

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: FitNow, Inc.
Serial No.: 86/403,278
Filed: September 23, 2014
Mark: NOURISH

TM Law Office 101
Ex. Atty. Jaqueline W. Abrams

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION NO. 1 (DATED 2/4/2016)

This is the official response of the applicant, FitNow, Inc. (“Applicant”), to the Office Action in the above-indicated matter dated February 4, 2016.

I. No Likelihood of Confusion

The Examining Attorney has concluded that the applied-for mark, NOURISH, in connection with “Downloadable software for mobile devices enabling users to locate and navigate to establishments that sell or serve healthy foods; downloadable software for mobile devices enabling users to identify healthy food options in restaurants and grocery stores; downloadable software for mobile devices offering users healthy meal suggestions; downloadable software for mobile devices enabling users to scan product barcodes and retrieve nutritional data” is likely to be confused with U.S. Registration No. 4,711,226 for NOURISH, registered in connection with, *inter alia*, “pre-recorded digital media, namely, DVDs, audio and video files featuring food, health and sustainability content; Downloadable documents in the fields of food, health and sustainability provided via a website and mobile devices; Downloadable videos, pictures and television programs about food, health and sustainability provided via the internet and wireless devices.”

Applicant acknowledges that the applied-for mark and the cited mark are identical. Nonetheless, Applicant submits that the goods set forth in Applicant’s application are

sufficiently dissimilar from the goods and services listed in the cited registration, such that no consumer confusion is likely to arise.

Where there is nothing in the record to indicate that there is “an overlap in the channels of trade for applicant’s and registrant[‘s] products,” this may be a “pivotal” factor in determining that no confusion is likely. *See In re Bentley Motors Ltd.*, Serial No. 85325994 (TTAB 2013), *citing In re HerbalScience Group LLC*, 96 USPQ2d 1321 (TTAB 2010) (finding no likelihood of confusion between nearly identical mark based on absence of evidence that the applied-for goods travel in the same channels of trade of the goods in the cited registration).

Applicant’s claimed goods are all in the form of downloadable software for mobile devices. Such goods are generally offered in “app stores” associated with various mobile telephone goods or service providers or directly from the provider of the software. The cited registration does not in any way encompass such goods. Accordingly, the channels of trade for the applied-for goods and the goods and services listed in the cited registration are completely different, indicating that there is no likelihood of confusion.

Moreover, while the goods listed in the application and those in the cited registration each concern to some degree health and food, this does not necessarily mean that they are related and that confusion is likely. It is evident from the goods and services in the cited registration that registrant is focused on educational services regarding food, health and sustainable agriculture. Review of all of the registered goods and services make it clear that the focus is on general ideas of food, health and sustainability, and educating the targeted consumers on these issues. Applicant’s goods, on the other hand, are focused on assisting consumer with the task of locating and purchasing healthy foods and meals. In short, registrant’s goods and services are conceptual in nature and Applicant’s goods assist consumers with day to day tasks. Even though

these all concern health and food, they do not serve the same purpose and will not be perceived by consumers as related to one another. Case law supports this finding. For example, in *Local Trademarks Inc. v. the Handy Boys Inc.*, the Board held that liquid drain opener and advertising services in the plumbing field were sufficiently different such that no confusion was likely, notwithstanding that the terms used in the marks in question were identical and that each was somehow related to plumbing. 16 U.S.P.Q.2d 1156. Here, as in *Handy*, the goods and services at issue are nominally related, but ultimately not practically related to one another. As such, confusion between the applied-for mark and the cited mark is not likely.

II. Conclusion

It is submitted that the application is in condition for publication, and such action is respectfully requested.

Respectfully submitted,

/ Anthony E. Rufo, Esq./

Date: July 1, 2016

Anthony E. Rufo
Foley Hoag LLP
155 Seaport Boulevard
Boston, MA 02210
Tel: (617) 832-1274
Fax: (617) 832-7000
e-mail: arufo@foleyhoag.com