

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant : Trevira GmbH
U.S. Serial No. : 76/294,340
Mark : **BIOACTIVE and Design**
Int'l Class : 25
Filing Date : August 2, 2001
Examining Attorney : Scott Oslick
Law Office : 108



04-09-2004
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

745 Fifth Avenue
New York, New York 10151

FIRST CLASS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB-NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on April 6, 2004

Marilyn Matthes Brogan, Reg. No. 31,223

Name of Applicant, Assignee or Registered Representative

Mark M. Brogan

Signature

April 6, 2004

Date of Signature

APPEAL BRIEF

Box TTAB – NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Sir:

In accordance with 37 C.F.R. § 2.142(b), Applicant hereby submits herewith its brief on the appeal from the final refusal of record in the above-referenced application.

I. INTRODUCTION

An Official Action was mailed July 1, 2002, by which the Examining Attorney maintained and finally refused registration of the mark for the goods in Class 25 under Trademark Act Section 2(d), because Applicant's mark, when used on or in connection with the identified Class 25 goods, allegedly so resembles the mark in U.S. Registration No. 1,229,977 dated March 23, 1983 for **BIO ACTIVE** (in fanciful script) for hosiery, as to be likely to cause confusion, etc.

Subsequently, by paper dated January 2, 2003, Applicant filed a Request to Divide the original application to retain the goods in International Classes 22, 23 and 24 in the parent application, and by making the goods in International Class 25, the subject of a new application. Applicant also filed a Notice of Appeal for all classes of goods in the instant application. On January 2, 2003, Applicant also filed an Amendment After Final Refusal and Request for Reconsideration, by which paper Applicant requested amendment to the identification of goods in Class 25 to read: "Articles of clothing, namely, jackets, coats, raincoats, wind-resistant jackets, pants, skiwear, shorts, skirts, blouses, dresses, headwear, hats, gloves, shoes, foul-weather gear, jogging suits, mufflers, coveralls, snow suits, tennis wear and underwear, **excluding hosiery**, in International Class 25".

Subsequently, by paper dated January 29, 2003, the appeal was instituted but proceedings were suspended and the application file forwarded to the Intent to Use Branch for processing of the Request to Divide. By that same January 29, 2003 paper, the Board instructed the Intent to Use Branch to return the "parent" and the newly-created "child" applications to the Board for further processing subsequent to the decision on the Request to Divide.

Next, by paper dated March 13, 2003, the Intent to Use Branch confirmed that the divisional request had been processed and that the goods and/or services in Classes 22, 23 and 24 were placed in the newly created child application serial no. 76/975,309, and that the goods in International Class 25 would remain in the original parent application serial no. 76/294,340 (the instant application).

Subsequently, by paper dated February 3, 2004, the Examining Attorney reported that he accepted the proposed amendment to the identification of goods, as set forth above, but has maintained the Section 2(d) refusal, and by paper dated February 6, 2004, the Board accorded applicant a period of sixty days, until April 6, 2004 in which to file the instant Appeal Brief.

II. ARGUMENT

Applicant respectfully submits that the refusal to register on the basis of alleged likelihood of confusion between the instant mark **BIOACTIVE and Design** and the registered mark **BIO ACTIVE** (in fanciful script) is unwarranted and should be reconsidered and withdrawn.

The instant mark, **BIOACTIVE and Design**, is distinctively different from the cited mark in overall appearance, particularly in view of the fact that the instant mark has a distinctive design feature and that the cited mark is registered in a unique script format.

The cited mark **BIO ACTIVE** appears in a fanciful script design. In contrast, Applicant's mark provides a very different overall appearance and cannot be taken for that mark, since it appears with a dominant and distinctive semi-circular design, and other design elements.

Potentially conflicting marks must be compared in their entireties. A mark can not be dissected or split up into its component parts and then compared with a corresponding part of a “conflicting mark” to determine likelihood of confusion. The fact that the trademarks in question contain a similar formative (i.e., “bio” and/or “active”) is not dispositive of the issue of confusion.

