

This communication is in response to the Office Action issued May 8, 2019 for which response is due by November 8, 2019. The Examining Attorney has refused to register



Applicant's mark; (“Applicant’s Mark”) in International Class 5 for “drug substances, namely, enzymes; pharmaceutical preparations for the treatment of cellulite; pharmaceutical preparations for skin care; nutritional and dietary supplements; vitamins and mineral supplements; food supplements” (“Applicant’s Pharmaceuticals”), on the ground that such mark is likely to cause confusion with the following marks owned by Emerald Health Bioceuticals, Inc. (“Emerald Health”):

- U.S. Trademark Reg. No. 5431256 for ENDO BLISS for “dietary and nutritional supplements, medicinal herbal extract, nutraceuticals for use as a dietary supplement, Homeopathic supplements, nutritional supplements, with none of the aforementioned for use in connection with pain relief”;
- U.S. Trademark Reg. No. 5376856 for ENDO CALM for “dietary and nutritional supplements, medicinal herbal extract, nutraceuticals for use as a dietary supplement, Homeopathic supplements, topical preparations for use in treating skin maladies, all of the aforementioned not for use in connection with pain relief”;
- U.S. Trademark Reg. No. 5376857 for ENDO BRAIN for “dietary and nutritional supplements, medicinal herbal extract, nutraceuticals for use as a dietary supplement, Homeopathic supplements, topical preparations for use in treating skin maladies, all of the aforementioned not for use in connection with pain relief”; and
- U.S. Trademark Reg. No. 5376858 for ENDO SLEEP for “dietary and nutritional supplements, medicinal herbal extract, nutraceuticals for use as a dietary supplement,

Homeopathic supplements, topical preparations for use in treating skin maladies, all of the aforementioned not for use in connection with pain relief’;

(collectively the “Emerald Health Marks”);

as well as one mark owned by Thalya C. Demott (the “Demott Mark”):

- U.S. Trademark Reg. No. 2273477 for ENDO-FEM for “vitamin supplement sold without a prescription”

(collectively the “Cited Marks” and such registrations the “Cited Registrations”).

Applicant respectfully requests that the Examining Attorney reconsider his position and withdraw the likelihood of confusion rejection because there is no likelihood of confusion between Applicant’s Mark and the Cited Marks given: (1) the inherently weak and diluted nature of the Cited Marks; (2) Applicant has used ENDO in connection with pain medication since 1916, and Applicant already owns and has registered a substantial number of ENDO marks for similar prescription pharmaceutical goods in Class 5; (3) Applicant’s Mark is used in connection with sufficiently unrelated goods than those in the Cited Registrations; (4) the sophistication of the respective purchasers of both Applicant’s goods and the goods in the Cited Registrations; (5) the differing channels of trade of Applicant’s goods compared to the goods in the Cited Registrations; and (6) the Applicant’s Mark is sufficiently different in sight, sound, meaning, and commercial impression from the Cited Marks.

I. The Cited Marks are Diluted and Weak and are Entitled to Only a Narrow Scope of Protection.

The first step in analyzing marks for a likelihood of confusion is to determine the relative strength of the parties’ marks as “[t]he strength of a mark is directly related to likelihood of confusion.” *H. Lubovsky, Inc. v. Espirit de Corp.*, 627 F. Supp. 483, 486-87, 228 U.S.P.Q. 814

(SDNY 1986). “Strong” marks are granted “protection over a wider range of related products and services and variations on visual and aural format.” 2 McCarthy, *McCarthy’s On Trademarks and Unfair Competition* 5th ed. § 11.73. By comparison, “relatively weak marks are given a relatively narrow range of protection both as to products and format variations.” *Id.* §11.73. A mark (or portion thereof) may be inherently weak if it is descriptive or suggestive, *see In re Hartz Hotel Services, Inc.*, Serial No. 76692673, at 12 (noting that highly suggestive marks are afforded a scope of protection that is “quite limited”), and/or may become weak through dilution if the consuming public is exposed to third-party use of similar marks on similar goods and services, *see Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005) (noting such evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection”); TMEP § 1207.01(b)(ix) (“weak designations may be entitled to a narrower scope of protection”). Such weak marks are entitled to only a narrow scope of protection ““as to permit the use and/or registration of the same mark for different goods or a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods.”” *In re Hartz Hotel Services, Inc.*, *supra* (citing *Standard Brands Inc. v. Peters*, 191 U.S.P.Q. 168, 172 (TTAB 1976)). Therefore, third parties are able to “come closer” to weak marks without creating a likelihood of confusion with another user’s mark. *In re Lucky Co.*, 209 U.S.P.Q. 422 (TTAB 1980). In fact, where the “common element of two marks is ‘weak’” *either* inherently *or* through dilution, consumers are less likely to be confused as to the source of two marks comprising the same or similar element. TMEP § 1207.01(b)(viii).

