

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. : 85412053
FILING DATE : August 31, 2011
MARK : EAT MORE KALE
APPLICANT : Robert Muller-Moore
EXAMINING ATTORNEY : Andrew D. Lawrence, Managing Attorney
Law Office 108

RESPONSE TO OFFICE ACTION

Applicant supplies this response to the Office Action issued by the Examining Attorney on March 7, 2013. For the reasons stated below, Applicant respectfully requests that the mark be approved for publication.

Amendments

Applicant amends his application to confirm ownership or control of the following website: eatmorekale.com. Applicant further states that he provides content to this website and that Applicant's website is used for the sale and promotion of the goods claimed under 1A in this Application and for other services related to Applicant's business. Applicant provides this statement in the appropriate location within the electronic form.

Applicant amends his application to provide three additional specimens for both International Class 16 and International Class 25 for the goods in use-based status only. Applicant is not withdrawing the existing specimen for IC 16 or IC25. The additional specimens are attached in the appropriate location in the online form and are labeled in this Response as Exhibits A, B, and C and comprise the following:

- Exhibit A: Photograph of package insert for merchandise sold, signed by Applicant as the "Eat More Kale" guy and additional brand references;
- Exhibit B-1, B-2, B-3, and B-4: Three screenshots to represent a single webpage on Applicant's eatmorekale.com website, available when one clicks "Buy Shirts," and a fourth screenshot (Exhibit B-4) of the photo collage linked from the Buy Shirts webpage when one clicks on the link "click here for photo."
- Exhibit C: Applicant's order form for use when customers mail in an order for EAT MORE KALE brand goods from Applicant.

Applicant amends his application to provide two additional specimens for International Class 40. Applicant is not withdrawing the existing specimen for IC40. The additional

specimens are attached in the appropriate location in the online form and consist of Exhibits B and C, further described above.

Applicant declares that the additional specimens (Exhibits A, B, and C) were in use in commerce at least as early as the filing date of the Application. The declaration signature of Applicant may be found in the appropriate location on the electronic form and in the signature pages of this Response.

Remarks

In the March 7, 2013 Office Action, the Examining Attorney identified four issues, briefly summarized as claiming website ownership, IC40 specimen, ornamentation (IC 16 and 25), and likelihood of confusion (IC 25 and 40). Applicant responds in brief as follows, with further remarks, *infra*.

1. Applicant claims ownership of eatmorekale.com, satisfying the Examiner's information requirement.
2. Applicant submits an additional specimen for IC 40. The specimen demonstrates that consumers make selections in ordering an imprinting of a t-shirt and are invited to "[d]esign [their own] . . . shirt"; consequently, this is a service mark specimen not a mere promotion of t-shirts as articles of goods.
3. EAT MORE KALE is used as a trademark, as further supported by the additional specimens provided for IC 16 and 25. Further, even assuming *arguendo* that use of EAT MORE KALE in connection with the use-based goods in IC 16 and 25 is merely ornamental, the use is as a secondary source to Applicant's other goods and services, both as claimed in this Application and in use under common law. Secondary source applies equally to intent-to-use as well as use-based items.
4. EAT MORE KALE is not likely to be confused with EAT MOR CHIKIN. Applicant refers the Examining Attorney to further discussion below.

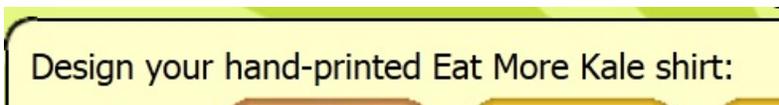
I. Request for Information – eatmorekale.com

Applicant claims ownership of eatmorekale.com as further described in the above amendments, *supra*, in compliance with the Office's request for information.

II. Specimen – IC 40

Applicant amended his Application to submit additional specimens with regard to IC 40. Applicant respectfully submits that the additional specimens pertain to the identification of services for IC 40, which reads as follows: "Imprinting of decorative designs on T-shirts; Screen printing; Silk screen printing." **Exhibit B** of this Response, one of the additional specimens for IC 40, comprises a series of screenshots depicting the "Buy Shirts" webpage at eatmorekale.com, the online order form for male consumers. The website address is "eatmorekale.com" and in the

upper right-hand corner of the screen shot is a very large green circle surrounding the phrase “EAT MORE KALE.com.” The topmost title of the pertinent box on the webpage utilizes the following command sentence: “*Design your* hand-printed Eat More Kale shirt.” (emphasis supplied). Below is how that sentence appears:



Below this invitation to consumers to design their own shirt is a list of options that Applicant offers consumers. This webpage offers choice of cut, meaning selection of shirt style for men, women, children, or infant. The consumer then has the choice of selecting which design they would like on the shirt, meaning which phrase they would like to have on the front of the shirt. This screen shot then shows the option of selecting which style the consumer would prefer, meaning short-sleeve, long-sleeve, hoodie, or pride tie dye. The consumer is then able to choose between three shirt colors, and finally the size of the shirt, ranging from Small to XXX-Large.

