

This Disposition is not
Citable as precedent of the TTAB

Jan. 11,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Good Earth Corporation

v.

Donald C. Volk

Opposition No. 99,081
to application Serial No. 74/455,769
filed on November 9, 1993

Rodney F. Page, Peter S. Reichertz, Anthony V. Lupo of Arent
Fox Kintner Plotkin & Kahn for The Good Earth Corporation.

Brian J. Hundertmark of Roberts & Hundertmark for Donald C.
Volk.

Before Sams, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Good Earth Corporation has opposed the application
of Donald C. Volk to register EARTHBURGER for "vegetable
protein food product in the nature of a hamburger
alternative."¹

¹ Application Serial No. 74/455,769, filed November 9, 1993,
based on an asserted bona fide intent to use the mark in
commerce.

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As grounds for opposition, opposer has alleged that since 1968 it and its predecessors-in-interest have used the trademark PLANET BURGER in association with a vegetarian sandwich consisting primarily of vegetables, nuts, seeds, beans, and spices; that opposer is the owner of the trademark application Serial No. 74/565,141 and the ensuing registration for the mark PLANET BURGER for goods in class 30;² that since 1987 opposer and its predecessors-in-interest have used the trademark GOOD EARTH BURGER in association with a hamburger sold in its licensee's restaurants; that since 1994 opposer has used the trademark EARTH BURGER in association with a hamburger sold in one of its licensee's restaurants;³ and that applicant's applied-for mark EARTHBURGER, if used for applicant's identified goods, is likely to cause confusion or mistake or to deceive.

Applicant has denied the essential allegations of the notice of opposition.

² Registration No. 2,031,412, registered on January 21, 1997, was not pleaded in the original or the amended notice of opposition. However, the underlying application Serial No. 74/565,141, which was filed on August 24, 1994, was asserted in the pleadings. Applicant itself made this application of record, and conceded opposer's ownership of the registration in its brief. Therefore, the pleadings are deemed amended to include Registration No. 2,031,412.

³ In its brief, opposer asserted for the first time that it owned registrations for various GOOD EARTH marks for restaurant services and certain food items. They were never pleaded nor were the registrations made of record, nor do we find that the issue of likelihood of confusion with regard to these registrations was tried.

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The record includes the pleadings; the file of the opposed application; and the testimony, with exhibits, of opposer's witness Louise Veninga. In addition, opposer has made of record by notice of reliance copies of applicant's answers to interrogatories nos. 1, 4, 7, and 15 of opposer's first set of interrogatories; and a copy of the dictionary definition of the word EARTH from Webster's New Riverside University Dictionary (1994). Also, applicant has made of record by notice of reliance opposer's answers to interrogatories nos. 5 and 6 of applicant's first set of interrogatories and opposer's answer to interrogatory no. 7 of applicant's second set of interrogatories.

Applicant also submitted, under a notice of reliance, opposer's responses to document requests nos. 1 and 7 of applicant's first set of requests for production of documents, which consist of copies of the contents of the filewrapper for opposer's application Serial No. 74/565,141 and a commercial search report for the mark PLANET BURGER. Documents produced in response to a request for production may not be made of record pursuant to a notice of reliance unless they are otherwise admissible under the provisions of Rule 2.122(e). See 37 CFR §2.120(j)(ii). However, because opposer has treated the materials as of record (and because the filewrapper is in any event admissible as an official

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record under Rule 2.122(e)), the Board deems them to have been stipulated into the record.

The parties have fully briefed the case; an oral hearing was not requested.

The record shows that from the late 1960's to 1994 opposer's predecessor-in-interest operated, through franchisees, restaurants under the mark THE GOOD EARTH. In 1994, opposer purchased that business and now licenses use of its trademarks in connection with restaurants and menu items in several states, including California, Arizona and Nevada. Among the marks licensed by opposer are PLANET BURGER for use in connection with a vegetarian sandwich sold in its licensees' restaurants and GOOD EARTH BURGER and EARTH BURGER for use in connection with hamburger sandwiches offered in a restaurant operated by one of its licensees. Opposer and its predecessor-in-interest have used the mark PLANET BURGER since 1968, the mark GOOD EARTH BURGER since 1987 and the mark EARTH BURGER since 1994. Opposer's licensees advertise their restaurants and menu items in local newspapers, such as the *Report* in Ontario-Upland, California and the *Progress Bulletin* in Pomona, California.

