

Amended Services

Int'l. Class 31 – Retail store services featuring nutritional supplements, dietary supplements and protein supplements

Remarks/Arguments

Applicant's counsel thanks the examining attorney for the careful consideration given the application. The current Action alleges a likelihood of confusion based on the registered marks ELEVATE THE EXPERIENCE (U.S. Registration No. 4210501), ELEVATE (U.S. Registration No. 4392386), and ELEVATE (U.S. Registration No. 5280645). The current Action also provides notice of prior filed applications, ELEV8 (U.S. Application No. 87817979), ELEVATE THE EVERYDAY (U.S. Application No. 88324215), and ELLEvate (U.S. Application No. 88331324), which may allegedly present a likelihood of confusion upon registration. For the reasons discussed below, it is respectfully submitted that Applicant's ELIVATE mark, when used on or in connection with Applicant's services, is not likely to be confused with the cited marks.

Initially, many similar "ELEVATE" marks coexist in connection with goods or services related to dietary supplements, as evidenced by the marks cited in the current action. Pursuant to *TMEP 1207.01(d)(iii)*, "third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." In the current case, ELEVATE, or a variant thereof, is so commonly used that the public must look to a specific element, such as the spelling, stylization and/or other components of the mark, to distinguish the source of the goods and/or services. For example, ELIVATE, and the cited marks (ELEVATE THE EXPERIENCE, ELEVATE, and ELEVATE) and pending marks (ELEV8, ELEVATE THE EVERYDAY, and ELLEvate), share related goods and services, but are distinguishable based on at least their spelling and/or stylization. Thus, in order to successfully coexist, the public is accustomed to looking for context clues, such as the spelling of ELIVATE versus ELEVATE, ELEV8, or ELLEvate to distinguish the source of the goods and/or services. This is particularly noteworthy for the '386 registration for unstylized ELEVATE and the stylized '645 registration for

ELEVATE

both for identical nutritional supplements. It is well established that to distinguish these marks, consumers will also look to the marks as a whole, such as differences impressed by "the experience" or "the everyday," for example. Accordingly, with regard to similar marks on similar goods, there is no likelihood of confusion between ELIVATE and the cited marks because consumers are accustomed to distinguishing the spelling, stylization and marks as a whole to determine the source of the goods and services.

Moreover, given the many ELEVATE formative marks on the registry, the cited marks are quite weak and therefore entitled to narrow protection. Pursuant to *TMEP 1207.01(b)(ix)*, "merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word." This is evidenced by the current co-existence of the cited marks already on the registry for identical and related goods and services. Accordingly, the distinction between the appearance of ELIVATE and the abundantly present ELEVATE marks

would enable consumers to distinguish between the mark of the instant application and the narrowly protected cited marks, such that confusion would be unlikely.

In light of the foregoing, it is respectfully submitted that the presence of similar marks for similar goods and services, as well as the weak nature of the cited marks, distinguish the mark of the instant application from the cited marks. Accordingly, it is respectfully submitted that there is no likelihood of confusion between Applicant's mark and the cited marks, and Applicant respectfully requests withdrawal of the corresponding 2(d) refusal. However, should the examining attorney consider there to be any remaining issues, she is respectfully requested to contact the undersigned attorney in an effort to resolve them by phone.