

UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO OFFICE ACTION

In re the Application of:

Applicant: GoodRx, Inc.

Mark: HEALTH AND HAPPINESS

Serial No.: 88/409,362

Filed: April 30, 2019

Trademark Law Office: 121

Examining Attorney: Elizabeth Shen

GoodRx, Inc. (“Applicant”) hereby responds to the Office Action dated July 10, 2019 (“Office Action”) in the above-captioned application for the mark HEALTH AND HAPPINESS (the “HEALTH AND HAPPINESS Mark” or “Applicant’s Mark”) in International Class 16 for registration on the Principal Register.

In the Office Action, the Examining Attorney issued a refusal under Section 2(d) based on a perceived likelihood of confusion with the registration HEALTH & HAPPINESS (Reg. No. 5,091,135) (“Cited Registration”), owned by LeeReedy, Inc. (“Registrant”), for “advertising and marketing services” in International Class 35. The Office Action further indicated that, if Applicant responds to the refusal, it should “amend the identification to clarify or limit the goods and/or services.” Finally, the Office Action indicated as an “Advisory” that “upon consideration of an allegation of use, registration may be refused” on the ground that the goods identified in the description were not “goods in trade.”

Although Applicant disagrees that confusion is likely with respect to the Cited Registration, Applicant will amend the description of its services in Class 16 as follows:

advertising mailer, **namely a selection of coupons for discounts on a range of health and wellness products and services** (hereinafter, “Applicant’s

Amended Identification”).

Applicant believes that these revisions to the description of services should address the Examining Attorney’s concerns. As discussed below, Applicant submits argument and evidence that, particularly in light of these revisions, there is no likelihood of confusion between Applicant’s Mark and the Cited Registration. Moreover, the goods identified in the description are “goods in trade” because the coupons are the item that Applicant transports in commerce for use by others. Applicant thus respectfully requests that the Examining Attorney reconsider her refusal and reverse it to allow Applicant’s Mark to proceed to registration.

I. NO LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT’S MARK AND THE CITED REGISTRATION

The question of likelihood of confusion between marks is

[R]elated not to the nature of the mark but to its effect “when applied to the goods of the applicant.” The only *relevant* application is made in the marketplace. The words “when applied” do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360–61 (C.C.P.A. 1973) (emphasis in original) (quoting 15 U.S.C. § 1052)). Applicant respectfully asserts that there is no likelihood of confusion between Applicant’s Mark and the Cited Registration. Several key factors point to an absence of confusion:

- **First**, the Cited Registration is weak and entitled to limited protection because it consists of common terms that are used in connection with many goods and services. Indeed, there are many existing federal trademark registrations and applications that use variations and combinations of the terms “Health” and “Happiness” or synonymous terms. In a crowded field such as this where many overlapping marks coexist, Applicant’s use of these common terms is an insufficient basis to find confusing similarity.
- **Second**, Applicant’s goods and Registrant’s services are different. Applicant distributes coupons and targets members of the general public who purchase healthcare and other wellness products and services at a discount by using Applicant’s proprietary coupons. By contrast, Registrant is a company that creates advertising and marketing for other companies, which would bear those companies’ trademarks, not the Cited Registration.

Registrant merely uses the Cited Registration in advertising to its potential customers, which it states are narrowly tailored toward businesses within a select number of industries, not the public at large. These differences in goods and services, and customers, are further underscored by the fact that the Cited Registration is for a different international class than Applicant's Mark. Simply put, whereas Registrant offers advertising and marketing services (under Class 35), Applicant provides paper coupons (goods under Class 16) specifically for discounts on health and wellness products and services.

- **Third**, the trade channels used by Applicant and Registrant are different. Consumers are unlikely to encounter the Cited Registration and Applicant's Mark in similar marketing conditions. Applicant will send selections of discount coupons via paper mailers. In contrast, there is nothing to suggest that Registrant sends paper mailers or discount coupons using the Cited Registration to advertise its services. Moreover, an advertising agency seeking to promote its specialty advertising services to marketing departments of companies in a "select number of industries" is unlikely to publicize itself via discount coupons in a paper mailer.
- **Fourth**, the degree of consumer care for Registrant's services and Applicant's goods are high, making confusion even less likely. Registrant's clients are businesses in a "select number of industries" that are looking to hire Registrant to create successful marketing campaigns. Applicant's clients are economically prudent members of the public. Both groups of consumers are likely to display a high level of discernment as to the source of the goods and services they are purchasing.
- **Fourth**, the Cited Registration is not famous.

