

RESPONSE TO NON-FINAL OFFICE ACTION

Applicant Jusuru International Inc. responds to the Office Action dated September 27, 2016, as follows:

REMARKS:

SECTION 2(D) REFUSAL - LIKELIHOOD OF CONFUSION

TRIA

The Examiner has rejected Applicant's mark, TRIA & Design: (shown as amended pursuant to this Response), on the basis that there may be a likelihood of confusion with Tria Beauty, Inc.'s ("Registrant's") U.S. registered trademarks listed below:

U.S. Reg. No.	Mark	Goods/Services
3828866	TRIA	<u>International Class 3</u> : Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; Non-medicated acne treatment preparations <u>International Class 8</u> : Hand held battery operated and electrical devices for personal use for facial rejuvenation and toning, skin care, and eliminating acne
3822558	TRIA BEAUTY	<u>International Class 3</u> : Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; Non-medicated acne treatment preparations

Applicant respectfully disagrees. Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations. See Lloyd's Food Prods., Inc. v. Eli's, Inc., 987 F.2d 766, 767, 25 U.S.P.Q.2d 2027, 2028 (Fed. Cir. 1993); Kenner Parker Toys Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 352, 22 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1992). It is determined on a case-specific basis, applying the factors set out in In re E. I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973) (enumerating factors that may be considered when relevant evidence is of record). Applicant respectfully submits that there is no likelihood of consumer confusion with the cited registration.

The DuPont factors are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade

channels; (4) the conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and (13) any other established fact probative of the effect of use. *See id.* For purposes of this analysis the most probative factors are the dissimilarity of the marks themselves (especially when the cited arguably similar term is common and therefore weak), the differences in the services and consumers, and the highly sophisticated and careful consumers with respect to such services.

As discussed herein, Applicant’s mark is not likely to cause consumer confusion with the cited registration under the DuPont Factors.

1) Applicant’s mark is not similar to the cited registered marks, where the respective marks are visually and aurally dissimilar, have different meanings and create distinct commercial impressions.

It is not appropriate for the Examining Attorney to compare the subject mark and the cited registrations by discriminately selecting portions of the marks for comparison while ignoring the aggregate effect created by each of the marks *as a whole*. Franklin Mint Corp. v. Master Mfg. Co., 212 U.S.P.Q. 233 (CCPA 1981). The Examining Attorney must focus on the entire mark as a whole, based on its overall sight, sound, connotation, and commercial impression, instead of just its component parts. In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273-74 (CCPA 1974); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS §23.15[1][a] (3rd Ed. 1992). While each mark may contain common or similar words, the marks should be considered in their entirety. Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, (Fed. Cir. 1992); In re National Data Corp., 753 F.2d 1056, (Fed. Cir. 1985) (individual components or features should not be dissected and analyzed piecemeal).

In many cases, courts have found that even where two marks share common terms combined with other dissimilar elements, the dissimilar element sufficiently distinguishes the two marks in their entirety to avoid a likelihood of confusion. To that end, numerous marks that have common or similar elements have avoided a finding of likelihood of confusion. *See, e.g.,* Marshall Field & Co. v. Mrs. Fields Cookies, 25 U.S.P.Q.2d 1321 (TTAB 1992) (“MARSHALL FIELD’S” and “FIELD’S,” both for department store services including baked goods, created no likelihood of confusion with “MRS. FIELDS,” for cookies and brownies); Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co., 228 U.S.P.Q. 364 (Fed. Cir. 1986) (“ROMAN” and “ROMANBURGER” were not confusingly similar); Bell Laboratories Inc. v. Colonial Products Inc., 231 U.S.P.Q. 569 (S.D. Fla. 1986) (both “FINAL FLIP” and “FINAL,” for pesticides were not confusingly similar); Interstate Brands v. Celestial Seasonings, 198 U.S.P.Q. 151, 153 (CCPA 1978) (“The presence of the word “RED” in Applicant’s mark cannot be dismissed as an identification factor. Thus whether we consider Applicant’s mark to be ‘THE RED ZINGER’ or ‘RED ZINGER,’ it is distinguishable from ‘ZINGER’ per se”); Plus Products v.


