

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Fable Holdings Pty Ltd

For: FABLE

Serial No. 79275727

OFFICE ACTION RESPONSE

In the Office Action, the Examining Attorney refused registration based on a likelihood of confusion with the following marks:

U.S. Registration No. 1019518
vegetable base imitation cream for whipping

U.S. Registration No. 5478661
Unprocessed fruits, vegetables, root vegetables, raw garlic, leafy greens, herbs, sprouts, microgreens, wheatgrass, and mushrooms.

For the following reasons, this refusal and potential refusal are respectfully traversed.

First, U.S. Registration No. 1019518 was cancelled because registrant did not file an acceptable declaration under Section 8. As such, this analysis is related to Reg. No. *5478661 for FABLE FROM FARM TO TABLE*.

In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 56 (CCPA 1973), cited by the Examining Attorney, stands for the proposition that likelihood of confusion depends upon whether the purchasing public would mistakenly assume that an applicant's goods originate from, are sponsored by, or are in some way associated with goods provided under one or more cited marks. In DuPont, the court enunciated several factors relevant to determining likelihood of confusion. In this case, the similarity or dissimilarity of the goods, is dispositive.

The Patent and Trademark Office bears “the burden of proving that a trademark falls within a prohibition of § 1052.” In re Mavety Media Group Ltd., 31 U.S.P.Q.2d 1923, 1925 (Fed. Cir 1994); see also In re Standard Elektrik Lorenz Aktiengesellschaft, 152 U.S.P.Q. 563 (C.C.P.A. 1967). Among the most important factors that must be considered in determining whether two trademarks are confusingly similar is the similarity or dissimilarity of the goods. The goods identified must be compared to determine if they are related, or if the activities surrounding their marketing would cause likely confusion as to origin. Guardian Prods. Co. v. Scott Paper Co., 200 U.S.P.Q. 738 (T.T.A.B. 1978). If the goods are not related, confusion is not likely, and it is clear that “a single DuPont factor may be dispositive in a likelihood of confusion analysis.” Odom's Tennessee Pride Sausage Inc. v. FF Acquisition LLC, 93 U.S.P.Q.2d 2030, 2032 (Fed. Cir. 2010) citing Champagne Louis Roederer, S.A. v. Delicato Vineyards, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998); In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973).

The Dissimilarity the Goods

As stated in TMEP Section 1207.01(a)(iv), “[t]he facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; thus, there can be no rule that certain goods are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See e.g., Information Resources Inc. v. X*Press Information Services, 6 U.S.P.Q.2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 U.S.P.Q.2d 1169, 1171 (TTAB 1987) (regarding jerky, sauces and fruit juices); 7-Eleven, Inc. v. HEB Grocery Co., LP, 83 U.S.P.Q.2d 1715 (TTAB 2007) (frozen entrees consisting primarily of meat, fish,

poultry or vegetables and drinking water) In re Quadram Corp., 228 U.S.P.Q. 863, 865 (TTAB 1985) (regarding computer hardware and software), and cases cited therein.

Further, the issue of whether or not goods “are related does not revolve around whether a term can be used that describes them both, or whether both can be classified under the same general category.” Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992). The case law is clear that goods cannot be deemed related merely because they are both food products or may both be sold in supermarkets. See, e.g. Nestle Co. v. Nash-Finch Co., 4 U.S.P.Q.2d 1085 (T.T.A.B. 1987). To the contrary, food products that are not reasonably interchangeable are not related goods. Worthington Foods, Inc. v. Kellogg Co., 14 U.S.P.Q.2d 1577, 1604-1605 (S.D. Ohio 1990) (finding substitute egg/sausage products not related to breakfast cereals because such goods are not substitutes or complementary products, despite both being eaten for breakfast). Also, in In California Prune and Apricot Growers Association v. Albany Packing Company, Inc., 41 USPQ 514 (CCPA 1939), the Court of Customs and Patent Appeals found that the registrant's mark TENDERIZED for hams, pork shoulders was not confusingly similar to Petitioner's identical mark TENDERIZED for dried fruits. The CCPA noted:

Petitioner points out that the goods of both parties are packed in cartons and sold in the same stores. These are tests to be applied, but they are by no means conclusive. The differences between dried fruits and meat products, in all their essential characteristics, are so great that I do not think anyone would be likely to assume that they have a common source of origin merely because they bear the same mark and are similarly packaged and sold in the same stores.

Applicant meat substitutes and are not any more similar to Registrant's fruits and vegetables, herbs, sprouts, microgreens, wheatgrass, and mushrooms than any other products

found in grocery store (California Prune and Apricot Growers, 41 USPQ at 515) or egg/sausage products are related to breakfast cereals (Worthington Foods).

Indeed, it is obvious that Applicant's meat substitutes are a specialized form of food directed to consumers looking for a very specific product, which approximates certain aesthetic qualities (primarily texture, flavor and appearance), or chemical characteristics of a specific meat without being animal meat. According to the attached evidence meat substitutes are often sold in separate sections of the grocery store or together or next to meats, which in any case always require special temperature storage conditions. Likewise, fresh fruits and vegetable products are sold in separate sections/departments. As such, both parties' goods would not be typically sold in the same sections, such goods are different in character and would not be encountered together by consumers. *See, Hi-Country Foods Corp. v. Hi-Country Beef Jerky*, 4 U.S.P.Q.2d 1169 (T.T.A.B. 1987) (finding beef-based snack foods unrelated to fruit juices "even when sold under virtually identical trademarks" because these products are "different in character" and "would not normally be sold in the same sections of food stores..."), In re Mars, Inc., 222 U.S.P.Q. 938 (Fed. Cir. 1984) (finding confusion unlikely for use of identical CANYON marks on citrus fruit and candy bars, respectively).

It is clear that Applicant's goods are not related, or similar to the goods of the cited marks, and that based on the prior case law, this factor alone is sufficient to demonstrate confusion is not likely in the present case.

Confusion Must Be Likely

Finally, under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods must be not merely *possible*, but likely. A mere possibility of confusion is an insufficient basis for rejection under § 2(d). In re Massey-

Ferguson, Inc., 222 U.S.P.Q. 367, 368; Witco Chem. Corp. v. Whitfield Chem. Co., 164 U.S.P.Q. 43 (CCPA 1969). “We 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 trademark laws deal.” Witco at 44.

Inasmuch as all outstanding issues have been resolved, Applicant submits that the mark is in condition for publication. Please direct any questions regarding this response to the undersigned attorney for Applicant.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Alex Lazouski", with a horizontal line extending to the right.

Alexander S. Lazouski