Accordingly, there is no likelihood of confusion between Applicant's Mark and the Cited Registration. Moreover, although the Examining Attorney asserts that the marks are similar when compared, the TMEP makes clear that "a determination that there is no likelihood of confusion may be appropriate, *even where the marks are similar* and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, . . . or another established fact probative of the effect of use." TMEP § 1207.01 (collecting cases) (emphasis added)). In light of the numerous other factors highlighting the lack of confusion between the marks, Applicant respectfully requests that the Examining Attorney allow the HEATH AND HAPPINESS Mark to proceed to registration.

A. The Cited Registration is Weak and Entitled to Limited Protection

Given that the Cited Registration consists of the frequently used terms “Health” and “Happiness,” it is entitled to weak protection, making confusion between the Cited Registration and Applicant’s Mark unlikely. *See In re E.I. DuPoint de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (where many similar marks already coexist, confusion from one more additional mark is unlikely). Indeed, the Trademark Trial and Appeal Board (“TTAB”) has held that “[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” *In re Cent. Soya Co.*, 220 U.S.P.Q. 914, 1984 WL 63140, at *4 (T.T.A.B. Jan. 18, 1984).



The Cited Registration is comprised of the words “Health”—a common noun describing a living being’s state of physical and/or mental wellness—and “Happiness”—another common noun describing a state of contentment. There are numerous trademark registrations and applications for marks containing combinations of common formulations expressing the ideas of wellness and contentment, including in particular the words “Health” and “Happiness.” “In a crowded field of similar marks . . . customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.” *Miss World (UK), Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (quoting 1 McCarthy on Trademarks & Unfair Competition § 11:26 (2d ed. 1984)); *see also Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579 (Fed. Cir. 1991) (“Where a mark is commonly used on numerous types of goods and services by different companies, a term such as PREMIUM, SUN, BLUE RIBBON, NATIONAL, GIANT or AMERICAN, it may be reasonable to infer in some situations that purchasers have been conditioned to expect different sources for specifically different goods or services even though such goods or services might be deemed


sufficiently related to be attributable to a single source under an uncommonly used mark.”); *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 259–60, 205 U.S.P.Q. 969, 975–76 (5th Cir.) (no confusion likely between DOMINO for sugar and DOMINO for pizza services in presence of third party use). Applicant notes the following exemplary third-party trademarks used across a variety of common goods and services incorporating similar terms:

	Reg. No. / Serial No.	Mark	Goods and/or Services
1.	Reg. No. 5,550,657	DELIVERING HEALTH & HAPPINESS	IC 39: Delivery of fresh healthy meals to individuals, families and businesses
2.	Ser. No. 87/682,705 ¹	FOR HEALTH AND HAPPINESS	IC 5: Dietary supplements IC 34: Oral vaporizers for smoking purposes
3.	Ser. No. 88/314,412	MRS. HEALTH & HAPPINESS	IC 41: Education services, namely, providing classes in the field of health and happiness
4.	Ser. No. 88/184,492	HEMP HEALTH AND HAPPINESS	IC 3: Essential oils; facial moisturizer; non-medicated body care products, namely, skin moisturizer, body oils, body creams IC 5: Pain relief cream; dietary supplements; vitamins; pain relief capsules; oil capsules IC 10: Compression garments, all comprised of hemp-based ingredients, namely, hemp oil derived from the mature stalks and seeds of the industrial hemp plant; arthritis gloves; knee wraps; back braces IC 29: Edible oil IC 31: Hemp seed hearts

¹ A Notice of Allowance issued on June 5, 2018. The applicant made its third request for an extension of time to file a Statement of Use, which was granted on October 26, 2019.

