S.P.Q. 263, 264 (TTAB 1984).

Even marks that are identical in sound 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. *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding the mark BOTTOMS UP for ladies' and children's underwear and the mark BOTTOMS UP for men's clothing were not likely to cause

confusion, noting that the term "Bottoms Up" connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have the same connotation when applied to ladies' and children's underwear). Here, the marks at issue in their entireties are visually different and convey significantly different commercial impressions.

It is well settled that "[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties 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." TMEP § 1207.01(b)(iii).

As discussed above, Applicant's Mark consists of a distinctive design that uses a highly stylized block font and stacks the "RI" on top of the "FF" to create a square shape without the use of any lines to create the image of a said square. In addition, Applicant's Mark incorporates spacing between each of the four characters in such a way that prevents the characters in the mark from touching one other. The uniform and sharp look created by Applicant's Mark is further reinforced by the block letters themselves, due to the many 90 degree angles in the letters themselves and lack of any curvatures. The overall commercial impression of Applicant's Mark has a distinctive, hardened impression which contrasts with Cited Mark #2. Cited Mark #2 is a highly stylized cursive font that connects the four characters together and utilizes curves in the lettering to create a fluid and soft look, which differs greatly from the Applicant's Mark's overall commercial impression. Similarly, the lack of stylized elements in Cited Mark #1 creates a different commercial impression when compared to the highly stylized elements in Applicant's Mark. Thus, the overall commercial impressions created are significantly different from each other, such that confusion among the relevant consumers is not likely.

In light of the above, the amendments to Applicant's goods, and 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.

VI. Prior-Filed Application Advisory

Applicant elects not to submit arguments in connection with the prior pending application identified by the Examiner at this time but reserves the right to file arguments if the prior pending application matures into a registration and a likelihood of confusion refusal is issued.

For all of the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the refusal and allow the application to proceed.