IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Chemistry Spirits, LLC

Law Office: **114**

Serial No.: **86/818813**

Examining Attorney:
Filed: **November 12, 2015** **Regina C. Hines**

Mark: **CHEMISTRY**

International Class: **033**

RESPONSE TO OFFICE ACTION NO. 1

BOX RESPONSES-NO FEE
COMMISSIONER OF TRADEMARKS
P.O. BOX 1451
Alexandria, VA 22313-1451

Dear Madam:

This is in response to Office Action No. 1, dated August 8, 2017, in connection with the above-referenced application.

I. REFUSAL-LIKELIHOOD OF CONFUSION

Examining Attorney has initially refused registration of the mark CHEMISTRY on the grounds that it is confusingly similar to the mark BODY CHEMISTRY shown in Registration No.: 3587917 (the "Cited Registration") which was registered on the Principal Register within the meaning of the Federal Trademark Act, as amended. The Examining Attorney contends that because the respective marks both include the term CHEMISTRY that there exists a likelihood of confusion. Applicant very respectfully disagrees.

As set forth in *In re E.I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), there are numerous factors to consider when assessing whether a likelihood of confusion exist. Although there is "no litmus rule which can provide a ready guide to all cases," the realities of use in the marketplace are to be considered. *Id.* at 567, 569. In assessing the

likelihood of confusion between Applicant's mark and that of the Cited Registration, as the Examining Attorney pointed out, the most relevant factors to be considered are:

1. the similarity or dissimilarity and nature of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. the similarity or dissimilarity and nature of the goods and services as described in the application or registration;
3. the similarity or dissimilarity of established, or likely-to-continue trade channels.

Id. at 567.

A. Applicant's Mark and the Cited Registration Should Be Compared in the Entireties

As noted above, one of the factors in evaluating a likelihood of confusion is the similarity or dissimilarity of the respective marks. When viewed in its entirety, Applicant believes that Applicant's mark creates a **substantially different commercial impression** because, when the Cited Registration, BODY CHEMISTRY, is viewed as a whole it become apparent that the two words together have a substantially different meaning.

In determining whether a likelihood of confusion exists, "the marks...must be viewed in their entireties." *Textronics v. Daktronics*, 534 F.2d 915 (CCPA 1976). It is inappropriate to disregard one element of a mark, thereby de-emphasizing other components of the mark. *In re Hearst Corp.*, 982 F.2d 493, 494. That is, "the marks must be considered in the way they are used and perceived." *Id.* at 1239, citing *In re national Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985). As the *Hearst* court stated, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight," citing *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847 (Fed. Cir. 1992). *Id.*

In the present case, the Examining Attorney has focused primarily on the shared components of the respective marks and neglected the component that is not shared. Applicant

submits that each portion of the respective marks must be considered together as a whole when in determining the overall appearance, sound, connotation, and commercial impression elicited from the marks.

1. **Applicant's Mark and the Cited Registration Have Very Meanings, And Therefore, Different Commercial Impressions**

The meaning of a mark is a very important aspect of the commercial impression. The Cited Registration consists of two words that create a very different meaning when they are combined. Specifically, the mark BODY CHEMISTRY is a two word term that is commonly used to describe either sexual attraction and the indefinable qualities that influence sexual compatibility of a couple, or alternatively, the holistic health of an individual's body such as vitamin intake and pH balance. In contrast, Applicant's mark consists of the word CHEMISTRY alone which is most commonly associated with the field of science that deals with the composition and properties of substances and various elemental forms of matter. These meanings are substantially different and do not weigh in favor of a finding of a likelihood of confusion.

Applicant respectfully argues that Examining Attorney initially overly focused on the shared term, CHEMISTRY, and neglected to give appropriate weight to the new and different meaning that is created when the word BODY and the word CHEMISTRY are combined.

