REMARKS/ARGUMENTS

I. INTRODUCTION

The present application is for:

Mark: PUREWAVE

Goods: (before entry of this amendment)
Hand-held electric massage apparatus for therapeutic purposes, namely, hand-held electric massagers for massaging the back, neck, feet, arms, and legs

The Examining Attorney has rejected the proposed mark under §2(d), 15 U.S.C. §1052(d), as being confusingly similar to the mark in:

Reg. No.: 4,925,190

Mark: PURWAVE

Goods: device for non-surgical cosmetic treatments, namely, an electric massage apparatus

Applicant thanks Examining Attorney Kung for the Office Action. Reconsideration of the application in view of the amendments and remarks contained herein is respectfully requested.

II. THE MARKS ARE DIFFERENT, AND WOULD BE PERCEIVED AS BEING DIFFERENT

With respect to the marks, the Examining Attorney contends that. "The marks are . . . visually highly similar, are phonetically identical, and have the same meaning and commercial impression." (Office Action at p. 2).

Applicant respectfully disagrees. Applicant's mark is two English language words concatenated: "PURE" and "WAVE," i.e., to pronounce Registrant's mark as Applicant's mark.

The registered mark, on the other hand, is the non-existent word PURWAVE. Upon viewing the mark, and consistent with the mark being one word, a consumer might easily perceive the "PUR" part to be pronounced "p~~ur~~r" or "pər," as in the purr of a cat, or as pronounced in:

purchase	pursue
purgatory	purview
purloin	purvey
purple	purpose.

Certainly, a prospective purchaser, when purveying the mark PURWAVE but before pursuing a purchase from the purveyor, might believe that the owner of the mark purposefully or at least purportedly intended the "PUR" to be pronounced pʊr as in "PURR."

In fact, when reviewing the words that begin with "pur" in a dictionary, the undersigned can find *no instance* of when "pur" at the beginning of a word followed by a consonant is pronounced "pyoor" as in PURE. Rather, every time that "pur" at the beginning of a word is followed by a consonant, the "pur" is pronounced "pʊr" or "pər". Whenever "pur" is pronounced "pyoor," it is *always* followed by a vowel as in:

pure
purify.

Thus it would be contrary to all English language experience to pronounce "PURWAVE" as "Pure Wave," i.e., to pronounce the Registrant's mark as Applicant's mark.

Furthermore, overall the pronunciations of "pʊr" and "pər" as in "purchase" and "puview" at the beginning of a word are much more common in the dictionary than "pyoor."

Because words that begin with "pur" are always pronounced "pʊr" or "pər" when followed by a consonant, Applicant respectfully submits that a consumer is more likely to perceive the mark PURWAVE as being pronounced "pʊr-wāv" or "pər-wāv" rather than "pyoor-wāv."

At the very least, upon viewing the mark a consumer would need to pause and consider how "PURWAVE" should be pronounced: Should it be pronounced "pʊr-wāv" as in "purchase" and "purview," or as a deliberate misspelling of "PURE WAVE"? Even if the consumer concludes that "PURWAVE" is a deliberate misspelling of "PURE WAVE," that noticed deliberate misspelling renders the mark distinctive, and clearly not the same mark as "PURE WAVE" spelled correctly but simply concatenated into one word.

Applicant respectfully submits that consumers would not expect a company to use two *different* versions of the same phonetic mark -- one a proper spelling, and the other a deliberate misspelling -- to convey to the public that both are from the same company. For example,

consumers would not expect Hasbro to produce both a PLAYSKOOL line of toys and a "PLAYSCHOOL" line of toys. Companies don't do that, and consumers know that.

Indeed, both the Trademark Trial and Appeal Board (TTAB) and the federal courts including the Court of Appeals for the Federal Circuit recognize that misspellings can render marks to be distinctly different. See, e.g., *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 1350, 98 U.S.P.Q.2d 1253, 1256 (Fed. Cir. 2011) ("This court has found mark dissimilarity when the words are spelled differently") (upholding the Board's determination that "CAPITAL CITY BANK" for banking and financial services are unlikely to be confused with opposer's registered "CITIBANK" marks for those same services, due to differences in appearance, sound, connotation, and commercial impression, in view of the facts that, *inter alia*:

> (2) 'City Bank' is two words, not a compound word, and
> (3) applicant's 'City' is spelled with a 'y,' not an 'i.').

