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Via Email and First Class Mail

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Re: *Chocolate Alchemy: A Bean to Bar Primer Book*

Dear Mr. Bivens:

As you are aware, our firm serves as outside intellectual property counsel to Rizzoli International Publications (“Rizzoli”). We have reviewed your January 25, 2018 correspondence to Rizzoli and Kristen Hard concerning your client Chocolate Alchemy, LLC (“Chocolate Alchemy”) and the *Chocolate Alchemy: A Bean to Bar Primer* book (the “Book”). While Rizzoli greatly respects the intellectual rights of third parties, we find Chocolate Alchemy’s trademark claims asserted in your correspondence without merit.

Because Chocolate Alchemy does not own a federal trademark registration in its purported “Chocolate Alchemy” mark, it bears the burden of proving that it has valid common law rights in a distinctive mark. However, the term “Chocolate Alchemy” is merely descriptive when applied to your client’s retail, wholesale and educational services, namely the provision of raw materials for and instructions for and information about making chocolate from scratch. Such descriptiveness is not only readily apparent from the ordinary dictionary definitions of the terms “chocolate” and “alchemy,” but is further supported by third party use of the phrase in ordinary parlance, the USPTO’s disclaimer requirements for third party marks using the terms and the description of services and other content on your client’s website and social media accounts.

Nonetheless, even if your client did possess some rights in its purported “Chocolate Alchemy” mark, consumers are not likely to be confused by Rizzoli’s use of the book title *Chocolate Alchemy: A Bean to Bar Primer*. Because of its descriptive nature, your client’s purported mark is inherently weak. Nor have we seen any evidence that your client’s purported mark possesses any appreciable commercial strength. The publisher and author of the *Chocolate Alchemy: A Bean to Bar Primer* book are clearly marked and there is no claim of association

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with your client or its principal, John Nanci. Nor does the book use a font or logo even remotely similar in style and connotation to the font and logos used by your client. Moreover, our client does not use the “Chocolate Alchemy” phrase as a trademark to identify the source of goods or services; it is merely part of the title of a book, which travels through very different distribution and marketing channels than does your client’s goods and services. Rizzoli announced the release of the book approximately nine months ago and is not aware of any instances of actual confusion. And Rizzoli had no intent to cause confusion or usurp any of your client’s goodwill in its mark, to the extent such goodwill exists.

Finally, Rizzoli’s use of the phrase “Chocolate Alchemy” as part of the title of the book *Chocolate Alchemy: A Bean to Bar Primer* is fully protected by the statutory fair use doctrine under Section 33(b)(4) of the Lanham Act, 15 U.S.C. § 1115(b)(4). Rizzoli is using the phrase “Chocolate Alchemy” other than as a mark, in good faith and to describe the subject of the *Chocolate Alchemy: A Bean to Bar Primer* book, namely the process of making chocolate. See *Dell Publ'g Co. v. Banner Press, Inc.*, 1982 U.S. Dist. LEXIS 17951 (S.D.N.Y. Dec. 30, 1982) (owner of WORD SEARCH PUZZLES mark could not prevent publisher from using title SUPER WORD SEARCH for puzzle book); *Kelly-Brown v. Winfrey*, 95 F. Supp. 3d 350, 358 (S.D.N.Y. 2015) (owner of OWN YOUR POWER trademark could not prevent publisher from using phrase as title of magazine article). By adopting a purported mark with a descriptive connotation, your client accepted the risk that others would use the phrase in a descriptive sense, even in light of potential consumer confusion. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

Based on the foregoing, your client has no viable claim against Rizzoli or Ms. Hard concerning the *Chocolate Alchemy: A Bean to Bar Primer* book. We therefore deem the matter closed.

This correspondence is without prejudice to any of our client’s rights, remedies and defenses in law and equity, all of which are expressly reserved.

Sincerely,

A handwritten signature in blue ink, appearing to read "E. Shimanoff", with a stylized flourish at the end.

Eric J. Shimanoff