

RESPONSE TO OFFICE ACTION

Applicant Spectrum Pro Labs, LLC (“Applicant”) has reviewed the Office Action issued in connection with Serial No. 88804630 for the mark XTRA, and, based upon the arguments presented below, respectfully requests that the Examiner withdraw the rejections and allow the mark to proceed to publication. The Examiner is encouraged to call and discuss this response with Applicant’s Attorney of Record if the Examiner is not ready to allow the application to proceed to publication.

I. Introduction

The Examining Attorney received a Letter of Protest, and based upon that letter, issued a non-final Office Action on May 18, 2020 for a likelihood of confusion with Registration Nos. 4418734, 4108549, and 4486308. Applicant respectfully disagrees and requests reconsideration and withdrawal of the rejections based on the arguments presented below.

II. Prior Registrations

The Examiner has rejected the Application under section 2(d) due to prior Registrations: 4418734 for “X-TRA”, 4108549 for “SKOAL X-TRA”, and 4486308 for “SKOAL X-TRA MINT CHILL” (“Registrant’s marks”). However, as argued below, the marks are different, the goods and services are different, and the customer is different, among others.

A. Dissimilarity of the marks

The average consumer does not dissect words or marks, and would, naturally, distinguish the marks when viewed as a whole—they contain different words and different spellings. The Federal Circuit clarifies, “[t]he relevant *DuPont* factor requires examination of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. As is apparent from the plain language of this factor, marks must be viewed ‘in their entirety,’ and it is

improper to dissect a mark when engaging in this analysis...” *In re Viterra Inc.*, 671 F.3d at 1362 (internal citations omitted). Therefore, the marks should be viewed as a whole, without removing any portions therefrom or otherwise altering the marks.

As such, when viewed in their entirety by a consumer, the consumer would not be confused to think that the marks emanate from the same source. The marks have different words and arrangement, and, as such, both the visual and auditory portions of the marks are distinguishable and not subject to confusion by a consumer. Specifically, the SKOAL X-TRA and SKOAL X-TRA MINT CHILL marks are distinct from Applicant’s XTRA mark in that the Applicant’s mark contains one word—XTRA. Consumers would not alter Registrant’s marks by deleting the brand SKOAL. Additionally, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. As a result, the SKOAL mark would not be confused with Applicant’s mark.

Regarding the X-TRA mark, it is still visually distinct from the Applicant’s mark XTRA, which does not contain a hyphen. Even if, *arguendo*, these marks are similar, the analysis is not complete, as discussed next.

B. Dissimilarity of the goods and/or services

Even if the marks were identical, it would not be dispositive of the issue. “[C]ases involving the alteration, addition or elimination of only a single letter from the old mark to the new reach divergent results.” *McGregor-Doniger Inc. V. Drizzle Inc.*, 599 F.2d 1126, 1133 (1979). In *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003), the Court reiterated: “to establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used...” (emphasis in original, internal citation omitted). “Trademark cases involving the issue

of likelihood of confusion must be decided on the basis of the respective descriptions of goods.” *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

The Registrant’s marks list the following as class descriptions:

- U.S. Registration No. 4418734 for X-TRA for use with “Tobacco Products, Namely, Smokeless Tobacco” in International Class 034.
- U.S. Registration No. 4108549 for SKOAL X-TRA for use with “Tobacco Products, Namely, Smokeless Tobacco” in International Class 034.
- U.S. Registration No. 4486308 for X-TRA for use with “Tobacco Products, Namely, Smokeless Tobacco” in International Class 034.

Applicant’s goods are:

- Electronic cigarette liquid (e-liquid) comprised of propylene glycol; Liquid nicotine solutions for use in electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes in International Class 044.

“Registrability must be determined on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of the goods are directed.” *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1372 (Fed. Cir. 2002) (internal citations omitted).

Using this well-established rule, it is clear that the prior Registrant’s marks with their associated good/services and Applicant’s goods/services do not overlap. Specifically, Registrant’s marks are directed to smokeless tobacco. Smokeless Tobacco is defined

as: “pulverized or shredded tobacco chewed or placed between cheek and gum : snuff” (See Merriam-Webster definition: <https://www.merriam-webster.com/dictionary/smokeless%20tobacco>). Registrant’s class description must be so limited for comparison purposes.

