

Mark: 4 Element Logo (Horizontal) AURORA (Stylized)



U.S. Trademark/Service Mark Application No. 88/498096

Filing Date: May 1, 2020; Int'l Class: 3, 9, 16, 32, 34, 41, 42 and 44

Applicant: 1769474 ALBERTA LTD.

## ARGUMENTS

### REMARKS

This amendment is being filed in response to the Office Action dated May 18, 2020.

#### **I. PARTIAL SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

##### CLASS 3 REFUSALS

In the Office Action dated May 19, 2020, the Examining Attorney initially refused registration of Applicant's AURORA mark (the "Mark") under Section 2(d) in view of U.S. Registration Nos. 5502881 (for AURORA, for use with "Mouthwashes, not for medical purposes"), 3966597 (for AURORA, for use with various goods in Class 3) and 0251731 (for BELLA AURORA, for use with "Toilet preparations-namely, face powder and face cream") (collectively the "Cited Registrations"). Applicant respectfully submits that the mark in the present application is distinguishable from the marks in the cited registrations for at least the following reasons.

##### The Marks are Different in Appearance, Sound, Meaning, and Commercial Impression

A comparison of Applicant's mark with the marks in the Cited Registrations shows that the marks are dissimilar in overall appearance, sound, meaning, and commercial impression. Extra and differing features contribute to the overall impression made by the mark on the relevant public. *Johnson & Johnson v. Colgate-Palmolive Co.*, 345 F. Supp. 1216, 1222, 175 U.S.P.Q. 287, 291 (D.N.J. 1972) (dissecting marks is "not the manner in which potential purchasers shop.") As the Court of Customs and Patent Appeals remarked in comparing the marks PEAK and PEAK PERIOD, "[t]he difference in appearance . . . of the marks in issue is too obvious to render detailed discussion necessary. In their entirety they neither look nor sound alike." *Colgate-Palmolive Co. v. Carter-Wallace Inc.*, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970).

Applicant's mark features a distinctive design element, known as the "four element" design. The design includes a two by two matrix formed by a plus sign with a stylized mountain in the first row, first column; a stylized drop in the first row, second column; a stylized sun in the second row, first column; and a stylized cloud with three straight lines in the second row, second column, followed by the term AURORA in stylized lettering. The prominent design element creates a commercial impression of balance, due to the matrix, and the natural elements land, water, sun, and clouds that is not present in any of the Cited Registrations. At a minimum, this distinctive design differentiates Applicant's mark from the Cited Registrations in terms of appearance and commercial impression.

The cited mark BELLA AURORA is easily distinguished from Applicant's mark AURORA in terms of appearance and sound by the wording "BELLA." With respect to meaning, the word "bella" means "beautiful" in English and creates a commercial impression of beauty with respect to Registrant's toilet preparations. Applicant's mark does not include the word "bella," and thus does not have the same meaning or create the same commercial impression as BELLA AURORA. These differences, especially the wording "BELLA" in Registrant's mark, serve to differentiate the marks from one another and would not be ignored or overlooked by consumers.

It is well settled that "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Packard Press Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1353 (Fed. Cir. 2000). In this case, the clear differences in appearance, sound, connotation and commercial impression between AURORA and the Cited Registrations obviate any likelihood of confusion.

### The Goods Are Not Identical

Generally speaking, Applicant's goods are skin, hair, and body preparations containing hemp and hemp derivatives. The identification of goods in Class 3 is amended to delete reference to "personal products" or "personal preparations."

The goods covered by cited U.S. Registration No. 5502881 (for AURORA) are "Mouthwashes, not for medical purposes," in Class 3. The present application does not cover mouthwashes. Further, goods consumed orally are clearly distinguishable from goods that are applied topically. In view of the differences in the goods, consumer confusion is unlikely.

The goods covered by cited U.S. Registration Nos. 3966597 (for AURORA) and 0251731 (for BELLA AURORA) are non-medicated personal care products and other goods in Class 3 and "Toilet preparations-namely, face powder and face cream," in Class 3, respectively.

In contrast to Applicant's goods containing hemp and hemp derivatives, the Cited Registrations do not cover goods containing hemp and hemp derivatives. Goods containing hemp and hemp derivatives are strictly regulated and traded in the U.S. Accordingly, consumer confusion as to the source of the goods is unlikely.

### The Channels of Trade Are Different

With respect to channels of trade, courts have made it clear there is usually no likelihood of confusion where the goods do not ultimately reach the same market or the same purchasers. *Windsor, Inc. v. Intravco Travel Centers, Inc.*, 25 U.S.P.Q.2d 1111, 1118 (S.D.N.Y. 1992). As noted above, goods containing hemp and hemp derivatives are strictly regulated and traded in the U.S. Due to the strict regulations surrounding these types of goods, Applicant's goods are not likely to be sold through the same channels of trade as Registrants' goods, which are available through all the normal channels of trade.

In view of the differences in the channels of trade, there is no likelihood of confusion between the marks.

## The Cited Registrations Coexist on the Principle Register Without Confusion

The Cited Registrations co-exist on the Principle Register and in the marketplace without creating consumer confusion, indicating that consumers are accustomed to distinguishing among marks that include the term "AURORA" for goods in Class 3.

As such, the scope of protection that should be afforded to the cited registrations is relatively narrow, and the addition of the term "BELLA" in the registration for BELLA AURORA renders Applicant's mark distinguishable as a whole.