The additional specimen found at **Exhibit C** (mail-in order form) duplicates these selection options.

Both the existing IC 40 specimen and the additional specimens filed with this Response demonstrate that Applicant provides a service of imprinting designs for others and silk screen printing (as more explicitly defined in the identification) for others on demand under the mark EAT MORE KALE. In light of the foregoing additional specimens, Applicant respectfully requests that the Examining Attorney withdraw the specimen refusal for IC 40.

III. Ornamentation

A. Ornamentation – Additional Specimens and Evidence for IC 16 and 25 (use-based goods)

Applicant submits additional specimens for IC 16 and 25 in the nature of Applicant’s online order form (**Exhibit B**) and mail-in order form (**Exhibit C**). Both of these specimens show point of sale use of Applicant’s mark with the use-based goods. The TRADEMARK MANUAL OF EXAMINING PROCEDURE describes the qualifications for an electronic point of sale display as follows:

A web page that displays a product can constitute a ‘display associated with the goods’ if it:

- (1) contains a picture or textual description of the identified goods;
- (2) shows the mark in association with the goods; and
- (3) provides a means for ordering the identified goods.

...

The mark must also be displayed on the web page in a manner in which customers will recognize it as a mark.

TMEP 904.03(i) (citations omitted).

Exhibit B depicts both a drawn image of the IC 25 goods and a photo collage of the IC 25 goods linked from that page. **Exhibit C** is linked from **Exhibit B** and it also describes the use-based IC25 goods as well as the use-based IC16 goods. Thus, the specimens contain both pictures of and a textual description of the identified goods.

Use-Based IC 25 Goods depicted/pictured:



MEN'S sizes in S, M, L, XL, XXL, XXXL.
T-SHIRTS available in *organic natural, black & bluespruce green or tie dye.*
LONG SLEEVES available in *dark orange & slate purple.*
HOODIES available in *yam orange & grass green.*

WOMEN'S sizes in XS, S, M, L, XL, XXL.
T-SHIRTS available in *organic natural, black & seafoam green, or tie dye.*
LONG SLEEVES available in *distinct red & lilac.*
HOODIES in *seafoam green & raspberry pink.* NO XS SIZE

CHILDREN'S sizes in XXS, XS, S, M, L.
T-SHIRTS available in *organic natural & kiwi green.*
LONG SLEEVES available in *distinct red & distinct purple.*

INFANT'S 3-6 mo or 6-12mo
ONESIES in *organic natural w/ Eat More Kale design only.*

APRON'S One Size Fits All
THREE POCKETS in *avocado w/ Eat More Kale design only.*

\$45 Hoodie
 \$20 Onesie
 \$35 Apron
 50¢ Sticker

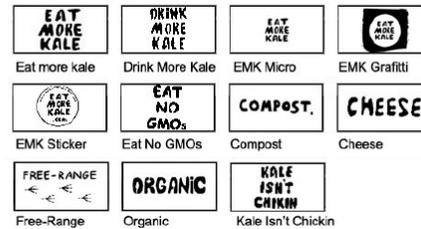
Defiant Dude shirts
 only in *black* and in
men's or women's
 sizes.



Buy 20 shirts in any combination of sizes, designs and colors and pay wholesale prices!!!

\$13 T-Shirt
 \$18 Tie Dye T
 \$14 Long Sleeve
 \$30 Hoodie
 \$11 Onesie

DESIGNS



Use-based IC 16 good (stickers) link and picture/depiction:

Mail-in order form can be found [here](#).





