

## ARGUMENTS

In the Office Action, the Examining Attorney initially refused registration in Classes 3 and 5 on the basis of Registration Nos. 3222681 and 5213785, both for the mark BLISS and covering “dietary and nutritional supplements” and “scented oils; essential oils for use in aromatherapy; reed diffusers comprised of scented oils and also including reeds and a diffuser container,” respectively. Applicant has removed the Class 3 goods from the application, rendering the refusal predicated on Registration No. 5213785 moot.

With respect to Registration No. 3222681, Applicant respectfully requests reconsideration of this refusal based on the following remarks.

In refusing registration, the Examining Attorney cited *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 56 (CCPA 1973) for the proposition that likelihood of confusion in regard to § 2(d) depends upon whether the purchasing public would mistakenly assume that an applicant's goods originate from, are sponsored by, or are in some way associated with goods provided under a cited registration. In *DuPont*, the court enunciated several factors relevant to determining likelihood of confusion, including the number and nature of similar marks in use on similar goods. In the instant case, this factor is dispositive.

As an initial matter, 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 (2<sup>nd</sup> Cir. 1979). Thus, in holding the mark "DRIZZLE" for women's overcoats was not likely to cause confusion with "DRIZZLER" for golf jackets, the Court of Appeals for the Second Circuit stated "[f]irst, even close similarity between two marks is not dispositive of 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).

Further, as noted in *Amstar Corporation v. Domino's Pizza, Inc. et al.*, 205 USPQ 969, 975 (5<sup>th</sup> Cir. 1980), "the strength and distinctiveness of plaintiffs mark is a vital consideration in determining the scope of protection it should be accorded." Moreover, "[t]he strength of a given mark rests on its distinctiveness. The scope of protection afforded a strong mark is greater than that afforded a weak one. In determining the distinctiveness of a mark one looks to the degree to which the public associates the mark with a particular source." *Miss World (UK) Ltd. v. Mrs. America Pageants Inc.*, 8 USPQ2d 1237, 1240 (9<sup>th</sup> Cir. 1988). A list of use-based applications and registrations for BLISS marks for relevant goods is attached. These marks are relevant to show that the term “BLISS” is relatively “weak” on the spectrum of distinctiveness and therefore entitled to a narrow scope of protection.

Also attached is a declaration attesting to the widespread use of BLISS marks for supplements. “[E]vidence of third-party use bears on the strength or weakness of an opposer’s mark.” *Juice Generation v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015). The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.*; see

*Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Id.* ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.")

As a result, Applicant submits that the cited BLISS mark is "hemmed in on all sides by similar marks on similar goods [and] cannot be very distinctive." *Miss World (UK) Ltd. V. Mrs. America Pageants Inc.* at 1241. Simply put, the cited mark is merely one "[I]n a 'crowded' field of similar marks, each member of the crowd, is relatively 'weak' in its ability to prevent use by others in the crowd." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:85 at 11-163 (4th Ed. 2001).

Accordingly, Applicant requests that its mark be approved for publication.