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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Maximum Human Performance, LLC

Application No.: 88270997

Filing Date: January 22, 2019

Mark: CLINICAL

Class: 05

Examining Attorney: Brittany Johnson

Law Office: 126

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**APPLICANT'S RESPONSE TO OFFICE ACTION**

Pursuant to 37 C.F.R. §2.62(a) and TMEP § 711, Applicant Maximum Human Performance, LLC ("Applicant"), by and through its attorneys, respectfully submits this Response to Office Action (the "Response") regarding Application Serial No. 88270997 (the "Application") for the mark CLINICAL ("Applicant's Mark"). Applicant is responding to the Office Action dated March 26, 2019 (the "Office Action"). Applicant responds to each of the issues identified in the Office Action as follows:

I. **No Likelihood of Confusion Exists between Applicant's Mark, the Four Cited Prior-Filed Applications and the Four Cited Registrations**

The Examining Attorney has issued a refusal to register Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that it could be confused with the following four prior-filed applications and four registrations (collectively, the "Cited Marks"):

Mark	Application or Registration Number	Owner
CLINICAL CANNABIS	88047262	American Biosciences Corporation

CLINICALRX	87770252	Scienza Ltd
	87249415	Rev Compounding Pharmacy Ltd.
SENSA CLINCIAL	87552731	Quality IP Holdings, LLC
CLINICAL OPC	5075466	EuroPharma, Inc.
CLINICAL CURCUMIN	5567350	Water Pure, Inc.
DOCTOR'S CLINCIAL	4121131	Tuong Nguyen (Individual)
	4145603	Tuong Nguyen (Individual)

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register based on the remaining Cited Marks. The Examining Attorney cited Prior-Filed Application No. 88070471 in addition to the Cited Marks. Prior-Filed Application No. 88080471 is abandoned and will therefore not block Applicant's Mark from registration.

The standard for determining whether two marks are likely to be confused is set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01. The *DuPont* case establishes several factors to be considered in the analysis of whether two marks are likely to be confused under Trademark Act Section 2(d). Each factor may play a more dominant or diminished role, depending on the facts of each case. *DuPont*, 177 USPQ at 567. No single factor is dispositive. *Id.* The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. *See In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985).

The most relevant *DuPont* factors in this case are: (1) the dissimilarities in the appearance, sound, and commercial impression of Applicant's Mark and the Cited Marks; and goods and services identified by Applicant's Mark and the Cited Marks; and (2) the strength of the respective marks.

Under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not just possible. As the Second Circuit has stated, “likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely ‘possible.’” *Estee Lauder, Inc. v. Gap, Inc.*, 42 USPQ2d 1228, 1232 (2d Cir. 1997) (internal quotations omitted) *quoting* 3 J. McCarthy, *Trademarks and Unfair Competition*, § 23:2 (1996) (now at 4 *McCarthy on Trademarks and Unfair Competition* § 23:3 (5th ed. 2017)). When the relevant *DuPont* factors are considered in relation to Applicant’s Mark, each factor weighs in favor of allowing Applicant’s Mark to register.

**A. The Notable Differences in Appearance, Sound, and Commercial Impression of the Marks Precludes Likelihood of Confusion.**

When Applicant’s Mark and the Cited Marks are viewed in their entireties, as they must be, the differences are sufficient to avoid a likelihood of confusion. The similarity between the respective marks in their entireties as to appearance, connotation, and overall commercial impression are primary factors to consider in a *DuPont* analysis. 177 USPQ at 567. It is well settled that in assessing likelihood of confusion, marks may not be dissected, nor any element of a mark ignored. TMEP 1207.01(b); *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Since marks tend to be perceived in their entireties, similarities between marks are based upon the overall impression of the marks. *Opryland USA, Inc. v. Great American Music Show Inc.*, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) (“When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared.”).

**i. Applicant’s Mark and the Cited Marks Differ in Appearance.**

Similarity in appearance is a factor in determining whether there is a likelihood of confusion between marks. TMEP § 1207.01(b)(ii). When the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. TMEP 1207.01(c); *E.g., In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). The mere fact that marks share certain elements does not compel a finding that confusion is likely. *Gen. Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442, 1445 (8th Cir. 1987) and cases cited; *see also Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc. et. al.*, 4 USPQ2d 1942 (6th Cir. 1987). In considering the marks for purposes of a likelihood of confusion analysis no feature of the mark is ignored, and all components thereof must be given appropriate weight. *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1241 (Fed. Cir. 1990) *citing Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272 (CCPA 1974); *Opryland*, 23 USPQ at 1474.

