

Applicant’s Response to Office Action
Trademark Act Section 2(d) - 15 U.S.C. § 1052(d)

Pursuant to 15 U.S.C. § 1062(b), the Applicant (Serial No. 88296195) responds to the May 1, 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 mark in U.S. Registration No. 4520750 (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: DERMALEVIA BY HIGHLIFE NOW

This Application was initially filed into International Class 005 for “ topical analgesic creams, lotions, and gels; analgesic cream with aromatherapy oils; aromatherapy oils, other than essential oils, for treating anxiety, curing insomnia, and relieving stress.”

Concurrently with this Response to Office Action and in compliance with Examining Attorney’s recommendation, Applicant is amending the Identification of Goods associated with its application as follows: “Topical analgesic creams, lotions, and gels; analgesic cream **made** with aromatherapy oils; aromatherapy oils, other than essential oils, for treating anxiety, curing insomnia, and relieving stress.”

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. 4520750

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

This mark fits into International Class 005 for “Bandages for dressings; Medical dressings; Self adhesive dressings; Wound dressings.”

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 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 appearance, sound, 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 number and nature of similar marks in use on similar goods or services.
- 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

¹ *Id.*

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

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).

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

i. *The Marks Differ in Appearance.*

It is accepted that “use of identical, even dominant, words in common does not automatically mean that two marks are similar.”⁹ Consumers will look at the marks in their entirety. The Examining Attorney has not presented any evidence on why consumers would only focus on the first element and ignore the mark as a whole. When Applicant’s mark is compared in its entirety, the first *Dupont* factor weighs in Applicant’s favor in finding that there is no likelihood of confusion.

It is established case law that registered marks can **share** the first word and **not** be confusingly similar. Instances when courts have found the use of identical dominant words or terms are **not** confusingly similar include:

- BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL not confusingly similar.¹⁰
- FIRSTBANK and FIRST BANK KANSAS not confusingly similar.¹¹
- LEAN CUISINE and MICHELINA’S LEAN ‘N TASTY not confusingly similar, even though both for low-fat frozen food.¹²
- OATMEAL RAISIN CRISP and APPLE RAISIN CRISP not confusingly similar.¹³
- FREEDOM SAVINGS AND LOAN and FREEDOM REALTY not confusingly similar.

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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.*

⁹ *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1446 (8th Cir. 1987).

¹⁰ *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)

¹¹ *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996)

¹² *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 USPQ2d 1047 (8th Cir. 1999)

¹³ *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1446 (8th Cir. 1987)

¹⁴ *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1183, 226 USPQ 123, 128 (C.A.11 Fla. 1985)

- SUN FEDERAL AND SAVINGS LOAN ASSOCIATION and SUN BANKS not confusingly similar.¹⁵
- ROMANBURGER and ROMAN for food not confusingly similar.¹⁶
- PIZZA CAESAR U.S.A. and LITTLE CAESAR’S not confusingly similar.¹⁷
- DOMINO SUGAR and DOMINO’S PIZZA not confusingly similar.¹⁸

Even if the dominant portion of a mark is given greater weight, each mark must still be considered as a whole.¹⁹

Looking at the literal elements, Applicant’s mark is not similar in terms of appearance to the Cited mark. While Applicant’s mark is made up of twenty-three (23) letters, the Cited mark is only made of ten (10) letters. Applicant’s mark is made up of four (4) words while the Cited mark is made up of one (1) word. Visually, the literal elements of the Applicant’s mark are highly distinct and much longer as the Applicant’s mark includes an increased number of literal elements not found in the Cited mark.

Viewing the marks in their entirety reveals differentiations between Applicant’s mark and any Cited mark. Because the marks are dissimilar in appearance, customer confusion as to source is unlikely.

ii. *The Marks Differ in Sound and Pronunciation.*

It has been held that a difference in the sound between two marks may exist given a difference in the number of syllables between the two word portions of a mark.²⁰ In this case, the marks differ phonetically as Applicant’s mark is made up of nine (9) syllables while the Cited mark is made up of four (4) syllables.

