

Applicant’s Response to Office Action

Pursuant to 15 U.S.C. § 1062(b), the Applicant (Serial No. 88238897) responds to the March 25, 2019 office action (the “Office Action”) refusing registration under Trademark Act Section 2(d) on the grounds that Applicant’s mark, when used in connection with the identified goods so resembles the marks in U.S. Registration No. 5285038 (the “Cited” mark) as to be likely to cause confusion, to cause mistake, or to deceive. Applicant disagrees with this conclusion and in further support of its original application (the “Application”), respectfully submits the following response, requesting that the Examining Attorney reconsider the refusal of the Application.

I. Applicant’s Mark

Applicant seeks protection for the standard character mark containing the literal elements: HEXAGEN.

This Application fits into International Class 005 for “Dietary and nutritional supplements.”

II. The Nature of the Mark the Examining Attorney Concluded Could Lead to Confusion, Mistake, or Deception under 15 U.S.C. § 1052(d)

U.S. Registration No. 5285038

The mark covered by this registration is a standard character mark containing the literal elements: HEXAGEN.

This mark fits into International Class 005 for “Allergy medications; Allergy relief medication; Antibacterial pharmaceuticals; Topical first aid gel.”

III. Explanation of the *DuPont* Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely

Any likelihood of confusion between marks is determined on a case-by-case basis.¹ The marks are compared for similarities, considering the various relevant factors.² There is no *per se* rule that requires that any one of the Du Pont factors be given greater weight than any other or

¹ *Id.*

² *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

considered in any particular order, and it is well settled that the dominant factor in this list may well vary from case to case.³ The *DuPont* factors relevant to this case are as follows:⁴

- The similarity or dissimilarity as to connotation and commercial impression.
- The similarity or dissimilarity of the nature of the goods or services.
- The similarity or dissimilarity of established trade channels.
- The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
- The extent of potential confusion.

IV. Application of the Relevant *DuPont* Factors to the Pending Application

Based on the differences between the appearance, sound, and connotation of the marks, as well as the differences between the goods and other factors as explained and outlined below, there is no likelihood of consumer confusion between the marks.

A. Comparing Applicant’s Mark with Relevant Registered Marks in Their Entireties Reveals Significant Differences that Make Consumer Confusion Unlikely.

DuPont requires the examining attorney to compare the marks in their entireties for similarities and dissimilarities in appearance, sound, and meaning or connotation.⁵ The Trademark Trial and Appeals Board (“TTAB”) has held that “Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related.”⁶ An Examining Attorney must determine whether the total effect conveyed by the two marks is confusingly similar, not simply whether the marks have similar features.⁷ According to Section 1 of the Lanham Act §1, when comparing design marks in the similarity-of-the-marks, likelihood of confusion is determined on the basis of the total effect of the designation, rather than a comparison of individual features.⁸

³ See *Du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567; and TMEP § 1207.01(a)(iv) citing *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988).

⁴ *Id.*

⁵ See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); TMEP § 1207.01(b)-(b)(v); *In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (An examining attorney “must compare the marks in their entireties” whenever evaluating their potential for confusion.)

⁶ *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

⁷ “All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); See also *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987), *Sensient Technologies Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754 (8th Cir. 2010); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008); 15 U.S.C.A. § 1051.

⁸ *Id.*

i. *The Marks Have Significantly Different Connotations and Commercial Impressions.*

The similarity or dissimilarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion.⁹ The meaning or connotation of a mark must be determined in relation to the named goods or services.¹⁰ Whether customers can distinguish the marks in a side-by-side comparison is not the test, instead our inquiry is “whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result.”¹¹

In cases where two marks are identical in appearance or sound, differences in connotation between the marks can be sufficient to obviate any likelihood of consumer confusion.¹²

In the *Taj Mahal* case, the marks at issue were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort.¹³ The court held that there was no likelihood of confusion, as the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence and extravagance.¹⁴

While Applicant’s mark, HEXAGEN, connotes a nutritional powder that is mixed to make a drink that replenishes glycogen post-workout, the Cited Mark, HEXAGEN, connotes medical wound dressing for doctors to use when treating injuries or to prescribe to a patient.

Connotation and significance can be determined based upon a mark holder’s current use in commerce.¹⁵ The Cited mark is used in commerce in connection with a wound dressing for acute and chronic wound management, which further supports that the Cited mark has a different connotation than Applicant’s mark.