			IC 32: Light beverages; non-alcoholic beverages; energy drinks
5.	Ser. No. 88/292,143	DELIVERING HEALTH AND HAPPINESS	<p>IC 10: Wellness kits comprised of a selection oral vaporizers prefilled with essential oils that emit vapor for treatment of cancers, pain disorders, psychiatric disorders, nutritional deficiencies, and diseases of the skin, ear, nose, throat, cardiovascular, respiratory, metabolic, immune, central nervous, endocrine, glandular, musculoskeletal, digestive, excretory, and reproductive systems</p> <p>IC 18: All-purpose sport bags, Backpacks, Duffel bags, Tote bags, Umbrellas</p> <p>IC 25: Trousers, jackets, tunics, bandanas, hats, head wraps, visors, berets, capes, jerkins, cloaks, dressing gowns, bathrobes, bathing suits, beachwear, belts, bermuda shorts, underwear, nightwear, camisoles, cardigans, children's and infants' cloth bibs, infantwear, ear bands, jogging pants, jogging suits, knitted wear, leggings, leotards, neckerchiefs, overalls, polo shirts, pullovers, suits, suspenders, tank tops, waistcoats, windjackets, skirts, blouses, t-shirts, sport shirts, hoodies</p> <p>IC 35: Campaign services to promote public awareness of the medical and therapeutic uses of plants and plant extracts and healthy approaches to celebrating new discoveries in the healing powers of plants</p> <p>IC 41: Educational and</p>

			<p>entertainment services, namely, providing a website featuring information about cannabis, cannabis dispensaries, products containing cannabis and current events relating to cannabis</p> <p>IC 42: Providing information in the field of plant and plant extracts research, namely, the interaction between combinations of plant extracts and the endocannabinoid system</p> <p>IC 44: Providing a website featuring resources, namely, online medical information pertaining to medical cannabis</p>
6.	Reg. No. 5,902,601		<p>IC 5: Hydrogel for medical purposes; Wound dressings; Surgical dressings; Skin barrier ointment for medical use; Pharmaceutical preparations for the skin, namely, a topical skin barrier lotion used to treat and manage skin conditions by repairing and hydrating the skin; Adhesive bandages; Bandages for dressings; Bandages for skin wounds; Gauze; Gauze for dressings; Cotton for medical purposes; Cotton sticks for medical use; Aseptic cotton; Tape for skin suture; Surgical tape; Medical adhesive tape; First-aid boxes, filled</p>
7.	Reg. No. 5,785,534		<p>IC 44: Consulting in the field of health and wellness to bring about personal happiness; Consulting services in the field of mental fitness; Consulting services in the field of mental health and wellness; Consulting services in the field of women's health; Consulting services in the fields of health and nutrition; Holistic health services;</p>

			<p>Online cosmetic skincare consultation services; Beauty consultation services; Beauty consultation services in the selection and use of cosmetics, fragrances, beauty aids, personal care products, and bath, body and beauty products; Beauty salon services; Food nutrition consultation; Hair salon services; Hair salon services, namely, hair cutting, styling, coloring, and hair extension services; Hair salon services, namely, treatments to protect hair from effects of exposure to sunlight, heat, humidity and chlorinated water; Hair color salon services; Medical consultations provided via phone, online chat or videoconferencing; On-line make-up consultation services; Providing an interactive holistic web site featuring health information and patient initiated, patient authorized, fee-for-service, holistic approach distance healing sessions based on the patient's specific set of symptoms, medical profile and medical record analysis and patient benefit information concerning organic and holistic products and services; Providing in-person holistic health care services</p>
8.	Ser. No. 88/594,196		<p>IC 5: Dietary food supplements; Dietary supplemental drinks; Dietary supplements; Dietary supplements consisting primarily of vitamins, minerals, carotenoids, omega 3, and botanical extracts; Dietary supplements for human</p>

			consumption; Dietary supplements for human eye and vision health; Dietary supplements in the form of softgel, capsule and tablet; Dietary and nutritional supplements; Dietary and nutritional supplements containing vitamins, minerals, carotenoids, omega 3, and botanical extracts; Food supplements; Mineral food supplements
9.	Reg. No. 5,109,041	HEALTH, HEALING, & HAPPINESS	IC 3: Essential oils
10.	Reg. No. 3,688,323	CREATING HOPE, HEALTH AND HAPPINESS	IC 44: Providing weight reduction planning, treatment and supervision through weight reduction programs featuring counseling and creating diet regimes; Health care services, namely, wellness programs.
11.	Reg. No. 3,454,694	H2U - HEALTH, HAPPINESS, YOU	IC 44: Providing healthy lifestyle and health information; healthcare services; medical services; health consultation services
12.	Ser. No. 88/678,868	YOUR GUTWAY TO HEALTH AND HAPPINESS	IC 16: Books
13.	Ser. No. 88/396,910	HEALTH, WEALTH AND HAPPINESS	IC 28: Gaming machines including poker machines; gaming machines including poker machines incorporating operating software; parts and accessories in this class for the aforesaid goods IC 41: Entertainment services, namely, providing online games for playing games of chance, games of skill and games of mixed skill and chance; entertainment services, namely, providing virtual environments in which users can interact through social games for recreational, leisure or entertainment purposes; entertainment services in the form of online contests; provision of

