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Subject: U.S. TRADEMARK APPLICATION NO. 76715478 - NUTRITIONAL CONCEPTS - N/A - EXAMINER BRIEF

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

<b>U.S. APPLICATION SERIAL NO.</b> 76715478  <b>MARK:</b> NUTRITIONAL CONCEPTS	
<b>CORRESPONDENT ADDRESS:</b> ROBERT A VANDERHYE  801 RIDGE DR  MC LEAN, VA 22101-1625	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> Nutritional Concepts, Inc.	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  N/A  <b>CORRESPONDENT E-MAIL ADDRESS:</b>	

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's final refusal to register the mark NUTRITIONAL CONCEPTS for "retail and wholesale on-line and store services featuring dietary and

nutritional supplements” and “personalized nutritional counseling services” on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in U.S. Registration Number 1,561,519, NUTRITION CONCEPTS for use in connection with “nutritional counseling services” in Class 42. It is respectfully requested that the Section 2(d) refusal be affirmed.

## **I. STATEMENT OF FACTS**

The applicant applied for registration on the Principal Register for the mark NUTRITIONAL CONCEPTS for “retail and wholesale sale of dietary and nutritional supplements” in Class 35 and “nutritional counseling services” in Class 44. On March 14, 2014, the examining attorney issued a non-final Office action refusing registration based on a likelihood of confusion with U.S. Registration Number 1,561,519, NUTRITION CONCEPTS for use in connection with “nutrition counseling services” in Class 42 under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Additionally, the examining attorney required a clarification of the identification. On July 22, 2014, the applicant filed a response with arguments in favor of registration. On August 13, 2014, the examining attorney issued a final refusal based on likelihood of confusion and the requirement for a definite identification. The applicant filed a Notice of Appeal on October 7, 2014.

## **II. ISSUE**

The sole issue on appeal is whether there is a likelihood of confusion between the applicant’s NUTRITIONAL CONCEPTS mark and the mark in Registration Number 1,561,519 under Trademark Act

Section 2(d). The other issue, whether the Class 35 identification is indefinite and unacceptable, has become moot as the applicant has agreed to amend to a definite identification if it prevails on the Section 2(d) issue.<sup>1</sup>

### III. ARGUMENT

#### **A. THE MARKS OF THE APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR IN OVERALL SOUND, APPEARANCE, MEANING AND COMMERCIAL IMPRESSION AND THE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination.<sup>2</sup> Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

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<sup>1</sup> As discussed on 11/6/2014, if the applicant prevails on the Section 2(d) refusal, applicant's attorney, Robert A. Vanderhuy, agrees to an examiner's amendment that will be issued prior to publication amending the Class 35 identification to following: Retail and wholesale store services, including online store services, featuring dietary and nutritional supplements.

<sup>2</sup> *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)).

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services.<sup>3</sup> See TMEP §1207.01. Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels.<sup>4</sup> See TMEP §1207.01, (a)(vi).

#### 1. **THE MARKS ARE CONFUSINGLY SIMILAR**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression.<sup>5</sup> TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

The proposed mark is NUTRITIONAL CONCEPTS for “retail and wholesale on-line and store services featuring dietary and nutritional supplements” and “personalized nutritional counseling services” and the registered mark is NUTRITION CONCEPTS for “nutrition counseling services.”

The marks share the language “nutrition-” and “concepts” and differ only by the letters “-al,” making these marks highly similar in overall appearance, sound and commercial impression. Marks may

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<sup>3</sup> See *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010).

<sup>4</sup> See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002).

<sup>5</sup> See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)).

be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. TMEP §1207.01(b)(ii)-(iii); See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar)<sup>6</sup>.

Also, the dictionary definitions of record show that “nutritional” is the adjectival form of “nutrition.” Specifically, “nutrition” is defined as food considered as something that keeps you healthy or the science of food and its effects on health and growth and “nutritional” is defined as concerning food as something that keeps you healthy. Both “nutrition concepts” and “nutritional concepts” mean concepts or ideas relating to food that keeps one healthy. Given the similarities of NUTRITIONAL CONCEPTS and NUTRITION CONCEPTS in overall sound, appearance, meaning and commercial impression, these marks are confusingly similar under a likelihood of confusion analysis.

