IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :		C8VANTAGE
Serial No.	:	88087400
For :		Nanjing Nutrabuilding Bio-tech Co., Ltd.
Examiner	:	Elizabeth A. O'Brien
Law Office	:	105

RESPONSE TO OFFICE ACTION DATED 10/22/2018

This is responsive to Office Action dated 10/22/2018. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Nanjing Nutrabuilding Bio-tech Co., Ltd. seeks registration of U.S. Serial No. 88087400 for C8VANTAGE in relation to "Raw materials in the nature of medium-chain triglycerides, derivatives of Medium-chain triglycerides including salts, polymers, esters, acids, Medium-chain triglycerides isomers, and derivatives of Medium-chain triglycerides isomers including salts, polymers, esters, acids used as raw materials in the manufacture of food supplements, nutritional supplements and dietary supplements" in International Class 1. The original identification has been amended as suggested.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s)

listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see* TMEP § § 1207.01 *et seq*.

- U.S. Registration No. 3833440 for VITAMIN C8 stylized covering "Dietary supplements containing vitamin C" in International class 5.

- U.S. Application Serial No.87687482 for C8-MAX in standard character covering "Dietary supplements" in International class 5. (Abandoned)

- U.S. Application Serial No.87737865 for C8 stylized covering "Dietary supplements" in International class 5.

- U.S. Application Serial No.87737872 for C8KETO in standard character covering "Dietary supplements; nutritional supplements; liquid protein supplements; weight loss supplements; health supplements" in International class 5.

APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF CONFUSION ONE BY ONE

Likelihood of confusion between two marks is determined at the USPTO by a review of all of the relevant factors under the DuPont test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Under DuPont, the marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). When dealing with a stylized logo such as the marks cited here, "the fundamental rule in this situation is that the marks must be considered in their entireties." TMEP 1207.01(c)(ii) (*citing Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74

C.C.P.A. 1974)).

Applicant respectfully suggests that consumer confusion between the C8VANTAGE and the stylized form of VITAMIN C8 is unlikely for the following reasons:

Applicant's **C8VANTAGE** mark differs in sight, sound and connotation when compared to the VITAMIN C8 such that consumers would not likely be confused regarding the origin of Applicant's "Raw materials in the nature of medium-chain triglycerides, derivatives of Medium-chain triglycerides including salts, polymers, esters, acids, Medium-chain triglycerides isomers, and derivatives of Medium-chain triglycerides isomers including salts, polymers, esters, acids used as raw materials in the manufacture of food supplements, nutritional supplements and dietary supplements" in International Class 1 with registrant's "Dietary supplements containing vitamin C" in International class 5. The factors that are relevant to a determination of likelihood of confusion are set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), wherein the two most significant factors relied upon are the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression and the similarity of the goods and channels of trade. The Federal Circuit has held that where the marks at issue are dissimilar, the first Du Pont factor may be dispositive of the likelihood of confusion issue. *In Kellog Co. v. Pack'em Enterprises, Inc.,* -- F.2d -- , 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (held: TTAB correctly granted summary judgment that there is no likelihood of confusion between FROOT LOOPS and FROOTEE ICE). *In ex parte examination*, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and relatedness of the goods or services. *See, TMEP 1207.01*. The other Du Pont factors may be considered only if relevant evidence is contained in the record. See, *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). Accordingly, differences in appearance, sound, connotation and commercial impression between marks are sufficient to support a finding of no likelihood of confusion.

The basic principle in determining confusion between marks is that marks must be compared in their entireties. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. *In Re National Data Corporation*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). **Applicant's mark must be considered in the way in which it is perceived by the relevant public, and not considered after hyper-technical dissection**. *In Re Shell Oil Company*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (The marks must be considered in the way in which they are perceived by the relevant public); See, also *In re Best Products, Co., Inc.* 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design for retail jewelry store services held not likely to be confused with JEWELERS BEST for jewelry). Furthermore, phonetic similarity alone is insufficient to establish likelihood of confusion. See, *Old Tyme Food, Inc. v. Roudy's Inc.*, 961 F.2d 200, 203 (Fed. Cir. 1992). **Here, applicant's mark is C8VANTAGE is a unitary term, while the registrant's mark is VITAMIN C8 as two separate words in stylized forms.**

Additionally, consumers are generally more inclined to focus on the first part in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee* En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) ("[T]he dominance of BARR in [a]pplicant's mark BARR GROUP is reinforced by its location as the first word in the mark."); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Here, **the Word "Vitamin" in Registrant's Mark Creates Substantial Differentiation. While the two marks undeniably share "C" and "8", they are just first part of applicant's unitary mark , and only the tail end of Registrant's, which is dominated by the word "Vitamin." This further serves to differentiate the marks in the minds of consumers.**

