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Subject: U.S. TRADEMARK APPLICATION NO. 77850772 - ARCTIC HEAT - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77850772

MARK: ARCTIC HEAT

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Poly-Gel L.L.C.

CORRESPONDENT'S REFERENCE/DOCKET NO:
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the trademark **ARCTIC HEAT** in standard character for "*therapeutic hot and cold compression wraps for cooling or warming parts of the human body; shoulder supports, ankle supports, back supports, knee supports, wrist supports, elbow supports and orthopedic supports with compression and without compression for reducing pain and increasing circulation and mobility to areas of the human body to which the supports are applied*," on the ground that the applied-for mark is likely to be confused with the mark in U.S. Registration No. 2,944,243 pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

FACTS

On October 16, 2009, Applicant, Poly-Gel L.L.C., applied for registration on the Principal Register of the mark **ARCTIC HEAT** in standard character for goods

ultimately identified as "*therapeutic hot and cold compression wraps for cooling or warming parts of the human body; shoulder supports, ankle supports, back supports, knee supports, wrist supports, elbow supports and orthopedic supports with compression and without compression for reducing pain and increasing circulation and mobility to areas of the human body to which the supports are applied*." On December 23, 2009, the examining attorney refused registration pursuant to Section 2(d) of the Trademark Act based on the confusingly similar mark **ARCTICHEAT. COOL DOWN AND FIRE UP** with design for goods identified, in relevant part, as "*human and veterinary medical devices, namely cooling and heating rehabilitation packs; temperature regulating devices for medical purposes, namely cooling and heating jackets and vests*." The examining attorney made final the refusal on July 19, 2010 after finding applicant's arguments unpersuasive. This appeal now follows.

ARGUMENT

(1) THE APPLICANT'S MARK IS WHOLLY ENCOMPASSED WITHIN THE REGISTRANT'S MARK AND THE SHARED, DOMINANT TERMS ARE IDENTICAL; AND (2) THE GOODS ARE SO HIGHLY RELATED THAT CONSUMERS ARE LIKELY TO BE CONFUSED OR MISTAKEN OR DECEIVED AS TO THTE SOURCE OF THE GOODS 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 that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP

§1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003).

The overriding concern is not only to prevent buyer confusion as to the source of the goods, 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. 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).

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

(1) **THE MARKS ARE CONFUSINGLY SIMILAR**

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. *In re E. I. du Pont*, 476 F.2d at 1361, 177 USPQ at 567. Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Here, applicant's mark, **ARCTIC HEAT**, in standard character form is confusingly similar to the registered mark, **ARCTICHEAT. COOL DOWN AND FIRE UP**, in sound, meaning and overall commercial impression. The marks share the identical dominant wording, **ARCTIC HEAT** and, as such, the first part of the marks will be pronounced identically. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980). Additionally, this Office has held marks to be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH).

The applicant's mark, consisting solely of the wording **ARCTIC HEAT** is wholly encompassed within the registrant's mark. The applicant has merely deleted wording **COOL DOWN AND FIRE UP** and the design from the registered mark. However, the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010). In the present case, applicant's mark does not create a distinct commercial impression because it contains the identical dominant wording **ARCTIC HEAT** as the registrant's mark, and there is no other wording to distinguish it from registrant's mark. As a result, purchasers are likely to perceive applicant's mark as a variation of registrant's mark and mistakenly believe that the goods emanate therefrom.

Moreover, the design element appearing in the registered mark, consisting of the registered mark superimposed on two rectangles, will not obviate the likelihood of

confusion between the two marks. Particularly, when a mark consists of a word portion and a design portion, the word portion is generally the dominant and most significant features of marks because the word portions more likely to be impressed upon a purchaser's memory and to be used in calling for the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). For this reason, greater weight is often given to the word portions of marks in determining whether there is a likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). Here, the design element is merely a carrier for the wording and creates little, if any, impression in the overall commercial impression of the mark. Moreover, the design element does not change the way that purchasers call for the goods; in other words, purchasers will not describe the design element in calling for the goods, but rather will use the dominant element appearing in the mark.

