From: Dalier, John

Sent: 9/8/2016 3:38:49 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86010527 - INNATIA - N/A - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 4

Files: HPMin3.jpg, HPMin2.jpg, HPMin1.jpg, 86010527.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86010527

MARK: INNATIA

CORRESPONDENT ADDRESS:

ARTURO PEREZ-GUERRERO

LAW OFFICES OF ARTURO PEREZ-GUERRERO

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SAN JUAN, PR 00902-4163

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: PREMEX S.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

arturo@perezguerrero.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 9/8/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated February 18, 2016 is maintained and continued to be final: Refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 4639407 as to be likely, when used on the identified services to cause confusion, or to cause mistake, or to deceive. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Also, applicant's claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. 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.

Applicant's mark INNATIA in standard characters is essentially identical to the cited mark INNATIA in stylized font with flourishes. The literal portions of both marks are identical in all respects. The stylization and additional flourishes present in the cited mark have minimal impact, and do not adequately differentiate the marks. As such, the parties' marks are highly and confusingly similar.

Also, note again that where the marks of the respective parties are identical or virtually identical, as is the case here, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, Llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a). However, the only difference possible between applicant's catalog ordering service and registrant's online store services is the format through which these retail services are rendered. That said, the retail services of whatever type are for the same purpose - selling goods. Furthermore, both the applicant's retail services and the registrant's retail services are specifically identified as featuring health products. *See* the applicant's identification of services and the registrant's identification of services.

Applicant argues that the registrant's health products do not include any goods like those featured in the applicant's services. No evidence was submitted in support of this conclusion. Regardless, the examining attorney must respectfully disagree with this conclusion. The applicant's mineral supplements, vitamin supplements and animal food are health goods, as shown in the attached evidence from http://www.swansonvitamins.com/, https://www.amazon.com/Mineral-Supplements/b?ie=UTF8&node=3774271 and http://www.vitacost.com/, all captured September 8, 2016. Each of these websites shows mineral and vitamin supplements like those of the applicant

provided as health products. The registrant provides health product goods via its services. Thus, the applicant's services and the registrant's services must be deemed related.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/John D. Dalier/

Trademark Examining Attorney

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- New Chapter (4)
- Nature Made (136)
- + See more

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- Frustration-Free Packaging (40)

Avg. Customer Review
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- ★★★☆☆ & Up (5,643)
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New Arrivals
- Last 30 days (23)
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International Shipping
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Price
- Under $25 (9,360)
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- Naturally Sourced Best Magnesium Oil... ★★★★★ (91) ~~$30.95~~ $18.47 Prime
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