From the Applicant’s website, the Applicant’s mark is used to identify a “Glycogen & Performance Matrix.” See *Exhibit A*. When viewed in commerce, the likely consumer impression of the Applicant’s mark is of a nutritional powder that is added to a drink to provide a variety of

⁹ TMEP § 1207.01(b)(v).

¹⁰ *Id.*

¹¹ *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91 USPQ2d 1594, 1598 (TTAB 2009).

¹² See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (finding that CROSS-OVER when applied to bras carried different connotation and/or commercial impression from CROSSOVER as applied to women’s sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (finding that PLAYERS for men’s underwear carried different connotation and/or commercial impression from PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) (finding that BOTTOMS UP for ladies’ and children’s underwear held a different connotation or commercial impression from BOTTOMS UP for men’s clothing).

¹³ See *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F.Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990).

¹⁴ *Id.*

¹⁵ *In re Nationwide Industries*, 6 USPQ2d 1882, 1884 (TTAB 1984) (“Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project”); See *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1721 (TTAB 2007).

fitness, pre- and post-workout related benefits. *Id.* The Applicant advertises the Applicant's mark with a wide variety of specialized nutritional ingredients that are meant to improve performance when working out. *Id.* Thus, the likely consumer impression, when viewing the Applicant's mark in commerce, is that the Applicant's mark is for a workout, fitness related powder that should be used when working to improve bodily performance.

In contrast, the Cited's mark is advertised on the Cited's website as a medical ointment for medical professionals to use when treating patients or as an available prescription medication to aid patients. *See Exhibit B.* The primary consumer of the Cited mark, who will be able to see the mark in commerce, will be medical professionals such as doctors, medical professionals, and medical suppliers as the Cited's good is specifically made and advertised as professional use only. *Id.* Cited's product also indicates it is available by prescription as well, meaning that an ordinary consumer would only be able to view the Cited's mark after visiting a doctor for a medical injury, having the doctor prescribe the Cited's good, having the Cited's medical insurance and pharmacy allow the consumer-patient to obtain the Cited's good, and then will an ordinary consumer be able to view the Cited's mark in commerce. As such, an ordinary consumer would easily understand that the Cited's mark is for a medication used to treat specific injuries and should only be used as directed by their doctor. Thus, the likely consumer impression at issue are the impression of a performance enhancing fitness drink and a medical gel for treating serious personal injuries. It is therefore unlikely that a consumer would be confused between medicine their doctor prescribed for an injury and the nutritional powder a gym buddy recommended to "improve their gains."

In sum, the commercial context of the Applicant's mark differs from that of the Cited mark. Such differences in commercial contexts weigh against a finding of likelihood of confusion between the marks.

B. Applicant's Offerings are Sufficiently Different from the Cited Offerings.

The second *DuPont* factor evaluates the similarity or dissimilarity of the goods and services offered under the respective marks. To sustain a finding of likelihood of confusion, the goods or services at issue must be "related in some matter and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods or services] emanate from the same source."¹⁶ The inquiry is whether the relevant goods and services could be related "in the mind of the consuming public" such that source confusion

¹⁶ *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) ("there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source").

would occur.¹⁷ An examining attorney must “provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.”¹⁸

i. *The Applicable Standard of Relatedness*

In circumstances where the goods or services in question “are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.”¹⁹

To establish that identified items are related, “it is not sufficient that a particular term may be found which may broadly describe” them.²⁰ “That two goods are used together . . . does not, in itself, justify a finding of relatedness.”²¹ That the same customer could seek out relevant goods or services is also insufficient for a finding of relatedness.²²

“Merely because parties operate in the same broad industry does not, by itself, establish that their goods and services are related.”²³ Being filed in the same class or presumably available to the same class of purchasers is also not a sufficient basis to conclude that identified items are related.²⁴

Simply because Applicant and the Cited mark operate generally in the broad industry of health does not establish that the goods are related.

When “the relatedness of the goods and services is not evident, well-known or generally recognized,” an examining attorney is required to provide “something more” in order to establish relatedness of goods or services.²⁵

¹⁷ See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000).

¹⁸ TMEP § 1207.01(a)(vi).

¹⁹ TMEP § 1207.01(a)(i).

²⁰ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

²¹ *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (no likelihood of confusion between RITZ for cooking classes and RITZ for kitchen textiles).

²² See *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (“even though opposer’s services and applicant’s product are or can be marketed to the same class of customers . . . these services and goods are so different that confusion is not likely even if they are marketed under the same mark”).