EMK Sticker

Both Exhibits B and C show the mark in association with the use-based goods in IC 16 and 25. Applicant directs the Examining Attorney to the segments of the specimens high-lighted below:

Design your hand-printed Eat More Kale shirt:



Eat More Kale is about supporting small business, business that actually cares and hasn't been swallowed up by the profit-hungry, corporate mentality. For years I was a one man show, so my shirts are distinctive, offbeat, one-of-a-kind works of art. I'm happy now to actually employ a handful of local

Eat More Kale is also about being part of a worldwide movement, a t-shirt revolution. My



Eat More Kale mail-in order form
Cuts, sizes, shirt types and colors

Eat More Kale
24 Vine St
Montpelier VT 05602

Both Exhibits B and C provide a means for ordering the identified goods. Applicant directs the Examining Attorney in particular to the following portions of the additional specimens:

¹ Although “EMK” may not be substantially exact to the EAT MORE KALE mark applied for, the repeated use and omnipresence of EAT MORE KALE on Applicant’s website would render unavoidable the conclusion that EMK refers to EAT MORE KALE in a short-hand manner, thus reinforcing the trademark nature of the use of EAT MORE KALE.



Stickers

| Qty | Price |
|-----|-------|
| | |

Fill out the order form completely. Enclose cash, check or money order and mail to:

Eat More Kale
24 Vine St
Montpelier VT 05602

EAT MORE KALE is displayed on the point of sale displays in a manner in which customers will recognize it as a mark. Applicant directs the Examining Attorney’s attention non-exclusively to portions of the specimen high-lighting this use:

*Eat More Kale ©2011 Bo Muller-Moore. All rights reserved.
Webpage by S.R.Helmick of [Locks Lodge]*



Eat More Kale mail-in order form
Cuts, sizes, shirt types and colors

Design your hand-printed Eat More Kale shirt:

Eat More Kale is also about being part of a worldwide movement, a t-shirt revolution. My

Eat More Kale is about supporting small business, business that actually cares and hasn't been swallowed up by the profit-hungry, corporate mentality. For years I was a one man show, so my shirts are distinctive, offbeat, one-of-a-kind works of art. I'm happy now to actually employ a handful of local



Applicant further submits evidence in the form of a photograph of a t-shirt sold by Applicant in which the EAT MORE KALE mark appears on the front of a t-shirt in small font below a larger “TEAM KALE” screen print in a manner that consumers would view as a source indicator. **Exhibit D** (TEAM KALE t-shirt front).

² See footnote 1, *supra*.

Because the additional specimens qualify as point of sale displays for the use-based goods in IC 16 and IC 25 and the mark is used as an indicator of source, Applicant respectfully requests that the Examiner withdraw the rejection of mere ornamentation.

B. Ornamentation – IC 16 and 25 (intent-to-use based goods)

As for the intent-to-use goods, Applicant respectfully submits that rejection on the basis of mere ornamentation for those goods is premature at this time, and that any rejection of those intent-to-use goods based on mere ornamentation – should it occur – would appropriately be raised following the filing of an amendment to allege use or statement of use. Consequently, Applicant submits that the mere ornamentation rejection be withdrawn (to the extent it was asserted) on the basis of lack of ripeness.

C. Ornamentation – Secondary Source

Assuming, *arguendo*, that the Office is not persuaded by the additional specimens and remarks pertaining to the ornamentation refusal against IC 16 and 25, the Applicant pleads alternatively that its mark, EAT MORE KALE is not merely ornamental because the mark enjoys a secondary source recognition. The EAT MORE KALE mark is used as a trademark in connection with concurrently applied-for services and services in which the mark has protection under the common law.

The TRADEMARK MANUAL OF EXAMINING PROCEDURE provides the following rule for establishing secondary source:

To show secondary source, the applicant may show: (1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under §1 of the Trademark Act; (2) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on a foreign registration under §44(e) or §66(a) of the Trademark Act for which an affidavit or declaration of use in commerce under §8 or §71 has been accepted; (3) non-ornamental use of the mark in commerce on other goods or services; or (4) ownership of a pending use-based application for the same mark, used in a non-ornamental manner, for other goods or services. Ownership of an intent-to-use application for which no allegation of use under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §§1051(c) or (d), has been filed is not sufficient to show secondary source. If the applicant establishes that the proposed mark serves as an identifier of secondary source, the matter is registrable on the Principal Register.

TMEP 1202.03(c).

Applicant here can establish secondary source under both options 3 and 4 in the above passage. The Application at issue contains a service class, IC 40, that is entirely use-based that is not subject to a merely ornamental rejection. On that basis alone, pursuant to TMEP 1202.03(c),

option 4, Applicant establishes secondary source and respectfully requests that the merely ornamental refusal with regard to IC 16 and 25 be withdrawn.