General Mills, Inc., 188 U.S.P.Q. 520 (TTAB 1975), aff'd without opinion, 534 F.2d 336 (CCPA 1975) ("PROTEIN PLUS" not confusingly similar to "PLUS"); Lever Bros. Co. v. Barcolene Co., 174 U.S.P.Q. 392 (CCPA 1972) ("ALL" and "ALL CLEAR," for household cleaners were not confusingly similar); Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 U.S.P.Q. 529 (CCPA 1970) ("PEAK PERIOD" not confusingly similar to "PEAK"); Long John Distilleries, Ltd. v. Sazerac Co., 420 F.2d 1403, 166 U.S.P.Q. 30 (CCPA 1970) (no likelihood of confusion between "FRIAR JOHN" and "LONG JOHN" for scotch whiskey - despite near identity in the goods).

Overall, Applicant's highly stylized mark is clearly different than the cited marks. First, the overall appearances of the marks as a whole are distinct and not likely to be confused:

	<p>TRIA BEAUTY</p>
	<p>TRIA</p>

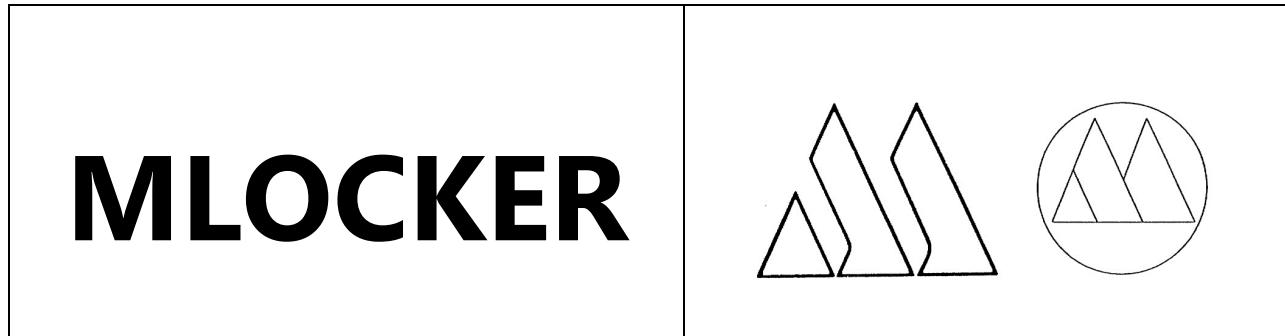
The Application is for a highly stylized logo. When viewed side by side with the cited registrations, it is clear that the respective marks are visually dissimilar and create wholly distinct commercial impressions – particularly in light of the vertical orientation of Applicant's mark (as amended).



The marks must be compared in their entireties, and  is unlikely to be associated with the cited registrations. Such a distinct commercial impression created by the marks is sufficient to overcome a likelihood of consumer confusion.

This case is similar to a fact scenario recently reviewed by the Board in In re Eaton Corp., Serial No. 85030456 (TTAB 2011) [not precedential] (ex parte review of MLOCKER and M Logos). In that case, the Applicant applied to register its mark for goods that the Board found were identical or closely

related to the goods in the cited registrations, presumed to travel in the same channels of trade and to the same purchasers of such goods. *Id.* Analogous to the present case, the Board compared the MLOCKER unitary word mark with two registrations for highly stylized M logos as shown below:





The Examining Attorney had contended that the marks were “legally identical,” arguing that “the applicant’s addition of the generic term LOCKER is of minor significance when looking at the overall commercial impression. The dominant portion of applicant’s and registrant’s marks is the letter M.” *Id.* However, the Board disagreed and found that the involved marks “differ sharply” in appearance and sound. And even if the word LOCKER is a weak formative for these goods, it still contributes to the visual and aural impression created by Applicant’s mark. Moreover, the cited marks are stylized letter marks, which “partake of both visual and oral indicia.” These marks are “in the gray region between pure design marks which cannot be vocalized and work marks which are clearly intended to be.” These stylized letter designs “cannot be treated simply as a word mark” as the stylization in the cited mark is “so high that they are more akin to design marks rather than simply stylized displays of the letter ‘M.’” *Id.*



Considering the marks in their entireties we find that registrant’s marks are so highly stylized that they project the image of design marks and the letter takes on its significance only by reference to registrant’s trade name Mohawk Manufacturing & Supply Co., Inc. . . . In contrast, the significance of applicant’s mark is focused on the letters MLOCKER in standard characters, notwithstanding the weakness of LOCKER in relation to the goods. Thus, we find that the marks are not so similar in sound, appearance, connotation or commercial impression, that, merely because such marks share the letter M, confusion as to origin or association is likely. *Id.*

2) The term “TRIA” is entitled to a narrow scope of protection.