Applicant’s mark is pronounced like DER-MA-LEH-VEE-AH-BY-HI-LIFE-NOW while the Cited mark is pronounced simply like DER-MA-LEH-VIN.

Even if descriptive portions of a mark are disregarded elsewhere in this analysis, descriptive portions would still appear on all of the relevant offerings and be seen and thus

¹⁵ *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass’n*, 651 F.2d 311, 211 USPQ 844 (5th Cir. 1981)

¹⁶ *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888, 228 USPQ 364, 366 (Fed. Cir. 1986)

¹⁷ *Little Caesar Enters. v. Pizza Caesar, Inc.*, 834 F.2d 568, 4 USPQ2d 1942 (6th Cir. 1987)

¹⁸ *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 205 USPQ 969 (5th Cir. 1980)

¹⁹ *See First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996); *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994).

²⁰ *See Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 USPQ2d 1012 (TTAB 2007).

pronounced by consumers. Thus, Applicant's mark coupled with the wording BY HIGHLIFE NOW still has over twice the additional wording needing to be pronounced. The words BY, HIGHLIFE, and NOW appear nowhere in the cited registration. The pronunciation is therefore dissimilar and no source confusion could take place.

Even if the marks were phonetically similar — which they are not — there would still be no likelihood of confusion because other differentiating factors are present.²¹ Ultimately, as outlined in *DuPont* and other jurisprudence above, an ultimate determination on likelihood of confusion must take into account all the various relevant factors.²² In sum, the differences in sound and pronunciation among Applicant's and the Cited marks make consumer confusion unlikely.

iii. *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.²³ The meaning or connotation of a mark must be determined in relation to the named goods or services.²⁴ 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.”²⁵

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.²⁶

In *Taj Mahal*, the marks at issue were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort.²⁷ The court held that there was no likelihood of confusion, as

²¹ See *Nat'l Distillers & Chem. Corp. v. William Grant & Sons*, 505 F.2d 719, 184 USPQ 34 (C.C.P.A. 1974) (finding that DUVET and DUET did not have a likelihood of confusion).

²² See also *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (“The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used”).

²³ TMEP § 1207.01(b)(v).

²⁴ *Id.*

²⁵ *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91 USPQ2d 1594, 1598 (TTAB 2009).

²⁶ 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).

²⁷ See *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F.Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990).

the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence and extravagance.²⁸

While Applicant's mark, DERMALEVIA, connotes essential oils, the Cited Mark, DERMALEVIN, connotes medical wound dressings for use by doctors in a medical setting.

Connotation and significance can be determined based upon a mark holder's current use in commerce.²⁹ The Cited mark is used in commerce in connection with wound dressings for medical professionals, which further supports that the Cited mark has a different connotation than Applicant's mark.

The Applicant's goods are not in commerce yet and therefore do not have a commercial impression. However, the inclusion of the words "BY HIGHLIFE NOW" act as a straightforward source identifier for consumers when viewed in commerce.

Cited's goods are medical-grade wound dressings for medical professional use only. *See Exhibit A.* The Cited's good can only be purchased through the Cited's designated vendors or through the Cited themselves after speaking with a sales representative. The Cited's goods are a specially designed wound dressing meant to be part of a series of dressing to manage acute or chronic partial and full thickness wounds/ulcers with moderate bleeding. These wound dressing are not for small paper cuts or scraps, but for large lacerations or cuts that cannot be handled without the help from a medical professional. This is why the Cited's goods are sold directly to medical professionals to use only for the specific wounds they see fit.

The consumer impressions at issue are likely to be an impression of essential oils and topical creams compared to a wound dressing for medical professionals to address serious injuries. An ordinary consumer may be able to view the Applicant's mark in commerce, however an ordinary consumer would never view the Cited's mark in commerce. The only potential consumer confusion is between medical professionals who have access to the market where the Cited sells their goods. Such consumers are unlikely to be easily confused by a mark alone and will carefully select a product first, i.e. a cream for a discomfort or a wound dressing for a serious laceration, before viewing a mark. Thus, the consumer impression at issue is the impression of a medical professional viewing a topical cream or essential oil compared to a serious wound dressing mark. Consumer confusion is unlikely in this situation.

