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

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In re Application of Matthew Newman

Trademark Law Office: 114

Serial No. 78/541411

Trademark Attorney: Won T. Oh

Filing Date: January 3, 2005

Mark: IMPACT

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**BRIEF FOR APPELLANT**

**I. INTRODUCTION**

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on November 9, 2007, the Applicant hereby appeals from the Examining Attorney's final refusal to register IMPACT, dated May 14, 2007, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision. IMPACT does not create a likelihood of confusion with the prior registered or applied for marks cited against Applicant, namely DAILY IMPACT (Reg. No. 2251324), ZEROIMPACT (Serial No. 78464362) and HEALTHY IMPACT (Reg. No. 2337439), the registration of which has been cancelled.

**II. STATEMENT OF FACTS**

Applicant seeks registration on the Principal Register for its mark, IMPACT, for "mineral supplement for ruminants," in International Class 31. IMPACT is used in connection with a 10-pound bag of minerals used to create an artificial salt lick, *i.e.* mineral supplement, for deer and other ruminants. (Applicant's Office Action Response dated February 1, 2006). The Applicant does not use the mark in

connection with human consumables. (Applicant's Office Action Response dated February 1, 2006).

The Examining Attorney initially refused to register Applicant's mark stating it was likely to be confused with DAILY IMPACT (Reg. No. 75459909) for "vitamins and dietary food supplements" and HEALTHY IMPACT (Reg. No. 2337439) for "health nutritional products, namely, nutritional supplements." (Office Action dated August 5, 2005.) Specifically, the Examining Attorney concluded that Applicant's mark was highly similar to DAILY IMPACT and HEALTHY IMPACT because Applicant's mark incorporated the dominant feature of the registered marks and Applicant's mark identifies supplements likely to be sold in the same channels of trade as the registered marks. (Office Action dated August 5, 2005.)

Additionally, the Examining Attorney noted a potential likelihood of confusion with the applications for IMPACT 250 (Serial No. 78161115) and ZEROIMPACT (Serial No. 78464362), which resulted in a suspension notice being issued on November 17, 2006. (Office Action dated August 5, 2005 and Suspension Notice dated November 17, 2006).

Applicant submitted a response to the August 5, 2005 Office Action on February 1, 2006. Applicant argued IMPACT was not likely to be confused with DAILY IMPACT, HEALTHY IMPACT and ZEROIMPACT because IMPACT differed in sight and sound, thus creating a different commercial impression. Furthermore, Applicant argued that the dissimilarity in goods was sufficient to eliminate any potential for confusion. Applicant's mark is used to create an artificial

salt lick for deer and other ruminants by hunters and wildlife enthusiasts and is not used in connection with human consumables. (Office Action dated February 1, 2006). The specimens of use for DAILY IMPACT and ZEROIMPACT show that these products are used exclusively for human consumption. (Office Action Responses dated February 1, 2006 and March 22, 2007).

Lastly, the Applicant argued that his products will not travel in the same channels of trade as DAILY IMPACT, HEALTHY IMPACT, and ZEROIMPACT because Applicant's product is marketed to sophisticated consumers of deer feed-related products and hunters through hunting and sporting stores and the hunting and sporting goods sections of department stores, as opposed to retail outlets where human consumables are sold. (Office Action Responses dated February 1, 2006 and March 22, 2007).

On May 14, 2007, the Examining Attorney issued a final Office Action refusing registration to IMPACT based on confusion with DAILY IMPACT and HEALTHY IMPACT. The Examiner was not persuaded by Applicant's arguments and ultimately denied registration under Section 2(d) 15 U.S.C. 1052(d). The Examining Attorney maintained his objection that Applicant's mark was highly similar to the registered marks because Applicant's mark is the dominant portion of the registered marks. Also, the Examiner concluded that Applicant's goods could be encountered in the same channels of trade because the registrants' goods descriptions are broad enough to encompass supplements for animals. (Office Action dated May 14, 2007).

### III. ARGUMENT

#### A. **Applicant's Mark Creates a Distinct Commercial Impression Such That it is Not Likely to be Confused with DAILY IMPACT, HEALTHY IMPACT, or ZEROIMPACT.**

Applicant respectfully submits that the Examining Attorney committed error by dissecting the DAILY IMPACT, HEALTHY IMPACT, and ZEROIMPACT composite trademarks in order to reach the conclusion that they are likely to be confused with Applicant's Mark. The "anti-dissection" rule dictates that composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into component parts for comparison. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 202 U.S. 538, 345-46, 40 S. Ct. 414, 64 L. ed. 705 (1920).