The term “TRIA” appears in 46 LIVE U.S. Patent and Trademark Office records, 38 of which are concurrently registered marks. To that end, just to name a few, the following LIVE registrations are currently coexisting:

U.S. Reg. No.	Mark	Goods/Services	Owner
4700868	TRIA ACNE CLEARING	IC 010: Hand held battery operated and electrical devices for personal use for facial rejuvenation and	Tria Beauty, Inc.

U.S. Reg. No.	Mark	Goods/Services	Owner
	BLUE LIGHT	toning, skin care, and eliminating acne.	
4700867	TRIA AGE-DEFYING LASER	IC 010: Hand held battery operated and electrical devices for personal use for facial rejuvenation and toning and skin care	Tria Beauty, Inc.
4728754	TRIA BOUTIQUE	IC 035: Retail store in the field of footwear, apparel and jewelry featuring luxury, dress, casual and athletic shoes and boots, hosiery, socks, handbags and jewelry	Tria Boutique LLC
4721274		IC 035: Retail store in the field of footwear, apparel and jewelry featuring luxury, dress, casual and athletic shoes and boots, hosiery, socks, handbags and jewelry	Tria Boutique LLC
4549126	TRIA HAIR REMOVAL LASER PRECISION	IC 008: Hand-held laser apparatus for hair removal and hair growth reduction	Tria Beauty, Inc.
4549125	TRIA LASER PRECISION	IC 008: Hand-held laser apparatus for hair removal and hair growth reduction	Tria Beauty, Inc.
4758058		IC 024: Textiles and textile goods, namely, fabrics for textile use, fabrics for curtains, fiberglass fabrics for textile use, velvet, fabric of imitation animal skins, woollen fabrics, cotton fabrics, calico, curtains of textile, shower curtains of textile, bed and table covers, bed pads, bed linen, unfitted fabric furniture covers, coverlets, bedspreads, covers for cushions, table napkins of textile; quilts, bed blankets; face towels of textile, towels of textile; wall hangings of textile; handkerchiefs of textile, labels of cloth, flags not of paper, sheets sets, fitted toilet lid covers of fabric, pillow covers, pillowcases, napkins of textile	Konya Tekstil Sanayi Ve Ticaret Limited
3360633	TRIA	IC 008: HAND HELD BATTERY OPERATED AND ELECTRICAL DEVICES FOR PERSONAL USE FOR THE REMOVAL OF HAIR	Tria Beauty, Inc.
2979596	TRIA	IC 044: Orthopedic medical services	Tria Orthopaedic Center, LLC


U.S. Reg. No.	Mark	Goods/Services	Owner
2979595	TRIA ORTHOPAEDIC CENTER	IC 044: Orthopedic medical services	Tria Orthopaedic Center, LLC
3110389		IC 044: Orthopedic medical services	Tria Orthopaedic Center, LLC
4261709	TRIA PLAY STRONG	IC 044: Medical services, orthopedic services, physical rehabilitation and physical therapy services, but specifically excluding services relating to cancer, cancer survival and cancer recovery; physical therapy evaluation, identification and management of movement dysfunction to restore, maintain and promote optimal physical function preventing the onset, symptoms and progression of impairments, functional limitations and disabilities resulting from disease, disorders, conditions or injuries, but specifically excluding services relating to cancer, cancer survival and cancer recovery	Tria Orthopaedic Center, LLC
3734935	TRIAS	IC 010: artificial limbs, in particular carbon-fiber feet	Otto Bock HealthCare GmbH
4063827		IC 042: FASHION DESIGN CONSULTANT, PROVIDING A WEBSITE FEATURING INFORMATION IN THE FIELD OF INTERIOR DESIGN, DESIGN OF COMPUTER NETWORKS AND SOFTWARE FOR OTHERS FOR THE FASHION INDUSTRY	Trias Sartorius S.L.
3599036	TRIA	IC 020: Pillows	Pacific Coast Feather Company
2521630	TRIAS	<p>IC 031: CUT FLOWERS, DRIED FLOWERS, LIVE POTTED PLANTS, LIVE POTTED FLOWERS, LIVE FLORAL ARRANGEMENTS, DRIED FLOWER ARRANGEMENTS, TOPIARIES, NAMELY, LIVING AND DRIED PLANT SCULPTURES, NONE OF WHICH ARE MADE WITH SPINACH OR TRITICALE</p> <p>IC 035: RETAIL FLORIST SHOPS AND ON-LINE RETAIL STORE SERVICES, BOTH FEATURING FLOWERS, PLANTS, GIFT BASKETS, AND RELATED</p>	Casas Trias, Corp.