²⁸ *Id.*

²⁹ *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).

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.”³⁰ The inquiry is whether the relevant goods and services could be related “in the mind of the consuming public” such that source confusion would occur.³¹ An examining attorney must “provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.”³²

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.”³³

To establish that identified items are related, “it is not sufficient that a particular term may be found which may broadly describe” them.³⁴ “That two goods are used together . . . does not, in itself, justify a finding of relatedness.”³⁵ That the same customer could seek out relevant goods or services is also insufficient for a finding of relatedness.³⁶

“Merely because parties operate in the same broad industry does not, by itself, establish that their goods and services are related.”³⁷ Being filed in the same class or presumably available

³⁰ *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”).

³¹ *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000).

³² TMEP § 1207.01(a)(vi).

³³ TMEP § 1207.01(a)(i).

³⁴ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

³⁵ *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).

³⁶ *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”).

³⁷ *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).

to the same class of purchasers is also not a sufficient basis to conclude that identified items are related.³⁸

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

ii. *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 both "words Examining Attorney searched to connect third party registrations to Applicant's mark and Cited marks."

Attempting to establish relatedness of goods and services on the exclusive basis of third party website evidence is generally disfavored by the Board.³⁹

Third-party registrations in the nature of house marks used for a wide variety of items are of little value by themselves to show that the various goods for which they are registered are all related. Similarly, here where the website evidence shows house marks used on a wide variety of goods, it is not so probative of this factor.⁴⁰

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 define the offerings.⁴¹ 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.⁴² 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.⁴³

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

³⁸ *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).

³⁹ *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.").

⁴⁰ *In re Marko Schuhfabrik GmbH*, Serial No. 79040612 (T.T.A.B. December 23, 2009) (non-precedential).

⁴¹ *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).

⁴² *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1214 (TTAB 2007).

⁴³ *Id.*

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.”⁴⁴ 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. The following items do not contain goods and services identified by both relevant marks:

- Aspercreme evidence - The Cited’s goods, as listed in their identification, are a variety of dressings. Dressings are meant to be used on wounds and sores, which are specific medical injuries. *See Exhibit B*. Wounds and sores refer to open skin caused by lacerations or other injuries. *Id.* Examining attorney’s use of Aspercreme for evidence does not show any type of dressing. The closest approximation to a dressing is the Aspercreme Lidocaine Patch. However, further evidence from the same webpage shows that Aspercreme specifically warns consumers NOT to use the product on wounds or sores. *See Exhibit C*. Therefore, the Aspercreme Lidocaine Patch is not dressing and is therefore not the same as the Cited’s identification. Therefore this evidence is not sufficient and should not be used to show the Applicant’s and Cited’s goods emanate from the same source.
- Johnson & Johnson evidence - The examining attorney has not shown that Band-aid is sold together with goods identical to the Applicant’s topical analgesic creams or aromatherapy oils. Examining Attorney has highlighted that the Neosporin brand is integrated into Band-Aid products. However, examining attorney does not show that Neosporin is sold as its own product sold together with the Band-aid mark. Examining attorney’s evidence only shows that Neosporin is sometimes an ingredient in Band-aid products but not that neosporin is a product identical to the Applicant’s identification. Finally, the examining attorney’s evidence indicates that the NEOSPORIN mark is a separate and distinctive mark from the BAND-AID mark. In this way, the examining attorney has not shown that NEOSPORIN is used to identify the Cited’s dressing identification or that BAND-AID is used to identify the Applicant’s topical analgesic creams. Examining attorney’s evidence must show that the same source is being identified, meaning the same mark identifies both goods and not that they different marks are commonly found together. Thus this evidence is insufficient and should not be used to show the Applicant’s and the Cited’s goods emanate from the same source.

