IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Share Skincare, Inc.
Serial No.:	88/155,327
Mark:	SOLUTION
Classes:	009, 040, 042, 044
Office Action Date:	October 16, 2019
Examiner:	Shari Gadson – L.O. 120

REQUEST FOR RECONSIDERATION

This response ("Response") to the Office Action issued on October 16, 2019 ("Office Action") regarding the application by Share Skincare, Inc. ("Applicant") for registration of the trademark SOLUTION ("Mark"), U.S. Trademark Serial No. 88/155,327 in Classes 9, 40, 42, and 44 ("Application") addresses the issues raised by the examining attorney ("Examiner"), namely, Partial Refusal: Section 2(d) – Likelihood of Confusion.

Based on response to the above referenced issue in this Response, Applicant respectfully requests that the Examiner approve the Application to proceed to publication on the Principal Register.

I. REQUEST FOR PARTIAL DIVISION OF APPLICATION

Applicant requests to divide out the following from the Application:

> Class 044: Web-based health assessment services, namely, a series of health-related questions for response from the user that result in a report that provides health-related information in the form of recommended educational resources; Consultation services in the field of health, wellness, and nutrition; Wellness analysis to determine dietary supplements and formulas of dietary supplements that are best suited to particular individuals, namely, medical testing for treatment purposes; Health care services, namely, preparation of personalized dietary supplements for others for treatment purposes; Providing a website featuring information on health and nutrition, wellness and cosmetic skin care services

II. PARTIAL REFUSAL SECTION 2(D) – LIKELIHOOD OF CONFUSION

In the Office Action, the Examiner refused the registration of the Mark based on a likelihood of confusion with the mark in U.S. Registration Nos. 2309323, 3989747, and 3700519 with respect to Class 44 only (the "Cited Marks") based on Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Applicant respectfully disagrees with the Examiner's conclusion and maintains that confusion between Applicant's Mark and the Cited Marks is unlikely for the reasons stated below.

LIKELIHOOD OF CONFUSION

A. Applicant's Mark and the Cited Marks Are Not Likely to Cause Confusion.

As discussed in Applicant's July 24, 2019 response (the "July Response"), the question of likelihood of confusion between marks is "not related to the nature of the mark but to its effect when applied to the goods of the applicant." *In re E.L. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973). That is, the relevant application should be made in the marketplace. "The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding the use of a mark." *Id.* The *du Pont* factors significant to this case strongly support a conclusion that there is no likelihood of confusion:

(1) Services under Applicant's Mark are unrelated to the services under the Cited Marks; and

(2) Consumers of Services under Applicant's Mark do not overlap with the consumers of services under the Cited Marks.

1. Services under Applicant's Mark are Unrelated to the Services under the Cited Marks.

U.S. Registration Nos. 2309323, 3989747, and 3700519

In the Office Action, the Examiner argued that the same entity commonly provides geriatric health care management services, namely wound care, medical information, healthcare information, and specialized skin care regimens to elderly consumers who reside in assisted living facilities also provides dermatology services similar to Applicant's Services. *See* Office Action. As supporting evidence, the Examiner submitted five (5) website evidence, namely, http://theomedicaldermatology.com/, https://ltcdocs.com/#about, https://ltcdocs.com/service/dermatalogy/, https://onsitedermatology.com/, and https://onsitedermatology.com/services/. *Id*. As the Examiner submitted in the Office Action, the evidence consists of third-party mobile dermatology services. In fact, all five (5) websites are owned by dermatologists. However, Applicant has nothing to do with dermatologists or goods and/or services that may be provided by dermatologists.