²³ *National Rural Electric Cooperative Ass’n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1885 (TTAB 2006); See *Steve’s Ice Cream, Inc. v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987).

²⁴ *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007); See *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009).

²⁵ *In re St. Helena Hosp.*, 774 F.3d 747, 754, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (“health care services . . . in a . . . residential program” as compared with printed materials “dealing with physical activity and physical fitness” requires “something more”); See *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (“beer” as compared with “restaurant services” requires “something more”).

In re Honeyhole Sandwiches Inc., Serial No. 87138294 (May 22, 2018) “In analyzing the relatedness of restaurant services and food items, we keep in mind the “something more” requirement that is imposed by the Federal Circuit. When determining the relatedness of one party’s food provision services, e.g., restaurant services, and the food and/or drink products of another party, it has long been held that the mere fact that a restaurant may offer certain food items or beverages does not by itself mean that the food or drink is related to the restaurant services; rather, in order “[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services.” *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) (emphasis added); see also *Opus One*, 60 USPQ2d at 1813 (finding restaurant services related to wine); cf. *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) (no showing of “something more” sufficient to find likelihood of confusion between beer and restaurant services).”

ii. *The Goods at Issue Are Not Related.*

The Applicant produces and sells a nutritional supplement meant to replenish glycogen and hydrate fitness and health minded consumers. The Cited sells a prescription topical gel that is sold to medical professionals or available upon receiving a prescription from a doctor. Fitness related nutritional supplements are not related to medical-grade prescription ointments that a doctor prescribes to a patient. Although some individuals may attempt to market essential oils as a cure for cancer, chemotherapy drugs prescribed by a doctor are not related to lavender oil. In the same way, the Applicant’s nutritional supplement to be used after exercising is not related to the Cited’s medical gel to be used by medical professional or upon prescription by a doctor.

iii. *The Third Party Evidence Offered by the Examining Attorney Is Not Sufficient to Establish That the Goods Are Related.*

Examining Attorney has made a finding that Applicant’s goods and the Cited goods are related based upon third party websites that indicate “the same parties offering dietary and nutritional supplements, allergy relief medications, antibacterial pharmaceuticals, and topical first aid gel.”

Attempting to establish relatedness of goods and services on the exclusive basis of third party website evidence is generally disfavored by the Board.²⁶

Third party items presented in this case do not meet the applicable standard, and do not establish that the goods are related. It is not enough to find a particular term that may broadly

²⁶ See *In re Shane Marquess*, Serial No. 86478749, (TTAB 2016) (non-precedential) (“we would be remiss if we did not point out the lack of third-party registration evidence that is usually submitted by the Office for purposes of showing certain goods may emanate from a common source under the same mark.”).

define the offerings.²⁷ An examination of the specific items in the identifications is required. In *W.W. Henry Co.* the Board evaluated two marks that were “virtually the same” and held the goods at issue were not related despite five third party registrations provided by the examining attorney.²⁸ The Board explicitly discounts third party evidence that is not indicative of actual use, and evidence that does not include the items listed in both identifications.²⁹

1. *Third Party Evidence Provided by the Examining Attorney Does Not Actually Cover Both Applicant’s and the Cited Mark’s Offerings.*

If third party evidence does not contain the items listed in the application *and* the cited registration, the third party evidence is “insufficient to show that applicant’s and registrant’s goods are of a type that may emanate from a single source.”³⁰ When considering the value of third party registrations, broad readings of the identified goods and services are not allowable. An examining attorney is not permitted to presume that third party marks cover the broadest possible range. Instead, an examining attorney is to use third party evidence to show relatedness between items only when such third party evidence shows the *same* items as both the Applicant’s and the Cited mark’s identifications. Here, the examining attorney shows evidence online retailers selling allergy medication, antibacterial pharmaceuticals and topical first aid gel but no evidence of the same retailers selling dietary and nutritional supplements, expecting Applicant to make assumptions rather than providing evidence. The following items provided by the examining attorney do not contain goods and services identified by both relevant marks:

- Website: www.vitacost.com - Good: *Buried Treasure* Aller Ease Allergy Relief - The examining attorney shows that the brand Buried Treasure makes allergy relief medication and that the online retail store Vitacost sells allergy relief medication. However, examining attorney provides no evidence that that Vitacost is actually selling dietary and nutritional supplements as identified by the Applicant, nor that the brand Buried Treasure makes nutritional and dietary supplements. As such, the examining attorney has not provided sufficient evidence to show that the Applicant’s goods are offered alongside the Cited’s goods.
- Website: www.drivitaminsolutions.com - Good: *Ortho Molecular Products* D-Hist - The examining attorney shows that the brand Ortho Molecular Products makes allergy relief medication and that the online retail store Dr Vitamin Solutions sells allergy relief medication. However, examining attorney provides no evidence that that Dr Vitamin

²⁷ See *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517 (TTAB 1975).