			online games and virtual slot machines for playing games of chance, games of skill and games of mixed skill and chance played, through non-downloadable software and via global online social networks
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In light of the existing registrations and applications, the Cited Registration is severely weakened. Moreover, customers are capable of distinguishing among the various marks and, thus, Applicant’s use of the words “Health” and “Happiness” cannot be a sufficient basis to find a likelihood of confusion with the Cited Registration. Accordingly, this factor weighs strongly against a finding of likelihood of confusion.

B. The Goods and Services Are Distinct

Applicant’s Mark also is not likely to cause confusion with the Cited Registration because Registrant’s services and Applicant’s goods are different and service different customers. This is an independent basis to reconsider the Examining Attorney’s refusal. *See, e.g., Lifetec, Ltd. v. Brue*, Opposition No. 103,538, 2000 WL 992443, at *3 (T.T.A.B. June 28, 2000) (dismissing opposition to registration of LIFETECH based on alleged likelihood of confusion with LIFETEC LEARNING SYSTEMS; finding that the parties’ educational services, which “on their face [were] distinctly different,” were not “so closely related in substantive content” to be confused).

As described in Applicant’s Amended Identification, Applicant’s Mark will be used on an “advertising mailer, namely a selection of coupons for discounts on a range of health and wellness products and services.” In sharp contrast, Registrant is an advertising agency, and it uses the Cited Registration as a tagline for its “advertising and marketing services.” In other words, as shown in the Cited Registration’s Specimen, Registrant creates advertising and marketing for other companies, which would bear those companies’ trademarks, not the Cited



Registration. Thus, its use of the Cited Registration is to refer to itself:



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*See Exhibit A.*² There is no evidence that Registrant uses the Cited Registration on advertising mailers or, more specifically, mailers containing coupons that provide its clients with discounts on products, nor do the plain words of the Cited Registration cover paper mailers or coupons. Indeed, in not one of the examples of Internet evidence upon which the Examining Attorney relied, did an advertising agency place its own tagline on the advertising mailer it prepared for its clientele.

The fact that Applicant's goods and Registrant's services relate to advertising in the most general sense does not make them similar for the purposes of the likelihood of confusion analysis, as even goods in the same class which are much more similar than the ones at issue here have been found to be different. *See, e.g., In re Lori Childers, dba Blue Stone Press*, Ser. No. Serial No. 76/160,227, 2003 WL 446815, at *3 (T.T.A.B. Feb. 20, 2003) (reversing

examiner's refusal to register  for a magazine because mark was not likely to cause confusion with  for a newspaper because the goods "may be considered related in the sense that they are both publications," but nevertheless, "the goods are specifically

² It is appropriate to consider Registrant's specimen in determining whether a likelihood of confusion exists. *See In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (noting PTO's consideration of specimens submitted by registrant and applicant in analyzing likelihood of confusion; reversing refusal to register mark).

different”); *Harlem Wizards Entm’t Basketball, Inc. v. NBA Props., Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997) (holding that parties’ concurrent use of WIZARDS mark for a “show basketball” team and a professional basketball team did not create a likelihood of confusion; noting that “when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion”); *Reynolds & Reynolds Co. v. I.E. Sys. Inc.*, 5 U.S.P.Q.2d 1749, 1751 (T.T.A.B. 1987) (finding no likelihood of confusion where there was no “similarity between the goods and services at issue . . . beyond the fact that each involves the use of computers”). This is highlighted by the fact that Applicant’s goods and Registrant’s services are in different classes. Applicant has sought to register the HEALTH AND HAPPINESS mark in Class 16, which relates to the general category of “paper goods and printed matter”; and the Cited Registration is in Class 35, which relates to the wholly distinct category of “advertising and business.” TMEP § 1401.02(a).