In the instant case, the dominant, most source-identifying element in the mark consists of the first part of the registrant's mark, and is the shared identical wording, **ARCTIC HEAT**. The Trademark Trial and Appeal Board has found that the first word, prefix or syllable of a mark is often the dominant portion and is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). As such, purchasers are likely to focus on and call for the goods using the shared identical wording appearing in both marks, **ARCTIC HEAT**, and in doing so, are likely to be confused as to the *source* of the goods.

Applicant argues that the shared terms **ARCTIC** and **HEAT** are common terms used by many entities in numerous industries to signify coolness and warmth. To date, applicant has provided no evidence to support this contention, but rather cites a 1982 Trademark Trial and Appeal Board decision in its Appeal Brief where the Board *speculated* that the word "arctic" may be a useful term in marketing refrigerators. *See In re Nantucket, Inc*., 677 F.2d 95, 107 n.8, 213 USPQ 889,893-894 n.8 (C.C.P.A. 1982). Moreover, neither the applicant nor the registrant sought registration for the terms, **ARCTIC** and **HEAT**, but rather the wording **ARCTIC HEAT**, which appears to be an arbitrary incongruous term that has no definable meaning.

Applicant further contends that the terms **ARCTIC** and **HEAT** should be viewed as weak and, accordingly, the registrant's mark should be entitled to a narrow scope of protection. It is well settled that 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. *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). However, applicant has not provided any evidence to support its claim that the registered mark is "weak" and has failed to refute the examining attorney's evidence showing the strength of the registered mark.

Specifically, in the final action, the examining attorney attached the search results from the X-Search database to show that there are only two (2) registrations and two (2) applications featuring the terms "ARCTIC" and "HEAT" on the trademark register. Particularly, applicant was advised that its own application, Serial No. 77850772 for the mark ARCTIC HEAT and application Serial Number 85079177 for the mark ARCTIC

HEAT for “rock salt” comprised the *only* applications currently on the registered incorporating the terms ARCTIC and HEAT. The relevant registrations include the cited registration for the trademark **ARCTICHEAT. COOL DOWN AND FIRE UP** and U.S. Registration 3230966 for the mark **ARCTIC HEAT** for “heating, ventilating, and air-conditioning systems for residential, commercial, and industrial use.” *Please see Outgoing Final Action dated 7/10/2010, Attachment 2 – X-Search results page, search strategy and hit list*. Moreover, the cited mark is registered on the Principal Register with no claim of acquired distinctiveness. Therefore, contrary to applicant’s assertions, the wording “ARCTIC HEAT” appears to be a strong mark for heating and cooling wraps, packs, jackets, supports and other related goods, and, as such, is entitled to the full scope of protection afforded by the Trademark Act.

Finally, the applicant argues that the stylized nature of the registered mark further reduce any likelihood of confusion with the applicant’s mark. In this case, the “stylization” in the registered mark consists of two rectangles that function as carriers for the wording **ARCTICHEAT. COOL DOWN AND FIRE UP** and do not obviate the similarities between the marks or a likelihood of confusion determination. The additional wording **COOL DOWN AND FIRE UP** appearing in the registrant’s mark merely reinforces the overall commercial impression of the dominant terms **ARCTIC HEAT**. Particularly, in the registrant’s mark, because the combined wording **ARCTIC HEAT** has no definable meaning, purchasers will understand the term “**ARCTIC**” as suggestive of **COOL**ing **DOWN** and the term **FIRE UP** as suggestive of “**HEAT**”. To that end, the suggestive wording in the mark really functions to tell purchasers about the nature of the goods and not to differentiate registrant as the source of the goods. Moreover, to the

extent that the wording **ARCTIC HEAT** signifies the coolness or warmth of the goods, as the applicant argues, it does so equally in both the registrants and the applicant's mark, thus conveying an identical commercial impression in the minds of consumers. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison or if people will confuse the marks, the question is whether the marks create the same overall impression and will confuse people into believing that the goods they identify come from the same source. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000).