²⁸ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1214 (TTAB 2007).

²⁹ *Id.*

³⁰ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

Solutions is actually selling dietary and nutritional supplements as identified by the Applicant, nor that the brand Ortho Molecular Products makes nutritional and dietary supplements. As such, the examining attorney has not provided sufficient evidence to show that the Applicant's goods are offered alongside the Cited's goods.

- Website: us.supersmart.com - Good: *Super Smart* Bacillus Subtilis - The examining attorney shows that the brand and online retailer Super Smart makes antibacterial medication. However, examining attorney provides no evidence that that Super Smart actually makes or sells dietary and nutritional supplements as identified by the Applicant. As such, the examining attorney has not provided sufficient evidence to show that the Applicant's goods are offered alongside the Cited's goods.
- Website: www.vitaminshoppe.com - Goods: *Sovereign Silver* Bio-Active Silver Hydrosol Liquid & First Aid Gel - The examining attorney shows that the brand Sovereign Silver makes topical first aid gel and immune system support medication, and that the online retail store Vitamin Shoppe sells topical first aid gel and immune system support medication. However, examining attorney provides no evidence that that Vitamin Shoppe is actually selling dietary and nutritional supplements as identified by the Applicant, nor that the brand Sovereign Silver makes nutritional and dietary supplements. In addition, the good Bio-Active Silver Hydrosol Liquid is an immune system support medication that has no relation to dietary and nutritional supplements, allergy relief medication, antibacterial pharmaceuticals, or topical first aid gel. As such, the examining attorney has not provided sufficient evidence to show that the Applicant's goods are offered alongside the Cited's goods.

2. *Third Party Evidence Provided by the Examining Attorney Is of Little to No Significance Because It Covers a Wide Range of Offerings.*

Evidence offered forth to show that products are related that comes from entities where a wide variety of goods and services are sold is of little to no value.³¹ Third party registrations that contain “laundry lists” of goods and services are not commonly seen as persuasive evidence that two products are related.³² Here, the Examining Attorney has presented items of third party evidence that each cover a wide swath of products and services. As such, each item is of little to no value in establishing that the offerings are related.

- Website: www.vitacost.com - This third party evidence is for Vitacost and due to the wide variety of goods sold on their website this evidence should constitute a “laundry list” and have little to no persuasive value. Goods unrelated to those at issue include a

³¹ See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

³² *Id.*

variety of beverages including coffee, juice, cocoa powder, concentrates, and powdered drinks, food including herbs, spices, beans, flour, and nuts, and a variety of cosmetic products including soap, essential oils and sunscreen. *See Exhibit C*. This wide variety of goods that are unrelated to the goods at issue shows that this evidence constitutes a “laundry list” that should not be seen as persuasive evidence.

- Website: www.vitaminshoppe.com - This third party evidence is for The Vitamin Shoppe and due to the wide variety of goods sold on their website this evidence should constitute a “laundry list” and have little to no persuasive value. Goods unrelated to those at issue include cleaning supplies such as hand soap, countertop cleaner, floor cleaner, and all-purpose cleaners, water bottles, candles, books, bracelets, energy drinks, food such as cookies and protein bars, and cosmetic products such as CBD skin care products, body lotion, soap, and a variety of makeup. *See Exhibit D*. This wide variety of goods that are unrelated to the goods at issue shows that this evidence constitutes a “laundry list” that should not be seen as persuasive evidence.

When these foregoing third party items are removed from consideration, no third party items remain relevant to this consideration. These items are insufficient to support a finding that goods are related.³³

C. There is no Likelihood of Confusion Arising from Similarity of Trade Channels.

Examining Attorney asserts that absent restrictions in an application and/or registration, the identified goods or services are presumed to travel in the same channels of trade to the same class of purchasers. The rule is that we do not infer nonexistent limitations into a definite identification – the identified goods and services of each mark are presumed to move in all normal trade channels for such goods and services.³⁴ To square this assertion with Examining Attorney’s: essentially, the differing identified items *are* the restrictions in the identifications that defeat a bald presumption of identical trade channels.

