IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)	
	)	
Cornell University	)	Trademark Attorney
	)	Leigh Caroline Case
Serial No.: 86555930	)	Law Office: 118
Filed: March 6, 2015	)	
Mark: SNAPDRAGON	)	

RESPONSE TO FIRST OFFICE ACTION

In a first office action dated June 11, 2015, the Trademark Attorney (the "Examiner") raised several issues concerning the application for the mark SNAPDRAGON (the "Mark") in the name of Cornell University (the "Applicant") for: "Cut fruits; Dehydrated fruit snacks; Fruit purees; Preserved fruits; Processed fruits, namely, apples," in Class 029; "Fresh fruit; Living fruit plants," in Class 031; and "Fruit beverages; Fruit drinks; Fruit juice," in Class 032 (the "Goods"). In particular, the Examiner: (1) refused registration, in part, as to the Class 029 goods based on likelihood of confusion with a prior registration; (2) issued an advisory, without specific supporting details or arguments, that there is possible confusion with several marks in prior pending applications; and (3) refused registration, in part, as to the Class 031 goods on the grounds that the Mark is a varietal or cultivar name.

Based on a teleconference between the Applicant's undersigned attorney and the Examiner on August 5, 2015, Applicant responds herein to the refusals and the advisory of record and respectfully requests the Examiner to approve the Mark for publication.

Response

I. There is no likelihood of confusion between the Mark and the Cited Mark, or possible confusion between the Mark and the marks in the Referenced Applications

The Examiner refused registration of the Mark with respect to the Class 029 Goods, because of likelihood of confusion with the mark SNAPDRAGON (Reg. No. 3939182) for, in relevant part, "prepared nuts," in Class 029 (the "Cited Mark").

The Examiner also argues that, if the marks in the applications referenced below (the "Referenced Applications") mature to registration, they may bar registration of the Mark based on likelihood of confusion.

Mark	**Serial No.**	**Goods/Services**
SNAP DRAGON HOME GARDEN	85641314	Class 035: On-line retail store services in the field of home, lawn and garden products and supplies.
	85641334	Class 035: On-line retail store services in the field of home, lawn and garden products and supplies.
SNAPDRAGONHOMEGARDEN.COM	85641272	Class 035: On-line retail store services in the field of home, lawn and garden products and supplies.

A likelihood of confusion analysis requires consideration of several factors. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). In this case, the most relevant factors are the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, and the similarity or dissimilarity and nature of the goods or services.

A key factor in every likelihood of confusion analysis is the similarity or dissimilarity of the marks at issue with respect to appearance, sound, meaning, and overall commercial impression. TMEP §1207.01; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098,

1103, 192 USPQ 24, 29 (C.C.P.A. 1976). Importantly, the Court of Appeals for the Federal Circuit instructs that when assessing if any likelihood of confusion exists, each mark must be considered in its entirety. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) ("The basic principle in determining confusion between marks is that marks must be compared in their entireties."); *see also In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990); *In re Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) ("Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight."). Accordingly, the analysis must include any distinguishing elements of the respective marks. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) ("[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered.").

Further, similarity as to one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). There also are numerous prior decisions finding that, even where a mark contains the whole of another's mark, there is no likelihood of confusion. *See, e.g., Electrolyte Labs. Inc.*, 929 F.2d at 647-48, 16 USPQ2d at 1240 (no likelihood of confusion between "K+ (and design)" and "K+EFF" for potassium supplements); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407, 184 USPQ 422, 425 (CCPA 1975) (no likelihood of confusion between "COUNTRY VOGUES" for women's dresses and "VOGUE" for a fashion magazine); *Lever Bros. Co. v. The Barcolene Co.*, 463 F.2d 1107, 1108-09, 174 USPQ 392, 393 (CCPA 1972) (no likelihood of confusion between "ALL" and "ALL CLEAR" for household cleaners); *Colgate-Palmolive Co.*

v. Carter-Wallace, Inc., 432 F.2d 1400, 1402, 167 USPQ 529, 531 (CCPA 1970) (no likelihood of confusion between "PEAK" for toothpaste and "PEAK PERIOD" for deodorant).

Importantly, even assuming that marks are identical in appearance and sound, they may well have different meanings and create sufficiently different commercial impressions when applied to the respective parties' goods or services such that there is no likelihood of confusion. *See* TMEP §1207.01(b)(v) and the cases cited therein; *see also Luigino's, Inc. v. Stouffer Corp.*, 170 F. 3d 827 (8th Cir. Minn. 1999) ("[t]he use of identical dominant words does not automatically mean that two marks are similar. The court must look to the overall impression created by the marks, not merely compare individual features.").

a. There is no likelihood of confusion between the Mark and the Cited Mark, because the marks have different meanings and distinct commercial impressions

The owner of the Cited Mark manufactures and supplies pre-packaged Asian food meals and sells prepared nuts as part of its Asian food product line (*see* www.snapdragonfood.com and the attached screenshots). Applicant, on the other hand, is a large educational university and research facility with several operations, including significant agricultural and biotechnology research operations. As part of these operations, Applicant provides apple-breeding and growing programs from which it produces the Goods.

The Cited Mark may have several meanings and impart several commercial impressions in the context of the Asian food market in which the owner of the Cited Mark operates. The most likely meaning and commercial impression is that the Cited Mark refers to and calls to mind the traditions and history of the mythical dragon creature that is common to the cultures and histories of various East Asian countries. Indeed, the attached screenshots from the website

associated with the Cited Mark support such a conclusion. In stark contrast, Applicant selected and coined the name SNAPDRAGON as a source identifier for the products from its apple-breeding and growing programs. Consumers have come to associate the mark as a source identifier for Applicant's Goods, and have found the crispy texture and spicy-sweet flavor of the Applicant's apples to be very appealing.

