


**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE (USPTO)**


**On Office Action (Official Letter) About Applicant's Trademark
Application Dated August 27, 2020.**

U.S. App. Serial No.:	88929642
Mark:	
Filed:	May 22, 2020
Applicant:	Vitality Now LLC
Examining Attorney:	Luke Cash Browning

The following is the response of Vitality Now LLC (the “Applicant”) by Counsel, to the Office Action sent via email on August 27, 2020 by Examining Attorney, Luke Cash Browning.

The Office Action concerns the Examining Attorney’s refusal to register Applicant’s trademark application based on Sec. 2(d) citing prior-filed applications and a registration for: (1) RENEW with Serial No. 88425671) for various goods; (2) RENEW with Serial No. 88468993; and (3) CELL RENEW with Registration No. 78247030.¹

Applicant sought to register the composite mark



(the “Applicant’s Mark”) in connection with

¹ Office Action, August 27, 2020

“Food supplements; Mineral food supplements; Enzyme food supplements; Health food supplements; Dietary food supplements; Vitamins; Vitamin supplements; Vitamin preparations; Vitamin tablets; Liquid vitamin supplements; Vitamin supplement patches; Vitamins for animals; Vitamin and mineral supplements; Vitamin oils for human consumption; Vitamin enriched water for medical purposes; Mineral supplements; Mineral food supplements; Mineral nutritional supplements; Vitamin and mineral supplements” goods under International Class 5.²

Holding that—the marks create substantially similar commercial impressions—the Examining Attorney found that the Applicant’s Mark incorporates the entirety of the registered mark.³

Furthermore, the Examining Attorney posited that the design element and the additional wording of the Applicant’s Mark do not negate a likelihood of confusion. The Examining Attorney discussed that the wording STEM of the Applicant’s Mark is “descriptive and merely refers to the type of cell being renewed;” thus, said wording is less significant or dominant. As with the design element, the Examining Attorney reasoned that—when it comes to a composite mark—the word portion is normally afforded a greater weight as it is the one likely to be remembered and used by purchasers to refer to the relevant goods and/or services; thus the design element of the Applicant’s Mark is not dominant.⁴

In effect, the Examining Attorney opined that the dominant portion of the Applicant’s Mark is the wording, CELL RENEW.

² See Applicant’s May 22, 2020 Application; See also <https://tsdr.uspto.gov/documentviewer?caseId=sn88929642&docId=APP20200526083556#docIndex=5&page=1>

³ Office Action, August 27, 2020

⁴ Id.

As to the comparison of goods, the Examining Attorney found that the Applicant used broad identification of its goods which presumably covered that of the Registered Mark's. In furtherance with this, the Examining Attorney also pointed out the lack of restrictions as to nature, type, channels of trade, or classes of purchasers of the Applicant's goods which led the presumption that the relevant goods travel in the same channel of trade to the same class of purchasers; thus, the goods are substantially similar.⁵

As already stated, the Examining Attorney found that the Applicant's Mark may also likely be found confusingly similar with the mentioned prior-filed applications.

For the formalities, the Examining Attorney required that the Applicant disclaim the wording, STEM CELLS because the same is merely descriptive of the Applicant's goods.

Finally, the Examining Attorney advised the Applicant to remove duplicate entries in the identification of goods.

Respectfully, the Applicant disagrees with the Examining Attorney's action in refusing the Applicant's Mark. The Applicant submits, as it does in the following discussions, that the Applicant's Mark is not confusingly similar to the Cited Marks; therefore, the 2d refusal is not valid.

AMENDMENTS

The Applicant submits or authorizes the Examining Attorney to amend the former's application to reflect the following statements :

⁵ Id.

For disclaimer:

No claim is made to the exclusive right to use “STEM CELL” apart from the mark as shown.

