

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Trademark Application of

ConSeal International Incorporated)
Mark: PROBIO)
Serial No.: 88/419,626)
Filing Date: May 7, 2019)
Examiner: Justin Miller)
Telephone: (571) 272-6040)

BOX RESPONSES

NO FEE

Commissioner for Trademarks

PO Box 1451

Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Applicant responds to the Office Action dated August 3, 2019 (“the Office Action”), as follows:

REMARKS

I. Section 2(d) Refusal – Likelihood of Confusion

Following the filing of Applicant’s trademark application, the Examiner has refused registration of Applicant’s Mark on the basis of an alleged likelihood of confusion between Applicant’s Mark PROBIO (“the Mark”) and the mark PROBIO LIVING in U.S. Registration No. 5,515,261 (“the Cited Mark”).

In the refusal, the Examiner argues that the Mark so resembles the Cited Mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the

goods and/or services of Applicant and the registrant. Applicant respectfully disagrees, and responds as follows:

A. The Mark and the Cited Mark Are Not the Same or Very Similar

The Mark and the Cited Mark are different in sight, sound, and commercial impression. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. *See Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *I, LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). When comparing the marks, “[a]ll 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. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *See e.g., In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)).

Here, Applicant’s Mark appears differently when compared to the Cited Mark. The Cited Mark contains an additional word than Applicant’s Mark, as it has added LIVING following the word PROBIO. A consumer viewing the Cited Mark would immediately take note of the additional and dissimilar term, recognizing the differences between the Mark and the Cited Mark, believing the additional term to be indicative of the goods provided under the Cited Mark. Due to the additional word, an inherent difference exists in the pronunciation of Applicant’s Mark and the

Cited Mark. Moreover, the additional word included in the Cited Mark conveys a different commercial impression due to the connotation of the distinct word. Furthermore, the additional word seen in the Cited Mark is phonetically dissimilar to Applicant's Mark. As a result, consumers can distinguish easily and quickly between the Cited Mark and Applicant's Mark as they present different appearances, sounds, and connotations.

Additionally, Applicant's Mark creates a different commercial impression than the Cited Mark. Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression).

Due to the additional word that appears in the Cited Mark, the commercial impression created by the Cited Mark differs substantially from Applicant's Mark. For example, the additional word in the Cited Mark, LIVING, connotes a conduct or manner of life. *See Exhibit A*, definitions of the word "living." When used in connection with the word PROBIO, the commercial impression

evokes a lifestyle related to probio goods. Contrarily, Applicant's Mark does not denote or suggest any lifestyle related to probio. A consumer will be able to differentiate between Applicant's Mark and the Cited Mark due to the different connotations of each mark. When analyzing the marks, it is unlikely that Applicant's Mark will be confused with the Cited Mark as the Cited Mark consists of multiple words that create a different meaning and commercial impression as compared to the meaning and commercial impression of Applicant's Mark. Given these differences in commercial impression created by Applicant's Mark and the Cited Mark, no likelihood of confusion exists between them.

B. The Goods Are Not Related

Here, the goods are not related. A likelihood of confusion does not exist between two marks merely because the respective goods or services are sold within the same broad market. *See, e.g., In re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (use of CANYON for candy bars not likely to cause confusion with registered mark CANYON for fresh citrus fruit); *see also Homeowner's Group, Inc. v. Home Marketing Specialists, Inc.*, 18 U.S.P.Q.2d 1587, 1594 (6th Cir. 1991) (no likelihood of confusion between marketing and advertising support services for real estate brokers under HMS and providing real estate brokerage services under HMS HOME MARKETING SPECIALISTS). In *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), the court did not find any likelihood of confusion even though the plaintiff sold E.D.S. computer services and defendant sold EDS power supplies and battery chargers, and both parties sold their respective goods and services in some instances even to the same hospitals. No likelihood of confusion existed because of the distinct types of goods and services and because - despite the overlap in customers - the purchases were made by different departments within those same hospitals.

Determining the similarity of goods and services is ultimately based on common sense and common experience. *ITT Corp. v. XTRA Corp.*, 225 U.S.P.Q. 723, 732 (D. Mass 1985). “The Board...has found no likelihood of confusion even with respect to identical marks applied to goods and or services used in a common industry where such goods and or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.” *Borg-Warner Chem, Inc. v. Helena Chem. Co.*, 225 U.S.P.Q. 222, 224 (TTAB 1983).

Further exemplifying this principle, sugar and pizza are both “food,” but they are not considered “related” goods for purposes of the likelihood of confusion analysis. *Amstar Corp. v. Domino’s Pizza, Inc.*, 205 U.S.P.Q. 969, 977 (5th Cir. 1980). A television production facility and a restaurant are both “tourist attractions” but they are not “related.” *CBS, Inc. v. Liederman*, 33 U.S.P.Q.2d 1333, 1337 (S.D.N.Y. 1994). Shoes and men’s underwear are both “clothing,” but they are not “related.” *In re British Bulldog*, 224 U.S.P.Q. 854, 856 (TTAB 1984). “Food products” are not “related” to “food services.” *Jacobs v. International Multifoods Corp.*, 212 U.S.P.Q. 641, 642 (CCPA 1982). “Computers” are not automatically “related” to other computers. *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992). “Hardware” is not automatically “related” to “software.” *In re Quadram Corp.*, 228 U.S.P.Q. 863 (TTAB 1985).

Here, the Cited Mark is used in association with “Air deodorant; Car deodorant; Household deodorant.” Contrarily, Applicant’s Mark is used in connection with “Odor neutralizing preparations and odor eliminators; chemical odor counteractants; odor neutralizing preparations for general use on various surfaces; cleaning preparations; cleaning preparations, namely, odor eliminators not for personal use; cleaning preparations, namely, odor neutralizers not for personal

use; Liquid and dried bacterial enzyme products used in silage preservers, animal feed additives, hard surface cleaning products, detergent products, and drain and septic tank cleaners and treatments; liquid and dried bacterial enzyme products used in chemical waste treatment, municipal waste treatment, organic waste treatment.” Analogous to *Amstar Corp.*, the fact that both the Cited Mark and Applicant’s Mark provide goods related to odor eliminators does not lead to a conclusion that consumers are likely to assume that the air fresheners provided under the Cited Mark are related to Applicant’s surface cleaners used to eliminate odors. Consumers will understand that Applicant provides surface cleaners that are used to eliminate odors on various surfaces, rather than air freshening goods for household and vehicle use. Thus, the goods are entirely different as they are used for starkly different purposes. As a result of the goods being readily distinguishable, no likelihood of confusion exists between Applicant’s Mark and the Cited Mark.

II. Conclusion

Applicant believes that the foregoing is fully responsive to the refusal to register, and that the refusal should be withdrawn. The Examiner is cordially invited to call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.