IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Share Skincare, Inc.
Serial No.:	88/155,327
Mark:	SOLUTION
Classes:	009, 042, 044
Office Action Date:	January 24, 2019
Examiner:	Thomas Young – L.O. 120

RESPONSE TO OFFICE ACTION

This response ("Response") to the Office Action issued on January 24, 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, 42, and 44 ("Application") addresses the issues raised by the examining attorney ("Examiner"), namely:

- Identification and Classification of Goods and Services;
- Multi-Class Application Requirements;
- Section 2(d) – Likelihood of Confusion;
- Section 2(e)(1) – Merely Descriptive; and
- Suspension of Application.

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

I. IDENTIFICATION AND CLASSIFICATION OF GOODS AND SERVICES

Applicant amends the description of goods and services in Classes 9, 42, and 44 in the Application based on the suggestion by the Examiner:

Class 009: Downloadable computer software applications for providing assessment and consultation based on user generated contents in the field of health and lifestyle; Downloadable computer software to enable uploading, capturing, posting, showing, editing, viewing, displaying, tagging, blogging, sharing, manipulating, distributing, publishing, reproducing, and otherwise providing electronic media, multimedia content, pictures, images, text, photos, user-generated content, and information via mobile devices, the Internet, and other communications networks; Providing downloadable software for lifestyle, health, microbiome, DNA, genetic information assessment and consultation in the field of health and lifestyle; Downloadable computer software to enable users to upload, store, manage, share, retrieve, aggregate, and analyze data in the field of healthcare and lifestyle; Downloadable computer software for use in the field of healthcare and lifestyle to assist users in assessing, personalizing and selecting healthcare and lifestyle products; Downloadable computer software to assess user generated contents in the field of health and lifestyle for providing assistance in selecting dietary supplements and personalizing dietary supplement formulas;

Class 40: Preparation of personalized dietary supplements for others**, namely, custom manufacture of dietary supplements;**

Class 42: **Providing temporary use of online**, non-downloadable software that allows users to interact with a website to provide users with access to a platform that assists users in the selection and personalization of dietary supplements and dietary supplement formulas, and contains information and how-to videos of techniques, digital tutorials and tips in the field of healthcare and lifestyle, and to

purchase dietary supplements; Platform as a service (PAAS) featuring computer software platforms for users to upload, capture, post, show, edit, view, display, tag, blog, share, manipulate, distribute, publish, reproduce, and otherwise provide electronic media, multimedia content, pictures, images, text, photos, user-generated content, and information via mobile devices, the Internet, and other communications networks; Providing online non-downloadable software for lifestyle, health, microbiome, DNA, genetic information assessment and consultation in the field of health and lifestyle; Software as a service (SAAS) services, namely, hosting software to enable users to upload, store, manage, share, retrieve, aggregate, and analyze data in the field of healthcare and lifestyle; Software as a service (SAAS) services, namely, hosting software for users to upload, store, manage, share, retrieve, aggregate, and analyze data in the field of healthcare and lifestyle; Software as a service (SAAS) services, namely, hosting software for use in the field of healthcare and lifestyle to assist users in assessing, personalizing, and selecting healthcare and lifestyle products;

Class 44: 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**

(the "Goods and Services").

Applicant believes that the amendments above should be acceptable because they clarify the original identification and do not expand or add different goods/services to the original identification. See 37 C.F.R. § 2.71(a); Trademark Manual of Examining Procedure ("TMEP") § 1402.06.

II. MULTI-CLASS APPLICATION REQUIREMENTS

Based on the amendment made to the descriptions of the Goods and Services, Applicant will make payments for an additional class.

III. 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, 3536145, 3989747, 3700519, and 4199192 (the "Cited Marks") based on Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Since U.S. Registration Nos. 3536145 and 4199192 have since been cancelled based on the failure to file an acceptable declaration under Section 8, Applicant will only address U.S. Registration Nos. 2309323, 3989747, and 3700519 in the Response. In sum, Applicant respectfully disagrees with the Examiner's conclusion and submits 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 stated in *In re E.L. du Pont de Nemours & Co.*, 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) Applicant's Mark Has a Commercial Impression Entirely Different from the Cited Marks;

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

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

1. Applicant's Mark Has a Commercial Impression Entirely Different from the Cited Marks.

Applicant's Mark and the Cited Marks have entirely distinct commercial meanings.