As further remarks toward establishing secondary source, Applicant asserts that it has strong common law rights in the EAT MORE KALE mark. Applicant's EAT MORE KALE mark signifies the service of promoting and educating small businesses, particularly those subject to trademark bullying, providing kale recipes, and promoting sustainable local agriculture. Evidence in support of those promotional and educational services includes the following excerpts from Exhibit B:

Eat More Kale is also about being part of a worldwide movement, a t-shirt revolution. My

Eat More Kale is about supporting small business, business that actually cares and hasn't been swallowed up by the profit-hungry, corporate mentality. For years I was a one man show, so my shirts are distinctive, offbeat, one-of-a-kind works of art. I'm happy now to actually employ a handful of local

I'm also about eating locally, supporting local farmers, bakers, farmers markets, farm stands, CSA's, community gardens and restaurants, sustainable lifestyles, social commentary and community. Most imp

Applicant additionally refers the Examining Attorney to further evidence of those promotional and educational services from Applicant's website as shown in the following exhibits:

- Exhibit E: Donate to the Cause webpage
- Exhibit F: Recipes webpage
- Exhibit G: Eat More Kale in the media!!! webpage

In brief, EAT MORE KALE is a well-known provider of educational and promotional services, and Applicant's apparel and stickers bearing that mark are registerable uses in light of Applicant's other services. The criteria for secondary source set forth in the TMEP does not include a duration of use or strength of the mark requirement. Even if it did, the EAT MORE KALE mark qualifies in light of the common law evidence submitted with this Response. Consequently, Applicant respectfully requests that the merely ornamental rejection be withdrawn in light of the alternatively plead basis of secondary source. Applicant notes that secondary source would apply to both use-based and intent-to-use based goods rejected on the basis of ornamentation and notes that, should the Examiner be persuaded that EAT MORE KALE is of secondary source, that re-examination upon the filing of an amendment to allege use or statement of use on the issue of mere ornamentation would be redundant.

IV. Likelihood of Confusion

As a housekeeping matter, Applicant approaches likelihood of confusion as a rejection against IC 25 and 40 only. Applicant notes the Examining Attorney's statement that this refusal does not pertain to IC 16 and thanks the Examiner for this reminder, Mar. 7, 2013 Off. Act., ¶ 3rd ("As a reminder, registration has not been refused under § 2(d) as to IC 16."), but further notes that Applicant is construing a later statement ("This [likelihood of confusion] refusal of registration applies to IC 16 and 25," Mar. 7, 2013 Off. Act., § A, ¶ 1st) to be an inadvertent error based on the clear import of the remainder of the Office Action. If Applicant's assumption is incorrect, Applicant (a) relies upon the existing arguments herein, and (b) invites the Examiner to clarify any rejection against IC 16.

As another housekeeping matter, Applicant thanks the Examining Attorney for clarification on the scope of the rejection as to both IC 25 and 40. As to the rejection directed toward IC 40, Applicant asserts that the IC 40 rejection logically would fall should the Applicant persuade the Office that there is no likelihood of confusion with regard to IC 25. In addition, Applicant will address IC 40 more particularly, *infra*.

A. "First Word" Rule

Applicant respectfully disagrees with Examining Attorney's finding that EAT MORE KALE and EAT MOR CHIKIN create the same commercial impression because of their mutual use of EAT MOR/EAT MORE. Examining Attorney cites *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772* to support this, impliedly finding that EAT MORE/EAT MOR is the "dominant feature." Off. Act., §A.1., ¶4th ("applicant asserts that the Office's reliance on what it refers to as the 'first word rule' is misplaced here"; "the trademark attorney draws a conclusion different from applicant."). The court in *Palm Bay* determined the disputed mark VEUVE was dominant because its meaning, "widow" is arbitrary when referring to sparkling wine, garnering a stronger commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772* 396 F.3d 1369, 1372-73 (Fed. Cir. 2005). However, unlike the court's finding that VEUVE is arbitrary, EAT MOR/EAT MORE when used as a source identifier on t-shirts lacks the same level of arbitrariness as "widow" for sparkling wine in the relative contexts of a t-shirt in use secondary to a service of the promotion of local agriculture and a t-shirt in use secondary to fast food restaurant services. Applicant traverses the Examiner's reliance on *Palm Bay* in this case and urges reliance instead on cases out of the Court of Appeals for the Federal Circuit having greater analogical value. For example, the court in *Kellogg Co. v. Pack 'em Enters, Inc.* found no likelihood of confusion between FROOTEE ICE for flavored ice bars and FROOT LOOPS for breakfast cereal, reasoning that the "only similarity between the marks is that one begins with the word 'FROOT' and the other with the word 'FROOTEE'." *Kellogg Co. v. Pack 'em Enters, Inc.* 951 F.2d 330, 333 (Fed. Cir. 1991), *see also Keebler Co. v. Murray Bakery Prods. Inc.* 866 F.2d 1386 (Fed. Cir. 1989) (holding PECAN SHORTIES and PECAN SANDIES are sufficiently dissimilar and not likely to cause confusion with PECAN SANDIES for cookies). Even though the first words FROOT/FROOTEE and PECAN were identical or highly similar, the court found no likelihood of confusion in light of the weaker level of distinctiveness for those terms. Correspondingly, a similar analysis of EAT MOR CHIKIN and EAT MORE KALE will yield the same results. The