## 2. THE SERVICES OF THE PARTIES ARE CLOSELY RELATED

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(i).<sup>7</sup> The respective goods and/or services need only be

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<sup>6</sup> See *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar).

<sup>7</sup> See *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind,

“related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, both parties seek registration for nutritional counseling services. Where the goods and/or services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Additionally, many entities that provide nutritional counseling services also provide retail or wholesale store services featuring dietary and nutritional supplements, including the applicant itself. (See the applicant’s identification of services showing it provides nutritional counseling and retail and wholesale store services featuring nutritional and dietary supplements.) The Examining Attorney attached webpages showing that the following businesses provide nutritional counseling and store services featuring dietary and nutritional supplements: Kalunga Wellness, Nutrition for Life, Sheer Nutrients, Nutrikey, On The Edge Fitness, Premier Weight Management Center, and, Maureen Stewart. This Internet evidence establishes that the same entity commonly provides the relevant services and sometimes even markets the services under the same mark, that the services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use

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the same goods can be related in the mind of the consuming public as to the origin of the goods.”).

and that the services are similar or complementary in terms of purpose or function.<sup>8</sup> Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Also of record are copies of third party registrations from the USPTO X-Search database showing that businesses commonly provide nutritional counseling and store services featuring nutritional goods. These printouts have probative value to the extent that they serve to suggest that the services listed therein, namely, nutritional counseling and retail, wholesale and various store services featuring nutritional and dietary supplements, are of a kind that may emanate from a single source.<sup>9</sup> See TMEP §1207.01(d)(iii).

#### **IV. APPLICANT'S ARGUMENTS**

The applicant's main arguments are that the marks are dissimilar and that the lack of any actual confusion brought to the applicant's attention over years of contemporaneous use results in a low likelihood of confusion, in addition to other arguments.

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<sup>8</sup> Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

<sup>9</sup> See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

a. Applicant's Arguments About Similarity of the Marks

The applicant argues that “nutrition” and “nutritional” have different meanings, but both meanings discussed by the applicant relate to food that keeps one healthy and both parties’ services relate to food and food-based goods that keeps one healthy. The applicant argues that no one “would EVER use ‘Nutritional’ to convey” the meaning of food considered as something that keeps you healthy but “would be used more with the second meaning ‘the science of food and its effect on health and growth.” (See page 10 of applicant’s brief.) This argument does not make sense as “nutritional” has only one meaning, namely, concerning food that keeps one healthy. If the applicant meant that no one “would EVER use [nutrition] to convey the meaning of food considered as something that keeps you healthy . . .,” this argument is unpersuasive because the applicant has provided no evidence or reasoning why consumers would not understand the word “nutrition” and its adjectival form “nutritional” to have their ordinary dictionary meaning of food as something that keeps one healthy, when used in this context.

The applicant cites several cases to support its position that the marks are dissimilar. However, these are unpersuasive because the marks in each case have different terms and entirely different meanings. See *Seven-Up Co. v. Tropicana Products, Inc.* 142 USPQ 384 (TTAB 1964), affirmed, 356 F.2d 567, 568, 53 CCPA 1209, 1211 (1966) (finding the marks SUN-UP and SEVEN-UP dissimilar because “sun” refers to a star that is the basis of the solar system and “seven” is the cardinal number of 6+1); *Revlon, Inc. v. Jerrell, Inc.*, 713 F. Supp, 93, 11 U.S. P.Q. 2d 1612, 1616 (S.D.N.Y. 1989)(finding the marks dissimilar because THE NINES suggests the number 9 while INTO THE NINETIES refers to the decade of the 1990’s); *Clarks of England, Inc. v. Glen Shoe Company*, 465 F. Supp. 375, 379, 209 USPQ 852, 854-55, (S.D.N.Y. 1960)(finding marks dissimilar because TREK for shoes connotes hiking across the Himalayas while STAR TREK connotes space travel). In contrast, the marks NUTRITION CONCEPTS and

NUTRITIONAL CONCEPTS do share the same terms “nutrition-” and “concepts” and both marks conjure up the idea of concepts relating to food that keeps one healthy.

