

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK APPLICATION – PRINCIPAL REGISTER**

Applicant: Vive Health LLC
Serial No.: 88726787
Response due date: August 10, 2020
Mark: CORETECH
Goods: Medical braces for the back, shoulder, neck, ankle, wrist, elbow, and knee

RESPONSE TO THE OFFICE ACTION

Applicant Vive Health LLC (hereinafter “Applicant”) respectfully submits this response to the Office Action regarding the above trademark application (the “Application”), as follows:

REMARKS

I. LIKELIHOOD OF CONFUSION

The Examining Attorney has rejected the Application under Section 2(d) of the Lanham Act, asserting that the applied-for mark is confusingly similar to the U.S. Registration Serial Nos. listed below:

Serial No.	Mark	Description
4410443	CORE	Cervical pillows for medical use; orthopaedic cushions; therapeutic non-electric body massagers; electric massage appliances, namely, electric vibrating massager; therapeutic hot and cold therapy packs; support belts used during pregnancy and for medical purposes; medical braces for arms, legs, wrists, knees and ankles for medical use; traction apparatus for medical use and, electrotherapy devices for providing transcutaneous electrical nerve stimulation.
5508589	CORE PRODUCTS	Cervical pillows for medical use; orthopaedic cushions; therapeutic non-electric body massagers; electric massage appliances, namely, electric vibrating massager; therapeutic hot and cold therapy packs; support belts used during pregnancy and for medical purposes; medical braces for arms, legs, wrists, knees and ankles for medical use; traction apparatus for medical use and, electrotherapy devices for providing transcutaneous electrical nerve stimulation for pain for the head, neck, shoulders, arms, wrists, hands, back, legs, ankles, and feet.

(hereinafter the “Cited Registrations” or “Cited Marks”). For the following reasons, Applicant respectfully requests the reconsideration and withdrawal of this refusal.

a. Legal Standard

The mere possibility of confusion is not a sufficient basis for refusal under §2(d) of the Lanham Act – there must be a likelihood of confusion. *See e.g. HMH Publishing Co. v. Brincat*, 183 USPQ 141, 144 (9th Cir. 1974); *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 136 USPQ 508, 518 (9th Cir.) cert. denied, 374 U.S. 830 (1963); *A&H Sportswear v. Victoria's Secret Stores, Inc.*, 237 F. 3d 198 (3rd Cir. 2000). In addition, the Trademark Trial and Appeal Board generally resolves doubts in favor of the applicant and of passing the mark to publication because of the subsequent opposition process which allows for other applicants and competitors to argue their own case. *See e.g. In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Whether a likelihood of confusion exists is determined by evaluating the *DuPont* factors. *See In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). “[N]ot all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered.” TMEP § 1207.01; *see also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered”) (internal citations omitted). With respect to the present application, the number and nature of similar marks in use on similar goods and the similarity or dissimilarity of the marks and their commercial impression demonstrate there is no likelihood of confusion.

b. The cited marks are weak and entitled to only a narrow scope of protection.

Marks incorporating commonly used terms are weak and allow for greater coexistence of arguably similar marks. *See e.g. King Candy Co.*, 496 F.2d at 1401 (“confusion is unlikely because the marks are of such non-arbitrary nature or so widely used that the public easily distinguishes slight differences in the marks under consideration as well as differences in the goods to which they are applied, even though the goods of the parties may be considered ‘related’”); *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295, 297 (CCPA 1958) (“It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where

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”). The strength of a mark is very important in the likelihood of confusion analysis:

“[w]hether a mark is classified as ‘strong’ or ‘weak’ is a very important element in deciding likelihood of confusion. If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion. A portion of a mark may be weak in the sense that such portion is . . . in common use by many other sellers in the market.”

McCarthy on Trademarks and Unfair Competition, § 23:48. Here, the term “core” is commonly used in regular parlance and in related marks and is therefore relatively weak and should be provided little protection.

i. CORE is common in parlance and registered marks

CORE is commonly used to describe elements of the body and is very often used in discussions regarding the maintenance of a healthy body. *See e.g.* Mayo Clinic Staff, *Core exercises: Why You Should Strengthen Your Core Muscles*, MAYO CLINIC, <https://www.mayoclinic.org/healthy-lifestyle/fitness/in-depth/core-exercises/art-20044751> (last visited 4/10/2020); American Council on Exercise, *Core Anatomy: Muscles of the Core*, ACEFITNESS, <https://www.acefitness.org/fitness-certifications/ace-answers/exam-preparation-blog/3562/core-anatomy-muscles-of-the-core/> (last visited 4/10/2020); JC Pinzon, *What is core exercise?*, SHARECARE.COM, <https://www.sharecare.com/health/types-of-exercise-programs/what-is-core-exercise> (last visited 4/10/2020); *see e.g.* “Brace Your Core” - What Does That Even Mean?, SPORTITUDE, <https://www.sportitude.com.au/blog/brace-your-core-what-does-that-even-mean> (last visited 4/10/2020); Chao-G, *How to "Brace Your Core" Correctly?*, NERDFITNESS, <https://rebellion.nerdfitness.com/index.php?/topic/45364-how-to-brace-your-core-correctly/> (last visited 4/10/2020); *5 Ways to Truly Brace Your Core*, YOURTRAINERPAIGE, <http://www.yourtrainerpaige.com/2014/06/5-ways-to-truly-brace-your-core/> (last visited 4/10/2020).