The record shows that applicant is located in Ohio and has applied for registration of the mark EARTHBURGER for use in connection with a vegetarian sandwich. Applicant has not furnished any evidence regarding its business or activities

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under the mark, which we note has been applied for under the provisions of Section 1(b) of the Act. However, applicant indicated in its response to interrogatory no. 1 that it intends to use the mark in "retail restaurant locations open to the general public."

We will discuss the question of likelihood of confusion with respect to each pleaded mark separately.

First, with regard to opposer's mark EARTH BURGER, we note that opposer does not have a registration for this mark. Accordingly, opposer must establish, in order to succeed on a claim of likelihood of confusion, priority of use. In that regard, opposer has not shown use prior to applicant's filing date of November 9, 1993. The filing date of applicant's intent-to-use application serves as applicant's constructive use date. Therefore, applicant's application is superior in right to opposer's use which occurred subsequent to applicant's filing date. **Zirco Corp. v. American Telephone and Telegraph Co.**, 21 USPQ2d 1542 (TTAB 1991). Because opposer has failed to establish priority of use, it cannot prevail, and we need not reach the question of likelihood of confusion concerning opposer's mark EARTH BURGER.

Turning now to opposer's claims regarding its mark PLANET BURGER, priority is not in issue in view of opposer's registration for the mark PLANET BURGER for a "vegetarian

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sandwich consisting primarily of vegetables, nuts, seeds, beans, and spices." Moreover, the evidence shows that opposer has used its PLANET BURGER mark in connection with a vegetarian sandwich since prior to November 9, 1993, the filing date of applicant's intent-to-use application which, because applicant has not furnished any evidence of use of its mark, is the earliest date on which it is entitled to rely.⁴

With respect to the issue of likelihood of confusion between PLANET BURGER and EARTHBURGER, there is no question that the vegetable protein hamburger alternative identified in applicant's application must be deemed to be closely related to opposer's vegetarian sandwich consisting primarily of vegetables, nuts, seeds, beans, and spices. In fact, the record shows that opposer's sandwich is a vegetarian hamburger sandwich. Obviously, applicant's hamburger alternative could be served as a sandwich. In this regard we note that applicant's original identification of goods in its application was for a "vegetarian burger."

Further, as these goods are identified in their respective application and registration, they are not

⁴ We reject applicant's argument that opposer has not shown continuous use. Aside from the fact that opposer has a registration for the mark, the proper question is whether opposer has previously used its mark and not abandoned it. See **West Florida Seafood Inc. v. Jet Restaurants Inc.**, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Applicant neither pleaded that opposer had abandoned its PLANET BURGER marks nor was this issue tried.

limited as to channels of trade. See **Glamorene Products Corp. v. Procter & Gamble Co.**, 538 F.2d 894, 190 USPQ 543 (CCPA 1976). Therefore, although applicant argues that the sandwiches would be sold only in the parties' respective restaurants, and that as a result confusion would not be likely to result, in determining the question of likelihood of confusion, we must deem the goods to travel in all normal channels of trade. This would include supermarkets and other food stores, where the goods might well be displayed in close proximity to each other. See **CBS, Inc. v. Morrow**, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Moreover, because both opposer's and applicant's goods are similar vegetarian products, they are likely to be purchased by the same class of consumers.

As for the marks, they are similar in construction and connotation. Each contains the identical word "BURGER," preceded by terms that have a similar connotation in the context of their goods, i.e., the word PLANET as used in opposer's mark connotes the earth. Accordingly, PLANET BURGER and EARTHBURGER, taken as a whole, convey similar commercial impressions.

Applicant argues that the word EARTH has another meaning outside of the planetary meaning, namely, soil. However, we are not persuaded that, as used for a food item, consumers would view EARTHBURGER as a soil burger.

