

Refusal under Section 2(d) of the Trademark Act

I. Introduction

Applicant filed an application to register the mark THE DIRT for the following goods and services, as amended:

Class 9 - Downloadable newsletters in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking information; downloadable audio and video ~~material~~ recordings and files featuring information in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking; downloadable podcasts in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking information;

Class 16 - Printed newsletters in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking information;

Class 41 - Providing a website featuring blogs and non-downloadable publications in the nature of newsletters and articles in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking information; entertainment services, namely, providing podcasts in the fields of food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking information; providing a website featuring non-downloadable audio and video files featuring information on food, ingredients, food growers and producers, restaurants and other food providers, recipes, and cooking;

Class 43 - Providing a website featuring information in the fields of food, ingredients, ~~food growers and producers~~, restaurants and other food providers, recipes, and cooking information; providing information in the fields of food, ingredients, ~~food growers and producers~~, recipes, and cooking information; and

Class 44 - Providing a website featuring information in the fields of food growers and producers; providing information in the field of food growers and producers;

(“Applicant’s Mark”). The Office Action refused to register Applicant's Mark under the Trademark Act §2(d) on the basis of an alleged likelihood of confusion between Applicant’s Mark and a registration for DIRT, U.S. Registration No. 5,072,844, for “on-line journals, namely, blogs featuring food and food industry related subject matter, including profiles,

interviews, essays and recipes,” in Class 41, owned by Dig Inn Restaurant Group, LLC (the “Cited Registration”).

Applicant respectfully requests reconsideration of this refusal to register.

II. Applicant’s Mark is not likely to be confused with the Cited Registration because the appearance, sound, meaning, and overall commercial impressions of the marks are different.

Confusion between Applicant’s Mark and the Cited Registration is not likely because the appearance, sound, meaning and overall commercial impressions of Applicant’s Mark and the Cited Registration are different.

Applicant’s Mark is different from the Cited Registration in appearance because it begins with the term THE, which is not included in the Cited Registration. See Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (finding dissimilarity between CRISTAL and CRYSTAL CREEK); Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344, 1350 (Fed. Cir. 2013) (“[t]his court has found mark dissimilarity when the words are spelled differently”); In re Reach Electronics, Inc., 175 U.S.P.Q. 734 (TTAB 1972) (finding no likelihood of confusion between REAC and REACH); Flushing Bank v. Green Dot Corp., 138 F.Supp.3d 561, 588 (SDNY 2015).

The marks are also different in the way they sound. Given that Applicant’s Mark includes a term (THE) that is not in the Cited Registration, the marks sound very different as a result. The differences in the marks in appearances and sound support a finding that confusion is not likely. See, e.g., Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295, 297 (CCPA 1958) (affirming Patent Office decision that marks RITE-FIT and SURE-FIT, both used in connection with slip covers, were not likely to be confused, and stating that “[t]he fact of the

matter is that ‘Rite’ and ‘Sure’ do not look alike or sound alike, factors which we feel...militate against” a finding of confusion).

The marks are also different in meaning because Applicant’s Mark THE DIRT, as used in connection with goods and services that relate to food growers and producers, calls to mind “the dirt,” or “the earth,” in which vegetables and fruits are grown. The Cited Registration does not have the same connotation because it does not include the term THE.

Finally, due to the differences in appearance, sound and meaning, when viewed in the context of the respective identifications, the marks have different commercial impressions. Given these fundamental differences, confusion between these marks is unlikely.

The Office Action dissects Applicant’s Mark and the Cited Registration into individual components, and asserts that the marks are similar because they share certain features. However, “[i]t is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion,” which includes consideration of the design element in Applicant’s Mark. Franklin Mint Corporation v. Master Manufacturing Company, 667 F.2d 1005, 1007 (CCPA 1981) (affirming TTAB’s decision of no likelihood of confusion between marks based on comparison of marks as a whole); In re Viterra Inc., 671 F.3d 1358, 1362 (Fed. Cir. 2012)(“[M]arks must be viewed ‘in their entirety, and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design”); Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA V. New Millennium Sports, Slu, 707 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015). In assessing likelihood of confusion, marks should be considered in their entirety as to appearance, sound and meaning. See Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344 (Fed. Cir. 2013);

Professional Art Distribution, Inc. v. Internationaler Zeichenverband Fur Kunstdruckpapier, E.V., 11 U.S.P.Q. 2d 1735 (Fed. Cir. 1989); Flushing Bank v. Green Dot Corp., 138 F.Supp.3d 561, 588 (SDNY 2015) (finding marks GOBANK and IGOBANKING, both with design elements, and used for banking services, despite some similarities were dissimilar when taken as a whole, reasoning that they convey different impressions, have different emphases, sound different and look different). The Office Action fails to consider the effect of the entire mark, including the additional term in Applicant's Mark. In view of the differences discussed above, the appearance, sound, meaning, and overall commercial impression of the Cited Registration is wholly distinct from that of Applicant's Mark, and confusion between the marks is not likely.

III. Conclusion

The marks at issue are different in appearance, sound, meaning and overall commercial impression. Accordingly, registration of Applicant's Mark would not result in likelihood of confusion and Applicant respectfully requests reconsideration of the refusal to register Applicant's Mark.