U.S. Reg. No.	Mark	Goods/Services	Owner
		GIFT ITEMS, NAMELY, VASES, PICTURE FRAMES, DECORATIVE PLATES AND FIGURINES, ANTIQUES AND HOME ACCESSORIES	
2443359	TRIA	IC 010: FETAL AND VASCULAR ULTRASOUND DOPPLER SYSTEMS CONSISTING OF A SPEAKER UNIT AND ONE OR MORE DOPPLER PROBES	MedaSonics, Inc.


To the extent the Examiner would find it helpful to see copies of the foregoing referenced marks, Applicant will provide such materials.


The presence of other, similar marks limits the range of protection, particularly in crowded fields like health and beauty. See, e.g., Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc., 77 U.S.P.Q.2d 1492, 1510 (T.T.A.B. 2005) (“in view of the third-party uses of [similar] marks . . . consumers likely are able to distinguish between entities based on distinctions among the marks”), appeal dismissed, 171 Fed. Appx. 838 (Fed. Cir. 2006).

It is clear that the existence of the term “TRIA” in the cited registrations should not be afforded an overly broad scope of protection – particularly given the fact that many of the currently co-existing marks are more similar to one-another than Applicant’s mark is similar to the cited registrations. Indeed, the retail stores associated with the mark TRIA BOUTIQUE (which offer for sale, among other items, apparel, jewelry, shoes, hosiery, and handbags) are highly likely to carry the same types of cosmetic skin care products which are being sold in connection with the cited TRIA and TRIA BEAUTY

marks. Further, the  registration for fashion design services is much more strongly associated with both the TRIA BOUTIQUE registrations and the TRIA and TRIA BEAUTY cited marks

than with Applicant’s  mark for an energy beverage product. The cosmetic beauty products sold in connection with the TRIA and TRIA BEAUTY cited marks are very likely to be sold to the same or similar consumers who are utilizing fashion services and/or purchasing retail apparel, jewelry, shoes and handbags. Despite this clear similarity in the types of consumers and channels of trade, each of

the TRIA BOUTIQUE marks, the  mark, and the cited TRIA and TRIA BEAUTY marks have been allowed to concurrently register and coexist. Further, the TRIAS registration for artificial limbs is highly similar to the TRIA registrations owned by Tria Orthopedic Center, LLC for orthopedic medical

services, yet they are similarly allowed to coexist. Likewise, Applicant’s own  mark should be allowed to similarly co-exist – especially in light of Applicant’s amended drawing of the mark and identification of goods. It’s extremely unlikely that energy beverage products would be sold alongside skin care products, and energy beverages are *most certainly* marketed to different sets of

consumers through different channels of trade than cosmetic and skin care products (as discussed further below).

TRIA

Given the many other similar marks with "TRIA" that coexist on the Register, the subject TRIA mark is no more likely to cause confusion than any of the other existing registrations. In light of such coexisting registrations incorporating the term TRIA, Applicant believes that the Examiner has afforded the cited registrations a scope of protection beyond that to which they are entitled. The Examiner is well aware that "any doubt in determining the registrability of [a mark] is resolved in favor of an applicant on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence." In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) (quoting In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (TTAB 1972)).

3) Applicant's goods – as amended – and Registrants' goods are not sufficiently similar or related to cause confusion.