Viterra, *Hewlett-Packard*, and progenitor precedent *CBS* all involved identifications that were identical in part, or encompassing of one another.³⁵

³³ *See In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (“although the Board had before it a few registrations for both restaurant services and beer, . . . the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark.”).

³⁴ *See Harry Winston, Inc. and Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1437 (TTAB 2014) (“we presume that . . . goods move in all channels of trade normal for the identified goods, and that they are available to all classes of purchasers for those goods”).

³⁵ *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“the goods at issue are identical”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (“programs for information manipulation and apparatus for data acquisition and processing” and “conversion

That is not the case here – and why a mere lack of geographic or other limitations in the relevant identifications does not establish that the relevant goods and services travel in the same trade channels.

Cited’s goods move only in very specific channels of trade, namely medical suppliers and prescription pharmacies. Examining Attorney has shown no evidence that the Cited marks travel in those trade channels.³⁶

D. Purchasers of the Goods Associated with Applicant’s and Cited Marks are Likely to be Sophisticated and Knowledgeable.

To the extent that a customer is likely to exercise a high degree of care and/or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks.³⁷

Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject products fail to constitute “impulse” purchases.³⁸ Goods that are sold to consumers that have a sophisticated knowledge of a given activity are less likely to be confused with goods that are sold to a different class of sophisticated buyers.³⁹ As the likely potential buyers of products sold under the Applicant’s mark and those sold under a Cited mark are sophisticated and knowledgeable about their respective interests, the likelihood of confusion between the marks is greatly limited.

While the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion.⁴⁰ Here, Applicant and Cited products both are not “impulse” goods or services as discussed in *Astra Pharm*, as consumers will research and spend time on offerings made by the respective parties.

from one media form to another media”); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 USPQ 198, 199 (Fed. Cir. 1983) (applied-for goods “are identified so broadly that they could include” registrant’s goods).

³⁶ See *In re Bentley Motors Ltd.*, Serial No. 85325994, (TTAB 2013) (non-precedential) (evidence shows applicant’s goods marketed “solely and exclusively” through particular channels while cited marks do not move in those channels “notwithstanding that they do not recite any trade channel limitations”).

³⁷ See *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 102, 57 USPQ2d 1969, 1981 (2d Cir. 2001) (“The more sophisticated the consumers, the less likely they are to be misled by similarity in marks.”); *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480, 37 USPQ2d 1508, 1513 (2d Cir. 1996) (“The sophistication factor recognizes that the likelihood of confusion between the products at issue depends in part on the sophistication of the relevant purchasers.”).

³⁸ See, e.g., *Astra Pharm. Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983) (finding that blood analyzers that cost between \$35,000 to \$60,000 require careful consideration likely to result in added consumer scrutiny and examination).

³⁹ See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992).

⁴⁰ TMEP § 1207.01(vii).

The consumers of the Cited's good will be medical professionals and doctors along with their patients. The patient consumers will be obliged to follow the directions of their medical professional and will only be able to obtain the Cited's good under a prescription, making it impossible for an ordinary consumer to purchase the Cited's good on impulse. Doctors and medical professionals typically must do a minimum amount of research into a good which they will prescribe to a patient in order to avoid medical liability and because it is required of their profession. Therefore, the consumers of the Cited's goods will either be highly knowledgeable and sophisticated consumers or ordinary consumers who had to go get a prescription that would prevent any impulse purchases.

Along with the Cited's knowledgeable consumers, the Applicant's consumers are likely to be fitness and nutritional enthusiasts who purchase goods based on how they will affect their body and fit into their dietary regime. Such consumers are likely to have at least an above average amount of knowledge regarding nutritional and dietary supplements. In particular, the Applicant's good is a specialized nutritional supplement meant to replenish glycogen and improve bodily hydration. Consumers who would seek out and purchase the Applicant's product are unlikely to be unsophisticated and are unlikely to confuse performance related nutritional supplements with medical injury prescription gels such as the Cited's.