Concerning the inherently weak nature of the Cited Marks, Applicant notes that ENDO as used in the Cited Marks is merely descriptive. In regard to the Demott Mark, the good

associated with ENDO-FEM is an herbal supplement to aid in the treatment of endometriosis for females. The Demott Mark's use of ENDO is meant to describe a quality and characteristic of the supplement - "Endometriosis," which is further shown by the current change of Registrant's website www.womensnaturalhealth.com to www.endometriosis.com. Registrant's website confirms the merely descriptive use of this mark. In fact, the entirety of the Demott Mark is inherently weak because it merely describes the good it is associated with – an herbal supplement to treat Endometriosis in Females, and should not have be federally protected without proof of secondary meaning. At a minimum, it is inherently weak and entitled to a narrow scope of protection. *See Exhibit A* for website screenshots and incorporated herein by reference.

In regard to the Emerald Health Marks, the goods associated with the Emerald Health Marks are cannabidiol (CBD) infused supplements to support the Endocannabinoid System. Not only does the use of the term ENDO in the marks denote "Endocannabinoid" but the term "Endo" is also used in connection with marijuana to merely describe the high-quality of the indoor grown marijuana (*see* <https://www.coloradopotguide.com/marijuana-glossary/endo/>). Accordingly, it is plain that the Emerald Health Marks are also inherently weak and, thus, entitled to only a very narrow scope of protection without proof of secondary meaning. *See Exhibit B* for website screenshots and incorporated herein by reference.

In fact, and importantly, the United States Patent and Trademark Office also agrees that the cited ENDO Registrations are weak and entitled to a narrow scope of protection as it has allowed the registrations of both the Emerald Health Marks and the Demott Mark to coexist even though owned by different entities. Emerald Health's registrations are for ENDO BLISS, ENDO CALM, ENDO BRAIN and ENDO SLEEP are all dietary and nutritional supplements, medicinal

herbal extract, nutraceuticals for use as a dietary supplement and Homeopathic supplements and Ms. DeMott's registration for ENDO-FEM is also for vitamin supplement. The USPTO believed that these respective ENDO marks, all for supplements and owned by different parties could coexist on the Principal Register is clear evidence that the USPTO believes that the Cited Registrations are weak and entitled to a very narrow scope of protection.

In further support of the fact that the Cited Registrations are weak and entitled to a narrow scope of protection, especially for supplements and vitamins, the USPTO has also granted registration to U.S. Trademark Reg. No. 5,655,849 for ENDOFLEX for, in part, "dietary and nutritional supplements; multivitamin preparations" in International Class 5 owned by Young Living Essential Oils, LC. See **Exhibit C** for website screenshots and incorporated herein by reference.

Moreover, the Cited Registrations are further diluted and weak as a result of multiple third party use of similar marks in connection with related goods and services. Applicant is further aware of the following multiple third party uses of marks comprising the term ENDO in connection with supplements and related goods and services:

- ENDO SUPREME for a dietary supplement primarily intended for use in combating fatigue and arthritis, as well as increasing libido, *see* [https://www.healthyhabitsliving.com/products/endo-supreme-90-capsules?gclid=EAIaIQobChMI7r7soKQ5QIVSj0MCh366QcUEAkYASABEgJxCPD_BwE](https://www.healthyhabitsliving.com/products/endo-supreme-90-capsules?gclid=EAIaIQobChMI7r7soKQ5QIVSj0MCh366QcUEAkYASABEgJxCPD_BwE;);
- ENDO A-C for a vitamin A and C supplement, *see* https://www.wellnessshoppingonline.com/supplements/endo-met-endo-a-c-180-tablets/?gclid=EAIaIQobChMI7r7soKQ5QIVSj0MCh366QcUEAkYBCABEgITzfd_BwE;
- ENDO-PAN for a pantothenic acid and zinc supplement, *see* https://www.wellnessshoppingonline.com/supplements/endo-met-endo-pan-90-tablets/?gclid=EAIaIQobChMI7r7soKQ5QIVSj0MCh366QcUEAkYByABEgKwF_D_BwE;

