

ARGUMENT

The Examining Attorney has determined that there is a likelihood of confusion between the applied-for mark, CALM, and the mark in U.S. Trademark Registration No. 5607289. The applicant disagrees with the Examining Attorney's refusal for the following reasons.

I. The goods covered by the present CALM application are distinguishable in their main purpose and fields of use.

As an initial matter, it should be noted that the mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 USPQ 81, 89 (2nd Cir 1979). Thus, in holding the mark "DRIZZLE" for women's overcoats was not likely to cause confusion with "DRIZZLER" for golf jackets, the Second Circuit stated: First, even close similarity between the marks is not dispositive on the issue of likelihood of confusion. Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question. *Id.* at 89 (citations omitted). It is respectfully noted that under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods, must be not merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection. *In re Massey-Ferguson, Inc.*, 222 USPQ 367 (TTAB 1983); *Witco Chemical Corp. v. Whitfield Chemical Co.*, 164 USPQ 43 (CCPA 1969). We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world with which trademark laws deal. *Id.* at 44.

In the present case, registration No. 5607289 is for CALM for "NEUTRACEUTICALS, NAMELY, VITAMIN AND MINERAL SUPPLEMENT ENHANCED DRINKS; NUTRITIONAL BEVERAGES, NAMELY, VITAMIN AND MINERAL SUPPLEMENT

ENHANCED DRINKS; DIETARY SUPPLEMENTAL DRINKS IN THE NATURE OF VITAMIN AND MINERAL BEVERAGES” in Class 5. Each clause of the cited registration limits the claimed goods to “drinks” and “beverages.”

In contrast, the applicant’s CALM application does not cover drinks and beverages. To clarify the nature of its product, the applicant has amended its Class 5 goods to clarify that its application is not intended to cover vitamin and mineral beverages. The applicant has amended its application as follows “Neutraceuticals for use as a dietary supplement, not including beverages containing vitamin and mineral supplements; nutritional supplements in the form of capsules, caplets, powder, chews, gummies, and gels; gummy vitamins; Prescription and non-prescription medicines, namely, pills, tablets, capsules, caplets, liquid drops, and sachets” in Class 5. These goods do not include vitamin and mineral beverages, and are instead intended to cover supplements in the form of capsules, caplets, powder, chew, gummies, and gels.

Further, although the cited registrant and the applicant both offer goods that fall into a general category of goods intended as alternative medicines, the registrant’s and applicant’s respective goods are not likely to be offered side by side in a retail or online store. The registrant’s beverage goods are limited to a prepackaged drinkable liquid product, whereas the applicant’s goods are in provided in other formats that are not beverages. Where there are a number of similar marks in use on similar goods, customers have become so conditioned by a plethora of such marks that they “have been educated to distinguish between different marks on the bases of minute distinctions.” *Palm Bay*, 73 U.S.P.Q.2d 1694 (Fed. Cir. 2005). The goods covered by the present CALM application will be offered in distinctive packaging, in distinguishable, non-beverage formats, and in limited channels of trade, and thus are readily distinguishable from the prepackaged beverage goods covered by the cited registration. The

two parties' goods would never be offered together in close proximity, and as such the possibility of consumer confusion is negligible.

In summary, the amendment of the applicant's identification of goods has clarified the nature of those goods such that no overlap remains between the applicant's Class 5 goods and the goods in the cited registration. Further, the cited CALM registration in Class 5 already coexists peacefully on the U.S. Trademark Register with more than two hundred similar CALM-type applications and registrations in Class 5. In a crowded field of similar CALM marks, there should be room for one more, namely, the applicant's CALM mark.

II. U.S. Trademark Registration No. 5607289 is not a strong mark and confusion with the applicant's mark is not likely.

There are more than two hundred CALM-type trademark registrations and applications currently coexisting on the PTO's register (see Exhibit A). The applicant argues that CALM-type marks are not uncommon in this class, and the coexistence of so many CALM-type marks underscores the limited scope of protection offered the marks in the cited registrations.

When considering the strength of a mark in a crowded field of similar marks, each member of the crowd is afforded only a narrowly-circumscribed scope of protection. *Standard Brands, Inc. v. RJR Foods, Inc.* 192 USPQ 393, 385 (TTAB 1976). The ultimate test of relative strength is the distinctiveness of a mark in the mind and perception of the relevant customer group. However, a mark that is surrounded by similar marks on similar goods or services cannot be very "distinctive". As a result, each member of the crowd is relatively "weak" in its ability to prevent use by others in the crowd. *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A.* 210 USPQ 315 (TTAB 1980).

Finally, the Examining Attorney has the burden of proving a finding of likelihood of confusion by a preponderance of the evidence. *E.I. du Pont de Nemours & Co. v. Yoshida Int'l, Inc.* 185 U.S.P.Q. 597 (E.D.N.Y. 1975). There is no evidence in the record to establish that the cited registration for CALM is famous or that there have been extensive sales and marketing expenditures such that the mark has become well known for the goods listed in the cited registration. In short, there is no evidence in the record to support the assertion that the marks in the cited registrations are strong marks for the registrant's goods. This lack of evidence supports the applicant's position that confusion is not likely.

III. In a crowded field of similar CALM marks, there should be room for one more, namely, the applicant's CALM mark.

The Examining Attorney argues that the applicant's CALM mark is highly similar to the mark in the cited registration due to the shared word element CALM. However, the applicant respectfully submits that the USPTO's database currently contains 203 live trademark applications and registrations containing the word CALM as part of the mark. Sixteen of those marks (of which eight are registered) include CALM used in connection with beverages, and fifteen of those marks (of which ten are registered) include CALM used in connection with pharmaceutical preparations. Indeed, a later-filed CUP OF CALM application was allowed to achieve registration (U.S. Reg. No. 4733185) for identical dietary supplement tea goods, in spite of the earlier-filed CALM registration cited in the instant case (U.S. Reg. No. 5607289). To date, all of the pending applications and registrations have been able to peacefully coexist on the U.S. Trademark Register. In a crowded field of similar CALM marks, there should be room for one more, namely the applicant's CALM mark.

IV. Conclusion

In conclusion, the burden is on the Examining Attorney to establish the cited grounds for refusal. *In re Nantucket, Inc.* 213 USPQ 889 (CCPA 1982), *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 USPQ 563 (CCPA 1967). For the reasons set forth above, the applicant respectfully submits that the Examining Attorney's burden has not been met. The applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal and approve the present CALM application for publication in its entirety.