When the relevant trade channels overlap only in the commercial venue, that is, only professionals who design and construct finished products containing goods have even a possibility of confusion, the sophistication of the relevant purchasers weighs against a finding of likelihood of confusion.⁴¹ Here, the Cited's product can only be purchased directly by medical professionals, and can only be obtained by ordinary consumers upon the recommendation and prescription of a medical professional

Even if one provider's products may be purchased by the general public "on impulse, because such purchasers would have no knowledge of" the other party's corresponding products and mark, source confusion between the relevant marks is impossible.⁴² Here, Applicant's mark and the Cited Mark travel in separate trade channels. Therefore, even if the consumers are unsophisticated, confusion is improbable if not impossible. The marks operate in separate markets.

Furthermore, even using a least knowledgeable general consumer standard, it is unlikely that source confusion will take place. Where Applicant's offerings carry no express or implied

⁴¹ See *In re Bunn-O-Matic Corp.*, Serial No. 77137482, (TTAB 2010) (non-precedential); *In re HerbalScience Group, LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010) (manufacturers "must be assumed to be knowledgeable and careful purchasers").

⁴² See *In re HerbalScience Group, LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010).

association with the Cited mark, consumers should easily be able to differentiate Applicant’s mark as a unique source identifier resulting in no likelihood of confusion.

Any of the *DuPont* factors may play a dominant role in a given case.⁴³ A single factor may also be dispositive. *See Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Here, it is completely implausible that the sophisticated customers at issue would be likely to confuse Applicant’s and the Cited marks. In the present case, “the sophistication of the customers” would “strongly outweigh” any factors favoring a likelihood of confusion. *See Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213 (TTAB 2011).

E. The Extent of Potential Confusion Between Applicant’s and the Cited Marks is *De Minimis*.

The extent of potential confusion is a relevant factor in determining likelihood of confusion between marks.⁴⁴ When “there is not a practical likelihood of confusion” applications should be permitted to proceed, because the likelihood of confusion analysis is “not concerned with the mere theoretical possibilities of confusion, deception or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.”⁴⁵ Where the extent of potential confusion is *de minimis*, the factor should weigh against a finding of likelihood of confusion.⁴⁶

The extent of potential confusion between the marks in this case is *de minimis* “because of the limited number of overlapping potential purchasers of the parties’ goods and services, and their sophistication.”⁴⁷ As a practical matter, only a very limited number of potential purchasers will be exposed to both Applicant’s and a Cited mark.⁴⁸

Here, the extent of potential confusion is also *de minimis* because the goods in question are highly specialized.⁴⁹ Specifically, the Cited’s good is a professional grade medical wound

⁴³ *In re E.I. DuPont de Nemours & Co.*, 476 F.2d at 1362, 177 USPQ at 567.

⁴⁴ *See, e.g., IDV North America, Inc. v. Chatam International Incorporated*, Opposition No. 101522, (TTAB 1999) (non-precedential); *Franklin Loufrani v. Wal-Mart Stores, Inc.*, Opposition No. 91152145, (TTAB 2009) (non-precedential).

⁴⁵ *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1414 (TTAB 2010) (quoting *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992)) (internal quotations omitted).

⁴⁶ *See Bose Corp. v. Custom Electronic Design & Installation Assoc.*, Cancellation No. 92042327, (TTAB 2007) (non-precedential).

⁴⁷ *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1223 (TTAB 2011).

⁴⁸ *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 717-18, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992); *See In re Brar Business Enterprises*, Serial No. 85641460, (TTAB 2014) (non-precedential) (“extent of potential confusion also concerns the number of people who are likely to be confused”).

⁴⁹ *See In re Vinod Bhandari*, Serial No. 75255103, (TTAB 1999) (non-precedential); *Cf. In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009) (“goods involved here are the type of goods that would be marketed to and

dressings that can only be obtained by medical professionals or through a prescription provided by a medical professional.

The Cited's goods is available to only a select few consumers and can only be obtained through the approval of a medical professional. A prescription cream or gel such as the Cited's will not appear in the same channels of trade as the Applicant's widely available nutritional supplement and the consumers of each good will significantly differ. Accordingly, the extent of potential confusion is *de minimis*. The twelfth *DuPont* factor should weigh in favor of no confusion.

V. Conclusion

For the reasons outlined above, Applicant respectfully submits that confusion between these marks is not likely. It is well settled that a refusal under Section 2(d) of the Lanham Act requires a determination that there is a probability, rather than a mere possibility, of consumer confusion. That standard has not been met in this case. Therefore, Applicant requests that the Examining Attorney withdraw the refusal to register and approve this application for publication in the *Official Gazette*.

purchased by significant numbers of purchasers ... potential for confusion therefore cannot be deemed to be *de minimis*”).