Applicant respectfully but strongly disagrees that Applicant's goods (particularly as amended) are confusingly similar to the two cited registrations. Applicant is seeking to amend its identification of goods to ensure there is no confusion regarding the nature of the goods. Indeed, Applicant's product is an **energy beverage** that is consumed for the purpose of quenching thirst and/or boosting energy and alertness.

The goods identified in the Application, as amended, solely focus on one specific, highly specialized item: energy beverages. In contrast, the cited registrations cover a variety of different (but also highly-specialized) skin-care cosmetics and acne treatment products that are topically applied to the surface of the skin, as well as devices for physically rejuvenating skin.

Both Applicant's and Registrant's goods are highly specialized, but they are specialized in drastically different ways (consumable energy beverages versus topic skin care preparations). While Applicant's goods would be directed to any individual seeking to quench their thirst or boost their level of alertness or physical energy, the Registrant appears to direct its goods to mainly female consumers who are interested in enhancing beauty or reducing the appearance of acne. Clearly, these are entirely different sets of respective consumers who are seeking entirely different products based on different motivations and anticipated results, and through wholly distinct and separate trade channels.

In Electronic Data Systems Corp. v. EDSA Micro Corp., the TTAB acknowledged that while all computer software programs process data, not all computer programs are related. Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460 (TTAB 1992). The issue of relatedness does not revolve around the question of whether the goods can both be classified under the same general category. Id. The test is whether the goods are related in the mind of the consuming public as to their origin. See In re Coors Brewing Co., 343 F.3d 1340, 1346 (Fed. Cir. 2003), finding that while some restaurants may brew their own beer, that does not necessarily mean that consumers are likely to believe that beer and restaurant services with similar marks emanate from the same source,

particularly where the evidence indicates that the degree of overlap between sources of beer and sources of restaurant services is *de minimis* and the very small number of dual use registrations does not counter the evidence. See also M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1381, 78 U.S.P.Q.2d 1994 (Fed. Cir. 2006) (where interactive multimedia CD-ROMs containing educational information in the pharmaceutical and medical product information industry were not found to be similar goods to computer software featuring business management applications for the film and music industries even though both fall in the same broad general category of informational software provided on the same media platform).

Similar to the Electronic Data Systems case and the M2 Software case, while Applicant and the Registrant may both touch on the broad category of *personal wellbeing*, consumers seek out and utilize Applicant's and Registrant's respective goods for entirely different purposes and based on entirely different motivations (thirst and/or a boost in feelings of energy and alertness versus improved skin appearance). Thus, it is very unlikely that consumers would view Applicant's goods as associated with Registrant's goods and vice versa. As such, these different consumers are not likely to be confused, especially where the marks themselves create distinct commercial impressions.

IDENTIFICATION OF GOODS (AND AMENDMENTS THERETO)

Applicant hereby seeks to amend the identification of goods ("Identification") as follows:

Liquid energy beverages

Applicant maintains that the amendment is proper in that it merely clarifies the originally described goods and does not add any goods that were not encompassed in the Application as originally filed. To that end, the amended Identification has been submitted directly into the TEAS form.

MARK ON DRAWING DOES NOT MATCH SPECIMEN

Pursuant to Examiner's suggestions, Applicant hereby seeks to submit a new drawing of the mark in vertical stylized format, as follows:



To that end, the new drawing has been submitted directly into the TEAS form.

MARK DESCRIPTION


Pursuant to Examiner's suggestions, Applicant hereby seeks to amend the description of the mark as follows:

The mark consists of the term "TRIA" in stylized font, written vertically.

To that end, the amended mark description has been submitted directly into the TEAS form.

CONCLUSION

Applicant respectfully suggests that there is no likelihood of confusion between Applicant's highly

stylized  mark and Registrant's word marks in connection with their clearly distinguishable, respective products. For the foregoing reasons, and in view of the evidence and arguments presented, Applicant respectfully submits that Applicant's highly stylized mark is entitled to registration on the Principal Register. Should the Examining Attorney wish to discuss this Application further, a telephone call to the undersigned attorney is respectfully invited.

Margaret M. Arcaro

marcaro@polsinelli.com

(303) 583-8275