Moreover, Applicant’s goods and Registrant’s services target different consumers, which further underscores the lack of potential confusion. *See, e.g., M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 U.S.P.Q.2d 1944 (Fed. Cir. 2006) (no likelihood of confusion between the senior user’s mark “M2” registered for CD-ROMS sold exclusively to the music and entertainment industries and the applicant’s mark M2 COMMUNICATIONS for CD-ROMS sold only to clients in the pharmaceutical and medical industries; noting that “paramount to this case is the industry-specific focus of the parties’ claimed goods”). Applicant targets members of the general public who purchase health and wellness products and services at a discount by using Applicant’s proprietary coupons. Declaration of Gracye Cheng (“Cheng Decl.”) ¶¶ 4–5. By contrast, Registrant’s services are narrowly tailored toward businesses within a select number of industries, not the public at large, as seen below in an excerpt from

Registrant’s application. The Cited Registration’s Specimen shows that Registrant’s business targets “a select number of industries.”

WHY WE’RE SUCCESSFUL.

We focus on understanding the intricacies of a select number of industries, and have a tried and true formula for increasing profitability for brands within these verticals.

RESTAURANT * FRANCHISE	FOOD * BEVERAGE	TRAVEL * HOSPITALITY	HEALTH * FITNESS
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See Exhibit A. It also indicates that Registrant’s business “solve[s] business problems with marketing” through an individualized and tailored “collaborative process” that Registrant’s client and Registrant “go through together”:

WE’RE BEST AT...

WE FULLY EXPLORE...

the state of the business, its challenges, opportunities and measurements of success, then create a plan for getting to that success.

BENEFIT: WE SOLVE BUSINESS PROBLEMS WITH MARKETING.

WE’RE BEST AT...

WE CAPTURE AND ARTICULATE...

the truth — the brand essence, the stake in the ground that anchors itself to the minds and hearts of the target audience. This truth embodies every step in the plan.

BENEFIT: WE FIND THE BEST WAY TO ARTICULATE YOUR GREATNESS - ONE THAT CAN ONLY BE ACHIEVED THROUGH A COLLABORATIVE PROCESS WE GO THROUGH TOGETHER.

Id. This further shows that there is no likelihood of confusion as Applicant targets individual members of the public who purchase health and wellness products and services at a discount, not companies or specific brands’ marketing departments. See *Procter & Gamble Co. v. A. E. Staley Mfg. Co.*, 342 F.2d 476, 479 (C.C.P.A. 1965) (difference in “classes of purchasers to which the goods of the respective parties are sold” supports finding of “no likelihood of confusion,” even where there is “without question a similarity in the appearance of the words which comprise the respective marks”).

In sum, because Applicant’s Mark is for different products than the Cited Registration’s services, consumers are not likely to believe that they emanate from the same source, and thus confusion is unlikely.

C. The Trade Channels Are Distinct

In addition, the trade channels used by Registrant and intended to be used by Applicant are distinct, which also supports a finding of no likelihood of confusion. *See, e.g., In re The W.W. Henry Company, L.P.*, 82 U.S.P.Q.2d 1213, 2007 WL 186661 (T.T.A.B. 2007) (no confusion likely between cited PATCH ‘N GO for chemical filler to repair polyolefin sold to plastic manufacturers and applicant’s PATCH & GO for cement patch for drywall, concrete and the like, sold to do-it-yourselfers and contractors in hardware stores, as the two products would be sold “to different classes of purchasers through different channels of trade”).

As evidenced by a comparison between Applicant’s Amended Identification and the Cited Registration’s Specimen, consumers are not likely to encounter the Cited Registration and Applicant’s Mark in similar marketing conditions. Recipients of Applicant’s goods will encounter Applicant’s Mark on discount coupons contained in a paper mailer. Moreover, as noted above, Applicant’s goods will be targeted towards members of the general public. Cheng Decl. ¶ 5.

The Internet evidence cited by the Examining Attorney shows that Registrant is unlikely to send such paper mailers or discount coupons to the general public using the Cited Registration to advertise its *own* services. This is further shown by Registrant’s focus on targeting “select” brands. *See Exhibit A; see Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 2006 WL 173463 (T.T.A.B. 2006) (no conflict between opposer’s TUNDRA clothing and applicant’s TUNDRA automobiles as “[t]he marks for these goods would not be encountered by purchasers under marketing conditions that would give rise to a likelihood of confusion”).

Accordingly, because the trade channels used by Registrant and intended to be used by Applicant are distinct, there is no likelihood of confusion.