In contrast, Applicant is a *commercial beauty brand* that provides personalized skincare. Applicant's competitors are beauty brands including, but not limited to, Clinique, Kiehls, Atolla, and Neutrogena. Attached as Exhibit A are screenshots of the websites owned by Clinique, Kiehls, Atolla, and Neutrogena. As clearly demonstrated on the websites, none of Clinique, Kiehls, Atolla, or Neutrogena offer geriatric health care management services or dermatology-related medical services. Applicant and Applicant's competitors are not medical products and technologies company like the registrant ConvaTec Inc. of the U.S. Registration Nos. 2309323 3989747. Further, Applicant and Applicant's competitors are not a home health and community care organization like the registrant United HomeCare Services, Inc. of U.S. Registration No. 3700519. As a result, Applicant and Applicant's competitors do not offer services related to "geriatric health care management services, namely wound care, medical information, healthcare information, and

specialized skin care regimens to elderly consumers who reside in assisted living facilities" as asserted by the Examiner. *See* Office Action.

A mere submission of evidence demonstrating how parties that provide medical information or geriatric health care management services provide some sort of medical skincare management does not prove that these parties also commonly offer commercial, beauty skincare products that Applicant offers. Also, such evidence does not prove that parties like Applicant also commonly provide geriatric healthcare services. In fact, as discussed above, Applicant and Applicant's competitors have nothing to do with geriatric healthcare services nor medical skincare management. Therefore, Applicant maintains that Applicant's Services are unrelated to the services offered under the Cited Marks.

In fact, in cases involving goods and services that have been only broadly related, but where parties do not compete and do not market to the same consumer groups, courts have generally found confusion unlikely. *See, e.g., Benjamin J. Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 1024 (T.T.A.B. 2009) (DESIGNED 2 SELL for staging rental property and DESIGNED TO SELL home design television show); *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445 (S.D.N.Y. 1982) (BENEFICIAL consumer loans and BENEFICIAL CAPITAL business loans). *See* July Response. In the present case, the confusion is even more unlikely given that Applicant's Mark and the Cited Mark offer different goods and/or services to discrete markets.

Lastly, the evidence submitted by the Examiner does not prove that parties that provide commercial beauty brand-related services also provide geriatric health care management services. Given the discrete markets served by Applicant and registrants of the Cited Marks, a mere fact that both Applicant's Services and services under the Cited Marks both relate to some sort of healthcare

management services is not enough to conclude that the Applicant's and registrants' services overlap or that such services would cause consumer confusion.

As discussed in the July Response, there exist multiple cases where it was found that broad relationships between goods/services are insufficient to find likelihood of consumer confusion, even where the marks at issue were identical, which is not even the case here. *See, e.g., Edwards Lifesciences Corporation v. Vigilanz Corporation*, 94 U.S.P.Q.2d 1399 (T.T.A.B. 2010) (VIGILANZ for hospital pharmacy monitoring system not confusingly similar to VIGILANCE heart monitor and software); *Pep Boys-Manny, Moe & Jack v. Edwin F. Guth Co.*, 197 F.2d 527 (C.C.P.A. 1952) (CADET for storage batteries and CADET for lighting fixtures not likely to be confused). Here, the relationships between the services offered by Applicant and the registrants are so broad that consumer confusion is highly unlikely.

2. Consumers of Services under Applicant's Mark Do Not Overlap with the Consumers of Services under the Cited Marks.

Applicant is a commercial beauty brand which provides personalized skincare system based on each consumer's needs. Relevant consumers of Applicant's Services use the Services for the purpose of achieving beautiful skin via basic skincare items including, but not limited to, moisturizer and serum. On the other hand, the relevant consumers of the Cited Marks are seniors seeking for geriatric services. These consumers are not only highly sophisticated but are also not interested in buying beauty skincare products.

There is no evidence that clinicians looking for "geriatric health care management services, namely wound care, medical information, healthcare information, and specialized skin care regimens to elderly consumers who reside in assisted living facilities" would seek to purchase

beauty skincare products. Therefore, it is unlikely that the relevant consumers of the Cited Marks would be confused with Applicant's Mark.

Further, even when the parties sold their goods/services to the same company, the Federal Circuit has found no likelihood of confusion where the goods were sold to different departments within that same company. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1993) (reversed and sustained opposition; registration allowed to issue to applicant). For example, in *Electronic Design*, the plaintiff sold E.D.S. data processing services to medical insurers, while the defendant sold its EDS batteries and power supplies to makers of medical equipment. Even though both parties sold their respective products to the same corporations in some instances, the purchasers were made by different departments and persons within those corporations. Even in such case, the court held that it could not assume that the same individuals made purchasing decisions on plaintiff's and defendant's products. *Id*. at 717.