Id. See also *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (affirming TTAB's conclusion that CRYSTAL CREEK for wine including champagne is not confusingly similar to CRISTAL for those same goods).

Accordingly, when consumers view PURWAVE and PUREWAVE, consumers would recognize the two as being different marks. Consumers would not expect them to emanate from the same source.

III. THE GOODS ARE MUTUALLY EXCLUSIVE, AND ARE SOLD THROUGH COMPLETELY DIFFERENT CHANNELS AND ARE USED IN DIFFERENT WAYS BY DIFFERENT USERS

A. The Registrant's Goods are Device for Cosmetic Treatments, for Use by Cosmetologists

The registrant's goods are:

> device for non-surgical cosmetic treatments, namely, an electric massage apparatus.

The goods are specified as being "for non-surgical cosmetic treatments." "Cosmetic treatments" in this context apparently refers to reducing lines and wrinkles. (Lee Decl. ¶ 10). Those goods would be apparently sold to professional cosmetologists and would be unlikely to be sold to individual consumers.

B. Applicant's Goods are Massagers for Therapeutic, Non-Cosmetic Use

In contrast to the Registrant's goods, Applicant's goods as amended are:

> Hand-held electric massage apparatus for therapeutic non-cosmetic purposes, namely, hand-held electric massagers for massaging the back, neck, feet, arms, and legs

The Examining Attorney contends that the goods are "possibly overlapping." (Office Action, Section II.B.)."

That is not correct. Applicant's Massagers are for *therapeutic* purposes, not for cosmetic purposes. In order to emphasize this distinction, the list of goods now specifically recites "therapeutic non-cosmetic purposes." There is now -- by definition -- no overlap of the goods.

The goods are much different goods. As explained by Mr. Steven Lee who is the CEO of Applicant Pado, Inc. ("Pado"):

- The goods are distinctly different.
- Cosmetic (anti-wrinkle) massagers are not suitable for use as therapeutic massage purposes; they are much too small and weak to deliver a therapeutic massage.
- Consumers who purchase cosmetic (anti-wrinkle) massagers are generally different consumers, who purchase the products for much different reasons, than consumers who purchase therapeutic massagers.
- Cosmetic (anti-wrinkle) massagers are not displayed and promoted at the same trade shows as therapeutic massagers.

(Lee Decl. ¶¶ 9-17).

In sum, there is no overlap between cosmetic (anti-wrinkle) massagers and therapeutic massagers. Furthermore, the list of goods has been amended to eliminate any possible overlap.

C. The Examiner's Evidence Does Not Demonstrate any Overlap of the Goods

The examiner has cited to the following as "evidence showing that electric massagers for cosmetic use are also commonly intended for use in massaging other parts of the user's body:"

> **[1.]** https://www.amazon.com/Multifunctional-Electric-Massager-Whitening-KLX-9902EMS/dp/B07FDZ2WMX - goods are a "multifunctional electric face massager" for cosmetic purposes, also "suitable for all your body";\
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> **[2.]** https://www.amazon.com/Massager-Electric-Instant-Anti-Wrinkles-Tightening/dp/B07N59NYBX/ref=pd_cp_194_1?pd_rd_w=QEhst&pf_rd_p=ef4dc990-

a9ca-4945-ae0bf8d549198ed6&pf_rd_r=YSRFXYB9CJSA9VS6FTYG&pd_rd_r=885c148f-240c-4fedba1c-5e4caca4f5b1&pd_rd_wg=VA3oM&pd_rd_i=B07N59NYBX&psc=1&refRID=YSRFXYB9CJSA9VS6FTYG – goods are an electric "face massager" intended to improve the user's appearance, also for use in massaging other body parts; and

[3.] https://akirabeauty.com/products/carat-ray?variant=19716358176827&currency=USD&gclid=EAIaIQobChMIwLLzwy35AIVCJ6fCh3sHAkKEAkYAyABEgLdHvD_BwE – an electric massager for use on the face and other body parts.

The cited websites do not demonstrate that there is any overlap between Registrant's goods and Applicant's goods.