The applicant also argues that since Reg. No. 2,832,202 for TRANXITION issued for computer software despite the fact that Reg. No. 1,985,615 for TRANXIT for computer software was live at the time, then NUTRITION CONCEPTS and NUTRITIONAL CONCEPTS also could coexist. This is inaccurate because Office records show that Registration No. 1,985,615 was cancelled on 4/12/2003 and Registration 2,832,202 registered on 4/13/2004, so these were not co-existing as registrations at the same time. Moreover, the examiner refused the TRANXITION application based on a likelihood of confusion with the TRANXIT registration, and it was not until the TRANXIT registration was cancelled that TRANXITION was approved for registration. Further, even if, hypothetically, these two registrations were coexisting as registrations for “tranxit—” marks, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi).<sup>10</sup>

b. Applicant’s Arguments Relating To “Actual Confusion”

The applicant argues that there is no likelihood of confusion because the applicant knows of no instances of actual confusion with over twenty years of contemporaneous use. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show

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<sup>10</sup> See *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

actual confusion to establish a likelihood of confusion. TMEP §1207.01(d)(ii).<sup>11</sup> The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); **and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).**[emphasis added]

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

The applicant's argument relies heavily on the TTAB's finding of no likelihood of confusion between GRAND PRIX for automobiles and GRAND PRIX for automotive replacement parts. See *In re General Motors*, 23 USPQ2d 1465, 1648-9 (TTAB 1992). In that case, the TTAB acknowledged that the mark "GRAND PRIX" was already found to be a weak mark in the automotive field based on *Tire & Battery Corp. v. Guldalian*, 206 USPQ 320, 322-23 (C.D. Calif. 1980)(see n. 15), and found that the evidence of several co-existing registrations, heavy advertising and printed articles all featuring GRAND PRIX used in the auto field confirmed the weakness of the mark in the *In re General Motors* case. *Id.* at 1467-68. The TTAB also found that with several million major automotive purchases nationwide over 28 years, along with robust advertising, the mark was famous and familiar to the general public, resulting in a low likelihood of confusion. (See notes 15 and 16.) To the contrary, in the instant case, the applicant has failed to submit a court ruling, internet attachments, third party registrations or other evidence showing that "nutrition concepts" and/or "nutritional concepts" are 1) weak marks in the marketplace and 2) famous nationwide such that the general public would be familiar with the marks.

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<sup>11</sup> See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)).

The applicant argues that the declarations attached to its response (dated July 22, 2014) establish facts similar to *In re General Motors* and “make clear, despite twenty nine years of HIGHLY VISIBLE (certainly in the case of the applicant) contemporaneous use,” there have been no known instances of actual confusion. (See p. 11 of applicant’s brief.) However, since there is no evidence that the applicant’s and registrant’s marks are weak in the marketplace, nationally famous or that the public is familiar with the marks, the facts in the instant case differ substantially from those in *In re General Motors*. Also, we have not heard from the registrant as to whether it has knowledge of instances of actual confusion as no consent agreement was submitted in this case.

On page 11 of its brief, the applicant lists several other cases to support its argument that since it knows of no actual confusion, there is no likelihood of confusion. However, in most of these cases, whether there was actual confusion was not a main factor in the likelihood of confusion analyses. Rather, in nearly all of these cases, the dissimilarity of the marks was the main reason the courts found no likelihood of confusion. See *Aktiebolaget Electrolux v. Armatron Int’l, Inc.*, 999 F.2d 1, 6 (1<sup>st</sup> Cir. 1993)(affirming that there was a likelihood of confusion when the marks were similar, namely, LEAF EATER and WEED EATER, but no likelihood of confusion with the marks that contained the additional manufacturer’s mark, namely, FLOWTRON LEAF EATER and VORNADO LEAF EATER); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 220 (2d Cir. 1999)(finding that of course there was no evidence of actual confusion as to fish-shaped mark for crackers because the junior user had not yet introduced its product into the marketplace and this should not be held against the junior user; both parties should be given an opportunity to present evidence to the court); *Ohio Art Co. v. Lewis Galoob Toys, Inc.*, 799 F.Supp. 870, 878 (N.D.Ill. 1992)(finding no likelihood of confusion because marks have very different trade dress and overall appearances and the Court even questioned the validity of the registration because the owner failed to establish secondary meaning in its trade dress); *Planet Hollywood (Region IV) v. Hollywood Casino*, 80 F. Supp.2d 815, 844 (N.D. Ill. 1999)(finding PLANET HOLLYWOOD and HOLLYWOOD CASINO

are not similar marks because of the different sequence in each mark, the different fonts and styles, sounds, meanings and impressions of each).