The Board has previously noted that "extensive evidence of third-party use and registrations is 'powerful on its face.'" See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) ("The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.")).

If the marks in the cited registrations coexist without risk of confusion, then Applicant's mark can also coexist without creating a likelihood of confusion. Further, if consumers are able to distinguish the prior registered "AURORA" marks for goods in Class 3, so too should consumers be able to distinguish the source of Applicant's goods, particularly in view of the differences in the marks, the goods containing hemp and hemp derivatives, and the strictly regulated channels of trade.

## Confusion is Not Probable

Likelihood of confusion "is synonymous with 'probable' confusion – it is not sufficient if confusion is merely 'possible.'" 2 McCarthy § 23:3. Or, as the Court of Appeals for the Federal Circuit has put it, "[w]e are not concerned 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." *Electronic Design.*, 21 U.S.P.Q.2d 1388, 1391 (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). See also *Signetics Corp. v. Sigona*, 212 U.S.P.Q. 318, 320 (T.T.A.B. 1981) ("[W]hile confusion may be possible, it does not seem to us to be likely. Unfortunately for opposer's case, likelihood, not possibility, is the test that we are required under the Trademark Act to apply."); *Phoenix Closures Inc. v. Yen Shaing Corp. Ltd.*, 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities.").

In this case, confusion simply is not probable. Applicant submits that there is no likelihood of confusion between the mark in the present application and the marks in the Cited Registrations.

## CLASS 5 REFUSALS (BASED ON CURRENTLY MISCLASSIFIED CLASS 32 GOODS)

The Examining Attorney initially refused registration of Applicant's AURORA mark (the "Mark") under Section 2(d) in view of U.S. Registration Nos. 4593145 (for AURORA ALGAE (stylized)), 4593144 (for

AURORA ALGAE), 5685772 (for NATURE AURORA), 3106119 (for AURORABLUE), 3725934 (for AURORAGREEN) and 3367054 (for AURORARED). In response, Class 32 has been deleted from the application, rendering the refusal moot.

#### CLASS 34 REFUSALS

The Examining Attorney initially refused registration of Applicant's AURORA mark (the "Mark") under Section 2(d) in view of U.S. Registration Nos. 5663896 (for AURORA BARREL AGED), 1410833 (for LA AURORA), 1372922 (for LA AURORA), 3929924 (for LA AURORA 107) and 4222711 (for LA AURORA 1903 EDITION). In response, Class 34 has been deleted from the application, rendering the refusal moot.

#### CLASS 44 REFUSALS

The Examining Attorney initially refused registration of Applicant's AURORA mark (the "Mark") under Section 2(d) in view of U.S. Registration Nos. 3158546 (for AURORA) and 4296758 (for AURORA QUICKCARE). In response, Class 44 has been deleted from the application, rendering the refusal moot.

Applicant respectfully submits that in view of the foregoing remarks, there is no likelihood of confusion between Applicant's mark and the marks in the Cited Registrations.

### **II. PRIOR-FILED APPLICATION(S)**

The Examining Attorney noted pending Application Nos. 87886859 (for AURORA), 88140199 (for LA AURORA) and 88317891 (for AURORA KOMBUCHA) (the "Pending Applications") as potential obstacles to registration.

Application No. 88317891 covers "Kombucha tea, loose leaf tea," in Class 30. Because the present application does not cover Class 30, there is no likelihood of confusion and Application No. 88317891 should be removed as a potential barrier to registration. Applicant reserves the right to make further arguments in support of registration if and when the prior applications mature to registration and are cited against the present application.

### **III. PARTIAL FDCA REFUSAL**

The Examining Attorney refused registration of Applicant's mark because the applicant does not have a bona fide intent to lawfully use the applied-for mark in commerce for some of the goods in Class 32. In response, Class 32 is deleted.

### **IV. IDENTIFICATION OF GOODS**

The identification of goods in Class 3 is amended herein. There are no amendments in Classes 9, 16, 41, and 42. Classes 32, 34, and 44 are deleted.

### **V. MULTI-CLASS APPLICATION REQUIREMENTS**

The application was filed covering 8 classes. In view of the proposed amendments, no additional fees should be required.

### **VI. INFORMATION ABOUT GOODS**

The Examining Attorney required additional information about the goods and services and a written statement indicating whether the goods/services identified in the application comply with the Food, Drug and Cosmetic Action (FDCA). In response, Applicant respectfully submits the following response.

1. Do or will the goods include cannabidiol (CBD)? – Yes, the goods include cannabidiol (CBD).
2. If yes, how much CBD will there be in the goods per serving? - Applicant's goods, as presently amended, are not measured in servings. All of the goods containing hemp or hemp derivatives will have a delta-9 tetrahydrocannabinol concentration of not more than 0.3 percent on a dry weight basis.
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.

**VII. ENTITY CLARIFICATION REQUIRED**

Applicant confirms that 1769474 ALBERTA LTD. is a Limited Company. The entity type in the application is hereby amended to "Limited Company."

**VIII. DESCRIPTION OF MARK**

The description of mark in the present application is amended herewith.

**CLOSING**

In view of the foregoing amendment and remarks, Applicant requests that the mark be approved for publication without further delay. If the Examining Attorney has any questions, she is invited to contact applicant's attorney at the number below or [melissa.nowak@cojk.com](mailto:melissa.nowak@cojk.com).