Ultimately, when purchasers call for the goods of the applicant and registrant, they are likely to be confused as to the sources of the goods by the contemporaneous use of marks beginning with the identical, arbitrary term **ARCTIC HEAT**.

(2) **THE GOODS ARE HIGHLY RELATED**

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Rather, they need only be are related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). Moreover, if the goods of the respective parties 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 would be required with diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

In the present case, both the applicant and the registrant identify goods in the nature of packs and wraps for heating and cooling parts of the human body. Neither the application nor the registration contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, including drug stores, discount department stores, sporting goods stores, and the like. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

To demonstrate the highly related nature of the goods, the examining attorney provided ten (10) third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant. *Please see outgoing Office Action, dated December 23, 2009 – Attachment 2.* For example, U.S. Registration No. 1294090 for the mark CHAMPION identifies both applicant's "**wrist braces, ankle braces, elbow braces**," and registrant's "moist **heat packs for therapeutic purposes.";** U.S. Registration No. 0920296 for the mark COL-PRESS identifies registrant's "disposable **heat packs, ice packs**," and applicant's "post-operative **heat and ice wraps**."; U.S. Registration No. 2550248 for the mark PROSERIES identifies both registrant's "**heat packs and cold packs for medical use**," and the applicant's "**braces**, sleeves **and supports for** medical use on **limbs and joints**."; and U.S. Registration No. 2268126 for the mark SAMMONS PRESTON identifies both registrant's "medical **heat packs and cold packs**" and the applicant's "**orthopedic supports**."

Additionally, in the Final Office action the examining attorney provided evidence from five (5) third party Internet websites to show that many other entities provide the same goods as listed by both applicant and registrant under the same or similar marks. *Please see Outgoing Final Action, dated July 19, 2010 – Attachment 3*. For example, Cryotherm®, Pro-Tec® and FlexiPac® all provide both "heating an cooling gel packs" and "cold and heat compression shoulder, ankle, elbow, wrist and back wraps." *Please see Outgoing Final Action, dated July 19, 2010 – Attachment 3, providing evidence from icewraps.com, activeforever.com, pro-tec-online.com and colonialmedical.com*. Moreover, the evidence attached in the Final Action also demonstrates that manufacturers of registrant's cooling and heating jackets and vests also provide the applicant's hot and cold compression wraps. For example, both the companies ClimaTech and Cool Bandanas provide both cooling packs and wraps and cooling and heating jackets and vests. *Please see Outgoing Final Action, dated July 19, 2010 – Attachment 3, providing evidence from coolbandanas.com and climatechsafety.com.*

Finally, the examining attorney attached evidence from the registrant's website to demonstrate that the registrant provides its cooling and heating rehabilitation packs in the form of shoulder, ankle, back, knee, wrist and elbow wraps. *Please see Outgoing Final Action, dated July 19, 2010 – Attachment 4 showing evidence from the registrants webpage*. Accordingly, all of the examining attorney's evidence demonstrates that these goods are of a kind that are likely to be encountered in the same channels of trade, by the same class of purchasers such that purchasers will mistakenly believe that they emanate from a single source. Therefore, purchasers familiar with the registrant's trademark for **ARCTICHEAT. COOL DOWN AND FIRE UP** for goods for heating and cooling parts

of the human body, are likely to mistakenly believe that applicant's trademark featuring the dominant term **ARCTIC HEAT** identifies a source associated with the registrant.

Ultimately, when purchasers encounter the highly related goods of the applicant and the registrant, they are likely to be confused as to the sources of the goods by the obvious overlap and clear association between them.

CONCLUSION

Because the marks share the identical, dominant term **ARCTIC HEAT**, and the heating and cooling goods of the applicant and registrant are so highly related, purchasers are likely to be confused or mistaken or deceived as to the sources of the goods. As such, the refusal to register pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), should be affirmed.

Respectfully submitted,

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