weaker distinctive position of EAT MOR/EAT MORE in the case at bar is a “rational reason,” *see In re Nat’l Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) (quotation cited in March 7, 2013 Office Action at §A.1., ¶4th), to place greater emphasis on the KALE and CHIKIN parts of the respective marks rather than the EAT MOR and EAT MORE parts of the respective marks.

Gauging the relative weight of first two words against last words of the respective marks logically requires consideration of the level of distinctiveness and similarity or dissimilarity of KALE and CHIKIN. The Examining Attorney has not contested the dictionary definitions of “kale” and “chicken” provided in Applicant’s September 27, 2012 Response to Office Action, Sept. 27, 2012 Resp., Exhs. F and I, nor has the Examining Attorney contested the conclusion that kale and chicken are highly dissimilar, *see id.* at 7 – 8. Rather, the Examining Attorney relies on a three-fold, round-about approach to challenge dissimilarity: first, that the marks bring to mind the “same idea,” second, that there is some similarity in appearance, and third, that the marks need not be highly similar in the context of identical goods. Mar. 7, 2013 Off. Act., §A.1., ¶ 6th, 7th, and 8th. Applicant respectfully traverses each of these round-about approaches on the basis that the “same idea” and “some similarity in appearance” cases cited by the Examiner are distinguishable, these marks do not convey the “same idea” or bear the “same appearance,” and similarity of the goods does not swallow the whole of the remaining *ex parte*-reviewable *DuPont* factors, all of which favor Applicant.

The three “same idea” cases cited by the Examiner -- MISTER STAIN compared against MR. CLEAN, TUNA O’ THE FARM compared against CHICKEN OF THE SEA, and UPTOWNER compared against DOWNTOWNER – are distinguishable. The Examining Attorney first cites *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332 (1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products). The holding is correct, but its application to the situation at bar is not appropriate. Central to that holding was that both MISTER STAIN and MR. CLEAN were being used on cleaning products. When applied to cleaning products, MISTER STAIN took on the opposite meaning of “stain” and changed the commercial impression to “clean.” *Id.* at 1335. The court noted, “it is our view that the commercial impression engendered by the mark when applied to a cleaning product will remove the blemish, spot or stain.” *Id.* This case shows that the relationship of the product with the mark can change the commercial impression of the mark. It would not make sense for someone to buy a cleaning product that made the stain worse. The court added, “If MISTER STAIN were applied to a product for coloring wood prior to finishing, the mark would mean what it says; but where the mark MISTER STAIN is applied to a cleaning product, it obviously does not mean that the product will produce a stain.” *Id.* at 1336. As applied to KALE, the marks are on t-shirt design and printing services, t-shirts, and stickers, and therefore, the product does not change the commercial impression of the mark. Without the good changing the meaning of the mark, the determination should be based on the differences between KALE and CHIKIN. As discussed numerous times herein, as well as in past responses, the differences are vast both as to sight, sound, and meaning, as well as to overall commercial impression.

The Examining Attorney then cites *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O’ THE FARM for canned chicken is likely to be confused with CHICKEN OF THE SEA for canned tuna). In this case, the court found that there was confusion because the CHICKEN OF THE SEA mark was so famous and well established

that TUNA O' THE FARM phrase was a likely area of development for them should they choose to expand into canned chicken. *Id.* at *8. Indeed, because CHICKEN OF THE SEA was so famous, and TUNA O' THE FARM was merely the inverse of that good will, a likely association could be made had CHICKEN OF THE SEA expanded into canned chicken. A central element of this case is the determination of the fame of the registered mark. For an *ex parte* proceeding, the fame of the mark cannot be considered because there is no evidence as to the actual fame. Because EAT MORE KALE is in an *ex parte* proceeding, this case is not relevant. Further, this is similar to *Proctor & Gamble*, discussed above, because the nature of the good changed the meaning of the mark, and that is not the case for EAT MORE KALE.