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

Applicant's Mark has a commercial impression entirely different from the Cited Marks SOLUTIONS. Here, Applicant's Mark SOLUTION with respect to Applicant's Goods and Services creates a commercial impression that Applicant provides an ultimate answer or system pertaining to providing and manufacturing personalized custom skincare products and dietary supplements. In contrast, the Cited Marks (U.S. Registration Nos. 2309323 and 3989747) suggest that the Cited Marks provide various solutions related to a recommended treatment in the field of wound, ostomy, and continence nursing. In agreement with their services, the consumers of the Cited Marks are clinicians looking to obtain a variety of educational resources, including continuing education courses, on topics in the field of wound, ostomy, and continence nursing.

As for the Cited Mark (U.S. Registration No. 3700519), the mark suggests that registrant United Homecare Services, Inc. offers various solutions to geriatric health care management services, rather than an optimized single answer or solution pertaining to providing personalized custom skincare products. Further, the consumers of the Cited Mark are seniors and families of seniors who seek home health and community care in South Florida.

In contrast to the consumers of the Cited Marks, Applicant's consumers are individuals who seek hyper-personalized custom skin regiment. Applicant's consumers do not need services pertaining to wound, ostomy, or continence nursing or geriatric services for seniors. Likewise, consumers of the Cited Marks do not seek personalized skincare regiment for beautiful skin. Undoubtedly, Applicant's consumers and the Cited Marks' consumers do not overlap and thus, purchasers of services under Applicant's Mark are not likely to encounter the Cited Marks.

Even where products have been arguably related to and/or have overlapped directly and were sold through the same channels to the same consumers, which is not the case here, the Federal Circuit and its predecessor, the C.C.P.A., have found confusion unlikely in cases where the marks at issue had different commercial meanings, even though the junior mark's first term was phonetically identical to the senior user's mark. *See e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998) (CRYSTAL for champagne v. CRYSTAL CREEK for wine); *Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 491 F.2d 1265 (C.C.P.A. 1974) (DUTCH MASTERS for cigars v. DUTCH APPLE for tobacco).

2. Goods and Services Under Applicant's SOLUTION Mark are Unrelated to the Services Under the Cited Marks.

Applicant provides services pertaining to hyper-personalized custom skincare regiment and dietary supplements to achieve beautiful skin. On the other hand, the Cited Marks offer services unrelated to anything remotely close to customized skincare and dietary supplements.

In fact, the services offered under the U.S. Registration Nos. 2309323 and 3989747 are medical information and healthcare information related to wound, ostomy, and continence nursing for clinicians. The services offered under the U.S. Registration No. 3700519 are health services in relation to geriatric services for seniors and their families.

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). In the present case, the confusion is even more unlikely given that Applicant's Mark and the Cited Mark offer entirely different goods and/or services to discrete markets.

Further, there is no evidence that parties that provide hyper-personalized custom skincare services also provide (1) wound and ostomy care for clinicians or (2) geriatric care for seniors and seniors' families. A simple fact that both Applicant's Goods and Services and services under the Cited Marks both relate to some kind of healthcare services is not enough to find that the goods and/or services are related. Numerous cases have found such broad relationships insufficient to find likely confusion, even where the marks at issue were identical, which is not 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.)

3. Consumers of Goods and Services Under Applicant's Mark Do Not Overlap with the Consumers of Services Under the Cited Marks.