- ENDO-DREN for an adrenal supplement, *see* <https://www.wellnessshoppingonline.com/supplements/endo-met-endo-dren-90-tablets/>;
- ENDO-EX for an herbal liquid remedy to promote healthy endometrial lining, uterus and fallopian tubes, *see* https://www.nativeremedies.com/endoex-support-female-reproductive-health.html?utm_source=google&utm_medium=cpc&utm_campaign=NRSEM19&gclid=EAiaIQobChMI8qiioeQ5QIViJ6fCh0WwAajEAKYASABEgIFR_D_BwE;
- ENDO ADRENAL for a botanical extract for adrenal and endocrine support, *see* https://www.amazon.com/Cortisol-Primal-Herb-Supplement-Rhodiola/dp/B074N4Y89S/ref=sr_1_8?keywords=endo&qid=1570654728&s=hpc&sr=1-8;
- ENDO-OPTIMIZE for a natural supplement to improve egg and embryo quality in female patients with Endometriosis, *see* <https://www.reproductiveimmunologysupplements.com/order-now/#!/Female-Bundle/p/126458927/category=30928077>; and
- AXIS ENDO for a dietary supplement to support hormone metabolism in men and women, *see* <https://www.metagenics.com/axis-endo>.

See Exhibit D for website screenshots showing the aforementioned uses incorporated herein by Reference. These uses alone are enough to support that ENDO as used in the Cited Marks are diluted and weak.

Such extensive third party registration, use of, and the co-existence of the uses of marks comprising the term ENDO, shows that ENDO- is only entitled to “a narrow scope of protection” when used in connection with the goods offered under the Cited Registrations. *Palm Bay Imports, Inc*, 396 at 1373. Accordingly, consumers will place more emphasis on the differences between the Cited Marks and Applicant’s Mark and will be able to readily distinguish the same.

II. Applicant has Historically Used ENDO in Connection With Prescription Pharmaceuticals.

Notably, Applicant has used ENDO in connection with pain medication since 1916 and owns US Registration No. 0324936 that dates back to 1935 that covers tablets for the relief of pain

in Class 5. Endo owns the following ENDO registrations in Class 5 related to prescription pharmaceuticals:

5131687 ENDO ADVANTAGE



4552362



4347658

endo

4605917



4653200



2921176

2317044 ENDO LABORATORIES

2267677 ENDO GENERIC PRODUCTS

endo

2189503

2004648 ENDO

1995948 ENDODAN

1993892 ENDOCET

ENDO

0324936

See **Exhibit E** for copies of the aforementioned registrations that are included herein by reference.

III. The Goods Associated with Applicant's Mark and the Cited Marks are Sufficiently Unrelated so as to Alleviate any Likelihood of Confusion.

Applicant's Pharmaceuticals and the goods appearing in the Cited Registrations are sufficiently unrelated so as to alleviate any potential consumer confusion, particularly given the weak and diluted nature of the Cited Marks. *Cf. Heartspring, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 557 (10th Cir. 1998) (finding no likelihood of confusion between HEARTSPRINGS for educational materials and HEARTSPRING for a residential school for disabled children).

Applicant has amended its identification of goods to remove all references to nutritional and dietary supplements and to clarify that all of the indicated goods are related to pharmaceuticals and injections available only via prescription. Applicant's amended identification is as follows:

drug substances, namely, enzymes applied by injection available only via prescription; pharmaceutical preparations for the treatment of cellulite applied by injection and available only via prescription.

As amended, it is clear the Applicant's Pharmaceuticals do not include "nutritional and dietary supplements; vitamins and mineral supplements; food supplements" and "pharmaceutical preparations for skin care." It is plain that such goods, as amended, are now no longer related to the nutritional supplements appearing in the Cited Registrations. Simply put, consumers would not associate Applicant's pharmaceutical injections available only via prescription as originating from the same source as a provider for herbal, dietary, nutritional, and vitamin supplements, especially given the widespread use of ENDO marks by various third parties in the nutritional and vitamin supplement field as discussed in Section I above.