The courts have determined that even similar marks can coexist without confusion. For example, the Examiner’s attention is invited to the following cases:

In Vitarroz Corporation v. Borden Inc., 209 U.S.P.Q. 969 (1981), Vitarroz sold a cracker under the name BRAVO’S. Borden Inc., the defendant, decided to add a round tortilla chip to its line of Wise products under the name BRAVOS. The Court held that confusion between the marks is unlikely given the difference in the products stating:

“The Court’s finding that the marks are virtually identical is not disputed. We agree with the District Court, however, that the potential for confusion inherent in the similarity of the marks is reduced by the different contexts in which the marks are presented...the products differ in significant respects and are not competitive as to certain significant uses.”

Id. at 976-977

Similarly, in Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 220 U.S.P.Q. 786 (1983), it was determined that there is *no* likelihood of confusion between ASTRA for pharmaceuticals and ASTRA for blood analyzers. In this case it was recognized that all of the duPont factors must be considered when assessing the likelihood of confusion, and that no one factor is necessarily determinative of the issue of likelihood of confusion. In the Astra case, despite the similarity of the marks, an analysis of all the different factors led to a finding of *no* likelihood of confusion.

Moreover, in Heartsprings, Inc. v. Heartspring, Inc. 46 U.S.P.Q.2d 1481 (10th Cir. 1998), the Court held that there was no confusion between the mark **HEARTSPRINGS** for a company that produces and sells educational materials designed to teach children how to resolve conflicts nonviolently and **HEARTSPRING** for the name of a school which teaches physically disabled children basic life skills. Despite the similarity of the marks, confusion was not likely since “[t]he parties offer distinctly different products and services and conduct different marketing campaigns, aimed at different portions of the public.” *Id.* at 558.

It is recognized by the courts that similarity between marks is determined on the basis of the total effect of the designation, rather than a comparison of the individual features. Astra Pharmaceutical Products v. Beckman Instruments, 220 USPQ 609 (D.Mass 1983).

Since the respective marks have very different overall appearances, it is submitted that confusion is unlikely. In re Akzona, Inc., 219 USPQ 94 (T.T.A.B. 1983). There is no evidence that there would be a likelihood of confusion. In the absence of any such evidence, it is submitted that the refusal to register should be reversed. In re Mars, 222 USPQ 938 (C.A.F.C. 1984).

Moreover, particularly in view of the instant amendment to the Class 25 goods, which now specifically excludes hosiery, the goods recited in the instant application are different and distinct from the hosiery recited in the **BIO ACTIVE** registration. Applicant’s goods, as amended, recite various articles of clothing, namely, jackets, coats, raincoats, wind-resistant jackets, pants, skiwear, shorts, skirts, blouses, dresses, headwear, hats, gloves, shoes, foul-weather gear, jogging suits, mufflers, coveralls, snow suits, tennis wear and underwear, **excluding hosiery**. This is in contrast to the **hosiery** which are the only goods in the cited registration.

Additionally, the respective goods are sold through different channels and outlets and to different consumers. For example, hosiery such as that of Registrant, is often sold at drug and cosmetic stores, freestanding hosiery outlets and lingerie shops, while clothing items such as those which are recited in the instant application, are not sold through such channels and outlets, but instead are offered through traditional retail clothes outlets.

Indeed, even if the hosiery and clothing were both offered in the same department store, they would be sold in different and distinct departments; for example, the jackets and coats, etc. of applicant, are not offered for sale in the hosiery department of department stores.

Applicant urges that when one examines the difference in the complete undissected marks, together with the differences in the goods and channels of trade for the goods in question, it must be found that confusion is unlikely. Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc., 233 USPQ 1027 at 1030 (T.T.A.B. 1984); Federated Foods, Inc. v. Fort Howard Paper Co., 192 USPQ 24 at 29 (C.C.P.A. 1976); In re Ness & Co., 18 USPQ 2d, 1815 at 1816 (T.T.A.B. 1991).

