

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Remix Therapeutics Inc.
Serial No. : 88/639146
Date Filed : October 2, 2019
Mark : REMIX
Class No. : 5, 42
Examiner : Lakeisha S. Munn Lewis
Law Office : 105

RESPONSE

Applicant submits the following remarks in response to the January 7, 2020 Office Action.

Identification of Goods and Services

Please amend the identification of goods and services to the following language:

- Class 5: Pharmaceutical and therapeutic preparations for the treatment of cancer, immune system related diseases and disorders, cardiovascular diseases and disorders, genetic diseases and disorders, and neurological diseases and disorders
- Class 42: Pharmaceutical, medical, scientific, and biopharmaceutical research and development

Applicant has enclosed the requisite fees of \$275 for the new class with the present Response.

REMARKS

Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney has initially denied registration of Applicant's REMIX mark for, in relevant part, "pharmaceutical and therapeutic preparations," contending that there is a likelihood of confusion under Section 2(d) of the Trademark Act with prior registrations for REMIX BY GISELLE WASFIE (stylized) (Registration No. 5364634) and REMIX BY GISELLE WASFIE (Registration No. 5364599) for "anti-wrinkle creams; aromatic oils; aromatic essential oils; body oil; cosmetic oils; essential oils; essential oils for aromatherapy use;

essential oils for household use; essential oils for personal use; essential oils for use in aromatherapy; eye cream; face oils; facial oils; hand cream; hand creams; lavender oil; natural essential oils; non-medicated cleansers, namely, facial skin cleanser; non-medicated skin care preparations; non-medicated skin care preparations, namely, essential oils, toners, serums, and creams for the treatment of fine lines, wrinkles and skin irregularities.; non-medicated skin serums; non-medicated skin toners; oils for cosmetic purposes; perfume oils; skin care products, namely, non-medicated skin serum; wrinkle removing skin care preparations.” Notably, the Examining Attorney has the burden of proving that confusion between Applicant’s mark and the cited marks is likely, not merely possible. *See In re Giovanni Food Co.*, 97 U.S.P.Q.2d 1990, 1991 (T.T.A.B. 2011). Applicant respectfully submits that a § 2(d) refusal would be improper in light of (a) the differences between the marks and (b) the parties’ dissimilar goods.

A. The Differences Between the Respective Marks Are Sufficient to Preclude a Likelihood of Confusion.

In evaluating a likelihood of confusion, marks should be compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000). Here, the Registrant’s marks end with the distinctive wording BY GISELLE WASFIE, causing the cited marks to be significantly longer than Applicant’s mark. These features and the other differences between the marks are sufficient to avoid consumer confusion.

Applicant’s mark consists of a single term, REMIX, and contains only five letters. In contrast, the Registrant’s mark has multiple components and features the three additional words BY GISELLE WASFIE, creating a four-word, twenty-letter mark. The overlapping portion is one-fourth of the Registrant’s marks, while Applicant’s mark is solely comprised of REMIX without any additional wording. GISELLE WASFIE is a unique and memorable name that would have a significant impact on consumers’ perception of the marks as well. Overall, these features in the Registrant’s marks create a visual impression that is wholly distinct from Applicant’s mark.

The cited marks are also distinguishable from Applicant’s mark in terms of sound. REMIX is a one-word, two-syllable mark that ends with a “miks” sound. In contrast, REMIX BY GISELLE WASFIE contains four words and seven syllables and ends with a “fē” sound. Although “rē” and “miks” are the only sounds in Applicant’s mark, the Registrant’s marks

contain five additional sound elements, creating utterly distinct sounds. Hence, the aural differences between the marks cut against a finding of likelihood of confusion.

B. The Parties' Dissimilar Goods and Trade Channels Obviate a Likelihood of Confusion.

Applicant's amended identification of goods eliminates any likelihood of confusion with the cited mark. It is well established that differences in the parties' goods and services alone may be sufficient to prevent a likelihood of confusion. When determining whether a likelihood of confusion exists under § 2(d), "confusion is related not to the nature of the mark but to its effect when applied to the goods of the Applicant. [Therefore,] the only relevant application is made in the marketplace." *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973). In fact, when determining whether a likelihood of confusion exists under § 2(d), if the goods and services in question "are not related . . . in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." T.M.E.P. § 1207.01(a)(i).

Here, the parties offer vastly different goods. Applicant's original identification stated "pharmaceutical and therapeutic preparations" without referencing Applicant's core treatment focuses. Theoretically, Applicant's original identification could have encompassed "pharmaceutical and therapeutic preparations for the treatment of dermatological conditions." This is no longer the case. Applicant has now amended its description of goods to narrow the identification by specifying that its "pharmaceutical and therapeutic preparations" are "for the treatment of cancer, immune system related diseases and disorders, cardiovascular diseases and disorders, genetic diseases and disorders, and neurological diseases and disorders." While Applicant does not concede that its original identification of goods conflicted with the Registrant's, none of the remaining goods in Applicant's identification relate to dermatological conditions or skin care treatments in any capacity. Hence, the differences between the parties' goods strongly weigh against a finding of likelihood of confusion.

The parties' dissimilar trade channels reinforce the fact that any consumer confusion between the marks is highly unlikely. Applicant is a pharmaceutical company developing drugs that will be distributed through authorized medical channels via licensed healthcare providers and pharmacists. In contrast, the Registrant provides *non-medicated* skin care products such as facial oil, eye cream, skin toners, and perfume oils. No prescription is required to purchase the

Registrant's goods, and consumers may purchase these types of cosmetic items at, for example, specialty beauty vendors and makeup stores. Patients would only take Applicant's medications after consulting with their doctor, but consumers typically purchase cosmetic items like the Registrant's products independently and on their own volition. Additionally, while Applicant's medications are designed for patients suffering from life-threatening illnesses such as cancer, the Registrant's goods are designed for, e.g., the prevention of wrinkles. Thus, Applicant and the Registrant's respective goods travel in different channels of trade and are directed towards different relevant consumers, obviating a finding of likelihood of confusion. Due to the wholly distinct uses for these marks, it is not likely or probable that consumers would confuse Applicant and the Registrant's respective goods.

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In summary, any confusion between Applicant and the Registrant's marks is highly unlikely. When considering the differences between the marks and the dissimilarity of the parties' goods and trade channels, the conclusion that there is no likelihood of confusion is inescapable. As the factors discussed above strongly weigh against a finding of a likelihood of confusion, the USPTO should reconsider the rejection in the present case.

CONCLUSION

In view of the foregoing, the Applicant believes the application is in condition for publication. Such action is solicited.