In contrast, the Applicant provides e-liquid for electronic cigarettes—which is not smokeless tobacco. As such, the goods do not overlap as set forth in the Registrant’s marks and the current application. More specifically, the Registrations do not include any type of electronic cigarette liquid (e-liquid). Accordingly, the goods offered by the Applicant are distinct from those offered by the Registrant.

The fact that retailers may sell both smokeless tobacco and e-liquid is not sufficient evidence to reach the conclusion that consumers would be confused. The courts have explained:

“ [the] fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining the likelihood of confusion...[T]he registered mark in this case is simply for restaurant services in general, and the Board's conclusion that restaurant services and beer are related is based on the fact that a tiny percentage of all restaurants also serve as a source of beer, which is a very weak evidentiary basis for a finding of relatedness...[T]he Board's finding that beer and restaurant services are related is not supported by substantial evidence... While the evidence produced by the examining attorney shows that some restaurants brew or serve their own private label beer, that evidence does not support the Board's conclusion that consumers are likely to conclude that beer and restaurant services with similar marks emanate from the same source.”

In re Coors Brewing co., 343 F.3d 1340, 1346-1347 (Fed. Cir. 2003).

The same is true in the instant case. Although some retailers may sell both tobacco and e-liquid, this does not mean that the source of those goods are the same. There are very few companies that are the source of both tobacco and e-liquid. Indeed, Skoal, and its parent company U.S. Smokeless Tobacco Co. (which also own Copenhagen) do not sell any form of e-liquid, and it is the leading producer of smokeless tobacco (per their own website: <https://www.us smokeless.com/> and <https://www.us smokeless.com/company/about-usstc?src=megaspotlight>). The goods are also used differently by consumers: Applicant's e-liquid is used in an e-cigarette, which resembles traditional cigarette smoking; Registrant's smokeless tobacco does not resemble smoking, and is instead, chewed or placed between the teeth and gums. A consumer seeking Registrant's goods would not be confused and buy Applicant's goods in their place.

In *In re Shell Oil Co.*, 992 F.2d 1204, 1208 (Fed. Cir. 1993), the court explains that the overriding concern is not only to prevent buyer confusion, but to “protect [] the registrant...from adverse commercial impact due to use of a similar mark by a newcomer.” Here, Applicant's mark will not create an adverse commercial impact to the Registrant's marks. As explained above, the Registrant provides smokeless tobacco (e.g., chewing tobacco) and does not offer (e-liquid) or cartridges filled with chemical flavorings. As a result, a consumer that is seeking Registrant's product will purchase from Registrant and will not mistakenly purchase from Applicant—Applicant sells a distinct product, that is not tobacco, and therefore will not confuse consumers. As a result, there is no commercial impact to Registrant.

While tobacco and e-liquid may be associated in the same general field via, at time, nicotine, the Federal Circuit has also stated, “[t]he mere fact that both barbeque mitts and gloves are worn on the hands simply does not support a finding that consumers would associate these products with a common source.” *Shen Mfg. Co., Inc. v. The Ritz Hotel, Ltd.*, 393 F. 3d 1238, 1246 (Fed. Cir. 2004). Therefore, it is clear that the Registrant, who provides smokeless tobacco, will not be confused with Applicant, who is providing e-liquid. In *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567 (Fed. Cir. 1984), the court states, “we deem it proper to say that, *while not controlling*, conjoint use is a fact proper to be considered along with other facts present in particular cases” (emphasis added). Any alleged complementary use here is not controlling, and is, at best, *de minimis*.

C. Trade Channels and Sophisticated Buyers

As noted above, Registrant and Applicant are in distinct channels of trade. Those looking for e-liquid for electronic cigarettes will not be confused with Registrant’s smokeless tobacco, and vice versa. Furthermore, the goods at issue are highly specialized and are for very particular purposes. Due to the myriad of products available in traditional smoke and smokeless tobacco, and add to that the addition of e-cigarettes, individuals must research their desired product before purchase. This is also true due to the flavorings and possible nicotine levels of e-liquid, which requires a user to scrutinize the product. Carcinogens may also play a role in the user making a determination as to product. Lastly, all of the aforementioned products are regulated by the Federal government and the individual States, limiting the channels of trade and buyers. As a result, any overlap between the products is likely a result of such regulation.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Conclusion

The marks in the Registration and Application have different words and spellings, the goods are distinct, and the goods are sold to highly sophisticated buyers. Therefore, Applicant respectfully requests that the Examiner allow the mark to proceed to publication.