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

Appln. Serial No. 76/715,478

Filed: December 2, 2013

Exam. Attorney: Mayes, Laurie  
Law Office: 101

Mark: NUTRITIONAL CONCEPTS

Applicant: Nutritional Concepts, Inc.

October 6, 2014

*New Appeal*

Commissioner for Trademarks  
P O Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF APPEAL AND APPEAL BRIEF**

Applicant hereby appeals the Final Rejection of August 13, 2014. A Form PTO-2038 is provided for payment of the appeal fee of \$200.00. Applicant also contemporaneously submits its appeal brief herewith.

Respectfully submitted,

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\*10-07-2014\*

U.S. Patent and Trademark Office #72

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**APPEAL BRIEF**

DESCRIPTION OF THE RECORD

The application was filed December 2, 2013. A first action rejection was mailed March 18, 2014. An amendment was received by the PTO July 22, 2014. The amendment included evidentiary materials in the form of a Declaration of Bonnie C. Minsky with attachment, a Declaration of Steven A. Minsky, a Declaration of Carolyn Martinelli, and a three page "Trademark Assignment Abstract of Title" from the records of the PTO that makes clear that the owner of registration 1,561,519 for NUTRITION CONCEPTS in class 042 is Aramark Corporation. A Final Rejection was mailed by the PTO August 13, 2014, which occasioned this appeal.

STATEMENT OF THE ISSUES

There are only two issues. The first and major issue is whether applicant's mark NUTRITIONAL CONCEPTS as applied to its services of personalized nutritional counseling

services in class 044 and retail and wholesale on-line and store services featuring dietary and nutritional supplements in class 035, and considering the evidence of record, is properly rejected under Section 2(d) as likely to be confused with the Aramark Corporation registration number 1,561,519 for NUTRITION CONCEPTS as applied to its services of nutrition counseling services in class 042 (hereafter “the ‘519 registration”).

The second issue is whether the wording “on-line and store services” in the services description for applicant’s class 0335 services is indefinite and/or if the Examining Attorney’s suggestion requiring elimination of the word “and” is inaccurate.

#### RECITATION OF THE FACTS

Aramark Corporation (hereafter “Aramark”) is the owner of the ‘519 registration and in one corporate form or another has been since the registration application was first filed in 1988 [“Trademark Assignment Abstract of Title” for the ‘519 registration].

With respect to the likelihood of confusion issue, applicant and its predecessor have continuously and extensively been using the mark NUTRITIONAL CONCEPTS for personalized nutrition counseling services in class 044 since 1985 [Statement of Use in the application; Bonnie Minsky Declaration], including promotion through its website “nutritionalconcepts.com” since 1998 [Bonnie Minsky and Steven Minsky Declarations], and applicant has used the mark with respect to services in class 035 since 1998, and in interstate commerce since about April, 1999 [Statement of Use in the application]. That is applicant and its predecessor have continuously and extensively used the mark for class 044 services for twenty nine (29) years, and for class 035 services for fifteen (15) years. In this time there has not been one instance of actual confusion with respect to the mark and services of the ‘519 registration

[Bonnie Minsky and Steven Minsky Declarations]. Applicant's mark for class 044 services has been in use in interstate commerce (1985) even BEFORE Aramark's mark of the '519 registration was in use in interstate commerce (September 30, 1986) for class 042 services. The first use dates of both applicant and Aramark are both 1985, meaning that they have been used contemporaneously for twenty nine (29) years.

The lack of any instances of actual confusion with respect to the '519 registration during the twenty nine years of contemporaneous use is in sharp contrast to the real world situation with respect to the sale of nutritional supplements by a Farmingdale New York company "Nutritional Concepts" where there have been literally dozens, if not hundreds, of instances of actual confusion [¶4 of Steven Minsky Declaration].

When applicant's and the '519 registrations particulars are examined, it is clear that the marks, services descriptions, and classifications are all different. That is there are dissimilarities in appearance, sound, connotation, and commercial impression, and in the actual services provided.

With respect to the identification of services issue for class 035 services, applicant's services description of "on-line and store services" is entirely correct as is and is the common commercial name for its services. This description clearly indicates that applicant sells its nutritional and dietary supplements to both customers who purchase over the Internet ("on-line") and to customers who purchase at applicant's office facilities ("store").