Thirdly, the connotation of the two marks are also different when associated with the corresponding goods and services. **"C8" in Applicant's mark refers to Caprylic Acid Triglyceride which is a type of Medium Chain Triglyceride frequently used in the manufacturing of dietary supplement, and it is commonly referred to as MCT "C8". Registrant's VITAMIN C8 mark, by contrast, is a literal reference to Vitamin C, as shown in Registrant's goods and services description: "Dietary supplements containing vitamin C." Indeed, the USPTO required Registrant to disclaim the word "Vitamin," and could (perhaps should) have required Registrant to disclaim the "C" as well**.

Applicant submits that the differences in sight, sound and appearance of applicant's C8VANTAGE Mark is distinct and different enough from the cited VITAMIN C8 Mark such that there is no likelihood of confusion. In the Office Action, the differences in the marks have not been given proper consideration and weight. **It is well established that marks must be compared in their entireties.** The office action fails to attribute proper weight to the distinct differences in appearance and sound, as well as the commercial impression and message conveyed to purchasers by Applicant's C8VANTAGE Mark compared to the cited marks. The appearance, sound, sight, and commercial impression of Applicant's C8VANTAGE Mark when viewed in its entirety (giving fair weight to the significant contributions of its component parts), are dissimilar in appearance, sound, and commercial impression when compared to the cited VITAMIN C8, C8-MAX, C8, C8KETO, KETO C8 Marks. The mere fact that the marks share a common word does not automatically result in a likelihood of confusion, as the marks must be viewed in their entirety. C8VANTAGE is a unitary term and should not be dissected into to part as C8 and VANTAGE. Therefore, when viewed in its entirety, consumers are not likely to be confused especially considering the marks are used in connection with different goods and services.

Argument against the potential likelihood of confusion with prior-filed applications

The Examiner has cited prior pending application Ser. No. 87687482 (C8-MAX). Without addressing the Examiner's initial view as to likelihood of confusion, we observe that an Office Action was issued in connection with C8-MAX on March 5, 2018, and no response was filed by the September 5, 2018 deadline for such responses. And the USPTO has marked that application abandoned, eliminating any potential conflict.

As for the potential likelihood of confusion with Ser. No.87737865  , Ser. No. 87737872 C8KETO, their appearance, sound, and commercial impression are also different from Applicant's C8VANTAGE in their entireties. Additionally, the goods and services are also different in nature and the target market varies.

The dissimilarity of nature of the goods or services as described in an application or registration;

There is also no likelihood of confusion since Applicant's C8VANTAGE Mark and the cited VITAMIN C8, C8-MAX, C8, C8KETO Marks are used in connection with different goods and services. Applicant's mark is used for "Raw materials in the nature of medium-chain triglycerides, derivatives of Medium-chain triglycerides including salts, polymers, esters, acids, Medium-chain triglycerides isomers, and derivatives of Medium-chain triglycerides isomers including salts, polymers, esters, acids used as raw materials in the manufacture of food supplements, nutritional supplements and dietary supplements" in Class 1. By contrast, the cited VITAMIN C8, C8-MAX, C8, C8KETO Marks are all related to ready-made dietary supplements.

Consumers are Sophisticated. Applicant's customers are usually manufacturers of dietary supplements, who are more sophisticated such that they are more discerning and educated in purchases and, as such, are unlikely to be confused. While Registrant's customers are purchasing products for ingestion. When it comes to people's own health and wellness, they are likely to be very careful and discerning. The completely different trademarks in appearance for the two different classes of products will certainly help in this regard. And the same consumer were not supposed to encounter both in commerce. The sale of dietary supplements is completely different from Applicant's "Raw materials in the nature of medium-chain triglycerides, derivatives of Medium-chain triglycerides including salts, polymers, esters, acids, Medium-chain triglycerides isomers, and derivatives of Medium-chain triglycerides isomers including salts, polymers, esters, acids used as raw materials in the manufacture of food supplements, nutritional supplements and dietary supplements". The channels are different and the group of consumers varies, there would be definitely no likelihood of confusion.

CONCLUSION

Given to the above arguments, Applicant's C8VANTAGE Mark unlikely to cause consumer confusion. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal to register Applicant's C8VANTAGE Mark under Section 2(d) of the Trademark Act.

Respectfully submitted: Wu Xianxi

On behalf of Nanjing Nutrabuilding Bio-tech Co., Ltd.