For identification of goods:

Food supplements; Enzyme food supplements; Health food supplements; Dietary food supplements; Vitamins; Vitamin supplements; Vitamin preparations; Vitamin tablets; Liquid vitamin supplements; Vitamin supplement patches; Vitamins for animals; Vitamin and mineral supplements; Vitamin oils for human consumption; Vitamin enriched water for medical purposes; Mineral supplements; Mineral food supplements; Mineral nutritional supplements; Vitamin and mineral supplements

APPLICABLE LAWS ON CONFUSION REFUSAL

When the question is likelihood of confusion, analysis is directed on the facts as they relate to the relevant factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973),⁶ such as the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.⁷

⁶ See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003);

⁷ See, *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401, 172 USPQ 176 (CCPA 1970) (finding no likelihood of confusion between the applied-for mark PEAK PERIOD for deodorant and the prior mark PEAK for dentifrice). See also *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992) (finding no likelihood of confusion between VARGA GIRL and VARGAS for identical goods); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108, 174 SUPQ 392, 393 (CCPA 1972) (finding no likelihood of confusion between the applied-for mark “ALL CLEAR!” and the prior mark ALL, both for household cleaning products; the commercial impression engendered by “ALL CLEAR!” was not derived from the component words ALL or CLEAR, but rather from the mark as a whole).

In comparing marks, the overall appearance of the mark as used in the marketplace is critical, not a deconstructionist view of the different components of the marks.⁸

While similarity in any one of the elements may be sufficient to find the marks confusingly similar⁹, the fact that marks happen to share a similar component is not determinative of likelihood of confusion.¹⁰

Indeed, the proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.¹¹

Verily, the dissimilarity in the marks' connotation and commercial impression outweighs their shared wording.¹² Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.¹³

More importantly, while similarity of marks in any one of their respective elements may be sufficient to find the marks confusingly

⁸ Playmakers, LLC v. ESPN, Inc. 376 F. 3d 894, 71 U.S.P.Q 2d 1759 (9th Cir. 2004)

⁹ In re Inn at St. John's, LLC, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing In re Davia, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

¹⁰ Little Caesar Enterprises Inc. v. Pizza Caesar Inc., 834 F.2d 568, 571 (6th Cir. 1987).

¹¹ In re i.am.symbolic, LLC, 123 USPQ2d at 1748 (quoting Coach Servs. Inc., 101 USPQ2d at 1721)

¹² See Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (agreeing with the Board that the "more important fact for resolving the issue of likelihood of confusion . . . is the dissimilarity in commercial impression between the marks").

¹³ See Opryl and USA Inc. v. Great Am. Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992);

similar¹⁴; such similar elements must be the same dominant portion of both marks.¹⁵

Simply-put, if the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.¹⁶

Corollary thereto, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.¹⁷

¹⁴ In re Inn at St. John's, LLC, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing In re Davia, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

¹⁵ See, In re Detroit Athletic Co., ___ F3d ___, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018).

¹⁶ Juice Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); In re Bed & Breakfast Registry, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); In re FabFitFun, Inc., 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I'M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN' HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); U.S. Shoe Corp. v. Chapman, 229 USPQ 74 (TTAB 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion); In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A., 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with "ASO" disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

¹⁷ Citigroup Inc. v. Capital City Bank Group, Inc., 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011)

**THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN
THE APPLICANT'S MARK AND THE CITED MARKS**

The Applicant respectfully disagrees with the Examining Attorney's refusal of the registration of the Applicant's Mark, and submits that, in the contrary, it does contravene with *Sec. 2(d) of the Trademark Act* because it is not confusingly similar to the Cited Marks.

First, the Applicant's Mark, in its entirety, is glaringly different from the Cited Marks. The Applicant's Mark is a composite mark with a distinctive design element and other distinctive word elements. With its word elements, the Applicant's Mark appears and sounds longer compared to the Cited Mark being a one-word mark.

The Applicant's Mark appears very distinctively different from the Cited Mark because its design element, with the supplement of the word-elements, stands out. Specifically, the design element occupies a considerable space in the Applicant's Mark in such a way that it is readily available to purchasers as a means to distinguish the Applicant's Mark from the other, and vice-versa.

The Examining Attorney reversibly erred when it deconstructed the Applicant's Mark to support a finding of a likelihood of confusion, thus ignoring the direction of *Playmakers, LLC* which states that the proper test is to consider the overall appearance of the compared marks. In other words, the Examining Attorney cannot simply and conveniently pick a portion of the Applicant's Mark and rule-out the rest. The Examining Attorney is mandated by well-settled case laws to consider the entirety of the compared marks, and such refusal based on a deconstructionist view must necessarily fail.