ARGUMENT

The 2(d) rejection is inappropriate and ignores relevant evidence of record

Reconsideration is respectfully requested of the Section 2(d) rejection based upon the '519 registration for NUTRITION CONCEPTS in class 042. The marks of the registration and the instant application are different in appearance, sound, connotation and commercial impression, and the services are different and are in different classes. Also, both marks are suggestive rather than arbitrary, and in the approximately twenty nine years of apparent contemporaneous use of the marks there have been no instances of actual confusion, as made clear by the Bonnie C. Minsky and Steven A. Minsky Declarations.

Although the Final Rejection does not appear to dispute it, applicant feels obligated to point out that the face of the printout of the '519 registration provided in the record is incorrect in listing JPMorgan Chase Bank as the "owner" of the registration. As the three page "Trademark Assignment Abstract of Title" from the records of the PTO that was submitted with the July 22 amendment makes clear, the bank only has a security interest in the '519 registration. The owner of the registration is Aramark Corporation, a corporation related to the original applicant; an Aramark company has been the consistent owner of the '519 registration since the application was filed in 1988. The Declarations of Bonnie C. Minsky, Steven A. Minsky, and Carolyn Martinelli that were provided with the July 22 amendment all relate to Aramark as the owner of the '519 registration.

In evaluating likelihood of confusion under 2(d) the factors that need be considered are set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA

1973). ALL relevant *du Pont* factors must be considered, not just some; *Id, USPQ 567*<sup>1</sup>. The relevant considerations here are the dissimilarities of the marks in appearance, sound, connotation and commercial impression, the dissimilarities in services, "The length of time during and conditions under which there has been concurrent use without evidence of actual confusion," and "Any other established fact probative of the effect of use."

The marks here unquestionably have different appearance, sound, connotation and commercial impression,. The mere fact that the first word includes "Nutrition" and the second word is "Concepts" is not enough to establish a *prima facie* case of similarity. See *Seven-Up Co. v. Tropicana Products, Inc.*, 142 USPQ 384 (TTAB 1964), affirmed, 356 F.2d 567, 568 (CCPA 1966), where the differences in the marks "SUN-UP" and "SEVEN-UP" for basically the same goods (non-alcoholic beverages) were considered and no likelihood of confusion was found. The TTAB's holding was that "...a small difference in spelling or appearance may be sufficient to distinguish them and avoid a finding of confusing similarity."

The Final Rejection refuses to give any deference to the *Seven-Up* case because the marks are "not the noun and the corresponding adjectival form like in the instant case."<sup>2</sup> That misses the point; the TTAB decision was more general than that, indicating that only small differences in spelling or appearance could make a difference. In the *Seven-Up* case only three letters in the middle of a word were different; here there are two at the end of a word, where they are more likely to be noticed.

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<sup>1</sup> For convenience, all of the *du Pont* factors are reproduced in the Appendix hereto.

<sup>2</sup> The bottom of the 4<sup>th</sup> unnumbered page of the Final Rejection.

There are other situations that are similar to that in *Seven-Up* where the marks were even closer. For example, Registration 2,832,202 for TRANXITION issued for computer software in class 009 despite the fact that Registration 1,985,615 for TRANXIT also for computer software in class 009 was live at the time.<sup>3</sup> When faced with a 2(d) rejection based on the '615 registration the then applicant in the '202 registration pointed out that the addition of the suffix "ION" provided a different connotation. The then applicant went on to convincingly argue:

"Such differences in connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used. *Revlon, Inc. v. Jerrell, Inc.*, 713 F. Supp. 93, 11 U.S.P.Q. 2d 1612, 1616 (S.D.N.Y. 1989) (No likelihood of confusion because the meaning and connotation of the marks THE NINES and INTO THE NINETIES are not related. THE NINES suggests the number nine, or nine of something in a group. INTO THE NINETIES is a reference to the decade of the 1990's, and more generally the future; Plaintiff's motion for preliminary injunction is denied.); citing *Clarks of England, Inc. v. Glen Shoe Company*, 465 F. Supp. 375, 379, 209 USPQ 852, 854-55, (S.D.N.Y. 1960) (TREK and STAR TREK for shoes; TREK connotes hiking across the Himalayas; STAR TREK connotes space travel.)."

