

Dear Examiner,

Per the Office Action for the trademark application with the serial number 88234858 for the word mark PRO (the “Mark”), the Examiner has notified Applicant that the Mark has been refused registration due to a likelihood of confusion under Trademark Act Section 2(d) with prior registered marks.

The prior registered marks are PRONATAL with registration number 4460223 for use on “Dietary supplements for pregnant and nursing mothers”; and PRO with registration number 4834159 for use on “food supplements for animals” and “foodstuffs for animals”.

Applicant has applied to register the mark PRO for use on “Dietary supplements for human consumption” (as amended).

The Mark’s Likelihood of Confusion with PRONATAL (Registration Number 4460223)

Despite the Examiner’s finding that the Mark should be refused registration due to a likelihood of confusion with the mark PRONATAL, Applicant’s mark and the Prior Filed Mark are not likely to be confused for the following reasons:

1. The marks themselves are different. Applicant’s Mark is an entirely different word with an entirely different meaning. PRO is suggestive of “probiotic”, one of the features of Applicant’s good. PRONATAL, on the other hand, seems to be the conjunction of the prefix “pro” and the word “natal”, meaning beneficial to birth.
2. PRONATAL is descriptive and thus should only be afforded narrow protection. PRONATAL is both commonly used (a quick Google search immediately reveals not less than four different companies using the mark PRONATAL), and descriptive as a good that is good for birth and/or birthing. Its use spans vitamins and fitness centers. The mark is thus weak and should receive narrow protection.
3. The target market for dietary supplements is sophisticated and exercises a high degree of purchaser care. Such consumers are concerned with the type, quality, and quantity of key ingredients, and are capable of distinguishing between the goods offered under the altogether different marks PRONATAL and PRO. The vastly different commercial impressions offered by the goods packaging (pharmaceutical and sterile v. pink and friendly) help to distinguish the marks and their goods in this regard.

The Mark’s Likelihood of Confusion with PRO (Registration Number 4834159)

Despite the Examiner’s finding that the Mark should be refused registration due to a likelihood of confusion with the mark PRO with Registration Number 4834159 (the “Pet Food Mark”), Applicant’s mark and the Pet Food Mark are not likely to be confused for the following reasons:

1. The Pet Food Mark is descriptive as it relates to food items for animals. It is a commonly used descriptive term for dog foods, used by brands such as Purina (“Pro Plan”), Victor (“Hi-Pro Plus” and “Professional Formula”), Inukshuk (“Professional Dry Dog Food”), and Pro Pac. The Pet Food Mark, with respect to its literal element, is thus weak and

should receive only narrow protection.

2. The separate target markets for dietary supplements and pet foods are sophisticated and exercise a high degree of purchaser care. Such consumers are concerned with the type, quality, and quantity of key ingredients; and the type of animals the products are designed for, and are capable of distinguishing between such goods.

In consideration of the above, Applicant respectfully requests the Examining Attorney allow the registration of Applicant's Mark on the Principal Register.

Sincerely,
Charles Kim
Attorney of Record