⁴⁴ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

When these foregoing third party items are removed from consideration, only one (1) third party evidence that contain the exact items at issue third party items remain relevant to this consideration.⁴⁵ This evidence is of a house mark used on a wide variety of medical goods and services that is of little value to show that the various goods at issue are related. These items are insufficient to support a finding that goods are related.⁴⁶

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.⁴⁷ 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.⁴⁸

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 the Cited’s own website and mobile app. Examining Attorney has shown no evidence that the Applicant’s marks travel in those trade channels.⁴⁹

⁴⁵ Website house mark FIRST AID ONLY

⁴⁶ 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.”).

⁴⁷ 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”).

⁴⁸ 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 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).

⁴⁹ 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”).

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.⁵⁰

Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject products fail to constitute “impulse” purchases.⁵¹ 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.⁵² 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.

The “discriminating purchaser” standard applies when the goods or services at issue are “expensive.”⁵³ We are concerned with how intelligent and sophisticated customers would assess these marks, because they are the likely customers of particularly expensive goods and services. Furthermore, “confusion is less likely where goods are expensive and purchased after careful consideration.”⁵⁴

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.⁵⁵ 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. Although the Applicant’s goods are not currently for sale, the Cited’s goods are. The Cited’s goods are only sold to medical professionals through a special order through the Cited’s website, app, or registered vendors. Due to how specialized medical equipment, including medical

⁵⁰ 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.”).

⁵¹ 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).

⁵² See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992).

⁵³ *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (citing 2 J. McCarthy, *Trademarks and Unfair Competition* § 23:28 at 130 (2d ed. 1984)).

⁵⁴ See *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 109 USPQ 313 (C.C.P.A. 1956).

⁵⁵ TMEP § 1207.01(vii).

dressing, are, along with the specialized uses different dressings serves, the difference between a dressing and a non-dressing product are significant in a medical setting. In addition, the consumers of the Cited's goods are medical professionals well versed in medical equipment and medical treatment making them a highly sophisticated and knowledgeable consumer. The difference between a topical cream or essential oil compared to a medical wound dressing is highly significant to a medical professional such that a medical professional is unlikely to confuse the Applicant's essential oils and creams with the Cited's medical grade, professional wound dressings.

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.⁵⁶

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.⁵⁷ 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 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.⁵⁸ 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 Weakness of the Cited Mark Weighs Against Confusion

⁵⁶ *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").

⁵⁷ *See In re HerbalScience Group, LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010).

⁵⁸ *In re E.I. DuPont de Nemours & Co.*, 476 F.2d at 1362, 177 USPQ at 567.

When determining the scope of protection a mark should be accorded, a vital consideration is the strength of the registered mark. When evaluating the strength of a mark, the commercial strength of the mark is considered along with the inherent strength of the mark.⁵⁹ “A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”⁶⁰ It is well established that when analyzing a mark, the Board will “consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”⁶¹

The USPTO has been comfortable registering marks sharing a weak element alongside one another. The mere fact that two marks incorporate a form of a common identifying word does not render the marks too similar.⁶²

Here, Applicant’s mark is not identical to the Cited Mark, and the weakness of the Cited mark supports that consumers are unlikely to be confused. Here, the differences between Applicant’s and Cited marks are NOT identical and result in separate and distinctive commercial impressions. Here, the prefix “DERMA” is a common element in medical and cosmetic marks in Class 005 because DERMA is a prefix that means “skin.” As goods that are used on or with skin are common, so too is the element DERMA common for the marks of such goods. Similar to how the Board found to be PAPER a weak element because of its wide use in the relevant industry, the common element between Applicant’s and Cited marks, DERMA, is weak and widely used.

i. The Element at Issue Lacks Inherent Strength

A vital consideration is the strength of marks cited by an examining attorney in order to determine the scope of protection to be accorded to those registered marks. Weaker marks are entitled to a narrow scope of protection, permitting closer similarities with an applicant’s mark “without causing a likelihood of confusion.”⁶³

The weakness of registered matter is a relevant consideration “because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive

⁵⁹ *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010).