On this issue, of interest is in In re Stirbl, 62 USPQ 2d 1446 (TTAB 2002), in which the Board reversed the refusal to register the mark **UIS (stylized)** based on a cited registration for **UIS UNIVERSAL INFORMATION SYSTEMS, INC. (stylized)**.

The **UIS (stylized)** mark in the application was directed to the “installation, repair, and maintenance of computers, computer systems, computer networks, and telecommunications equipment, and business and office machinery and equipment” in Class 37 and “integration of computer systems and networks; consultation services in the fields of computers, computer networks, computer software and hardware, computer software and design and installation, computer network and site design, installation and integration” in Class 42; the cited registration

for **UIS UNIVERSAL INFORMATION SYSTEMS, INC. (stylized)** was directed to “providing personnel on a short term basis to businesses to perform data processing; microfilm services,” in Class 35 and “computer programming services” in Class 42.

In reversing the Examining Attorney’s rejection, the Board noted that the two marks “convey different commercial impressions.” The Board also noted that the registrant’s computer programming services are different and specialized, the Board held that the mark **UIS (stylized)** was entitled to registration.

Similarly, as found in Stirbl, Applicant respectfully submits that given the different overall commercial impressions provided by the marks in question, the fact that the parties’ respective goods are different and specialized, offered through different channels and outlets, to different customers, there is no likelihood of confusion between the two marks.

Moreover, the position that confusion is unlikely, is further supported by another du Pont factor, i.e., the existence of various of third-party marks which contain the formatives “bio” and/or “active”, or the like, all of which marks co-exist, both with each other and with the **BIOACTIVE (stylized)** mark in the cited registration.

See, for example, the following marks, all of which co-exist:

<u>MARKS</u>	<u>REGISTRATION/SERIAL NO.</u>	<u>REGISTRATION/FILING DATE</u>
BIO-ACTIVE LIVE	Reg. No. 2,411,490	Registered December 5, 2000
BIOACTIVE MODULATORS	Ser. No. 78/139,566	Filed June 27, 2002
XP BIOACTIVE	Ser. No. 76/496,541	Filed March 10, 2003
BIOACTIVE TECHNOLOGIES	Ser. No. 74/362,801	Filed March 1, 1993
BIOACTIVES	Reg. No. 1,508,913	Registered October 18, 1988

Thus, various third party marks which contain the formatives “bio” and/or “active, and the like (including the mark **BIOACTIVE** the subject of the cited registration).

For all the foregoing reasons, including the differences in the overall appearances of the complete, undissected marks, the differences in the goods and channels of trade and customers for the goods, and the existence of numerous third-party marks containing the formatives “bio” and/or “active” and the like, Applicant urges that the refusal to register Applicant's mark **BIOACTIVE and Design** on the basis of alleged confusing similarity with **BIOACTIVE stylized**, is unwarranted, and requests reconsideration and withdrawal of same.

III. CONCLUSION

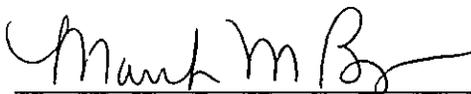
For all the foregoing reasons, Applicant submits that the refusal to register the mark **BIOACTIVE and Design**, as likely to be confused with the mark in U.S. Registration No. 1,229,977 is unwarranted, and should be reversed. Applicant requests that the instant mark be approved for publication for registration on the Principal Register.

It is believed that no fee should be required by reason of the instant submission. However, if any fee is required, or if any overpayment has been made, please charge or credit Deposit Account No. 50-0320.

This Brief is submitted in triplicate.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By: 
Marilyn Matthes Brogan
Reg. No. 31,223
(212) 588-0800