

RESPONSE TO OFFICE ACTION

T.M. MYNE

Application No. 88/301,853

Attorney Ref. No. 6592-101917-01

This is in response to the Office Action dated April 23, 2019.

Recitation of Goods

Please amend the recitation of goods as follows:

Class 5 [REVISED]: *Dietary and nutritional supplements; vitamin and mineral supplements; food supplements; weight management ~~products~~ supplements; meal replacement bars for weight loss purposes; dietary supplement ~~food bars, drink mixes, teas~~; all-purpose disinfectants; protein supplements in powder form, powders; ~~powders used in the preparation of sports drinks; preparations for making beverages~~; and powdered concentrate for making nutritional supplement beverages*

Class 5 [AS REVISED]: *Dietary and nutritional supplements; vitamin and mineral supplements; food supplements; weight management supplements; meal replacement bars for weight loss purposes; dietary supplement drink mixes; all-purpose disinfectants; protein supplements in powder form, and powdered concentrate for making nutritional supplement beverages*

REMARKS

Alleged Likelihood of Confusion

The Examiner has refused registration of Applicant's mark based on an alleged likelihood of confusion with the mark MINE, Application No. 87/123,982 (the "Cited Mark") reciting:

biopharmaceutical preparations for use in the treatment of immunological conditions; biopharmaceutical preparations for use in the treatment of tumors; biopharmaceutical preparations for use in the treatment of immune system conditions; medicinal preparations for the treatment of infectious diseases and for use in oncology; biopharmaceutical preparations for personalized cancer immunotherapies and immuno-oncology therapies" in class 5, and

pharmaceutical and medical research and development in the fields of pharmaceutical and biological preparations used in the diagnosis and treatment of cancer and pharmaceutical and biological preparations used in active specific immunotherapy for the treatment of cancer; providing medical and scientific research information in the fields of pharmaceuticals, biologicals, and clinical trials; providing immunotherapy and immuno-oncology platforms in the nature of the development of biochemical assays for the treatment of immune system conditions and cancer in class 42

Currently, the MINE application remains suspended.

Due to the differences in the marks themselves in both sight and meaning (note also that MYNE is a coined term), the significant differences in the respective goods, the different consumer sets, different channels of trade, and the high sophistication level of the consumer set for the Cited Mark for the mark MINE, Applicant disagrees that there is a likelihood of confusion and respectfully requests reconsideration.

a. The Respective Marks are Significantly Different in Sight and Meaning such that Confusion is Not Likely

The Federal Circuit recently reminded the Trademark Trial and Appeal Board that when analyzing whether a likelihood of confusion exists between two marks, it must consider all the *du Pont* likelihood-of-confusion factors. *In re Guild Mortgage Company*, Case No. 2017-2620 (Fed. Cir. Jan. 14, 2019). As the Office knows, besides the dissimilarities of the marks themselves, other factors such as differences on the goods, differences in the channels of trade, differences in consumer sets, and sophistication levels of the consumers are to be considered. Furthermore, the different consumer sets and the sophistication level of the respective consumers also weigh heavily in this analysis (discussed below). Accordingly, the similarity of the marks is not dispositive of the likelihood of confusion question in this case.

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). 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. Rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar, but a similarity of one factor is not dispositive of the entire analysis. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

First, when looking at the similarities (and dissimilarities) of MYNE versus MINE, several differences stand out, including the differences in sight, the differences in meaning and the different commercial impressions the marks make on consumers.

MYNE and MINE are significantly different visually, as the “Y” in MYNE is visually striking. In addition, MYNE is a coined term, giving more dominance to the visual differences from the Cited Mark. Further still, MYNE has no meaning whereas MINE, the Cited Mark, is a well-known word with a well-known meaning. MINE gives the consumer the immediate understanding of something that belongs to one’s self. The present trademark however, being a non-word (a coined term) evokes no immediate meaning at all in the consumer. These differences between MYNE and MINE result in a significantly different impression on consumers.

It should also be noted that the Federal Circuit has indicated, a strong phonetic similarity alone is insufficient to establish a likelihood of confusion as a matter of law. *Olde Tyme Foods, Inc. v Roundy’s, Inc.* 961 F.2d 200, 203 (Fed Cir. 1992) (OLD TYME for donuts, rolls, buns, bread, fruit pies and ice cream not confusingly similar as a matter of law to YE OLDE TYME for cakes, cookies, muffins, tortillas and breading).

Based on the differences in the marks visually, differences in meanings and the resulting different commercial impressions the marks themselves make, confusion does not appear likely.

b. The Respective Goods of the Marks are Sufficiently Different such that Confusion is not Likely

Applicant’s nutritional and dietary supplements are significantly different from the Cited Mark’s biopharmaceutical preparations for use in the treatment of immunological conditions, infectious diseases, and oncology, such that confusion is not likely.