Applicant's Goods and Services are for providing hyper-personalized custom skincare system based on each consumer's lifestyle, health, microbiome, DNA, and generic information. Relevant consumers of Applicant's Goods and Services use the Goods and Services for the purpose of achieving beautiful skin. On the other hand, the relevant consumers of the Cited Marks are either (1) clinicians looking to further education in the field of wound care or (2) seniors seeking for geriatric services. In fact, clinicians looking to further their education about wound care do not seek personalized custom skincare and dietary supplements for beauty reasons. Likewise, there is no reason for seniors or their families looking for geriatric services to seek customized skincare regiment and dietary supplements using innovative technology. Further, both consumers of Applicant's Mark and the Cited Marks are highly sophisticated that likelihood of confusion is unlikely. The relevant consumers of Applicant's Mark are individuals who are highly interested in taking care of their skin and health, using innovative technology that encompasses one's lifestyle, healthy, microbiome, DNA, and generic information. It is unlikely that these consumers would be confused with the services provided by the Cited Marks, namely, wound care information for clinicians and geriatric services for seniors. Likewise, clinicians looking to further their education in a specific clinical area and seniors who are looking for geriatric services such as finding a senior home are highly sophisticated consumers who do tons of research before making a decision to purchase. As such, it is unlikely that the relevant consumers of the Cited Marks would be confused.

Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Thus, consumers of Applicant's Mark would not be confused by the Cited Mark and vice versa. In fact, the consumers of the Goods and Services offered under Applicant's Mark are entirely separate from the consumers of the services offered under the Cited Mark.

The lack of likelihood of confusion is well illustrated by the Federal Circuit's decision in *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). 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. Although 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. 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.

The facts involving Applicant's Goods and Services and the services under the Cited Marks reflect even more disparate channels of trade than found by the Federal Circuit in Electronic Design. In the present case, there is no evidence that the parties will ever provide their goods and/or services to the same purchasers. In fact, based on the disparate nature of the goods and/or services, the consumers who use Applicant's Goods and Services to achieve beautiful skin would clearly never seek to obtain clinical education on wound care or geriatric services. Additionally,

even if Applicant's consumers came into contact with goods and services under the Cited Marks, there is no evidence that these consumers, especially as sophisticated consumers, would be likely to assume that the goods and/or services came from a common source. Given these varied goods and services, Applicant does not believe there would be any chance of consumer confusion.

IV. SECTION 2(E)(1) – MERELY DESCRIPTIVE

The Examiner based his refusal of registration of Applicant's Mark on the proposition that the term "SOLUTION" is defined as "a liquid mixture" and "products or services designed to meet a particular need," which merely describes a feature of Applicant's Goods and Services, namely, "providing software designed to meet a particular need, which is the formulation of a liquid mixture for dietary supplements." Applicant respectfully submits that Applicant's Mark at most suggestive because the term "SOLUTION" in relation to Applicant's Goods and Services has multiple meanings and therefore does not immediately describe Applicant's Goods and Services.

A. The Term "SOLUTION" Is Not Merely Descriptive Because It Does Not Immediately Describe Applicant's Goods and Services.

Imagination Test

Applicant's Mark does not immediately describe the feature of Applicant's Goods and Services, which provides personalized custom skincare system for individual consumers. The term "SOLUTION" is not even remotely related to skincare regiment for beautiful skin. At most, Applicant's Mark suggests the desired result of using Applicant's skincare system as a solution to achieve beautiful skin and does not immediately describe the feature of those Services. Because thought and imagination are required to understand the nature of Applicant's Goods and Services, the Mark is suggestive, and therefore registrable on the Principal Register.

To be deemed merely descriptive, a mark must directly provide the consumer with reasonably provide the consumer with reasonably accurate knowledge of the characteristics of the product of service in connection with which it is used. If the information about the product of service is indirect or vague, then the mark is considered suggestive, not descriptive. *See J. McCarthy, 2 McCarthy on Trademarks and Unfair Competition*, §11.19 (5th ed. 2018). *See e.g. Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Management, Inc.*, 618 F.3d 1025, 1033, 96 U.S.P.Q.2d 1585 (9th Cir. 2010) ("[A] mark is more likely suggestive if it passes the imagination test, which asks whether the mark 'requires a mental leap from the mark to the product.'); *see also 2 J. McCarthy, Trademarks and Unfair Competition*, § 11:71 (4th ed. 2004) (framing the question about evaluating whether a mark is suggestive as "[i]s some reflection or multistage reasoning process necessary to cull some direct information about the product from the term used as a mark?"). Applying these principles, Applicant submits that Applicant's Mark is not merely descriptive. The term "SOLUTION" does not immediately convey to the one encountering it the nature of Applicant's Goods and Services. *See* TMEP § 1209.01(a) ("a descriptive term…immediately tells something about the goods or services").