Here, the present case of Applicant and the registrants of the Cited Marks involve even more disparate channels of trade than found by the Federal Circuit in *Electronic Design*. That is, there is no evidence that the parties will ever provide their services to the same purchasers. The Examiner's submission of website evidence involving medical doctors that provide geriatric healthcare services do not and cannot prove that Applicant's consumers overlap with the consumers of those companies. Applicant's company is not even remotely related to medical doctors providing geriatric healthcare services.

As such, even if Applicant's consumers encounter services under the Cited Marks, there is no evidence that these consumers would be likely to assume that the services came from a same source. In sum, Applicant maintains that there is no likelihood of consumer confusion.

CONCLUSION

Based upon the foregoing, Applicant submits that it has addressed the issue raised in the Office Action and respectfully requests that the Mark be allowed to proceed to publication. If there are any remaining concerns with respect to this Application, please contact the Attorney of Record.

EXHIBIT A

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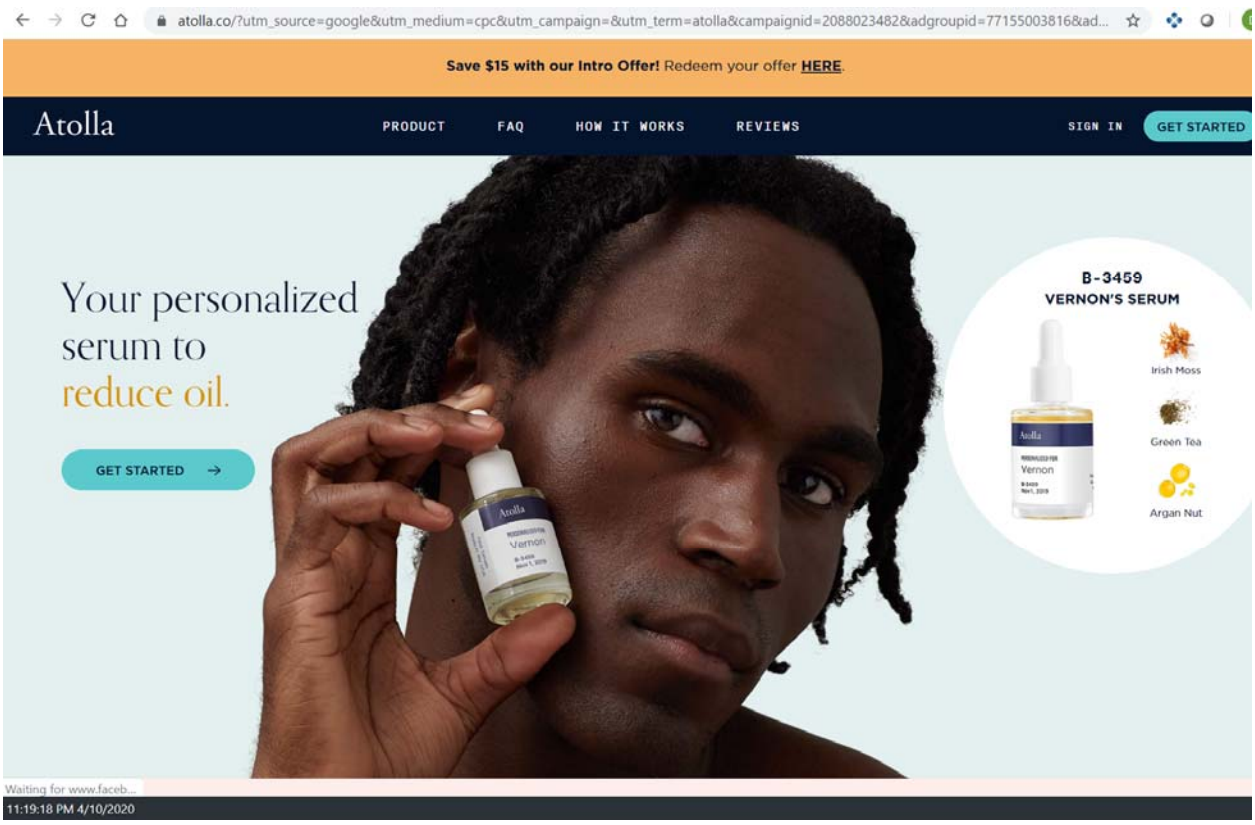
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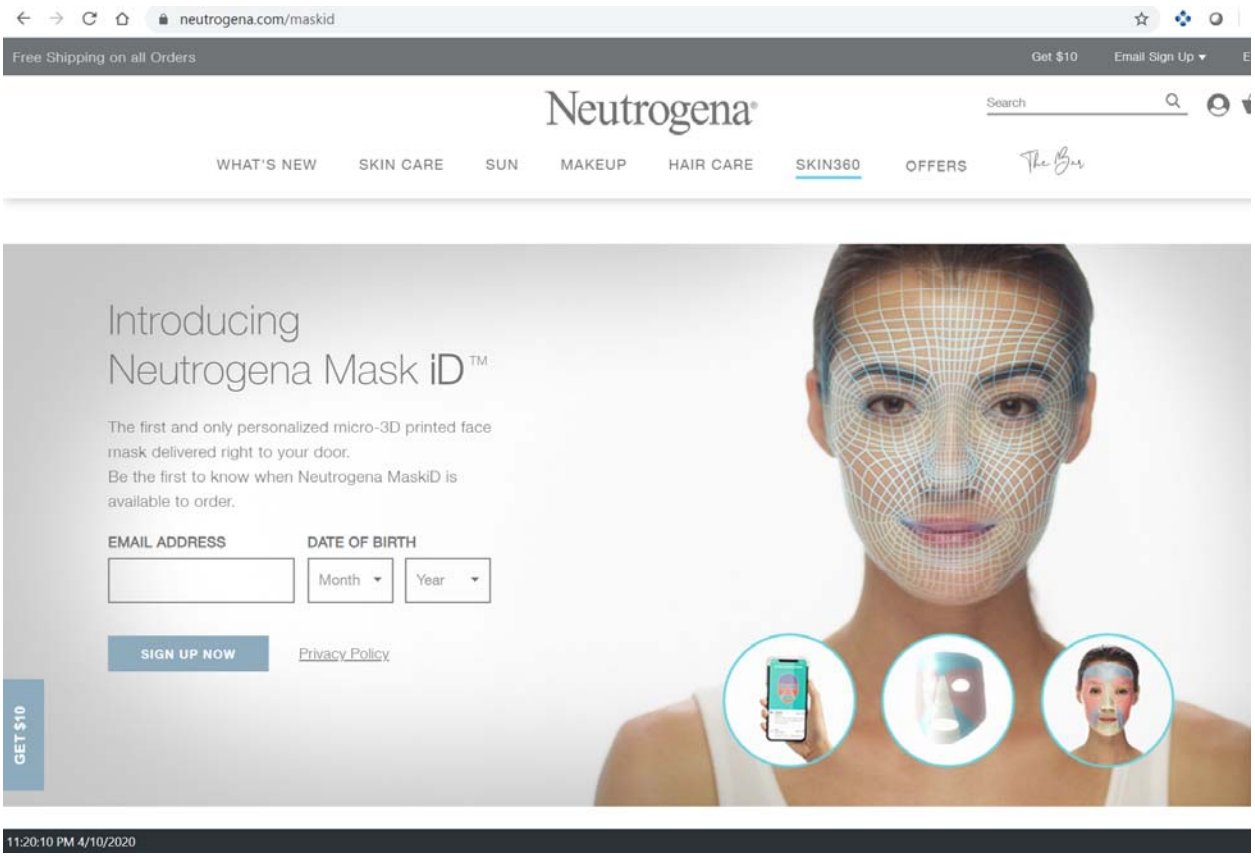
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