In addition, the Examining Attorney, in negating the additional distinctive value of the wording, "STEM" of the

Applicant's Mark, misapplied the case of *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015).

The court, in that case, heavily anchored its decision—that WINEBUD is confusingly similar to BUD—on the fact that the latter mark is a well-known or famous mark. In other words, the emphasis on the relevant word is conditioned that such a word has acquired consumer recognition, such that a dissection of the WINEBUD mark became necessary and warranted. Also, the compared marks in the said case are word marks; neither one is a composite mark.

The question of whether the Registered Mark is a famous mark cannot be resolved in an ex-parte proceeding such as this instant case. More importantly, the Applicant's Mark is a composite mark with a highly distinctive design mark—a fact absent in the cited case. Instead, the converse application of the *Anheuser-Busch, LLC* case dictates that only when a registered mark is a famous mark or that the marks involved are both word-marks, may the method of dissecting the Applicant's Mark—as an exception from the main doctrine of comparing marks in their entireties—be made a proper test in determining a likelihood of confusion.

The same is true with the case of *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018). The Examining Attorney cited this relevant case to justify that the wording, not the design element, is the dominant portion of a composite mark. A careful reading of the said case law concludes that the same, is likewise, misapplied by the Examining Attorney for the reasons: that dominant word in that important case law is LAROQUE—a highly distinctive mark being neither a foreign term nor having an English translation. This circumstance is again lacking in this case. Specifically, the Registered Mark is not highly distinctive; it is rather, at best, suggestive which is, nevertheless, relatively weak compared to that of a fanciful term.

To illustrate the weakness of the Registered Mark, the Applicant uses the same criterion the Examining Attorney used in

holding that the wording “STEM” of the Applicant’s Mark is descriptive or weak. The common element of two marks is considered “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services.¹⁸ Here, the wording “CELL RENEW” is conceptually weak because it refers to a purpose of many supplements, namely, supplements are commonly used to promote cell renewal or production.

Assuming that the both marks share the same dominant portion, confusion refusal is still likely bound to fail. As directed by *Juice Generation, Inc. (supra)* the common element being weak and the absence of any other commonality between the Registered Mark and the Applicant’s Mark overall appearance and commercial impression—the addition of the Applicant of its design element and other word elements sufficiently avoids confusion.

The mere fact that the Examining Attorney cited the prior–filed applications shows a sheer lack of standard in the proper application of the law. Interestingly, after having attempted to establish that the Applicant’s dominant portion is the identical wording of the Registrant’s Mark, the Examining Attorney is, in effect, advancing the idea the dominant portion of the Applicant’s Mark may be adjusted for purposes of determining a likelihood of confusion.

In this case, the Examining Attorney adjusted the dominant portion of the Applicant’s Mark from “CELL RENEW” to only the wording “RENEW” thus, the Applicant’s Mark being confusingly similar with the cited prior–filed applications. Such a method of assessing likelihood of confusion is not only unheard of; thus, bizarre—it is also devoid of legal basis and upsets basic logic and sense of fairness, the very evil the statute and case laws seek to suppress.

The relevant case laws have already settled for a test that inquires into the entireties of the compared marks for the purpose, *inter alia*, of: avoiding a situation where one dissects a trademark and picks,

¹⁸ *Juice Generation, Inc. (supra)*

at his own choosing, a certain element of which he will make a determination of a likelihood of confusion.

Assuming *arguendo*, that such a test is allowed, confusion refusal, nevertheless, would not have a leg to stand. The Applicant reiterates its arguments (1) that mere commonality in the use of the wording "RENEW" does not, by itself, establish a likelihood of confusion; (2) that the word "RENEW" is not highly distinctive in relation to the relevant goods as it is conceptually weak due to its suggestive character ; (3) that additions of elements in the Applicant's Mark is sufficient to avoid a confusion; and (4) that the fact that wording "STEM" is disclaimed, does not render the same devoid of any distinctiveness contribution to the Applicant's Mark.

The Applicant's Mark, therefore, does not contravene *Sec. 2(d) of the Act* as it is not confusingly similar with the Cited Marks.

CONCLUSION

For the foregoing circumstances, the Applicant respectfully requests and prays that in regards to the 2(d) refusal, the Examining Attorney reconsiders, and ultimately allows the Applicant's Mark to proceed with the registration process.