The Examining Attorney finally cites *Downtown Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services). This case is very factually different from EAT MORE KALE. In this case, UPTOWNER used said mark after previously having been a franchisee of DOWNTOWNER. Further, UPTOWNER used the phrase "Resort Atmosphere--Downtown Convenience," which makes use of part of the DOWNTOWNER mark and establishes that "uptown" and "downtown" are synonymous. EAT MORE KALE has never been a franchisee of EAT MORE CHIKIN, and KALE and CHIKIN are not synonymous.

The Examiner argues that marks can be found to cause likelihood of confusion "on the basis of similar terms or phrases, or similar parts of terms or phrases, appearing in both the applicant's and registrant's mark." Because stating "some similarity in the marks" is sufficient to fully support a finding of a likelihood of confusion would be an egregious oversimplification of the law of likelihood of confusion,³ each of the nine cited cases cited by the Examiner in this regard need be fully analogized to Applicant's mark to be persuasive. Because each of the Examiner's cited cases is distinguishable from the instant case, their persuasive value on the issue of "some similarity in appearance" is very limited. First, multiple of the Examiner's supporting citations refer to *inter partes* proceedings. *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986); *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187 (TTAB 2012); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006); *Columbia Pictures Indus., Inc. v. Miller*, 211 USPQ 816, (TTAB 1981). The *inter partes* proceedings are distinguishable from the instant case because *inter partes* proceedings allow the opposition to present evidence regarding the strength of its mark. In an *ex parte* proceeding, the proceeding is solely for the benefit of the applicant as an adverse party does not exist. BLACK'S LAW DICTIONARY (9th ed. 2009). Second, multiple of the Examiner's cited *inter partes* proceedings concern a famous mark holder opposing a non-famous mark applicant thus allowing for considerable weight to be placed on the scale in favor of a finding of likelihood of confusion for the famous mark holder. *See, e.g., Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187 (TTAB 2012); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006). In the instant case, an *ex parte*

³ If the "some similarity in appearance" cases were not reviewed comprehensively considering all other pertinent factors, it could be construed, for example, to mean that the 341 applications for marks containing CLUE filed after the first application should have been refused, or the 18,577 applications for marks containing SOFT filed after the first application should have been refused, or the 3,251 applications for marks containing EXTREME filed after the first application should have been refused. Office practice of allowing these co-existing marks containing "some similarity in appearance" clearly does not tolerate such a broad rule.

proceeding, an opposing mark holder is not a party to the proceeding and therefore does not deserve an increased chance of finding a likelihood of confusion.

Regarding the Examiner's supporting citations that refer to *ex parte* proceedings, each is distinguishable from the instant case because the differences between the competing marks in the cited proceedings are slight and far less different than the differences between the marks in the instant case. *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (the competing marks are 21 CLUB, a standard character mark used with shirts, and the all but identical stylized mark, THE "21" CLUB, also used with shirts); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (the court held that the mark COLLEGIENNE blocked the mark COLLEGIAN OF CALIFORNIA; however, it should be noted that the applicant disclaimed CALIFORNIA indicating the strength of that term to be only slight. The Court held that the words COLLEGIENNE and COLLEGIAN, words that are almost identical in sight, sound, and meaning, were not sufficiently different to avoid a finding of likelihood of confusion. This similarity is unlike the instant case where neither KALE nor CHIKIN is disclaimed); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (the court held that the essential difference between the marks MILTRON and MILLTRONICS was the applicant's added final syllable ICS and therefore the difference was insufficient to avoid a likelihood of confusion ruling. In the instant case, the differences are not simply the addition of a single syllabled suffix, rather the instant marks contain entirely different words, KALE versus CHIKIN); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (similar to *In re Pellerin*, the court held that the essential difference between the two marks – LUTEXAL and LUTEX -- was the suffix AL. This was insufficiently different to avoid a finding of likelihood of confusion. Again, the differences in the instant case are not a simple addition of a single syllabled suffix, but rather the instant marks contain entirely different words, KALE versus CHIKIN).

Unlike the *ex parte* proceedings cited by the Examiner in which the differences between the marks were minimal in that the applicant's mark was different by only a few letters, or an added single syllabled suffix or prefix to a suggestive or possibly arbitrary mark, in the instant case, the differences between the marks are quite pronounced. KALE neither sounds like, looks like, nor means the same thing as CHIKIN. In addition, in the cited proceedings, the differences in the applied for marks are mere additions or subtractions of letters and are thus distinguishable from the instant case where the difference rests in variant spellings and entirely different multisyllabic words.

