To:	Ashley D. Johnson(ajohnson@dogwood-law.com)
Subject:	U.S. Trademark Application Serial No. 90780582 - NURTURED NEST - 480/2 TM
Sent:	July 05, 2022 05:06:43 PM EDT
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Attachments

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 90780582

Mark: NURTURED NEST

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Applicant: THE NURTURED NEST, INC.

Reference/Docket No. 480/2 TM

Correspondence Email Address: ajohnson@dogwood-law.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: July 05, 2022

This Office Action is in response to applicant's Response to Office Action, dated May 26, 2022.

In a previous Office action dated March 14, 2022, the following issues were outstanding with this application:

1. Section 2(d) Refusal – Likelihood of Confusion
2. Identification of Services Indefinite and Overly Broad – Amendment Required
3. Clarification of The Number of Classes For Which Registration Is Sought Required
4. Advisory – Multiple Class Application Requirements for Applications Based On Section 1(a)
5. Representative Specimens Required

In the Response, applicant:

- Provided arguments against the Section 2(d) Refusal;
- Provided an additional specimen; and
- Amended the Identification of Services.

The examining attorney has reviewed the applicants response and determined the following:

1. Applicant's arguments against the Section 2(d) Refusal are not persuasive and the Section 2(d) Refusal – Likelihood of Confusion is ***maintained and CONTINUED***;
2. The assigned trademark examining attorney inadvertently omitted a requirement relevant to the mark in the subject application. *See* TMEP §§706, 711.02. Specifically, there is still indefinite wording in the identification of services that was not raised in the previous office action. The details are set forth below. The trademark examining attorney apologizes for any inconvenience caused by the delay in raising this issue. Accordingly, the Clarification of Number of Classes Requirement is ***satisfied*** and the Amended Identification Requirement is ***maintained and CONTINUED***; and
3. Applicant's additional specimen is accepted and made of record. Accordingly, the Representative Specimens Requirement is ***satisfied***.

Applicant must respond to all issues raised in this Office action and the previous March 14, 2022, Office action, within six (6) months of the date of issuance of this Office action. 37 C.F.R. §2.62(a); *see* TMEP §711.02. If applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

SUMMARY OF ISSUES:
- Section 2(d) Refusal - Likelihood of Confusion
- **NEW ISSUE:** Identification of Services Indefinite - Amendment Required

SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 6564039. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the previously attached registration.

Applicant has applied to register the mark **NURTURED NEST** for use in connection with "*Education services, namely, providing classes, online classes, seminars, workshops and non-downloadable webinars in the fields of labor, childbirth, breastfeeding, infant sleep, postpartum, grandparenting, infant safety, infant feeding, introducing technology to toddlers and children, new dads, child safety, pelvic floor education, dogs and children, childhood behaviors, feeding children, family meal planning, guidance and tips for children ages 0-18; Educational programs, namely, pre-schools; Providing classroom instruction at the preschool level using hands on, sensory, scripted, artistic, game-based, play-based, or auditory principles*" in Class 41.

The registered mark is **NURTURED NESTS** for use in connection with "*Providing a website featuring information regarding healthy living and lifestyle wellness*" in Class 44.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Here, applicant's mark, **NURTURED NEST**, is confusingly similar to the registered mark, **NURTURED NESTS**. In particular, the marks share the identical terms NURTURED and NEST. Accordingly, because of this shared wording, the marks convey the same commercial impression of raising or educating in a home. *See the previously attached definitions of nurtured and nest from the American Heritage Dictionary*.

The fact that the term NEST is in plural form in the registered mark does not diminish the confusing similarity of the marks for purposes of Section 2(d). An applied-for mark that is the singular or plural form of a registered mark is essentially identical in sound, appearance, meaning, and commercial impression, and thus the marks are confusingly similar. *Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding "it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar"); *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding the singular and plural forms of SHAPE to be essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341

(C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark). In this case, the term in applicant's mark, NEST, is the singular form of the term in registrant's mark, NESTS. The terms are essentially identical and create an overall similar commercial impression of a home.

Preliminary Response to Applicant's Arguments

Applicant asserts that the marks are sufficiently different in visual appearance and pronunciation because the term NEST in registrant's mark is in the plural form. Further applicant argues that the marks convey different commercial impressions. Specifically, that applicant's mark creates the commercial impression of providing educational materials to families on parenting from experts in the field and the registered mark creates the commercial impression of a bird's nest, which birds use to lay eggs and shelter their young.

