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Sent: 9/18/2015 8:44:31 AM

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37455-403 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77505597

MARK: DRHORSEPOWER YOUR PRESCRIPTION FOR



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: DRHORSEPOWER, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

37455-403

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (with design), for the goods "Non-alcoholic beverages, namely, energy drinks," in International Class 32. The examining attorney has refused

registration on the Principal Register because applicant's mark is confusingly similar with Registration Number 3690631 for the mark HORSEPOWER ENERGY DRINKS (in standard character format) for the goods, "Beverage drinks, namely, energy drinks," in International Class 32. See 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b).

Accordingly, it is respectfully requested that the refusal based on likelihood of confusion under Trademark Act Section 2(d) be affirmed.

I. FACTS

On June 26, 2008, DRHORSEPOWER, INC., filed U.S. Trademark Application Serial No. 75/505597, seeking registration of the proposed mark, DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (with design) for "Non-alcoholic beverages, namely, energy drinks."

On September 14, 2008, the examining attorney issued an office action suspending the mark against the prior pending application Serial No. 78/568206 for the mark HORSEPOWER ENERGY DRINKS (in standard characters) for the goods, "Beverage drinks, namely, energy drinks."

On October 13, 2010, the prior pending application matured into Registration No. 3690631, and a refusal under Section 2(d) of the Trademark Act emanated from this registration.

On April 13, 2011, applicant responded to the Office Action and presented arguments in an effort to overcome the refusal under Section 2(d) of the Trademark Act.

On May 6, 2011, the examining attorney made final the refusal under Section 2(d) of the Trademark Act.

On November 6, 2011, applicant filed a request for reconsideration of the final office action however, the request was denied on December 7, 2011. On February 9, 2012, applicant's motion to suspend pending Cancellation No. 92055154 was granted.

On May 31, 2012, applicant's Ex Parte Appeal was terminated.

On March 24, 2015, proceedings resumed, and on July 24, 2015, applicant filed its Brief in support of Registration of Serial Number 77/505597.

II. THE MARKS OF APPLICANT AND REGISTRANT ARE HIGHLY SIMILAR IN DOMINANT PORTION AND THE GOODS ARE VIRTUALLY IDENTICAL SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, UNDER SECTION 2(d) OF THE TRADEMARK ACT

The Board should affirm the likelihood of confusion refusal because the marks are highly similar in part and the goods are virtually identical in nature and purpose. The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is dissimilar to trademarks already being used. See *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463 (Fed. Cir. 1988).

- A. The marks are similar because the dominant word portion of the applicant's mark is highly similar to the registrant's mark and thus is confusingly similar.**

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979). When an applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40 (D.C. Cir.), cert. denied, 351 U.S. 973 (1956).

1. Applicant's Dominant Feature of the Mark and Registrant's Mark are Similar in Overall Impression and Meaning

The likelihood of confusion refusal should be affirmed because the dominant portion of the marks are comprised of highly similar wording. The law is clear that marks may still be confusingly similar notwithstanding the addition, deletion or subtraction of letters or words. *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988). "It is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear." *Standard Oil Co. v. Standard Oil Co.*, 116 USPQ 176, 182 (10th Cir. 1958).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*

1772, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). In the present case, the term DRHORSEPOWER (in large, overarching letters in applicant’s mark) is the dominant feature of applicant’s mark, which is highly similar to registrant’s dominant feature of their mark HORSEPOWER. And, although applicant’s mark contains the additional wording YOUR PRESCRIPTION FOR WINNING!, this slogan not the dominant feature of the mark.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. The wording DRHORSEPOWER, due to its location and size, in applicant’s mark is the dominant wording in applicant’s mark.

Applicant argues that, “the examining attorney erroneously dissected the applicant’s mark and ignored several highly distinctive elements in the applicant’s mark...” during the examiner’s review. (Please see page 6 of Applicant’s Brief). When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110

USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”)). Notwithstanding the design element and the additional terms YOUR PRESCRIPTION FOR WINNING!, the term DR HORSEPOWER in applicant’s mark makes a strong impact on the viewer of the mark and this term is highly similar to registrant’s dominant feature of their mark, HORSEPOWER.

Although applicant’s mark contains stylized writing and a design element, registrant’s mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument

concerning a difference in type style is not viable where one party asserts rights in no particular display”). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii).

The commercial impression of the marks is also similar because the terms ENERGY DRINKS in registrant’s mark are descriptive and do not distinguish the overall meaning of the mark. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Accordingly, there is nothing improper in giving less weight to the highly descriptive and disclaimed terms ENERGY DRINKS and more weight to the term HORSEPOWER as the dominant term in the registrant’s mark, when consideration is given to the similarity of the marks in their entireties.

2. Evidence of Dilution of the term HORSEPOWER is Unpersuasive

Applicant has submitted market evidence that the wording HORSEPOWER is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat’l Cable Television Ass’n*,

Inc. v. Am. Cinema Editors, Inc., 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

This argument and the supporting evidence are unpersuasive. Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Because the applied-for mark contains highly similar wording as the registered mark but no other distinguishing wording, it does not create a distinct commercial impression from the registered mark. Accordingly, even though the dominant feature of the applied-for mark and the registered mark are not word-for-word copies of one another, they are confusingly similar.

B. The goods are virtually identical

The likelihood of confusion refusal should also be affirmed because the goods are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, without limitations or restrictions as to their channels of trade or classes of purchasers, the goods must be deemed to be promoted in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

1. Applicant's and registrant's goods are for the identical goods "energy drinks"

Here, the applicant's "Non-alcoholic beverages, namely, energy drinks," are virtually identical to the registrant's "Beverage drinks, namely, energy drinks." Both the applicant's and the registrant's goods are virtually identical for energy drinks.

Applicant argues that the applicant's and the registrant's goods travel in different channels of trade, therefore providing a reduced chance of a likelihood of confusion with the goods. However, with respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods 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)).

However, absent restrictions in an application and/or registration, the identified goods are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods 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).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers.

The Office Action and the Final Office Action included online articles depicting single sources that provide energy drinks. For example, the excerpt from Red Bull demonstrates that they provide “Red Bull energy drinks,” and 5-hour Energy provides “fast and easy to drink” energy shots. (Please see pages 4-6 from initial office action dated October 13, 2010). The excerpt from Screamingenergy (Please see pages 2-7 from final office action dated May 6, 2011), describes the various flavors and types of energy drinks provided, as well as the web pages from Amazon and Walmart that demonstrate the provision of several types of energy drinks provided via their web site (p. 8-17.)

This market evidence demonstrates the provision of energy drinks and the virtually identical nature of the applicant’s and registrant’s goods.

Finally, where the goods of an applicant and registrant are identical or virtually identical, 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. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b).

III. CONCLUSION

Because the marks are highly similar in dominant portion and the goods are virtually identical, consumers encountering the applicant’s mark and the registered marks in the marketplace are likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

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