

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bread Labs, Inc.)	
)	Trademark Law Office: 105
Serial No.: 85013544)	
Filed: 4/14/2010)	
Mark: bread)	Attorney: Evelyn Bradley
)	

BOX RESPONSES

NO FEE

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Bread Labs, Inc. (hereinafter "Applicant") responds to the Office Action dated July 28, 2010 as follows:

DISCUSSION

The Examining Attorney has refused registration of the Applicant's trademark "bread" on the basis of a likelihood of confusion with the mark in U.S. Registration No. 3,651,225, namely "BREAD & Butter" (stylized) for inter alia:

providing advertising services; management of business affairs; business administration and office work; organization of exhibitions for commercial or advertising purpose; counseling on business matters, namely business consultation; procurement services for others, namely, purchasing goods and services for other businesses; shop-window dressing and display arrangement services; publication of publicity texts; modeling and modeling agencies for advertising or sales promotion, business marketing services; market research; organization of trade fairs and exhibitions for commercial or advertising purposes and for arranging and conducting commercial conferences; public relations services; production and distribution of radio commercials; providing statistical information; compilation and systemization of information in computer databases; business merchandising display services in class 35.

Reconsideration of this refusal is respectfully requested for the reasons stated below.

In her refusal the Examining Attorney indicates that refusal is appropriate because of: (i) the similarity of the marks; (ii) the similarity of the goods or services; and (iii) similarity of trade channels of the goods or services. *Cites Omitted.*

In comparing the Applicant's and Registrant's marks for similarities in sound, meaning and connotation, the Examining Attorney notes that the marks share the same dominant feature, namely

“Bread,” and are therefore similar in sound and connotation so as to create the same overall commercial impression. However, the Examining Attorney has not set forth a criterion for determining the dominant portion of a mark, namely whether a buyer would be more likely to use and remember one part of a mark as indicating the origin of the goods or services. *See Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 U.S.P.Q. 266 (C.C.P.A 1955). “Bread & Butter” is a widely used idiomatic expression which, as defined in the Merriam-Webster dictionary, may be used as either an adjective or noun and refers to a means of sustenance or livelihood, or reliability and dependability. *See attached Excerpts from www.Merriam-Webster.com visited on 8/24/2010 and attached hereto as Exhibit 1.* Given its common usage and well-known meaning, it is unlikely that consumers would be inclined to remember and use one part of “Bread & Butter,” namely “Bread,” to refer to the origin of Registrant’s goods and services rather than the entire phrase. The commercial impression created by registrant’s mark is likely derived from the popular meaning of that well-known phrase. Consequently, Applicant’s mark “bread” does not create the same overall commercial impression as “BREAD & butter.”

With regard to the services offered under the Applicant’s and Registrant’s marks respectively, the Examining Attorney notes that “it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source.” *Cites omitted.* In comparing the Applicant’s services as originally described in the application and Registrant’s services, the Examining Attorney concludes that they are sufficiently related to give rise to a likelihood of confusion because they are “business or advertising services” and as such would be “available to the same class of consumers and would be encountered under circumstances leading one to mistakenly believe that they originate from the same source.”

TMEP 1207.01(a)(iii) provides, in relevant part, that “[t]he nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration.” As stated in its amended identification of services, Applicant’s mark will be used for ““On-line advertising and marketing services, namely providing consumer product information via the

Internet; promoting the goods and services of others by providing hypertext links to the websites of others; provision of space on websites for promoting the goods and services of others; promoting the charitable services of others, namely providing information regarding charitable organizations via the Internet in Class 35." It is clear that Applicant's advertising services are solely provided via the Internet. On the other hand, in Registrant's lengthy list of services, the extent to which advertising services are promoted in relation to the other services provided under the mark and the manner by which they are provided is vague.

"Where the terminology in the identification is unclear, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. The Board noted that in light of such evidence it is improper to consider the identification in a vacuum and attach all possible interpretations to it." *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990). The attached pages from the Registrant's website and LinkedIn Profile (*See Exhibit 2*) are instructive as to both the nature of the services that Registrant provides under its mark and the consumers of those services. Registrant is in the business of organizing and running trade fairs for select brands in the apparel and fashion industries. In conjunction with such trade fairs, Registrant provides the services which are identified in the registration as:

providing advertising services; management of business affairs; business administration and office work; organization of exhibitions for commercial or advertising purpose; counseling on business matters, namely business consultation; procurement services for others, namely, purchasing goods and services for other businesses; shop-window dressing and display arrangement services; publication of publicity texts; modeling and modeling agencies for advertising or sales promotion, business marketing services; market research; organization of trade fairs and exhibitions for commercial or advertising purposes and for arranging and conducting commercial conferences; public relations services; production and distribution of radio commercials; providing statistical information; compilation and systemization of information in computer databases; business merchandising display services" in class 35.

In TMEP 1207.01(a)(iv) the Office states that "there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto." 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. TMEP 1207.01(a)(i). *Additional cites omitted.* Here, Registrant organizes trade fairs for the fashion and apparel industry and advertising is one of the many services provided by Registrant to the various participants in those trade fairs. It should also be noted that Registrant's services as recited in the registration are of the more traditional "brick and mortar" variety of services and are not web-based. Applicant's services, on the other hand, will be provided solely via the Internet and do not include or anticipate the organization of trade fairs. As evidenced by the landing page from Applicant's website (www.bread.co), attached hereto as *Exhibit 3*, Applicant's on-line advertising and marketing services, which will be launched later this year, will utilize a combination of social media and other Internet-based resources in order to promote the goods, services and charitable organizations of others. In situations where, as in this case, the registrant and applicant deal in non-competing goods and services, the Office should accord greater weight to the nature of the products and services and the context in which they are marketed and sold. Whether there is a likelihood of confusion between Registrant and Applicant's use of the marks "BREAD & butter" and "bread" rests not as much on the alleged similarity between the goods and services as it does on the dissimilarity of the target markets towards which the goods and services are directed.

It is clear that the cited Registrant's services are completely different from the services recited in Applicant's identification of services as amended. Applicant's services are not competitive with Registrant's and are not a substitute for them. They have completely different and unrelated purposes and functions, are not complementary and do not overlap in terms of their target markets or channels of trade. Applicant's Internet-based advertising and promotional services are not intended or designed to fulfill the more traditional advertising and promotional services provided to Registrant's trade fair consumers. Accordingly the risk of confusion in the marketplace from the concurrent use of the marks is minimal.

Applicant submits that even in cases where marks are similar, there are cases where there is no likelihood of confusion when the marks and the goods and services are evaluated in their entirety and

proper weight is accorded to the differences between the goods and services, their respective target markets and channels of trade. For the reasons stated herein, Applicant submits that the use and registration of its mark is not likely to cause confusion in the marketplace, and respectfully requests approval of its application for publication. If further information or clarification is required, a telephone call to the undersigned would be greatly appreciated.

Respectfully submitted,
/Susan Brushaber/Attorney for Applicant