"Nutritional" is an adjective, while "Nutrition" is a noun, and that would be recognized by someone seeking counseling services, especially personalized nutritional counseling services as provided under applicant's mark, something much more complex than buying beverages as in the *Seven-Up* case, and at least as complex as someone buying software as in the TRANXITION situation cited above. Also, which accepted definition of the root word would be connoted is much different for the two words. The MacMillan dictionary attached to the First Official Action, for example, makes this clear. The first definition of "Nutrition" is "food considered as

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<sup>3</sup> A copy of each of these registrations was attached to the July 22 amendment.

something that keeps you healthy,” clearly a noun. No one would EVER use “Nutritional” to convey that meaning. Rather, the adjective “Nutritional” would be used more with the second meaning “the science of food and its effect on health and growth.” While related, the two meanings are dissimilar (just like in *Seven-Up* case and the TRANXITION situation), therefore the commercial impression provided by the two marks is significantly different.

The adjective vs. noun difference here is even more significant than it normally would be because the services involved, “nutrition counseling services” versus “personalized nutritional counseling services,” have different classifications. The ‘519 registration services are in Class 042 and the services of the instant application are in Class 044. While classification *per se* is not controlling of likelihood of confusion, it is certainly one of the factors (*du Pont* factor 13) that indicates no likelihood of confusion and cannot be ignored.

Even more significant than the differences in classification, however, is the fact that *personalized* nutrition counseling services are different than nutrition counseling services in general. The Final Rejection fails to address this distinction.

Also, the services in class 035 are much different than those in the ‘519 registration. The fact that other registrations might indicate that some other registrants have listed both sale of dietary supplements and general counseling regarding matters of nutrition is not conclusive of likelihood of confusion. The fact remains that despite allegedly using its mark since 1985 and having its own website, Aramark itself has never gone into online or store services regarding dietary and nutritional supplements; this is much more significant a fact than widely diverse marks registered by others. If someone hasn’t gone into a particular business for almost thirty years, those in the trade will conclude that they are not ever going into the business.

While applicant believes that it is entitled to prevail for just the reasons set forth above, *du Pont* factor 8 – absence of likelihood of confusion – considered in light of the applicable law and the real commercial world virtually requires that applicant prevail. “[A]n absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is **highly probative** in showing that little likelihood of confusion exists,” (emphasis added) *Aktiebolaget Electrolux v. Armatron Int'l, Inc.*, 999 F.2d 1, 4 (1st Cir.1993). *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 228 (2d Cir.1999) [noting that peaceful coexistence is a “**powerful indicator** that the junior trademark does not cause a meaningful *likelihood* of confusion” (emphasis added)]. “[W]here both parties have extensively marketed their products, the absence of actual confusion is **highly persuasive** evidence that confusion is not likely,” (emphasis added). *Ohio Art Co. v. Lewis Galoob Toys, Inc.*, 799 F.Supp. 870, 884 (N.D.Ill.1992). *Planet Hollywood (Region IV) v. Hollywood Casino*, 80 F.Supp.2d 815 (N.D. Ill., 1999) [no actual confusion between Planet Hollywood and Hollywood Casino is highly persuasive of no likelihood of confusion]. *Caliber Auto. Liquidators, Inc. v. Chrysler*, 605 F.3d 931, 936 (11th Cir. 2010) “All parties concede that evidence of actual confusion is the **most weighty** consideration.” (emphasis added).

There is **NO** likelihood of confusion because of the irrefutable proof provided by applicant regarding *du Pont* factor 8, namely “The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” As the Declarations of Bonnie C. Minsky and Steven A. Minsky make clear, despite about twenty nine years of **HIGHLY VISIBLE** (certainly in the case of the applicant) contemporaneous use [both the ‘519 registration and this application for Class 044 services claim 1985 as the first use in Commerce,

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and for Interstate Commerce 1985 for applicant and September 30, 1986 for Aramark], including use in published books, articles, and literally hundreds of presentations and seminars, there hasn't even been a situation where the Aramark mark of the '519 registration has been brought to the attention of applicant, let alone any case of actual confusion. **NOT ONE.** A clearer factor 8 presentation could not be imagined.

The case of *In re General Motors*, 23 USPQ2d 1465, 1468-9 (TTAB 1992) is directly on point here for two reasons; the marks involved were/are suggestive, and there was/is "nearly thirty years" (it is twenty nine here) of contemporaneous extensive use without even one case of actual confusion. In reversing a rejection and passing the case to publication the TTAB held:

