

REMARKS AND ARGUMENTS

February 11, 2020

I. SEARCH RESULTS: PRIOR PENDING APPLICATION

The Office Action indicates that pending application 88109782 (Hemp MD) was filed earlier than the instant case, but allows for arguments to address potential conflicts between the marks. For simplicity’s sake the cases are referred to here as the ‘782 application and instant application.

A. Class of Goods

Applicant herewith deletes claims to class 005, for pharmaceutical goods. Hence the instant application now pertains only to class 003 (specifically cosmetic preparations). By contrast, as the record currently stands, the ‘782 application pertains only to class 005. By definition, classes 003 and 005 pertain to statutorily divergent markets. Logically, confusion as to source of goods is necessarily diminished or erased between those markets. Note that the respective goods are neither similar nor related: cosmetic vs. nutritional, and topical vs. foods.

B. Timing

The ‘782 case did not allude to topical products in any way until 01/13/2020, when a revised identification of goods was filed. That was almost a year *after* the instant application was filed (03/05/2019), so the instant application has seniority for topical products and uses.

C. Mistaken Reinterpretation

The ‘782 application as filed recites only “nutritional supplements” for its identified goods. For reference, expert sources equate nutritional supplements (hereafter abbreviated as NSs) exclusively with *dietary* supplements (hereafter abbreviated as DSs).

- (1) The National Cancer Institute (NCI) defines an NS as “A product that is added to the diet. A [NS] is taken by mouth and usually contains one or more dietary ingredient (such as vitamin, mineral, herb, amino acid, and enzyme. Also called [DS].” See <https://www.cancer.gov/publications/dictionaries/cancer-terms/def/nutritional-supplement> .
- (2) The editors of the journal Nature, which is ranked at the pinnacle of scientific journals, defines NSs as follows. “[NSs] are any [DS] that is intended to provide nutrients that may otherwise not be consumed in sufficient quantities; for example, vitamins, minerals, proteins, amino acids or other nutritional substances. Products are usually ingested in capsule, tablet or liquid form.” See <https://www.nature.com/subjects/nutritional-supplements> .
- (3) The FDA recites a substantially similar definition of DSs from the Dietary Supplemental Health and Education Act of 1994. It begins, “A dietary supplement is a product taken by mouth that contains a ‘dietary ingredient’ intended to

supplement the diet.” See <https://www.fda.gov/food/information-consumers-using-dietary-supplements/questions-and-answers-dietary-supplements>.

The ‘782 application’s 1/13/2020 revised identification treats NSs as though the term encompasses skin nutrition and or transdermal nutrition. ‘782’s relevant new language reads, “Nutritional supplements in topical, balm or lotion form sold as a component of nutritional skin and animal coat care products ...”.

That revision is contrary to conventional and statutory definitions and thus in error, moreover its semantics attempt to convert a class 5 good into a class 3 good. The error is compounded because it expands the scope of the application as filed, which the MTEP forbids. Here again, the instant application has seniority for the class and type of goods contemplated.

D. Lawful Use

If the Office ultimately determines that the ‘782 application pertains entirely to unlawful goods, then that mark could not issue under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; TMEP §907, so it should be moot as a reference to invalidate the instant application.

However, even if the ‘782 application is found to pertain to some federally lawful goods, they will necessarily be dietary supplements as shown above, and thus distinguished from the topical products recited in the instant application.

E. Conclusion as to the ‘782 Application

Between the two cases, only the present application has a valid basis to receive a mark for topical products, which are the only goods it now continues to identify. And in any event the instant mark as currently prosecuted pertains to a different market and would create no significant consumer confusion as to the origin of another vendor’s goods.

II. FDCA REFUSAL – BASED ON ID

This refusal concerns goods in International Class 005 only. In order to expedite prosecution, applicant herewith amends the application to delete goods in Class 005, as stated above.

III. IDENTIFICATION OF GOODS

For remaining International Class 003 the identification of goods was deemed to be indefinite and require clarification for the types of after-sun treatments, such as creams, lotions and gels. Applicant herewith adopts the following changes.

International Class 3: Cosmetic preparations based on hemp extracts for skin health, namely: creams; ointments; after-sun treatment creams, lotions, gels and sprays; moisturizers; toners; cleansers; anti-wrinkle creams; day and night creams; and lotions.

Edits are shown in the mark-up copy below.

International Class 3: Cosmetic preparations based on hemp extracts for skin health, namely[,]; creams[,]; ointments[,]; after-sun treatment creams, lotions, gels and sprays; moisturizers[,]; toners[,]; cleansers[,]; anti-wrinkle creams[,]; day and night creams[,]; and lotions.

IV. DISCLAIMER REQUIRED

A disclaimer was required for an unregistrable part of the mark, Hemp MD. That disclaimer is provided herewith.

No claim is made to the exclusive right to use “HEMP MD” apart from the mark as shown.

V. CONCLUSION

This reply is believed in good faith to address all actions and concerns stated in the Office Action. The Examiner is urged to consider this application with a view toward allowance, and to contact the undersigned if further information or an amendment might resolve remaining issues.

Sincerely,

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