Although the Examining Attorney may give greater weight to the dominant portion of a composite mark in determining the question of likelihood of confusion, Applicant contends that the Examining Attorney relied too heavily on this factor in refusing registration of Applicant's mark considering the other overwhelming factors that weigh heavily against a finding of a likelihood of confusion. Applicant's mark is easily distinguished from the prior registered marks on the basis of sight and sound alone. Both registered marks and ZEROIMPACT contain two words and a total of four syllables; Applicant's mark contains only one word and two syllables. In fact, DAILY IMPACT and HEALTHY IMPACT are much more similar to each other than IMPACT is to either of these prior registered marks. Both DAILY IMPACT and HEALTHY IMPACT are two word marks that end in the "Y" letter and sound, giving

them a very similar appearance and virtually identical sound. Applicant's one-word mark is more distinct from DAILY IMPACT and the already approved HEALTHY IMPACT. Based on the marks' sight and sound, Applicant's mark is less likely to cause confusion with the prior marks than the prior marks are likely to cause confusion between themselves, particularly when Applicant's goods is a mineral supplement in the form of a salt lick for animals that has never been marketed to humans.

Applicant respectfully submits that the Examining Attorney overemphasized the strength of the word "IMPACT" in connection with nutritional supplements in denying IMPACT's registration because it consists of the dominant portion of prior registered marks. The mere fact that the Examining Attorney has cited three other marks that incorporate the word "IMPACT" to identify nutritional supplements establishes that it is not uncommon for "IMPACT" to be used in the field of nutritional supplements. As such, the word "IMPACT" is a weak mark entitled to a limited scope of protection vis-à-vis other marks and that these registrations are able to co-exist without causing a likelihood of confusion with each other. Accordingly, any difference in the trademark and the goods associated therewith should be sufficient to eliminate a likelihood of confusion. There are significant differences between Applicant's goods and those identified by the prior registered marks and ZEROIMPACT.

Clearly if consumers can successfully distinguish DAILY IMPACT, HEALTH IMPACT, and ZERO IMPACT from each other when they each identify nutritional

supplements and are sold together in health-food stores or on the nutritional aisle of the grocery store, then consumers can also distinguish Applicant's goods that will not be sold in the same aisle or likely even the same stores as Applicant's products. *See H. Lubovsky, Inc. v. Esprit De Corp.*, 627 F. Supp. 483, 228 U.S.P.Q. (BNA) 814 (S.D. N.Y. 1986) (the weakness of ESPIRIT as a mark is confirmed by the trademark register and other evidence that a number of unconnected entities have used "esprit" as a mark on wearing apparel).

Furthermore, Applicant's goods are marketed through different channels and to different prospective purchasers. Applicant's products are marketed to avid hunters and wildlife enthusiasts, as such these products are found at hunting and outdoors trade shows, hunting and sporting good stores (in the hunting section) or in the hunting or sporting goods sections of department stores. Such products would not be marketed alongside products for human consumption such as DAILY IMPACT, as evidenced by the DAILY IMPACT specimen material. (*See* copy of Section 8 & 15 Declaration for DAILY IMPACT attached to February 1, 2006 Office Action Response).

A number of decisions support the argument advanced by Applicant. In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401 (C.C.P.A. 1970), the court allowed the registration of the mark PEAK PERIOD for personal deodorant over the objection of the owner of the registered mark PEAK for a dentifrice (oral cleanser). The registrant argued that adding the work "PERIOD" to its mark "PEAK" was insufficient to differentiate the two marks, and that the products offered in

connection with the marks were so similar that confusion was likely. The court disagreed. It held that while the respective goods of the parties could be encompassed by the broad characterization of “toilet preparations,” they were nevertheless different and noncompetitive. The court concluded that, although both products could be considered cosmetics for human use, they are applied to the skin for completely different purposes, and it allowed registration of PEAK PERIOD.

As applied here, there is far more distance between Applicant’s goods, a mineral lick for ruminants, and “nutritional supplements,” or vitamins for humans than there is between two human toilet preparations. The broad distance between the types of goods, channels-of-trade, and likely customers for the goods offered in connection with the Applicant’s mark and the goods offered in connection with the registered marks indicates that there is no likelihood of consumer confusion.

Similarly, *In Ferrero, Application of*, 479 F.2d 1395 (Cust. & Pat. App. 1973), the court held that the Trademark Trial and Appeal Board had improperly refused to allow the registration of TIC TAC for candy (class 30) over the prior registered mark TIC TAC TOE for ice cream and sherbert (also class 30). The court primarily attacked the board’s opinion on the grounds that it “appear[ed] to have regarded only the marks, without their significance, and the broad goods descriptions, without the relation of the marks to the goods.” *Id.* at 1396. The court believed that the significance of the TIC TAC TOE mark was intimately tied to the ice cream product, which had a checkerboard pattern when sliced. *Id.* at 1397. For this reason, the court found it unlikely that the registrant would “apply [the mark] to other goods or that

purchasers would expect the mark, or any variant thereof to be applied to different goods, such as candy.” *Id.*

Applicant believes that by taking into account all the relevant factors in comparing Applicant’s mark to the marks cited against Applicant, including the different commercial impression when the mark is used on product exclusively for animals by wildlife enthusiasts and hunters, the Board will find that a likelihood of confusion does not exist.