Besides being apparent from a plain reading of the recitation of goods of the Cited Mark, as stated in the file history for the Cited Mark (see Response to Office Action filed herewith as Exhibit A), it is a clinical-stage biotechnology company that produces cancer immunotherapies goods. The Cited Mark has had an application for the mark CELLMINE cited against it. The goods of the CELLMINE application are noted by Applicant of the Cited Mark, as being “laboratory assays for use in detecting circulating tumor cells for scientific research purposes” (Class 1) and “laboratory assays for use in detecting circulating tumor cells for medical diagnostic purposes” (Class 5). Applicant of the Cited Mark responds to the likelihood of confusion rejection with the explanation that its goods comprise *biopharmaceutical preparations for use in the treatment of immunological conditions, infectious diseases, and oncology, including personalized cancer immunotherapies and immune-oncology therapies*. Applicant of the Cited

Mark indicates that its biopharmaceutical preparations are very specific goods and target a very specific consumer set.

The present application recites: *dietary and nutritional supplements; vitamin and mineral supplements; food supplements; weight management supplements; meal replacement bars for weight loss purposes; dietary supplement drink mixes; all-purpose disinfectants; protein supplements in powder form, and powdered concentrate for making nutritional supplement beverages*. Such pedestrian goods are vastly different from the Cited Mark's highly specific and sophisticated *biopharmaceutical preparations for use in the treatment of immunological conditions, tumors, immune system conditions, and medicinal preparations for the treatment of infectious diseases, oncology and for personalized cancer immunotherapies and immuno-oncology therapies*. The significant differences in goods also argue against a finding of a likelihood of confusion.

c. The differences in the Respective Channels of Trade also Indicate there is No Likelihood of Confusion

As mentioned above, the goods of the cited MINE Application are *biopharmaceutical preparations for use in the treatment of immunological conditions, infectious diseases, and oncology, including personalized cancer immunotherapies and immune-oncology therapies and used in association with treatment regimens*. Such types of pharmaceutical goods are marketed to and prescribed by doctors, and are typically administered in hospitals and cancer treatment clinics. As to the use of such goods for research, clearly those channels of trade are to scientists through the scientific community. The channels of trade for medicines marketed to doctors for cancer treatments and to scientists for research *per se* differ significantly from the general availability of the nutritional supplements and the like sold by Applicant to everyday consumers.

d. The Sophistication Level of the Consumers and the Different Consumer Sets also Indicate that Confusion is Not Likely

Also of significance in the present case is the *du Pont* factor regarding the sophistication level of the consumers. The courts will look to the sophistication of the buyers of the goods or services as a factor in determining whether there is a likelihood of confusion. Courts have found that sophisticated buyers, such as those who have expertise in a specific area, are less likely to be confused by similarities in marks. In addition, courts have held that consumers of goods and services that are expensive, exercise a higher degree of care in making these expensive purchases. As such, the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.* 954 F.2d 713, 718, 21 USPQ2d 1388 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties' goods and services "are usually purchased after careful consideration by persons who are highly

knowledgeable about the goods or services and their source.”). See also TMEP §1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion).

The Cited Mark is marketed by a clinical-stage biotechnology company that specializes in developing cancer immunotherapies. Its recited services include the research of investigational immunotherapies. The Cited Mark’s goods are marketed to and prescribed by a physician if used for treatment of a patient. If used for research (as indicated in its class 5 and 42 goods and services and its explanation in the file history) then they are sold to highly educated scientists. As such, there is no realistic likelihood that such prescribing doctors and/or cancer and immunotherapy R&D scientists will be confused by a nutritional supplement sold under a different mark.

Further, the goods of the Cited Mark are “*personalized cancer immunotherapies and immunology therapies*,” which clearly are expensive prescription drugs. The Cited Mark’s consumers are not your everyday consumer. The Cited Mark’s target audience are highly educated consumers in a specialized field, such as prescribing medical professionals, e.g., doctors, pharmacists, research biotechnologists and the like, in the immunological and neopeptide-based immunotherapy fields. These are not impulse buyers, but instead are sophisticated purchasers. The respective educated consumers exercise a high degree of care when purchasing such goods due to the importance of the respective role that the goods play in a person’s cancer treatment.

Because the consumer sets differ almost completely or completely, and because such sophisticated consumers use a greater degree of care in their purchases and thus readily distinguish different marks, for these reasons as well there is no likelihood of confusion.

Lastly, it is notable that there is no evidence or indication that Applicant’s nutritional products consumers would ever even be exposed to the Cited Mark’s goods. They are a completely different consumer sets, which also weighs against any existence of a likelihood of confusion.

Publication of Trademarks is Part of the Law that Allows the Owner of the Cited Marks to Object Should it Believe Its Rights Extend That Far

Applicant lastly notes that a finding of a likelihood of confusion must be probable, and not merely possible, to warrant rejection of registration on such grounds. See McCarthy, *supra*, Vol. 4, Section 23:3, pages 23-15-17 (December 2006) (citing *American Steel Foundries v. Robertson*, 269 U.S. 372 (1926)). Here, there are noteworthy differences in the respective consumer sets, the goods, as well as a high sophistication level of the consumers of the Cited Mark, all of which play an important role in this analysis and weigh against a finding of a likelihood of confusion. Furthermore, the standard procedures for publication and opposition are set up for this very purpose. Publication provides notice to the public and allows a registrant who believes registration of a mark may infringe their rights can oppose the application.

For at least the above reasons, there would be no likelihood of confusion.