RESPONSE TO OFFICE ACTION

Mark: SENNA

Appl. No.: 87/683,504

Applicant: OMM Imports Inc.

Class: 010

Goods: Electronic aesthetic skin treatment devices using light emitting diodes, namely, infrared, red, orange, yellow, green, and blue wavelengths for generating light rays; Electronic light therapy apparatus for the skin

Filing Date: November 14, 2017

BACKGROUND

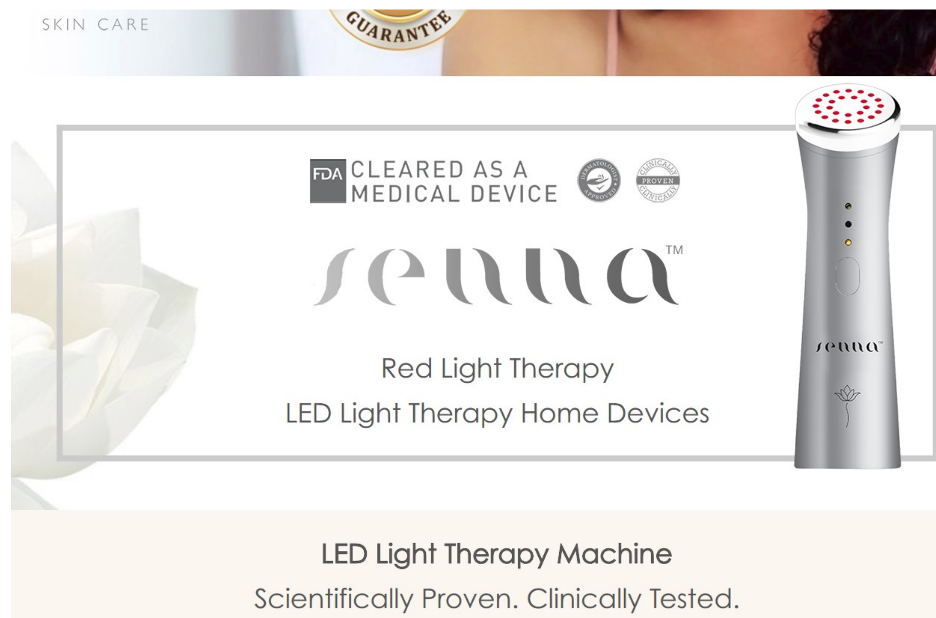
The Examining Attorney issued a provisional refusal to register the Applicant's mark, due to a likelihood of confusion with a prior-Registered mark. Applicant's mark is SENNA in connection with, generally, "electronic aesthetic skin treatment devices" in International Class 010. The cited registration is U.S. Registration No. 2,188,775 for SENNA in classes 3, 18 and 21 for, generally, makeup, skin care preparations and soaps, cosmetic cases, "make-up brushes and … sponges" (the "Conflicting Registration"). Applicant respectfully disagrees with the Examining Attorney and as grounds therefore states that there is no likelihood on confusion for two main reasons: the goods are different and applicant's product is requires consideration prior to purchasing.

NO LIKELIHOOD OF CONFUSION

Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In a "likelihood of confusion" determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression and the similarity of the goods and services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Likelihood of confusion

depends on whether the purchasing public would mistakenly assume that the Applicant's goods or services emanate from the same source or are associated therewith. *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973). Likelihood of confusion determinations must be made on a case-by-case basis (*On-Line Careline, Inc. v. Am. Online, Inc.*, 56 U.S.P.Q.2d 1471, 1474 (Fed. Cir. 2000)).

Here, Applicant's good is a device used for anti-aging. It is in class 10, which is for medical devices. The goods in the conflicting registration are cosmetics or for use with cosmetics. The fact that it happens to be used on the face, like the goods in the Conflicting Registration should not be enough to cause a likelihood of confusion. Plainly stated, Applicant's goods are not cosmetic products. Please see below for screen shot of Applicant's goods showing it is indeed very much a medical device:



A. Possibility of Confusion is Not Enough

For the "confusion" to be considered "likely," the confusion must be more than merely possible, it must be probable. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1465 (T.T.A.B. 1992) (standard is likelihood of confusion, "not some theoretical possibility built on a series of imagined horrors"); *Rodeo Collection, Ltd. v. West Seventh*, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("probable, not simply a possibility"). Trademark law is

"not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.,* 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992), quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 4445 (C.C.P.A. 1969), 153 U.S.P.Q. 412 (T.T.A.B. 1967).

D. There Is No Likelihood of Confusion Because the Nature of Applicant's Goods Requires Consideration and Consumers are Sophisticated

Even if the same consumers were to run across both marks at issue here, those consumers would not suffer confusion, as the consumers would be required to stop and think prior to purchasing the goods associated with Applicant's mark. Applicant's goods retail for about $200 - $600. Please see below screen shot from Applicant's webpage:

Further, individuals purchasing medical devices are sophisticated. Sifting through the many products available takes time, consideration and research. See *In re N.A.D. Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, (Fed. Cir. 1985) (finding there would be no likelihood of confusion where "only very sophisticated purchasers [ ] are involved who would buy with great care and unquestionably know the source of the goods."); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390 (TTAB 1990) (noting education level of

buyers as relevant to their sophistication); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 U.S.P.Q.2d 1061, 1064 (TTAB 1998) (customers that were "fashion conscious, high income and quite sophisticated" were not likely to be confused by same surname of mark on clothing). *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164 (TTAB 2001) (sophistication of both parties' purchases and lack of impulse purchases for product types factors against likelihood of confusion).