B. EAT MORE is Weak

Applicant asserts, in addition to the reasons stated *supra*, that the wording "EAT MORE" is weak, evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Palm* 396 F.3d at 1373. The probative value of third-party trademarks depends on their usage. *Id.* Third-party usage falls under the sixth *du Pont* factor, "the number and nature of similar marks in use on similar goods." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Evidence of third-party use of "EAT MORE" and its phonetic equivalents/derivatives are found in registered trademarks in the federal register, including registrant's primary market, the restaurant industry.

EAT MO' BETTAH, Registration No. 3816273, is a live registered trademark on the Principal Register with goods and services in the restaurant industry. **Exhibit H** (EAT MO' BETTAH TESS page). EAT MO' is the phonetic equivalent to EAT MORE, used as a source identifier for a restaurant in New Orleans. The mark was published for opposition in April 2010, and subsequently awarded registration in July 2010. Although EAT MO' BETTAH does not have t-shirts listed in its goods and services, it nonetheless is a registered mark with goods and services matching registrant's registered mark EAT MOR CHIKIN, registration number 2240326, with goods and services also in restaurant services. Correspondingly, this evidences the USPTO's disposition to allow co-existing marks with the same or similar goods and services. Additionally, registrant for the EAT MO' BETTAH mark, although he does not have a registered trademark for t-shirts, also sells t-shirts with his registered mark EAT MO' BETTAH across the front; *see Exhibits I-1, I-2, I-3, and I-4* (EAT MO' BETTAH t-shirt sales).

In addition to EAT MO' BETTAH's registration, the following live registered marks also use EAT and/or MORE in their marks:

- | | | |
|--------------------|-----------------------------|------------------|
| 1. EATMORE | Registration number 4221704 | Exhibit J |
| 2. EAT SCALLOPS | Registration number 3403617 | Exhibit K |
| 3. EAT MORE VERBS! | Registration number 3277912 | Exhibit L |

Applicant further submits that third-party usage need not necessarily be proved to be trademark usage nor sourced from a U.S. location to be of some weight in analyzing this factor. This *DuPont* factor is directed toward consumer numbering to EAT MORE used in connection with t-shirts. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004); *see also* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, s. 23.48 (4th ed. 2012). It defies logic that well over a dozen – possibly over a hundred -- “Eat More” t-shirt options may exist, all available on the U.S.-accessible Internet and in English, all with those words on the t-shirt front, just as with registrant and Applicant, and that cumulative evidence cannot be given some weight on strength of the EAT MORE component of registrant's mark. Thus, Applicant respectfully traverses the Examining Attorney's challenge to his evidence and asserts that every example of “EAT MORE” in connection with t-shirts and printing services, *see* Applicant's Sept. 27, 2012 Resp., Exhs. K and L, is relevant, particularly in its cumulative state and particularly where t-shirts and imprinting services are concerned. This evidence clearly demonstrates a significant weakness in the EAT MORE/EAT MOR portions of the respective marks. The Examining Attorney argues that in this *ex parte* examination there is no adversary to contravene Applicant's assertions as to third-party usage unless that use is by a live, registered mark. *See* Mar. 7, 2012 Off. Act., A.2., 2nd para. (assuming Applicant correctly understands the scope of the Examiner's concern). Although this point is appreciated, Applicant submits that this volume of evidence, taken without considering whether the use is trademark usage, cumulatively, should be allowed some weight in considering this factor.

C. The conditions under which and buyers to whom sale are made, i.e. “impulse” vs. careful, sophisticated purchasing, are significantly different.

Applicant respectfully traverses the Examining Attorney's assertion that “in the end” the common articles of clothing aspect of the goods renders the consumers to lack heightened

sophistication. In this instance of a legal conflict involving political speech, consumers are sophisticated. Similar to *Int'l Assoc. of Machinists and Aerospace Workers, AFL-CIO v. Winship Green Nursing Center*, 41 USPQ2d 1251, 1258-59, 103 F.3d 196, 206-07 (1st Cir. 1996) (cited in Applicant's Sept. 27, 2012 Resp. at 11), a politically charged, contested atmosphere exists around registrant and Applicant, as evidenced by a number of Applicant's exhibits and acknowledged by the Examiner, see Mar. 7, 2012 Off. Act., n. 10. Applicant sees no reason why the news articles in evidence (including Exhibit G to this Response) cannot be relied upon in establishing consumer education on the respective marks, nor has the Examiner provided a reasoned argument to disregard this evidence. Furthermore, Examiner's "in the end" consumer sophistication position appears to apply only to t-shirts, and not to the imprinting services at issue in the Application.