⁶⁰ *Id.*

⁶¹ *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011).

⁶² *See, e.g. In re Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (VARGA GIRL and VARGAS are sufficiently different to negate likelihood of confusion); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407, 184 USPQ 422, 425 (C.C.P.A. 1975) (COUNTRY VOGUES and VOGUE publications “do not look or sound alike”).

⁶³ *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *See* TMEP § 1207.01(b)(ix). Highly suggestive or descriptive marks are entitled to a narrower scope of protection. *See In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213 (TTAB 2007) (“Purchasers are simply unlikely to assume that all [goods] offered under these highly suggestive marks emanate from the same source.”).

term is less than that accorded an arbitrary or coined mark.”⁶⁴ Where a term is considered to be weak, “minor alterations could effectively negate any confusing similarity between the” marks.⁶⁵

Ultimately whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. USPTO has been comfortable registering marks sharing a weak element alongside one another “so long as there has been some difference between the marks as a whole or between the goods or services.”⁶⁶

ii. The Market at Issue is a Crowded Field, which Weighs Against Confusion

Widespread third-party use “can serve to diminish the strength of a mark and thus the scope of protection to which a mark is entitled.”⁶⁷ “Extensive evidence of third-party use and registrations is powerful on its face, even where the specific extent and impact of the usage has not been established.”⁶⁸ Evidence of third party use shows that customers in the relevant industry are likely “to distinguish between different marks on the basis of minute distinctions.”⁶⁹

The possibility for the same consumer to purchase items sold under Applicant’s and the Cited marks does not itself establish a likelihood of confusion as to the source of those goods.⁷⁰ There is nothing in the record that suggests that the consumer would consider the goods as likely to emanate from the same source or have the same sponsorship. Instead, the multitude of third-party marks that all share the same element, DERMA, suggests that consumers are unlikely to be confused as to the source of these goods.

If other registrations appear that are owned by more than one registrant, the dilution of those terms among several users indicates that there is no likelihood of confusion between the Applicant’s mark and a Cited mark.⁷¹ Applicant notes that there are over 264 marks found marks utilizing a variation of the element DERMA or phonetic equivalents thereof in International Class 005. TESS Search terms: (live)[LD] AND (derma*)[COMB] and (005)[IC] and `RN >

⁶⁴ *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

⁶⁵ *See, e.g. Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1183, 226 USPQ 123, 128 (C.A.11 Fla. 1985) (“Freedom Savings and Loan” and “Freedom Realty” marks “lack ... confusing similarity”); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384, 179 USPQ 45 (C.C.P.A. 1973) (“SILK ‘N SATIN” beauty and bath lotion and oil not similar to “SILK” face cream).

⁶⁶ *See In re FiftyThree, Inc.*, Serial No. 86180291, (TTAB 2017) (non-precedential) (PAPER not likely to be confused with BAMBOO PAPER for identical in part goods when it was shown that PAPER is widely used and weak in the relevant industry).

⁶⁷ *Nike, Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187 (TTAB 2007); *See also In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003); TMEP § 1207.01(d)(iii).

⁶⁸ *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373-74, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

⁶⁹ *Juice Generation, Inc.*, 794 F.3d at 1338, 115 USPQ2d at 1674 (internal quotations omitted).

⁷⁰ *See The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, 63 USPQ2d 1782, 1794 (TTAB 2001).

⁷¹ *See* TMEP § 1207.01(d)(x).

"0". Given such widespread use of the element DERMA consumers are more likely to acknowledge slight variances among its uses.