In the Office Action, the Examiner asserts that the term "SOLUTION" is merely descriptive of Applicant's Goods and Services because the term "SOLUTION" is defined as "a liquid mixture" and "products or services designed to meet a particular need," which merely describes a feature of Applicant's Goods and Services, namely, "providing software designed to meet a particular need, which is the formulation of a liquid mixture for dietary supplements." However, as evident on Merriam-Webster's Online Dictionary, the term "SOLUTION" has multiple, commonly understood meanings, and thus the Examiner was incorrect in assuming that "formulation of a liquid mixture for dietary supplements" is a readily recognized definition of the

term “SOLUTION” with respect to Applicant’s Goods and Services. *See* Exhibit A. Besides a dictionary definition, the Examiner did not present any evidence and there is no reason to believe that consumers of Applicant’s Goods and Services would readily recognize the term “SOLUTION” as “formulation of a liquid mixture for dietary supplements.”

In fact, according to Merriam-Webster’s Online Dictionary, the term “SOLUTION” is defined as “an action or process of solving a problem; an answer to a problem; an act or the process by which a solid, liquid, or gaseous substance is homogeneously mixed with a liquid or sometimes a gas or solid; a homogeneous mixture formed by this process; and a bringing or coming to an end or into a state of discontinuity.” As such, the term “SOLUTION” with respect to Applicant’s Goods and Services may mean multiple things. For example, the term “SOLUTION” could mean coming up with a personalized skincare solution for each consumer or “a liquid mixture for dietary supplements,” as the Examiner mentioned.

Such ambiguity demonstrates that the term “SOLUTION” is not merely descriptive with respect to Applicant's Goods and Services. As the United States Court of Appeals for the Federal Circuit explained in *In re Hutchinson Technology Incorporated*, 852 F.2d 552, 555 (Fed. Cir. 1988); 7 U.S.P.Q.2D (BNA) 1490, 1492, 1493, a term that can has multiple meanings does not convey the sort of immediate understanding of the goods necessary to classify a mark as merely descriptive. The court found the term "technology" to be a very broad term, encompassing many categories of goods, and that the idea "technology" does not convey an immediate idea of the "ingredients, qualities, or characteristics of the goods" listed in the application: etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment disks; [and] flexible assemblies for disk drives. Thus, the term "technology" was not merely descriptive. Similarly, the term "SOLUTION" fails to provide immediate information about

Applicant's Goods and Services, and therefore is not merely descriptive with respect to those Services.

For the reasons stated above, Applicant's Mark is at most suggestive because "imagination, thought, or perception is required to reach a conclusion on the nature of goods or services." *In re Quick-Print Shops, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980).

V. SUSPENSION OF APPLICATION

In case the Examiner disagrees, Applicant requests that the Examiner suspend the application until the Cited Marks are either registered or abandoned/cancelled.

CONCLUSION

Based upon the foregoing, Applicant submits that it has addressed the issues 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

https://www.merriam-webster.com/dictionary/solution

solution noun

so·lu·tion | \ sə-ˈlü-shən \

Definition of *solution*

1 **a** : an action or process of solving a problem

b : an answer to a problem : EXPLANATION

specifically : a set of values of the variables that satisfies an equation

2 **a** : an act or the process by which a solid, liquid, or gaseous substance is homogeneously mixed with a liquid or sometimes a gas or solid

b : a homogeneous mixture formed by this process

especially : a single-phase liquid system

c : the condition of being dissolved

3 : a bringing or coming to an end or into a state of discontinuity

Synonyms

Example Sentences

Learn More about *solution*

Synonyms for *solution*

Synonyms

answer, result

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Examples of *solution* in a Sentence

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gnomic

characterized by aphorism

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Farm Idioms Quiz

What does 'poke' refer to in the expression 'pig in a poke'?

state of difficulty | stable | mud pit | bag

TRUE or FALSE

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