When considered in their entireties as required, it is apparent that there are important and obvious differences between the Mark and the Cited Mark in meaning and commercial impression. Because of the unique meanings and commercial impressions created by the respective marks, there is no likelihood (i.e., *probability*) of confusion. *See*, *e.g.*, 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:3 (4th ed. 2015) and the cases cited therein ("Likelihood of confusion is synonymous with 'probable' confusion – it is not sufficient if confusion is merely 'possible.'"). Any commonalities between the marks in appearance and sound are not sufficient to conclude otherwise in this case.

b. There is no likelihood of confusion between the Mark and the Cited Mark, because there are differences between Applicant's Class 029 Goods and the goods under the Cited Mark

Applicant has amended its Class 029 Goods in the appropriate section of the Response to Office Action Form as follows: "Cut and canned, bagged, or jarred fruits; ~~Dehydrated fruit snacks~~; Fruit purees; Preserved fruits; Processed fruits, namely, apples" (the "Amended Goods").

Based on Applicant's status as an agricultural and biotechnology research operation that provides apple-breeding and growing programs from which Applicant produces the Goods, Applicant's products are primarily fresh fruit (*see* Class 031 in the application), and fruit that has been marginally processed or preserved by, for example, having been pureed, or peeled, sliced,

and bagged. It is because of this marginal processing that some of Applicant's products fall under Class 029, rather than Class 031. However, fruit that has been processed or preserved in such a minimal way is more akin to "fresh fruit" in Class 031 than it is to other, more traditional processed and preserved fruits and other products that belong in Class 029, such as dehydrated fruit, dehydrated fruit snacks, snack mixes comprising preserved or dehydrated fruits and nuts, or processed and prepared nuts. Indeed, in the context of grocery or other food stores, Applicant's Amended Goods would likely reside in store sections that include fresh fruit and not in store sections that house prepared nuts or other dehydrated fruit products. Moreover, with respect to prepared nuts specifically as covered by the Cited Mark, consumers seeking prepared nuts are unlikely to encounter the Amended Goods, and vice versa. Accordingly, the nature of Applicant's Amended Goods is quite different from the nature of the prepared nuts under the Cited Mark such that likelihood of confusion is unlikely.

Because the Amended Goods are akin to fresh fruit, if there is no likelihood of confusion as to the prepared nuts in Class 029 of the Cited Mark and Applicant's fresh fruit in Class 031, Applicant submits that there also is no likelihood of confusion with respect to the Amended Goods. The mere fact that Applicant's Amended Goods are in the same class as prepared nuts because of minor preservation or processing techniques is not sufficient to conclude otherwise.

Finally, because of Applicant's status as, in relevant part, an apple-breeder/grower, consumers will appreciate that the Amended Goods are akin to fresh fruit, as opposed to more traditional processed snack foods, such as prepared nuts. Consumers will also understand that the Applicant, and the owner of the cited mark, who is an Asian food producer, operate in completely different industries, and are therefore very different sources. This, combined with the

differences in the goods at issue, establishes that it is unlikely that there will be any confusion as to the source of the goods offered under the Mark and the Cited Mark.

c. There is no possible confusion between Applicant's Mark and the marks in the Referenced Applications

Here, although the marks in the Referenced Applications and the Mark all contain the term SNAPDRAGON (or SNAP DRAGON), that is where any similarities end. Indeed, each of the marks in the Referenced Applications contain several elements that are wholly absent from the Mark. These elements include HOME GARDEN, .COM, and the significant design of a dragon's head. Accordingly, based on presentation alone, the marks in the Referenced Applications and the Mark are, in their entireties, very different in appearance and sound.

What is more is that, by inclusion of the terms HOME, GARDEN, and .COM, the marks in the Referenced Applications very clearly mean and convey to consumers that the owner provides services in the field of home and garden supplies, in particular over the Internet. Such a meaning and commercial impression is completely absent from Applicant's Mark.

In addition, the "on-line retail store services in the field of home, lawn and garden products and supplies" under the Referenced Applications are not similar to any of Applicant's Goods. Even assuming *arguendo* that there are any similarities, the differences in the entireties of the marks with respect to appearance, sound, meaning, and commercial impression outweigh any such similarities.

Accordingly, Applicant respectfully submits that there can be no possibility (i.e., probability) of confusion as to the source of the goods and services offered under the Mark and the marks in the Referenced Applications.

II. Applicant's Mark is not a varietal or cultivar name

Applicant coined and selected the Mark SNAPDRAGON as a source identifier for its Goods. The name SNAPDRAGON has never been used as a varietal or cultivar name for the Goods. In addition, Applicant has not used the SNAPDRAGON name in connection with any plant patent, utility patent, or certificate for plant-variety protection. As evidence of the foregoing, Applicant respectfully notes that it owns a federal trademark registration on the Principal Register of the USPTO for the mark SNAPDRAGON (Reg. No. 4667913) for "Fresh fruit" in Class 031.

Conclusion

For all of the foregoing reasons, arguments, authorities, and evidence, Applicant respectfully requests the Examiner to withdraw the refusals of record, to withdraw the potential confusion issue, and to approve the application for publication.

Respectfully submitted,

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