Applicant’s Mark’s appearance is entirely unique in comparison to the Cited Marks. Each Cited Mark contains a unique element, differentiating each Cited Mark from Applicant’s Mark. Each Cited Mark contains a unique term that is not present in Applicant’s Mark such as Y, CANNABIS, RX, BIOSENSE, SENSEA, OPC, CURCUMIN, and DOCTOR’S. In addition, Applicant’s Mark has an entirely unique stylization that differentiates its appearance relative to

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each Cited Mark - . The unique blend of lowercase and uppercase letters, bold alternating fonts, and the accented “i” make Applicant’s Mark’s appearance stand out relative to the Cited Marks. To reach a conclusion that the marks are visually similar, one would have to ignore these distinct components.

While there may be wording in common in the respective marks, the word portion of a mark is not dispositive of whether there is likelihood of confusion. *See e.g., In re Electrolyte Laboratories*, 16 USPQ2d at 1240. In *In re Electrolyte Laboratories*, the Federal Circuit held that the overlapping marks, depicted below, for dietary potassium supplements were not likely to be confused because, even though the chemical symbols for potassium (K), potassium ion (K+) and the abbreviation for “effervescent” (EFF) in the marks could be vocalized, the combined design and letter features of the marks prevented confusing similarity. In reversing the decision of the Board, the Court stated that the Board erred in its focus on K+ in the marks to the exclusion of the other elements of the marks.

The logo consists of the text "K+EFF" in a bold, black, sans-serif font. The "K" and "E" are significantly larger than the "+" and "FF".

Similarly, the visual differences between Applicant’s Mark and the Cited Marks are such that the relevant consumers are not likely to confuse the respective marks in the marketplace:

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CLINICAL CANNABIS; ClinicalRx; SENA CLINICAL; Clinical OPC;

CLINICAL CURCUMIN; DOCTOR’S CLINICAL



### ii. Applicant’s Mark and the Cited Marks Differ in Sound.

The phonetic differences between Applicant’s and the Cited Marks preclude a likelihood of confusion. Similarities in sound and word structure are additional factors to consider in determining whether a likelihood of confusion exists. TMEP § 1207.01(b)(iv); *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 USPQ 848, 851 (TTAB 1983) (BABE v. BABOR; double as opposed to single sound); *HQ Network Sys. v. Executive Headquarters*, 755 F. Supp. 1110, 18

USPQ 2d 1897, 1902 (D. Mass. 1991) (different total number of syllables; use of one mark as a noun, the other as an adjective).

Applicant's Mark consists of three syllables, whereas the Cited Marks each contain five or six syllables. Thus, the Cited Marks are at least nearly twice as long in syllabic length than Applicant's Mark. Further, the unique terms contained in each Cited Mark, Y, CANNABIS, RX, BIOSENSE, SENSA, OPC, CURCUMIN, and DOCTOR'S each create a unique blend of consonants and vowels contrasting with the sound of Applicant's Mark. Applicant's Mark's original stylization also may differentiate the sound of the mark in relation to the Cited Marks. Applicant's Mark contains an accented "i" common to the Spanish language. Many prospective consumers may understand the mark to phonetically sound as "clin-EE-cal" in comparison to each Cited Mark's CLINICAL element phonetically reading as "CLIN-ih-cal." Alternatively, the Applicant's Mark capitalizes the "CAL" element of the its mark. Thus, some prospective consumers may emphasize the CAL portion of the pronunciation, while no Cited Mark would warrant such emphasis because no Cited Mark contains the unique capitalization found in Applicant's Mark.

In view of these factors, Applicant's Mark is phonetically and orally distinct from the Cited Marks, obviating a likelihood of confusion.

**iii. Applicant's Mark and the Cited Marks differ in Commercial Impression.**

The respective marks also convey very distinct meanings and commercial impressions. The meaning or connotation conveyed by marks in relation to the specified goods or services is a further factor in determining whether a likelihood of confusion exists. TMEP § 1207.01(b)(v); *see In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing; the Board found that the term connotes the phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

Consumers seeking the dietary supplements associated with Applicant's Mark may very well understand Applicant's Mark's capitalization of CAL to refer to "calories" because a consumer in the market for dietary supplements is likely to be keenly aware of the impact of calories on one's diet and the impact a dietary supplement may have on the consumer's caloric intake. None of the Cited Marks emphasize the "cal" element of the shared term CLINICAL, and none of the Cited Marks make any reference to calories in general. Thus, Applicant's Mark's stylization obviates any opportunity for consumer confusion in the commercial impression category with the Cited Marks. Moreover, the Cited Mark's unique terms – Y, CANNABIS, RX, BIOSENSE, SENSA, OPC, CURCUMIN, and DOCTOR'S – each conjure their own individual commercial impression in relation to both each other and Applicant's Mark.