Applicant further disagrees with the Examiner's allegation that Applicant's "Kale Isn't Chikin" and "Free Range" t-shirts inflame confusion. Applicant notes that "isn't" is a negative term, distancing registrant's and applicant's goods and services. Applicant further refers the Office to Applicant's Sept. 27, 2012 Response at 11 in which Applicant explains that registrant's chicken reference is without regard to source of the meat, contrary to the local, free range notions espoused by Applicant.

D. The parties' goods have different trade channels

The salient question for this *DuPont* factor is whether there is a likelihood of confusion that the relevant purchasing public will be misled to believe that the goods and/or services offered under the involved marks originate from a common source because of the similar trade channels. To assert that the marks have identical trade channels because both can be ordered via the Internet is an outdated view of the Internet. Although this argument may be better placed before the Board for the reasons and cases cited in the Examiner's Office Action, Applicant argues that present day Internet technology creates more silos between Internet sites than, for example, different types of stores or methods of sales. As happens with the development of the common law, technology typically outpaces the law. Merely to illustrate this point, Applicant describes Internet search surrounding registrant's and Applicant's goods and services. Doing a Google search for "EAT MOR CHIKIN" does not bring up "EAT MORE KALE" unless it is an article talking about the present legal conflict. Similarly, a Google search for "EAT MORE KALE" does not bring up "EAT MOR CHIKIN" except in news articles or blogs discussing the present litigation. When locating each mark on the Internet, there is no confusion when searching for them. It also seems that the only way to find them on the Internet would be to specifically search for them on a search engine. For these reasons, Applicant preserves its argument on channels of trade.

Despite the presumption of all trade channels described in the Office Action, Applicant reiterates its secondary source reasoning. In essence, if front-of-t-shirt marks gain registration/overcome a merely ornamental rejection and there is a secondary source, it is likely that the original source of services controls the trade channels, and, moreover, evidence demonstrates that this is a reasonable conclusion for restaurant-name t-shirts. Applicant urges the Office to review the entirety of Applicant's evidence on trade channels; in contravention to what may have been suggested, Applicant's trade channels do include farmers markets and like

small venues. Even if this assertion is more properly before the Board in a different proceeding, Applicant preserves its argument that a small degree of Internet cross-over is unlikely to cause confusion and that secondary source registrations may be interpreted to contain a limitation, even if the registration certificate limitations list has not yet evolved to include this limitation.

Because of the specificity required in locating the marks on the internet and the very different channels of trade the two marks are found not on the internet, the significantly different trade channels support a finding that the relevant purchasing public will not be misled to believe that the goods and/or services offered originate from a common source.

F. Co-existence of the marks at issue without actual confusion

For the reasons already asserted, the Applicant reiterates the argument that the substantial period of coexistence, and the fame of the Applicant's mark suggest that there is no likelihood of confusion. To accept the position that a cease and desist letter automatically overcomes a co-existence argument would encourage overzealous trademark bullying, and would ignore the significant time that lapsed between Applicant's date of first use and registrant's letter of protest. The Office may counter that that debate is best held in an *inter partes* case, but Applicant will be deprived of that opportunity in the absence of the Mark being approved for publication. Thus, Applicant pleads that the Examiner consider this evidence of substantial co-existence for many years in the likelihood of confusion analysis so that the Mark may be published, particularly where a letter of protest was filed by registrant and said letter included no evidence of any actual confusion during co-existence.

G. Other Matters

The Office extends its likelihood of confusion rejection to the "related" service of imprinting in IC 40 in light of the EAT MOR CHIKIN t-shirt registration. First, should the likelihood of confusion rejection be withdrawn for IC 25, the rejection for IC 40 should logically fall as well. Second, the registrant's goods and Applicant's applied-for imprinting services are not sufficiently related. In this case, Applicant's imprinting services are unrelated to registrant's apparel goods, because EAT MOR CHIKIN is a secondary source to a restaurant. Restaurants are unlikely to imprint t-shirts on demand for others, and the Examiner has not provided any evidence that such a connection is likely nor any case citation that such a relation is to be presumed. Further, the cases cited involve identical or nearly identical marks (BIGG'S and BIGGS; 21 CLUB and THE "21" CLUB; CAREER IMAGE and CREST CAREER IMAGES; STEELCARE INC. and STEELCASE). The *DuPont* factors are balanced; in the present case, the balancing of the factors simply does not equate to that found in the cases cited.

Conclusion

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw the rejections and requirements and approve the mark for publication.