"We also concur with the Examining Attorney that, as applied to applicant's and registrant's goods, the marks involved in this appeal create the same commercial impression. Nevertheless, unlike the situations in *Jeep*, *General Motors* and *Jetzon*, which involved arbitrary marks, the present case relates to a highly suggestive mark. As emphasized by applicant, the term "GRAND PRIX" "connotes an image of speed, high performance, and excellence--the qualities necessary to win a 'Grand Prix' race," when used in connection with automobiles and their replacement parts. Given this suggestiveness, we believe that as applied to such goods, the mark "GRAND PRIX" should be accorded a more narrow scope of protection than arbitrary or fanciful terms like "LAREDO," "STARFIRE" and "GEMINI". [FN14] See, e.g., *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 116-17 (TTAB 1978) and cases cited therein at 117. Because of the inherent weakness in a laudatory, highly suggestive mark such as "GRAND PRIX," [FN15] we think that when this factor is considered in conjunction with the relative fame of applicant's mark and the coexistence thereof with registrant's mark for nearly thirty years without applicant's becoming aware of a single instance of actual confusion, the conclusion is compelling that confusion is not likely to occur." (emphasis added)

Here, there can be no doubt that the marks NUTRITION CONCEPTS and NUTRITIONAL CONCEPTS are suggestive, and that combined with no instances of actual confusion for nearly thirty years clearly puts this case on par with *General Motors*.

The feeble attempt in the Final Rejection to distinguish this case from *General Motors* actually serves to highlight how controlling *General Motors* is. The Final Rejection says that this situation is distinct from that in *General Motors* because in that case there was a court holding that the marks were suggestive whereas here there is not. Of course the Final Rejection does not allege that the marks of the application and the '159 registration are not suggestive because that would be disingenuous. The relevant factors of no actual confusion for twenty nine years between suggestive marks are common, and that is all that is important.

Further, the fact that the Grand Prix products were used extensively also does not distinguish from this case. As the Bonnie Minsky Declaration makes clear applicant's mark has been used extensively, including on a website since 1998.

Even more significant in this case is the situation with respect to another entity actually using "Nutritional Concepts" as opposed to "Nutrition Concepts," as set forth in paragraph 4 of the Steven A. Minsky Declaration. As detailed there, with another "Nutritional Concepts" as opposed to "Nutrition Concepts" there have been dozens if not hundreds of instances of actual confusion. This evidence – completely ignored in the Final Rejection – is real commercial evidence, not mere argument about a hypothetical situation. It is clear from this evidence that those in the trade clearly recognize the differences between "Nutrition Concepts" and "Nutritional Concepts;" how else could one explain no instances of actual confusion between

those two, and dozens if not hundreds of instances of actual confusion between two “Nutritional Concepts” marks?

Finally, unlike the normal situation where the first user is given the benefit of the doubt, since applicant and the ‘519 registration claim a date of first use in class 044 and class 042, respectively, of 1985, and applicant’s use in interstate commerce is actually nine months EARLIER, here there is either no senior user to give the benefit of the doubt to, or since applicant is the senior user applicant should get the benefit of the doubt.

Applicant’s Class 035 services description is definite

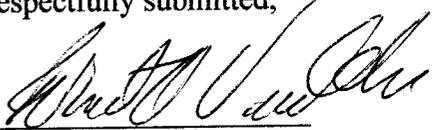
There is no evidentiary basis whatsoever for the assertion at the top of unnumbered page seven of the Final Rejection that applicant’s class 035 services description is indefinite. In fact it is the Examining Attorney’s suggested description that is not only wrong but indefinite. Applicant sells both over the Internet (which is not a “store” in the classic sense) and at brick and mortar facilities (a “store” in the classic sense). Therefore applicant’s description is clearly the correct one, not that suggested by the Examining Attorney.

CONCLUSION

In conclusion, it is respectfully submitted that there is no likelihood of confusion under 2(d) between the mark and services of the application and those of the ‘519 registration. Further, applicant’s class 035 services description is accurate and definite. Therefore early reversal of the Final Rejection and passage to publication are respectfully requested.

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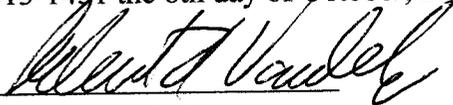
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Certificate of Mailing

I hereby certify that I mailed the foregoing Notice of Appeal and Appeal Brief, first class, postage prepaid, addressed to Commissioner of Trademarks, P O Box 1451, Alexandria, VA 22313-1451 the 6th day of October, 2014.



Robert A. Vanderhye

APPENDIX

The *du Pont* factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity of and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
10. The market interface between applicant and the owner of a prior mark:
  - (a) a mere "consent" to register or use.
  - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
  - (c) assignment of mark, application, registration and good will of the related business.
  - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.