**iv. Established Case Law Demonstrates that the Shared Elements in the Respective Marks Are Not Sufficient to Render Confusion Likely**

The fact that the marks at issue share similar wording does not automatically compel a finding that confusion is likely. Even when word marks with overlapping elements are applied to

arguably related goods or services, they can function to signify different sources. *See Gen. Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442, 1445 (8th Cir. 1987) (Kellogg, which used APPLE RAISIN CRISP for cereal, failed to show entitled to preliminary injunction against General Mills' use of OATMEAL RAISIN CRISP for cereal); *Little Caesar Enterpriser Inc. v. Pizza Caesar Inc.*, 4 USPQ2d 1942, 1444-45 (6th Cir. 1987) (LITTLE CAESARS for pizza not infringed by PIZZA CAESAR USA for an Italian restaurant).

Many TTAB and Federal Circuit decisions reiterate this requirement to compare marks in their entireties in order to assess whether they create a distinct commercial impression. Additional examples of cases in which marks with overlapping wording were found unlikely to be confused include the following:

- HEALTHY LIFE versus HEALTH FOR LIFE (both for vitamins and dietary supplements)
- GULP and BIG GULP (for large soft drink) versus GULPY (water dish for pets)
- NUTRI/SYSTEM versus NUTRI-TRIM (both for weight loss services)
- SWATCH versus T-WATCH (both for watches)
- PECAN SANDIES versus PECAN SHORTIES (both for cookies)
- TACO TOWN versus TACO TIME (both for restaurant services)

*Approved Pharmaceutical Corp. v. P. Leiner Nutritional Products Inc.*, 5 USPQ2d 1219 (TTAB 1987); *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715 (TTAB 2007); *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 1 USPQ2d 1809 (9th Cir. 1987); *Swatch Watch, S.A. v. Taxor, Inc.*, 229 USPQ 391 (11th Cir. 1986); *Keebler Co. v. Murray Bakery Prods.*, 9 USPQ2d 1736 (Fed. Cir. 1989); *Taco Time Intl., Inc. v. Taco Town, Inc.*, 217 USPQ 268 (TTAB 1982).

If all components of the respective marks are considered, as with the examples above, Applicant Mark and Cited Marks are not likely to be confused.

#### **B. USPTO Precedent Demonstrates that Applicant's Mark and the Cited Marks Can Coexist.**

In examining likelihood of confusion under Section 2(d), the Examining Attorney must consider the number and nature of similar marks in use on similar goods and services. As already observed above, Applicant contends that Applicant's Mark is sufficiently distinguishable from the registered Cited Marks.

A review of the records demonstrates that the Cited Registrations have coexisted on the Supplemental and Principal Registers without any apparent conflict or confusion for three years. The fact that there are eight registrations and applications all currently coexisting on the Principal and Supplemental Registry and all featuring the term "CLINICAL" for dietary supplements in class 05 supports the conclusion that registration of Applicant's Mark on the Principal Register will likewise not cause consumer confusion. As a result of the visual and aural differences and distinct commercial impressions between the respective marks, Applicant respectfully asserts that its Mark is no more similar to the Cited Marks than such marks are to

each other. *See e.g. Amstar Corp. v. Domino's Pizza, Inc.*, 205 USPQ 969, 975-76 (5th Cir. 1980) (evidence of third party uses and registrations of identical or related marks reduces the risk of a likelihood of confusion); *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (Applicant's stylized KEY mark for banking services was "no more likely to cause confusion with the five cited registered [KEY-formative] marks [for banking related services] than the five cited marks [were] likely to cause confusion with [each other and] the fifteen other registered marks that contain the term 'KEY'" for banking related services").