The present case is similar to the issue in *Hearst, supra.* In *Hearst*, the Court of Appeals for the Federal Circuit stated that the Trademark Trial and Appeal Board (the "Board") erred in determining that VARGUS was confusingly similar to VARGUS GIRL. The Court held that the marks were not confusingly similar and that the Board had inappropriately changed the mark VARGA GIRL by stressing the portion "VARGA" and diminishing the portion "GIRL." In reversing the Board's decision, the Court stated that the term GIRL, although descriptive, should be given fair weight so that confusion becomes less likely. Similarly, in the instant case Applicant argues that Examining Attorney focused only on the portion in common, namely the word "CHEMISTRY," and neglected to appropriately weight and diminished the additional

portion of the cited registration, namely the word "BODY," and most importantly, neglected to weigh the meaning of the whole phrase, "BODY CHEMISTRY," in reaching her decision that the two marks are confusingly similar.

2. Applicant's Mark and the Cited Registration Have Different Aural Impressions

In order to determine whether marks are aurally distinct one should employ an "auditory comparison test." *Bell Laboratories v. Colonia Products, Inc.*, 644 F.Supp 542, 546, 231 USPQ 569 (S.D. Fla. 1986). The test determines whether the pronunciation of one mark generates and auditory response that may be confused with the sound of another mark. *Id.*

In the present case, despite the similarity of the term "CHEMISTRY," the marks are clearly aurally distinguishable due to Applicant's use of a second term, namely, the word "BODY." See *Schmid Laboratories v. Youngs Products Corp.*, 482 F.Supp. 1 (D.N.J. 1979). ("RIBBED" and "SENSIRIBBED" for condom packaging aurally distinct).

3. Applicant's Mark and the Cited Registration Have Different Visual Impressions

When the marks of the parties are viewed in their entireties, Applicant's mark significantly differs from the Cited Registration in visual appearance such that confusion would not be likely. The Cited Registration contains the word "BODY." This word is not found in Applicant's mark and no similar second term is found in its place. As discussed above, when analyzing the visual similarity of two marks it is not proper to discard or ignore non-similar elements.

Applicant's position is supported by several analogous cases. For example, in *Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 167 USPQ 529 (CCPA 1970), the mark "PEAK PERIOD" for personal deodorants was found not to be confusingly similar to the mark "PEAK" for dentifrinces. The Court specifically noted that all the determinations of likelihood of confusion "[m]ust arise from a consideration of the respective marks in their entireties." The Court further stated:

"The differences in appearance and sound of marks in issue are too obvious to render detailed discussion necessary. In their entireties nether looks nor sounds alike." *Id.* at 530.

See also *Gruner & Jahr USA Publishing v. Meredith Corp.*, 26 USPQ2d 1583 (2d. Cir. 1993) ("PARENTS" and "PARENT DIGEST" for the same type of magazines determined not to be confusingly similar); *In re Ferraro*, 178 USPQ 167(CCPA 1973)("TIC TAC" for candy held not confusingly similar to "TIC TAC DOE" for ice cream); *In re Hearst Corp.*, 25 USPQ2d 1238 (Fed. Cir. 1992)("VARGUS" and "VARGUS GIRL" both for calendars, were sufficiently different so that there was no likelihood of confusion); *Pace Sport Ltd. V. Paco Rabanne Parfums*, 54 USPQ2d 1205 ("PACO" was not confusingly similar to "PACO RABANNE"); or finally *Bell Laboratories v. Colonial Products*, 231 USPQ 569(S.D. Fla. 196), in which the Court emphasized the differences in sight and sound between "FINAL" and FINAL FLIP" both for pesticides.

In light of the foregoing comments and information, and having complied with all of the outstanding requirements of the Examining Attorney's Office Action, Applicant respectfully request that the Examining Attorney withdraw the §2(d) refusal and allow the subject application to proceed to publication.

Date: March 8, 2018

Respectfully Submitted,

Chemistry Spirits, LLC

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