1. Reference #1

Reference #1 is a "Multifunctional Electric Face Massager Machine Needle Free Cosmetic Anti Wrinkle Firming Whitening Skin Care KLX-9902EMS" which says in relevant part:

> It help you to make anti wrinkle face.
> Firming face skin which make you more beautiful.
> It whitening eye, face which is multifunctional.
> Suitable for all your body.

This advertising copy seems to indicate that the device would be suitable for cosmetic purposes ("anti wrinkle" and "make you more beautiful") on possibly other parts of the body, but does not indicate that the device delivers a *therapeutic* massage on the muscles of, e.g., the legs, arms, shoulders, as with Applicant's goods.

2. Reference #2

Reference #2 is a "2-IN-1 Beauty Bar 24k Golden Pulse Facial Face Massager, Electric 3D Roller and T Shape Arm Eye Nose Head Massager Instant Face Lift, Anti-Wrinkles, Skin Tightening, Face Firming" showing the following image:

Although the ad copy mentions use on the body, this device is so small, and uses only a single AA battery ("NOTE: Requires one AA battery (not included) . . . ") that it would be badly underpowered and would definitely not be suitable for use as a therapeutic massager for, e.g., the back, shoulders, and legs, as with Applicant's goods.

3. Reference #3

Reference #3 is a small device that has "The Double Drainage [that] Rollers grip and glide to replicate the 'kneading' manipulations that help firm and tighten your skin." It "Helps rejuvenate your skin's radiance and suppleness with grip and glide action. Coated in a brilliantly bright platinum, it is compatible for even delicate skin." The product is shown below.

The product "Features a large solar panel for generating 'microcurrent.'" Other than the solar panel for generating "microcurrent," it appears to be a completely manual device that does not even have a motor in it. It is not an electric massage device. It does not fall within either the

Registrant's goods nor Applicant's goods. Accordingly, it does not validly evidence any overlap between Registrant's goods and Applicant's goods.

4. The Goods are Mutually Exclusive, Would be Sold to Different Purchasers, and Would be Used in Different Ways for Different Purposes

The goods are mutually exclusive. Registrant's goods are for cosmetic purposes, i.e., for reducing lines and wrinkles in the face. In contrast, Applicant's goods are for delivering therapeutic (muscle) massage in the user's back, neck, feet, arms, and legs.

There is no overlap between Registrant's goods and Applicant's goods. (Lee Decl. ¶ 9-17). Applicant's goods as amended now specifically exclude the registrant's goods of devices for non-surgical cosmetic treatments.

Additionally, the goods would be sold to different purchasers. The Registrant's devices for non-surgical cosmetic treatments would apparently be sold to professional cosmetologists for use in professional cosmetology environments such as in doctors' offices or possibly in beauty salons.

In contrast, Applicant sells its products directly to consumers via Applicant's own website and Amazon (Lee Decl. ¶ 20), as well as on eBay, not to professional cosmetologists. (Lee Decl. ¶ 20). Applicant's goods will be used by the individual purchasers in their own homes for personal use as a massager on themselves or possibly on their partners.

The undersigned conducted an Internet search and as far as the undersigned could determine, the Registrant's goods are not sold on Amazon. They are not sold on eBay. In fact, they are not sold anywhere on the Internet.

In sum, the goods are very different, the purchasers would be very different, and the uses would be very different. There would be no overlap in any of those areas.

D. Applicant's Goods are Sold in Different Channels than Registrant's Goods

The Examining Attorney contends that Applicant's goods and those of the registered trademark "may" travel in the same trade channels. (Office Action at Section II.B). That appears to be incorrect.

Applicant sells its therapeutic massagers directly on the Internet through its own website at www.padousa.com and Amazon.com, see Lee Decl. ¶¶ 1-7, as well as on eBay. As far as the

undersigned has been able to determine, Registrant does not its cosmetic (anti-wrinkle) devices anywhere on the Internet.

Cosmetic (anti-wrinkle) massagers are not even promoted and sold at the same trade shows as therapeutic massagers. (Lee Decl. ¶¶ 11-16). As far as Applicant is aware, no company makes both cosmetic massagers and therapeutic massagers. (Lee Decl. ¶¶ 16-17).