In this Office Action the Examining Attorney cited five prior-filed applications and four registrations owned by eight different entities; the number of third-party marks containing the element "CLINICAL" significantly weakens the scope of protection properly afforded to each. *In re Red Carpet Corp. v. Johnson American Enterprises, Inc.*, 7 U.S.P.Q.2d 1404 (T.T.A.B. 1988). It cannot be ignored that where numerous third parties in the same field use the same or similar marks, each mark tends to be a weak indicator of a single source and is accordingly entitled to only a limited scope of protection. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1396, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) ("Evidence of third party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection"); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 47 U.S.P.Q.2d 1672, 1676 (6th Cir. 1998); *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 226 U.S.P.Q. 123, 127 (11th Cir. 1985); *citing Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 211 U.S.P.Q. 844, 848-49 (5th Cir. 1981), and *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259, 205 U.S.P.Q. 969, 975 (5th Cir. 1980), *quoting Restatement of Torts* § 729 (1938) ("The greater the number of identical or more or less similar trademark already in use on different kinds of goods, the less the likelihood of confusion"). Based on the number of Cited Marks utilizing the CLINICAL component, it is improper to grant any single mark such a broad scope of protection as to cover the instant application.

The coexistence of the Cited Marks demonstrates that consumers are accustomed to differentiating between these marks. This coexistence suggests that consumers do not believe the goods and services identified by the Cited Marks emanate from a single source, thereby making it unlikely that consumers will be confused as to Applicant's Mark and the source of Applicant's Goods. Thus, Applicant's Mark will be able to peacefully coexist with the Cited Marks without any likelihood of confusion.

### **C. Summary**

In view of the foregoing, Applicant respectfully submits that the refusal under Trademark Act Section 2(d) based on the Cited Marks is inappropriate because the threshold of a probability of confusion has not been met. The differences between the respective marks' appearance, sound, commercial impression, and the limited scope of the registered marks compel the conclusion that the risk of confusion is remote. Applicant therefore respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal.

## **II. Section 2(e)(1) Refusal – Merely Descriptive**

The Examining Attorney refused registration of Applicant's Mark on the Principal Register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), based on a **cliníCAL**

finding that Applicant's Mark, \_\_\_\_\_, is merely descriptive of the Class 05 dietary supplements identified in the Application.

Adding stylization to descriptive or generic wording does not render the resulting mark registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself. TMEP 1209.03(w); *See In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-1640 (Fed. Cir. 2016). If descriptive or generic wording is in fact presented in a distinctive display or design, the mark as a whole may be registered with a disclaimer of the unregistrable component. TMEP 1209.03(w); *See In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1486-88 (TTAB 2012).

Applicant recognizes the descriptive nature of the word element CLINICAL when taken separate and apart from Applicant's Mark. However, Applicant's Mark's stylization creates a commercial impression separate and apart from the impression made by CLINICAL itself, thereby making Applicant's Mark eligible for registration. As explained in Section I of this **cliníCAL**

Response, Applicant's Mark \_\_\_\_\_ consists of a commercially distinctive display that both obviates any likelihood of confusion and any basis for a descriptiveness refusal in conjunction with a disclaimer Applicant's Mark's word element. The bold and lower-case font with an accented "i" followed by the upper-case word element "CAL" in slim font creates a commercial impression separate and apart from that of CLINICAL. Prospective consumers are likely to understand the CAL element to represent "calories," and the accented "i" alters the phonetics of the word element beyond the scope of the standard pronunciation for CLINICAL. The overall commercial impression is distinct from that of the Cited Marks and from that of the word element CLINICAL.

Applicant requests the following disclaimer for the descriptive component of Applicant's Mark:

**No claim is made to the exclusive right to use "CLINICAL" apart from the mark shown.**

In light of the disclaimer, Applicant respectfully requests the Examining Attorney to withdraw the Section 2(e)(1) refusal and approve the Application for publication and registration on the Principal Register because the mark as a whole is not descriptive.

### III. Conclusion

Applicant submits that with the amendments, responses, and arguments above, all of the issues raised by the Examining Attorney in the Office Action have been resolved. Applicant therefore respectfully requests that the Application be approved for publication.



The Examining Attorney is invited to contact the undersigned with any remaining questions or concerns.

Respectfully submitted,  
/Benjamin M. Cantor/

Benjamin Cantor  
Cantor Colburn LLP Attorneys for Applicant Maximum Human Performance, LLC

Our Ref: MHP0546TUS  
Benjamin Cantor  
Cantor Colburn LLP  
20 Church Street  
22<sup>nd</sup> Floor  
Hartford, Connecticut 06103-3207 U.S.A.  
Phone: 860-286-2929  
Fax: 860-286-0115  
Email: [TM-CT@cantorcolburn.com](mailto:TM-CT@cantorcolburn.com)