The Trademark Trial and Appeal Board has held that an applied-for mark that is the singular or plural form of a registered mark is essentially identical in sound, appearance, meaning, and commercial impression, and thus the marks are confusingly similar. Applicant has not provided any evidence to support its contention that the letter S at the end of the word NEST changes the word such that it creates a different commercial impression. In this case, the nature of applicant's and registrant's services do not change the commercial impression of the words in the marks. As the previously attached evidence establishes, the marks convey the same commercial impression of a home that is nourished or cultivated. Accordingly, applicant's arguments are unpersuasive to overcome the refusal.

Ultimately, when purchasers call for the services of applicant and registrant using **NURTURED NEST** and **NURTURED NESTS**, they are likely to be confused as to the sources of those services by the similarities between the marks. **Thus, the marks are confusingly similar**.

Relatedness of the Services

The services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

Here, applicant's Class 41, "*Education services, namely, providing classes, online classes, seminars, workshops, webinars in the fields of labor, childbirth, breastfeeding, infant sleep, postpartum, grandparenting, infant safety, infant feeding, introducing technology to toddlers and children, new dads, child safety, pelvic floor education, dogs and children, childhood behaviors, feeding children, family meal planning, guidance and tips for children ages 0-18; Educational programs, namely, pre-schools; Providing classroom instruction at the preschool level using virtual and online principles,*" are closely related to registrant's Class 44, "*Providing a website featuring information regarding healthy living and lifestyle wellness.*"

The previously attached Internet evidence, consisting of webpages from AFHK, Be Strong Families, Family Paths, Happy Baby, Walnut Montessori, Childtime Learning Center and Everbrook Academy, establishes that the same entity commonly provides the relevant services and markets the services under the same mark. Thus, applicant's and registrants services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Preliminary Response to Applicant's Arguments

Applicant asserts that applicant's and registrant's services are significantly different. Specifically, applicant argues that registrant's services consist of a website featuring ways to create an environmentally friendly living space. Additionally, applicant asserts that the different classes are indicative of the difference in the services themselves and that there are numerous registered marks used with services in both Classes 41 and 44 that differ by only the final letter "S". Applicant also contends that the sophistication of applicant's and registrant's consumers reduces the likelihood of confusion.

First, determining a likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. Additionally, the fact that virtually identical marks coexist on the register in both Classes 41 and 44 for predominantly different services is not probative. In this case, the registration uses broad wording to describe providing information regarding healthy living and lifestyle wellness which encompasses the various subject matters of applicant's educational services, e.g., labor, childbirth, breastfeeding, feeding children, family meal planning, etc. Further, the evidence of record establishes that applicant's and registrant's services are often offered by the same entity under the same mark. Moreover, the fact that purchasers may be sophisticated in a particular field does not mean they are immune from source confusion. Accordingly, applicant's arguments are unpersuasive to overcome the refusal.

When purchasers encounter the educational services and information about healthy living services of applicant and registrant, they are likely to be confused as to the source of the services by the commercial relationship between them in the marketplace. **Thus, the services are closely related**.

Therefore, because the marks are confusingly similar, and the services are closely related, purchasers encountering these services are likely to believe, mistakenly, that they emanate from a common source. Accordingly, there is a likelihood of confusion and registration is refused pursuant to Section 2(d) of the Trademark Act.

Response to Section 2(d) – Likelihood of Confusion Refusal

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

REQUIREMENT

If applicant responds to the refusal, applicant must also respond to the requirement set forth below.

IDENTIFICATION OF SERVICES INDEFINITE - AMENDMENT REQUIRED

The wording “postpartum", "new dads", "dogs and children", "grandparenting", and "childhood behaviors” in the identification of services is indefinite and must be clarified because the subject matter of the educational services is not clear. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Therefore, applicant must amend this wording to clearly state the nature of the services, e.g., Education services, namely, providing classes, online classes, seminars, workshops and non-downloadable webinars in the fields of labor, childbirth, breastfeeding, infant sleep, postpartum depression, new baby classes for grandparents, infant safety, infant feeding, introducing technology to toddlers and children, parenting

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