The Examining Attorney's Cited Registrations are not related let alone identical to the heavily regulated FDA approved prescription pharmaceutical preparations and enzymes applied via injection that Applicant's goods will entail. Further, the use of enzymes in the amended goods is no longer indefinite and has been clarified to specifically be used in connection with injections available only via prescription. Though the ingestion of enzyme containing foods for skin care has been widely known for uses such as exfoliation, anti-inflammation, and the prevention of oxidative damage, the use of enzymes in pharmaceutical injections is not widely known nor widely used given their complexity and, particularly, not used by laymen who require the means to regulate the pH and temperatures of the environment for the enzymes to be effective. In relation to "topical preparations for use in treating skin maladies" of the Emerald Health Marks, Applicant's Pharmaceuticals as amended are neither related nor identical to the goods applied in the Emerald Cited Registrations. Applicant's heavily regulated FDA approved prescription pharmaceutical preparations and enzymes applied via injection that Applicant's goods will entail skin care solutions are directed only toward cellulite and are prescription based pharmaceutical injections which are highly tested and FDA regulated. Accordingly, these FDA regulated prescription based pharmaceutical injections are not overlapping with or related to mere unregulated topical preparations for skin care intended to support the Endocannabinoid System.

IV. Purchasers of Applicant's Pharmaceuticals and the Goods in the Cited Registrations are Sophisticated.

An additional factor that supports there is no likelihood of confusion between the respective marks is the sophistication of the consumers. Where purchases reflect careful, sophisticated purchasing versus "impulse" purchasing, consumer confusion is less likely. *In re E.I. DuPont DeNemours & Co.*, 476 F2d 1357, 1361 (C.C.P.A. 1973); TMEP § 1207.01(d)(vii)

(explaining that where goods are bought in circumstances suggesting care in purchasing, likelihood of confusion is minimized). The targeted consumers of Applicant's Pharmaceuticals are medical professionals, such as dermatologists and plastic surgeons, who are seeking to treat their patients with Applicant's Class 5 pharmaceuticals. The decision to use Applicant's Pharmaceuticals will be made either by the medical professional alone or made in conjunction with the patient. However, due to their nature, Applicant's products cannot be offered over the counter or used directly by patients.

Moreover, the cost to purchase Applicant's Class 5 pharmaceutical application in a doctor's office will be very expensive – likely hundreds of dollars an application and potentially in excess of a thousand an application depending on the scope of the application.

Consumers of the nutritional supplements of the Cited Marks are also sophisticated. Choosing what supplements to buy and ingest requires a high degree of care, particularly when in recent years news outlets have warned consumers of the inferior, and potentially harmful, ingredients in unregulated supplements. In examining dietary supplements in the marketplace, “researchers found banned, or even experimental and potentially dangerous pharmaceutical grade ingredients, in dietary supplements.” Kathleen Doheny, *What's Really in Those Dietary Supplements? Fair Warning for Patients*, EndocrineWeb, June 6, 2019, <https://www.endocrineweb.com/professional/endocrinology/popular-dietary-supplements-contain-hidden-harmful-substances>. With the rise in use of dietary supplements coupled with the risk associated with ingesting low quality supplements, consumers are increasingly doing their homework to ensure the companies they buy their supplements from are using good manufacturing practices, using quality ingredients, getting certifications, and researching the safety and efficacy of their products. Nick Lugo, *Nutritional Supplements – Why Quality is*

Important!, LugoNutrition, Apr. 6, 2018, <https://lugonutrition.com/collagen/nutritional-supplements-quality-important/>.

Further, nutritional supplements are expensive and Emerald Health's supplements are very expensive. There is a wide range of prices for dietary supplements starting as low as \$0.01 per capsule. Comparatively, the top five (5) supplements noted in Worthly's list of "The Most Expensive Nutritional Supplements", <https://worthly.com/most-expensive/expensive-nutritional-supplements/>, cost between \$0.52 per capsule upwards to, at most, \$0.67 per capsule. *See Exhibit F* for website screenshots and incorporated herein by reference, as well as for website screenshots of the most and least expensive supplements designated on Worthly's list for comparison. The most expensive goods associated with the Emerald Health Marks, for example, cost more than the most expensive supplement on Worthly's list at \$0.75 per capsule, with the cheapest goods associated with the Emerald Health Marks costing no less than \$0.60 per capsule. This makes Emerald Health's goods one of the most expensive dietary supplements on the market. Purchasers of costly products are classified as sophisticated. Jerome Gilson & Anne Gilson LaLonde, *Trademark Protection and Practice* § 5.08 (2004) (asserting that the courts classify sophisticated purchasers as having either "special training" or "purchas[ing] costly product"); *McCarthy, supra* at §§ 13.95-23.102 (identifying price, class of purchasers, and other factors relevant to the degree of consumer sophistication). Given the high cost of the goods associated with the Cited Marks, purchasers will spend greater time, attention, and/or care in deciding whether to make the purchase. As such, consumers of the Cited Marks are sophisticated not only due to the high degree of care required in purchasing safe and effective supplements but also due to the high cost of the goods associated with the Cited Registrations.

