

Applicant: The Terra Group LLC – The Terra Fund

Mark: **TERRA**

App. No.: 88589437

Filing Date: 08.22.2019

Re: **Response to Suspension Letter**

On November 22, 2019, the Office suspended proceedings pending the outcome of applications for US Serial No(s): 88337793, 88122800, 88122806, 88122808 and 88122811.

Applicant believes its **TERRA** application is unlikely to confuse, mislead or deceive consumers. Therefore, as supported below, Applicant respectfully requests allowance of its mark on the Principal Register for "Providing financial and investment services, namely, creating and managing investment funds, including, mutual funds and exchange-traded funds; providing financial information, namely, financial indexes based on selected groups of securities; providing and updating financial indices."

In assessing likelihood of confusion, marks must be compared in their entireties. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). The comparison also involves assessing other probative factors including the dissimilarities between the goods and the established, likely to continue channels of trade. *Federated Foods, Inc., v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976}. With reference to TMEP 1207.01(a)(i), "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, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012).

Here, Applicant seeks to register **TERRA**. This application differs from

US Serial No(s): 88337793, 88122800, 88122806, 88122808 and 88122811 in several aspects. Thus, under the circumstances, Applicant's **TERRA** mark is qualified to register.

First, the **TERRA** Application does not include "cryptocurrency exchange services" as identified in US Serial No. 88337793 (**TERRA**), applicant ("Zooterra"). The **TERRA** application identifies financial and investment services for creating and managing mutual funds and exchange-trade funds (ETFs); financial indexes based on securities; and providing financial indices (indexes). There is no indication that Applicant and the cited Zooterra compete against each other or that mutual funds, ETFs, or financial indexes are in Zooterra's "normal fields of expansion". Specifically, Zooterra's application identifies cryptocurrency exchange services providing digital tokens relating to nature conservation. The channels of trade and class of consumers are not the same or related. *In re Viterra Inc.*, 671 F3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012).

Second and third, the **TERRA** Application does not include "cryptocurrency" as identified in US Serial No. 88122800 (**TERRA COIN**), applicant ("Terraform Labs"), and US Serial No. 88122806 (**TERRA TOKEN**), applicant ("Terraform Labs"). There is no indication that Applicant and the cited Terraform Labs compete against each other or that mutual funds, ETFs, or financial indexes are in Terraform Labs' "normal fields of expansion". Specifically, both the **TERRA COIN** and **TERRA TOKEN** applications cited above identify cryptocurrency providing a virtual currency for use by members of an on-line community. The channels of trade and class of consumers are not the same or related.

Fourth, the **TERRA** Application does not include "virtual currency, currency exchange, or currency trading" as identified in Class 036 for US Serial No. 88122808 (**TERRA WALLET**), applicant ("Terraform Labs"). There is no indication that Applicant and the cited Terraform Labs compete against each other

or that mutual funds, ETFs, or financial indexes are in Terraform Labs' "normal fields of expansion". Specifically, TERRA WALLET identifies "Financial services, namely, providing virtual currency or digital tokens of value for use by members of an on-line community via a global computer network utilizing a blockchain; Financial services, namely, virtual currency central repository services in the nature of providing electronic transfer of a virtual currency for use by members on an on-line community via a global computer network; Financial services, namely, virtual currency exchange transaction services and credit card and payment card services; Online currency marketplace services, namely, providing a marketplace for trading virtual currency and digital assets; Exchange services for virtual currency or digital tokens of value; Transfer services for virtual currency or digital tokens of value; Buying and selling currency; On-line real-time currency trading; Computerized financial services relating to foreign currency dealings; Financial transactions relating to currency swaps; Providing information and analysis via the Internet in the field of financial investments; Issue of tokens of value." TERRA WALLET also identifies computer software and platform services in Classes 009 and 042. As identified in the **TERRA** Application, the investment and financial services, including mutual funds and exchange-traded funds (ETFs), and financial information on financial indexes, are unrelated services to the classes identified in pending TERRA WALLET. The channels of trade and class of consumers are not the same or related.

Fifth, the **TERRA** Application does not include "virtual currency, currency exchange, or currency trading" as identified in Class 036 for US Serial No. 88122811 "TERRA MONEY," applicant ("Terraform Labs"). There is no indication that Applicant and the cited Terraform Labs compete against each other or that mutual funds, ETFs, or financial indexes are in Terraform Labs' "normal fields of expansion". Specifically, TERRA MONEY identifies "Financial services, namely, providing virtual currency or digital tokens of value for use by members of an on-line community via a global computer network utilizing a blockchain; Financial services, namely, virtual currency central repository services in the nature of providing

electronic transfer of a virtual currency for use by members on an on-line community via a global computer network; Financial services, namely, virtual currency exchange transaction services and credit card and payment card services; Online currency marketplace services, namely, providing a marketplace for trading virtual currency and digital assets; Exchange services for virtual currency or digital tokens of value; Transfer services for virtual currency or digital tokens of value; Buying and selling currency; On-line real-time currency trading; Computerized financial services relating to foreign currency dealings; Financial transactions relating to currency swaps; Providing information and analysis via the Internet in the field of financial investments; Issue of tokens of value.” TERRA MONEY also identifies computer software and platform services in Classes 009 and 042. As identified in the **TERRA** Application, the investment and financial services, including mutual funds and exchange-traded funds (ETFs), and financial information on financial indexes, are unrelated services to the classes identified in pending TERRA MONEY. The channels of trade and class of consumers are not the same or related.

In sum, likelihood of confusion as to the source of the goods is the standard for denying registration and must be established by applicable factors. *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012). Employing the applicable factors, there's no likelihood of confusion between Applicant's **TERRA** application and any of the pending applications referenced in the Office's most recent correspondence. As a result, in the event that any or all of the cited pending applications are registered, Applicant's mark can coexist on the Principal Register without confusing or misleading consumers.

Should the Examining Attorney wish to discuss any related issues, please contact the undersigned. Otherwise, Applicant respectfully requests that its **TERRA** application be removed from suspension and allowed to register.

Respectfully submitted,

/Peter Adams/

Peter Adams, Esq

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Date: December 22, 2019