CORE is also commonly used in registered marks. A search of USPTO records reveals a total of 199 “live” registrations or applications for marks containing the term “core” across all IC 010 goods. *See* Exhibit A. As such, CORE in the Cited Marks is suggestive and entitled to narrow protection. *In re Hunke*, 185 USPQ at 188 (emphasis added) (“[I]t is well established that the scope of protection afforded a ... *highly suggestive term* is less than that accorded an arbitrary or coined mark”).

ii. Coexistence of CORE marks for braces

Composite CORE marks for medical braces already coexist on the Principal Register.

Serial No.	Mark	Description
5018608	CORE-MAX	fitted compression and stabilizing orthotics for the neck, chest, torso, arms, hands, legs, and feet, and flexible compression braces for limbs and joints
3971879	CORELINE	Orthopedic soft goods, namely, medical braces for the knee, ankle and elbow, knee immobilizers, wrist splints, thumb spica, post-op shoes, soft cervical collars, arm slings, finger splints, clavicle straps, hip abduction splints, spinal orthoses, fracture boots, anti-embolism hose, compression hose, contracture boots, night splints
5762085	KORE24 (design mark)	Online retail store services featuring health, wellness, and beauty products, braces and supports for different parts of the body to help with those that are injured or in pain, leggings and compression clothing, fitness products, pillows, and medical devices

See Exhibit B. Likewise, a Google search shows a number of composite CORE marks being used in the market. *See i.e.* COREMEDICAL, INC., <https://www.corediscountmedical.com/> (last visited 4/9/20); *Core Back Braces*, CORE THRIVE, <https://www.amazon.com/slp/core-back-braces/o76gv3tc8w9w5av> (last visited 4/9/20). The presence of these registered and common law marks demonstrates consumers can distinguish between composite CORE marks and therefore the presence of the Cited Marks should not bar registration of the applied-for mark.

The TTAB faced a similar situation in *Box, Inc. v. Hakem Ikbariyeh*, Opposition No. 91202576 (TTAB July 7, 2016). *Box* was an opposition proceeding involving the opposer’s BOX marks and the applicant’s BOXME mark. The Board found the “services are identical” and

presumed “that the channels of trade and classes of purchased for those services are too.” *Id.* at 28. The analysis then turned to the strength or weakness of the common element between the parties’ respective marks. The Board noted that “[i]ndeed, [t]he 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.* at 31 (*quoting Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

The Board concluded “the record as a whole makes clear that Opposer’s BOX mark is conceptually and commercially weak, such that the differences between BOX and BOXME are sufficient, despite the identical services and channels of trade, that consumer confusion is unlikely.” *Id.* at 36; *see also Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ.2d 1458, 1476-78 (finding, based on this same principle, “that the mark PERKSPOT is sufficiently different from the marks PERKS and PERKSCARD to avoid a likelihood of confusion” even though the marks were used for legally identical services); *RevZilla Motorsports, LLC v. Powersports Plus LLC*, Opposition No. 91212858 (TTAB June 2, 2017) (finding that the marks REVZILLA and PARTSZILLA were not mutually exclusive even when used on directly competing, if not identical, goods/services and channels of trade, because the “-zilla” suffix was commonly used by a number of unrelated parties in different markets to convey similar impressions); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 779-80 (TTAB 1979) (allowing registration of NATURE’S PLUS for vitamins despite prior registration of PLUS for vitamins, because it already coexisted with a number of registrations containing PLUS for similar goods issued both before and after opposer’s registration).

Similar to *Box*, CORE for medical braces is a weak term and consumers can distinguish between composite CORE marks to avoid a likelihood of confusion. The applied-for mark is at least as distinguishable from the Cited Marks as the registered marks CORE-MAX, CORELINE, and KORE24 are from the Cited Marks.

c. Applicant’s mark is sufficiently dissimilar from the cited marks.

Especially given the composite CORE marks detailed above, Applicant's mark is sufficiently distinguishable in sight, sound, meaning, and commercial impression from the Cited Marks to avoid a likelihood of confusion.

CORETECH is visually distinct from CORE and CORE PRODUCTS. *See e.g. Information Resources Inc. v. X*Press Information Systems*, 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988) (“[a]lthough these two marks [EXPRESS and X*PRESS] are quite similar in sound, prospective purchasers are likely to encounter the marks visually rather than orally, and the marks differ significantly in appearance;” EXPRESS and X'PRESS for news services not confusingly similar even where provided by two companies involved in computer hardware and software).

CORETECH also sounds different than CORE and CORE PRODUCTS. At a minimum, it sounds as different from CORE and CORE PRODUCTS as CORELINE or CORE-MAX sound from CORE and CORE PRODUCTS.

CORETECH also has a different meaning than CORE or CORE PRODUCTS. While CORE and CORE PRODUCTS refer to the body and maintaining health, CORETECH is a suggestive term that may refer to the body and maintaining health or to the core (or primary) technical functions of the goods at issue. In addition, the meaning of CORETECH differs from that of CORE and CORE PRODUCTS at least as much if not more than CORE-MAX, CORELINE, and KORE 24.

CONCLUSION

For the foregoing reasons, Applicant requests allowance of this Application. If any concerns remain that can be informally resolved, the Examining Attorney is invited to contact the undersigned at djohnson@wnlaw.com or 801-533-9800.

Submitted this 10th day of August, 2020.

/David P. Johnson/
David P. Johnson
Workman Nydegger

Attorney for Applicant