IV. THE PRODUCTS HAVE PEACEFULLY COEXISTED IN THE MARKETPLACE FOR MORE THAN FOUR YEARS NOW DESPITE EXTENSIVE ADVERTISING BY APPLICANT, WITH NO CONSUMER CONFUSION AND NO COMPLAINTS BY THE REGISTRANT, AND NO CONTACT FROM SIGMA INSTRUMENTS

Finally, and most probatively, there is no evidence of record indicating that there has been actual confusion in the marketplace as between Applicant's goods and the registrant's goods.

The absence of any instances of actual confusion is a meaningful factor where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or all affected trademark owners. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *In re GMC*, 23 U.S.P.Q.2D 1465, 1471 (TTAB 1992) ("The absence of any known incident of actual confusion in an extensive period of contemporaneous use of the marks is strong evidence that confusion is not likely to occur in the future.") (citing *In re American Management Associations*, 218 USPQ 477, 478 (TTAB 1983)) (finding "GRAND PRIX" for automobiles to not be confusingly similar under the circumstances to "GRAND PRIX" and design for a variety of automotive products including tires, motor oil, motor oil filters, shock absorbers, and muffler and brake part.); *Red Carpet Corp. v. Johnstown American Enterprises Inc.,* 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders,* 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring").

In this case, the respective marks and goods have peacefully coexisted in the marketplace for more than four years now, despite Applicant's extensive advertising and its strong Internet presence.

Applicant Pado, Inc ("Pado") has been selling its PUREWAVE massagers since its claimed date of first use in commerce of June 12, 2015 (Lee Decl. ¶ 2), which is more than four years ago.

Pado's's profile on the Internet and in the industry has been high. Pado has been selling its PUREWAVE products on its website of www.padousa.com and on Amazon.com for more than four (4) years now. (Lee Decl. ¶¶ 1-2) It has been purchasing "PUREWAVE" as an Internet advertising keyword for four (4) years. (Lee Decl. ¶ 6). **Pado has spent over $19 million advertising** its PUREWAVE massagers in the form of Google, Amazon Advertising, and Amazon Media Group advertisements, and advertisements in trade publication magazines Chiropractic Economics, The American Chiropractor, The Chiropractic Assistant, and PGA Tour. (Lee Decl. ¶ 3). At a cost of approximately $150,000, Pado has attended and displayed its PUREWAVE massagers at display booths at Parker Seminar events, and APTA American Physical Therapist Association CMS seminars. (Lee Decl. ¶ 4). It has spent approximately $15,000 sponsoring sporting events including the Spartan Race in 2018, and the Revel Run Marathon in 2018. (Lee Decl. ¶ 5).

Pado also owns the domain www.purewave.com which redirects to www.padousa.com. (Lee Decl. ¶ 7).

Pado has now sold more than 645,000 PUREWAVE therapeutic massager units, at a total selling price of more than $71 million. (Lee Decl. ¶ 8).

Pado has never seen Registrant Sigma Instruments, Inc. ("Sigma") nor its PURWAVE cosmetic massage device at any of the trade shows that Pado has attended (Lee Decl. ¶¶ 13-14), nor any cosmetic (anti-wrinkle) massager by any other company (*id.*). Pado has never even heard of the PURWAVE device, nor any other device by Sigma being displayed at any trade show within Pado's field. (Lee Decl. ¶ 15). PADO has never received any inquiries from consumers, retailers, or distributors regarding Sigma or its PURWAVE cosmetic device (Lee Decl. ¶¶ 18-120). PADO has never received any complaint from Sigma regarding alleged instances of consumer confusion, nor a complaint from Sigma that Sigma perceives a likelihood

of confusion, nor even any communication from Sigma on any subject at all. (Lee Decl. ¶¶ 21-22).

Under these circumstances, Applicant respectfully suggests that the long period of peaceful coexistence with neither any consumer confusion nor any objections by Sigma constitutes strong evidence that consumer confusion is highly unlikely. See *Gillette* ("The absence of any known incident of actual confusion in an extensive period of contemporaneous use of the marks is strong evidence that confusion is not likely to occur in the future.").

V. CONCLUSION

For all of these reasons, Applicant respectfully submits its mark is not confusingly similar to the cited registration, and respectfully requests that the Examining Attorney approve the mark for publication.

Respectfully submitted,

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