In this regard, Applicant respectfully submits the following representative sample of use-based registrations for the same and closely related goods and services. Registrant has coexisted with these marks without any evidence of confusion. These registrations are attached as Exhibit D and listed below:

#	MARK	U.S. Reg. No.	OWNER	SERVICES/GOODS
1	DERMAKR	5791944	COMPANY Y CO., LTD.	Class 005: wound dressings
2	DERMAGI	5680582	Wang, Lu DBA Lu's Skincare Clinic	Class 005: Medicated facial cleansers
3	DERMALICIOUS	5270799	DERMALICIOUS LLC	Class 005: multipurpose medicated antibiotic cream, analgesic balm and mentholated salve;
4	DERMAPHEX	5711088	Aphex BioCleanse Systems, Inc.	Class 005: Antimicrobial hand-sanitizing preparations
5	DERMAMED	5583570	DermaMed Coatings Company, LLC	Class 005: Adhesives in the nature of medical dressings, dressings for wounds, dressings for surgery, bandages for dressings, bandages for skin wounds, surgical bandages and adhesive tapes for use in the medical field
6	DERMALAGE	5260997	Infection Elimination Solutions LLC	Class 005: Antiseptic preparations
7	DERMATA	5138355	Dermata Therapeutics, LLC	Class 005: Dermatological pharmaceutical products.

8	DERMATROL	4637157	Evergreen Herbs International, LLC	Class 005: Dietary supplements
9	DERMATRAN	4504658	DermaTran Health Solutions, LLC	Class 005: Pharmaceutical preparations used to treat pain
10	DERMANEX	4318495	Kim, Kevin	Class 005: Medicated cosmetics
11	DERMAVITE	4860016	MediNiche, Inc	Class 005: Dietary and nutritional supplements
12	DERMAZINC	3201878	Dermalogix Partners, Inc.	Class 005: Medicated skin care preparations
13	DERMAWOUND	3097449	EZ MEDICAL SOLUTIONS LLC	Class 005: Pharmaceutical Preparations, for Wounds
14	DERMADOCTOR	2978251	D. DOCTOR ACQUISITION, LLC	Class 005: Skin care products, namely, medicated skin care preparations
15	DERMATIN	2531795	Melaleuca, Inc.	Class 005: Antifungal cream

Attached as Exhibit D, these third party registrations are evidence that Registrant is not entitled to the broad scope of protect initially suggested by the Examining Attorney.

The Cited mark, DERMALEVIN, already coexists with 264 other marks that also contain “DERMA” in Class 005. International Class 005 is a crowded field and the prefix DERMA is a weak mark, therefore consumers are unlikely to be confused by the registration of Applicant’s mark where it has the additional wording BY HIGHLIFE NOW. In sum, this DuPont factor should weigh in favor of a finding that there is no likelihood of confusion between Applicant’s and Cited marks.

F. 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.⁷² 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.”⁷³ Where the extent of potential confusion is *de minimis*, the factor should weigh against a finding of likelihood of confusion.⁷⁴

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.”⁷⁵ As a practical matter, only a very limited number of potential purchasers will be exposed to both Applicant’s and a Cited mark.⁷⁶

Here, the extent of potential confusion is also *de minimis* because the goods in question are highly specialized.⁷⁷

The International Class 005 is a crowded field for marks with the prefix element DERMA, making this element common and less likely to be seen as distinguishing or important to consumers. Cited’s product is a specialized wound dressing that is sold to medical professionals to be used on larger lacerations and similar injuries. Thus, the potential consumer is highly sophisticated and the relevant good is both highly specialized and difficult to obtain without specific knowledge of the good. Accordingly, the extent of potential confusion is *de minimis*. The twelfth *DuPont* factor should weigh in favor of no confusion.

⁷² 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).

⁷³ 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).

⁷⁴ See *Bose Corp. v. Custom Electronic Design & Installation Assoc.*, Cancellation No. 92042327, (TTAB 2007) (non-precedential).

⁷⁵ *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1223 (TTAB 2011).

⁷⁶ 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”).

⁷⁷ 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 purchased by significant numbers of purchasers ... potential for confusion therefore cannot be deemed to be de minimis”).

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*.

VI. Prior Pending Applications.

Examining Attorney has noted two (2) prior pending applications that may give rise to likelihood of confusion claims should the marks be registered. Applicant reserves the right to dispute any future claims these applications may cause should they be registered.