There is no realistic probability of a likelihood of confusion when the consumers of Applicant's Pharmaceuticals are sophisticated medical professionals and the expected cost of an application of injections of Applicant's Pharmaceuticals is hundreds if not a thousand dollars, and the consumers of the goods associated with the Cited Marks expend significant time and energy in deciding whether such a high cost product is the right choice for them.

V. The Channels of Trade Differ for Applicant's Pharmaceuticals and the Cited Marks' Goods.

There is no overlap between the consumer bases of Applicant's Pharmaceuticals and the goods associated with the Cited Marks. The consumers of the goods associated with the Emerald Health Marks are purchasers who aim to support the Endocannabinoid System which purportedly aids in, among other things, pain relief, whole body wellness, quality of sleep, immune system response, mood, and mental acuity and cognition. To buy any of these products, consumers can do so online directly from Emerald Health's website, *see* <https://emeraldhealthbio.com/>, from participating online retailers, *see* <https://emeraldhealthbio.com/pages/where-to-buy>, or from retail stores located in Pennsylvania, California, Texas, and Nevada, *see* <https://emeraldhealthbio.com/apps/store-locator/>. Whereas, the consumers of the goods associated with the Demott Mark are females attempting to treat endometriosis. The Demott Mark goods are currently unavailable for sale. *See* Google Shopping search results for the absence of goods associated with the Demott Mark while the website is under construction https://www.google.com/search?q=endo-%22fem%22+womens+natural+health&rlz=1C1GCEJ_enUS865US866&source=lnms&tbm=shop&sa=X&ved=0ahUKEwiUytDOxZTIAhWig-AKHaxwA9IQ_AUIEigB&biw=1680&bih=969. *See* **Exhibit G** for website screenshots and incorporated herein by reference

On the other hand, the consumers of Applicant's Pharmaceuticals will be dermatologists or plastic surgeons who are treating patients for cellulite and other aesthetic concerns with prescription pharmaceutical injections. Patients in need of Applicant's Pharmaceuticals cannot buy such goods directly online or through participating retail stores and must go to their dermatologist or plastic surgeon to receive an injection to acquire the pharmaceutical enzyme. Goods and services are related where there is "likely to be sufficient overlap of the respective purchasers of the parties' goods and services to confuse actual and potential purchasers." *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992). In this case, there is no overlap between the respective purchasers. The channels of trade are distinct and the goods themselves are unrelated. Considering the differences in the goods, the respective channels of trade, and the sophistication and distinct consumer group, and the expense of the respective goods, there is no likelihood of confusion.

VI. The Applicant's Mark and the Cited Marks are Sufficiently Different in Sound, Meaning, Appearance, and Commercial Impression

In reviewing the likelihood of confusion between marks, the Examining Attorney must also look at the marks themselves for similarities in appearance, sound, connotation, and commercial impression. Here, Applicant's Mark is visually different from the Cited Marks, containing only the term ENDO in all lower case text, preceded by a geometric figure forming the letter 'e'. The Cited Marks contain additional terms subsequent to the term ENDO that identify the associated good (i.e. ENDO *SLEEP* for supporting the Endocannabinoid System in such a way that helps regulate a healthy sleep-wake cycle or ENDO-*FEM* for regulating endometriosis in females). See **Exhibit H** for website screenshots of the associated goods with the Emerald Health Marks showing the additional terms identify the associated goods.

The marks, when viewed in their entirety, have different meanings and create different commercial impressions that will be readily apparent to their respective consumers. Importantly, even identical or closely similar marks may not give rise to a likelihood of confusion because the meanings they convey in each context will point to a distinctly different direction. *Revlon, Inc. v. Jerell, Inc.*, 11 U.S.P.Q.2d 1612, 1616 (S.D.N.Y. 1989) (stating that “[s]uch differences of connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used.”). In light of the dissimilarities in appearance, sound, connotation, and commercial impression, consumers of Applicant’s Pharmaceuticals and consumers of those goods associated with the Cited Marks will not likely be confused.

Based on these factors, Applicant respectfully requests that the Examining Attorney reconsider his conclusion that there might be a likelihood of confusion between Applicant’s Mark and the Cited Registrations.

COMMENTS

It is believed that Applicant has responded to all of the Examining Attorney’s questions and objections and that the application is now in a condition to go forward to publication.