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On the contrary, both PLANET and EARTH, used in connection with vegetarian burgers, present a commercial impression of being "green," that is, environmentally pure and healthful for the consumer. This commercial impression stands in contrast to the handful of third-party registrations for "PLANET" marks appearing in opposer's search report where the term PLANET is used in connection with restaurant services or food items that do not fall into the category of "health food."

In view of the similarity of the goods, the marks, the channels of trade and the consumers, we find a likelihood of confusion between the marks PLANET BURGER and EARTHBURGER.

This brings us to a consideration of whether applicant's use of EARTHBURGER is likely to cause confusion with opposer's use of GOOD EARTH BURGER. Opposer does not have a registration for this mark and, therefore, must rely on its common law rights. The evidence shows that opposer has used its GOOD EARTH BURGER mark in connection with a hamburger sandwich since 1987. Opposer's use precedes the November 9, 1993, filing date of applicant's intent-to-use application; therefore, opposer has established priority of use.

GOOD EARTH BURGER is used by opposer as the name of a menu item in opposer's GOOD EARTH restaurants. While the goods are related, in that opposer's product is a hamburger

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sandwich and applicant's vegetarian hamburger alternative may also be used for a sandwich, there are also clear differences in the goods. Specifically, opposer uses its mark for a meat sandwich, while applicant's is vegetarian.

In addition, the parties' products will not be sold in the same places. Opposer's GOOD EARTH BURGER hamburger sandwich is sold only in its licensees' restaurants. As noted above, opposer's rights derive only from its common law use and, therefore, its channels of trade are limited to its own GOOD EARTH restaurants. Although applicant's channels of trade have not been restricted, opposer cannot assert that it will sell applicant's vegetarian burger in opposer's restaurants. Opposer cannot prevail on a claim of likelihood of confusion by deliberately causing confusion by its own actions.

Nor do we believe that confusion is likely if applicant were to sell its vegetarian burger in supermarkets. Unlike the case with opposer's PLANET BURGER registration, opposer's channel of trade is limited to its own restaurants; we cannot presume close proximity of use in supermarkets. Further, because of the differences in the goods and the marks, consumers who encounter EARTHBURGER vegetarian burgers in a supermarket are unlikely to think they emanate from the same source as GOOD EARTH BURGER hamburger sandwiches sold in GOOD EARTH restaurants.

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With respect to the marks, while they share the elements EARTH and BURGER, the mark GOOD EARTH BURGER used in connection with a traditional meat hamburger does not carry the "green" connotation that is imbued in applicant's mark EARTHBURGER used in connection with a vegetarian burger. This dissimilarity in connotation of opposer's mark GOOD EARTH BURGER along with the additional element "GOOD" presents a different commercial impression from applicant's mark EARTHBURGER.

In reaching this conclusion, we have considered opposer's argument that its mark GOOD EARTH BURGER is well known and thus should receive broad protection. In support of this argument opposer has submitted two advertisements from local papers displaying the mark GOOD EARTH BURGER in connection with opposer's menu items; one article in the Pomona, California *Progress-Bulletin* mentioning opposer's mark GOOD EARTH BURGER; and the statement by opposer's secretary/treasurer and vice president, Louise Veninga, that the majority of opposer's licensees' restaurants have the mark GOOD EARTH BURGER on their menus, and that approximately 2000 people frequent the restaurants daily. Opposer did not provide any evidence as to sales or advertising for GOOD EARTH BURGER hamburger sandwiches. Based on the evidence of record, we cannot find that opposer

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has established that the mark GOOD EARTH BURGER is well known.

Opposer has also argued that applicant, by adopting the mark EARTHBURGER, intended to trade upon opposer's goodwill. In support thereof, opposer has asserted that its mark is well known. As discussed above, opposer has not established that its mark is well known. Moreover, there is no evidence that applicant was even aware of opposer's use of GOOD EARTH BURGER. In this connection, we note that applicant is located in Ohio while opposer has had restaurants in California, Nevada, Arizona, Oregon and Florida.

Accordingly, opposer has failed to prove likelihood of confusion with respect to its mark GOOD EARTH BURGER.

Decision: The opposition is sustained on the basis that applicant's mark EARTHBURGER is likely to cause confusion with opposer's mark PLANET BURGER.

J. D. Sams

E. J. Seeherman

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board