D. The Degree of Consumer Care Is High for the Cited Registration

Although not addressed in the Office Action, the degree of care used by consumers of Applicant's goods and the clients of Registrant's services is high, albeit for different reasons, as discussed below. This too supports a finding of no likelihood of confusion. *See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (no likelihood of confusion where plaintiff sold "E.D.S." computer services to "experienced corporate officials after significant study and contractual negotiation" while defendant sold "EDS" power supplies and battery chargers to OEMs as both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable").

As noted above, Registrant's clients are businesses in a "select number of industries" that are looking to hire Registrant to "fully explore the state of the business, its challenges, opportunities and measurements of success, [and] then create a plan for getting to that success." *See* Exhibit A. In choosing an advertising agency to "articulate [their] greatness" and their "brand essence," Registrant's clients—*i.e.*, businesses—are likely to be highly discerning. *Id.* Such highly discerning consumers are unlikely to be confused by Applicant's use of its mark. *See, e.g., Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575 (Fed. Cir. 1983) (no likelihood of confusion found in sale of industrial parts "to large corporations and government agencies, whose purchasing agents have sufficient expertise to distinguish between the sources of the goods"); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390, 1991 WL 350751 (T.T.A.B. 1991) (sophisticated buyers of medical instruments are not likely to be confused between "HP" and "HPM"). Further, by their very nature, advertising and marketing services are not purchased on a whim, but rather are carefully and selectively chosen by businesses.

Similarly, recipients of Applicant's coupons for discounts on health and wellness products and services are members of the general public who are holders of a GoodRx discount card. Cheng Decl. ¶ 5. Economically prudent members of the public also are likely to be discerning as to the source of potential savings. *Cf. Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827 (8th Cir. 1999) (diet-conscious consumers tend to examine food packages more carefully to determine source and caloric content).

Accordingly, the high degree of consumer care displayed by the discerning purchasers of both Applicant's goods and Registrant's services indicates that it is unlikely that these purchasers will be misled as to the source of the goods and services.

E. The Cited Registration Is Not Famous

In addition to the above considerations, the lack of fame of the Cited Registration weighs against a likelihood of confusion. In determining the fame of a mark, "the relevant inquiry is the extent to which customers and potential customers of a product (as opposed to the general public) are aware of the prior mark." *See Miguel Torres, S.A. v. Bodegas Muga, S.A.*, 176 F. App'x. 124, 127 (Fed. Cir. 2006). "[T]he fame of a mark is usually proved by evidence reflecting the volume of sales, the extent of advertising of goods bearing the mark, and the length of time that those indicia of consumer awareness have been present." *Id.* at 128 (finding no likelihood of confusion between the marks TORRE MUGA and TORRE as Torres' newspaper recognition and critical acclaim were not enough to show fame of its mark and noting that what was necessary was a showing that the marks were unquestionably famous, usually done through a market share analysis). Here, there is no evidence that the Cited Registration has come even close to achieving fame in the United States. The date of first use on the Cited Registration's application is 2014. The lack of fame of the Cited Registration weighs against a finding of likelihood of confusion.

II. THE GOODS ARE “GOODS IN TRADE”

The Examining Attorney noted that Applicant’s registration could be refused on the ground that the cited goods were not “goods in trade.” Goods in trade are items that an applicant sells or transports in commerce and that have utility to others. *See, e.g., In Re Snap-on Tools Corp.*, 159 U.S.P.Q. (BNA) ¶ 254 (T.T.A.B. Sept. 27, 1968) (ball point pens used to promote applicant’s tools were “goods in trade” where they had a utilitarian function and purpose and had been sold or transported in commerce under the mark); *In re United Merchants & Mfrs., Inc.*, 154 U.S.P.Q. 625 (T.T.A.B. 1967) (calendar used to promote applicant’s plastic film constitutes goods in trade, where calendar has a utilitarian function and purpose in and of itself, and has been regularly distributed in commerce for several years); TMEP § 1202.06. By contrast, “incidental items” are items that “applicant uses in conducting its business” and that are not separately sold or distributed to consumers for their use and are not considered “goods in trade.” TMEP § 1202.06. Here, Applicant’s advertising mailers contain coupons to be used by members of the general public. Cheng Decl. ¶¶ 4–5. They are not items that are incidental to Applicant’s business as letterheads, invoices, and business forms may be.

In light of the foregoing, Applicant respectfully requests that the Examining Attorney allow Applicant’s Mark to proceed to registration.

Dated: January 10, 2020

Respectfully submitted,



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