Finally, as to the last case listed by the applicant on page 11, the applicant quotes from that case: “All parties concede that evidence of actual confusion is the **most weighty** consideration.” (emphasis added). *Caliber Auto Liquidators, Inc. v. Chrysler*, 605 F.3d 931 (11<sup>th</sup> Cir. 2010). Quoting this sentence out of context is misleading as the issue on appeal was whether the lower court correctly dismissed the case on summary judgment because there were no issues of fact or whether the case should have proceeded to trial because there were issues of fact as to any actual confusion. The court found that there were issues of fact as to whether there was any actual confusion and remanded the case back to the lower court for a trial. Therefore, this case fails to support the applicant’s arguments against a likelihood of confusion.

In summary, none of the cases listed by the applicant on page 11 of its brief support the applicant’s position that the applicant’s lack of knowledge of any confusion is dispositive in a likelihood of confusion analysis. To the contrary, these cases support the Examining Attorney’s position that the totality of the facts in the instant case, especially the similarity of the marks and the relatedness of the services, shows that consumers are likely to be confused as to the source of the parties’ services.

### c. Applicant’s Other Arguments

The applicant argues that there is no likelihood of confusion because the classes of the services differ. However, the fact that the Office classifies goods or services in different classes does not establish that the goods and services are unrelated under Trademark Act Section 2(d). See TMEP §1207.01(d)(v). The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *Jean Patou, Inc. v. Theon, Inc.*,

9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

The applicant argues that the registrant has never provided retail store services to sell their supplements. This is unpersuasive because the goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion.<sup>12</sup> As previously discussed, the evidence of record shows that various types of store services featuring nutritional and dietary supplements are related to nutritional counseling services because they are commonly provided, marketed and sold by the same businesses, in similar channels of trade and to similar prospective consumers and the services are even complementary. Thus, customers are likely to be confused as to the source of the services.

The applicant argues that personalized nutrition counseling is distinct from nutrition counseling, but provides no evidence or reasoning to show that these services differ. Rather, "counseling" by its very definition is personalized. Further, the language "nutrition counseling" in the registration is so broad that it is presumed to include all types of nutrition counseling including personalized nutrition counseling. Unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The applicant provided declarations from Bonnie Minsky, founder, officer and majority shareholder, from her son Steven Minsky, officer and shareholder, and Carolyn Martinelli, part-time employee and daughter of Bonnie Minsky. In paragraph 5 of his declaration, Steven Minsky states that he went to registrant's website, namely, [www.aramark.com](http://www.aramark.com), and was unable to find any reference at all to the

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<sup>12</sup> See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

registered mark, to the language “nutrition concepts,” “nutrition counseling” or to “nutritional counseling services.” Carolyn Martinelli states in paragraph 2 of her declaration that she sent an email to the registrant via the registrant’s website inquiring whether they provide nutrition counseling and requesting information about Nutrition Concepts. These declarations appear to suggest that the owner of the cited registration does not use the mark in line with the specific services listed in the registration’s identification or that it has abandoned its service mark due to nonuse.

This evidence is unpersuasive because the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Also, a service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Further, the registrant has recently renewed its registration, indicating its continuous and present use. Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant’s nonuse of its mark, are not relevant during ex parte prosecution.<sup>13</sup> TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir.

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<sup>13</sup> See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992).

1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Therefore, it is respectfully requested that the Section 2(d) refusal be affirmed.

### **CONCLUSION**

Accordingly, the refusal of record based upon Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) should be affirmed.

Respectfully submitted,

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