**IV. Applicant’s Goods are Unrelated to Registrant’s Goods and are Sold in Separate Channels of Trade to Sophisticated Consumers**

The Examining Attorney erroneously concluded Applicant’s goods are highly similar to the goods identified by DAILY IMPACT, HEALTHY IMPACT, and ZEROIMPACT. The Examiner noted that even though Applicant’s goods are supplements for animals, Applicant’s goods are still highly similar to those of DAILY IMPACT and HEALTHY IMPACT because the prior registrants’ goods are not limited to goods for human consumption. To support this conclusion, the Examiner cited excerpts from the online searchable *Manual of Acceptable Identifications of Goods and Services* showing that supplements for humans and supplements for animals are classified in class 5. Notably, none of the illustrations of acceptable goods and services included a description for a supplement by a single applicant for use by both animals and humans. (*See Attachments 1-2 to Office Action dated May 14, 2007.*)

The fact is that human pharmaceuticals and veterinary preparations are broadly diverse products. Because of the broad gap between the types of products, the PTO would have required specimens showing use of the registered marks in connection with veterinary products as well as with products for human consumption if the PTO had understood the registered marks' descriptions to include veterinary products. See TMEP 1402.03 ("However, if an identification is so broad that it encompasses a wide range of products, the applicant must submit evidence that it actually uses the mark on a wide range of products to obtain registration."); see *In re Air Products & Chemicals, Inc.*, 192 U.S.P.Q. 84, *recon. denied* 192 U.S.P.Q. 157 (TTAB 1976)."); see also TMEP 1420.05, *citing In re Air Products & Chemicals, Inc.*, 192 U.S.P.Q. 84, *recon. denied* 192 U.S.P.Q. 157 (TTAB 1976) (acceptance of identification of goods as "catalysts," which could include large number of catalysts that applicant does not manufacture, would give applicant a scope of protection to which it was not entitled); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 U.S.P.Q. 505, 509 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 U.S.P.Q. 722 (C.C.P.A. 1974) (noting that, in view of specimens, greater specificity should have been required in identifying registrant's detergent product); *In re Toro Mfg. Corp.*, 174 U.S.P.Q. 241 (TTAB 1972) (noting that use on "grass-catcher bags for lawn-mowers" did not justify the broad identification "bags," which would encompass goods diverse from and commercially unrelated to applicant's specialized article). Accordingly, the registered marks' descriptions of use in connection with human vitamins and

nutritional supplements should not bar Applicant's registration for a mineral supplement in the form of a salt lick for animals.

Applicant respectfully submits that there is no similarity between the established, likely-to-continue trade channels for its product and the products covered by the registered marks. Applicant's mark is used to market a mineral supplement for ruminants to hunters and wildlife watchers. The product is marketed through hunting and sporting goods stores, and the hunting and sporting goods sections of department stores. It is marketed in connection with other wildlife nutritional products purchased by similar consumers. Such products would not be sold in the areas where DAILY IMPACT, HEALTHY IMPACT, and ZEROIMPACT goods would be sold, such as health-food stores or on the nutritional supplement aisle of the grocery store. Applicant's goods are not marketed in connection with human consumables.

In contrast, the registered marks are used in connection with products marketed for human consumption that would be sold through various retail outlets where human consumables are sold. There is no likelihood that the Applicant's mark will cause confusion with the Prior Marks based on channels of trade.

The TMEP states that if the goods in question are not related or marketed in such a way that they would be encountered by the same person in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. TMEP Section 1207.01(a)(i). For all of the reasons stated herein Applicant's products are not likely to be confused

with those identified by DAILY IMPACT, HEALTHY IMPACT and ZEROIMPACT.

Lastly, the Applicant sells its IMPACT-marked product to sophisticated consumers of deer feed-related products, such as hunters and wildlife enthusiasts. The product is only found at sportsman trade shows, hunting or sporting goods stores, or in such sections of large department stores. It is not marketed in connection with human consumables. As discussed above, a buyer looking to purchase human nutritional supplements is not likely to find, much less be confused by, a mineral supplement for ruminants. Even an impulse shopper is not likely to confuse a mineral-lick product bearing Applicant's mark with a human-consumable product bearing one of the registered marks. All of these factors weigh in favor of registration.

## **V. CONCLUSION**

For the reasons set forth hereinabove, Applicant submits that there is no likelihood of confusion between Applicant's mark and the prior cited registrations. Accordingly, Applicant's mark is entitled to registration. Applicant respectfully requests the Board to reverse the Examining Attorney's decision refusing registration of Applicant's mark.

Respectfully submitted,

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