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Subject: U.S. TRADEMARK APPLICATION NO. 86029611 - COFAL - 2.451.13 - Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 86029611

MARK: COFAL



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Plaza Izalco, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

2.451.13

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

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 1/30/16. maintained and continue to be final: the likelihood to cause confusion refusal.

Likelihood to Cause Confusion Refusal Maintained

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration Nos. 3540972 and 4581604 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive.

The applicant's mark is "COFAL" in standard characters for analgesic and muscle relaxant pharmaceutical preparations; analgesic balm; analgesic preparations; curare for use as a muscle relaxant; medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; muscle relaxants. The registrant's referenced marks are "KOFAL" and "KOFAL-T" for analgesic balm and other goods. The examining attorney's position is that confusion as to the source of origin or sponsorship is extremely likely if the applicant's proposed mark is allowed to register.

The applicant presents several arguments in favor of registration in the request for reconsideration. The main argument is, in essence, that marks are different. The examining attorney has carefully considered the applicant's arguments, but has found them unpersuasive. For the reasons below, the **FINAL** refusal under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) is maintained.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (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); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. 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); TMEP §1207.01, (a)(vi).

In accordance with these decisions, as cited in the earlier actions, the examining attorney considered the applicant's mark in its entirety when making the likelihood of confusion comparison. The applicant's mark is the one term mark, "COFAL," presented in standard characters. The registrant's marks are the standard character terms, "KOFAL" and "KOFAL-T." The applicant's mark "COFAL" comprises the phonetic equivalent of the registered marks term "KOFAL." The only difference is the applicant's use of "C" for a "K" and the Registration No. 3540972's additional term "-T".

The applicant's arguments rely upon a third party registration, No. 3078829, "KOFAL" for unrelated goods. The applicant argues that the determination in that case that "KOFAL" was primarily merely a surname requiring a claim of acquired distinctiveness to be registered distinguishes the marks in this instance. However, it is well established that each case is decided on its own facts, and each mark stands on its own merits. See *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

The cited registered marks in this case have no claim of acquired distinctiveness. Even if "KOFAL" was considered primarily merely a surname, it would still sound similar to the applicant's marks. The registrant's "KOFAL" and the applicant's "COFAL" are essentially phonetic equivalents that sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

As to Registration No. 3540972, the applicant's mark deletes the "-T" from the phonetically equivalent portion shared. 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 re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark.

The applicant argues that the additional "T" creates a different commercial impression, namely, that of a personal name and relies on TMEP Section 1211.01(b)(iii) and the case, *In re P.J. Fitzpatrick*, 95 USPQ2d 1412 (TTAB 2010) to support the argument. However, TMEP Section 1211.01(b)(iii) cites *In re P.J. Fitzpatrick*, 95 USPQ2d 1412 (TTAB 2010) by stating "[a] mark that consists of two or more initials ***preceding*** a surname will typically convey the commercial impression of a personal name and thus generally will not be primarily merely a surname (bold and italics added)." In this instance, the single letter follows the portion considered a "surname" by the applicant. None of the examples cited in the TMEP Section utilize a dash with the additional lettering following a term. Accordingly, it does not appear that "KOFAL-T" would be perceived as a personal name. Assuming for arguments sake that it were somehow considered a personal name, the portions "KOFAL" and "COFAL" would still be phonetic equivalents and similarly confusing to consumers.

Marks may 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. 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); *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); TMEP §1207.01(b)(ii)-(iii).

The applicant argues that the term “KOFAL” in the registered marks is weak. However, 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. See *Nat’l Cable Tel. 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).

In addition, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’”); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

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 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 Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Truimph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); 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. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

It should also be noted that when 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 *In re Bay State Brewing Co.*, 117 USPQ2d

1958, 1960 (TTAB 2016) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *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). As stated below, the applicant's and registrant's marks are used on identical goods, such as analgesic balm, analgesic and muscle relaxant pharmaceutical preparations and curare for use as a muscle relaxant.

Since the marks themselves are considered similar, the examination now turns to the relationship between the goods of the parties. The applicant's mark is for analgesic and muscle relaxant pharmaceutical preparations; analgesic balm; analgesic preparations; curare for use as a muscle relaxant; medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; muscle relaxants. The registrant's referenced marks are for analgesic balm and adhesive bandages; adhesive bands for medical purposes; analgesic and muscle relaxant pharmaceutical preparations; analgesic balm; anti-inflammatory gels; anti-inflammatory salves; anti-inflammatory sprays; balms for medical purposes; balms for pharmaceutical purposes; curare for use as a muscle relaxant; herbal topical creams, gels, salves, sprays, powder, balms, liniment and ointments for the relief of aches and pain; medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; muscle relaxants; sports cream for relief of pain; therapeutic spray to sooth and relax the muscles. The overlapping identifications of analgesic balm, analgesic and muscle relaxant pharmaceutical preparations; curare for use as a muscle relaxant; medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; multipurpose medicated antibiotic cream, analgesic balm and mentholated salve and muscle relaxants evidences the relationship.

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)). 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 and/or services travel in all normal channels of trade, and are available to the same class of purchasers.

Further, the registrant uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in applicant's more narrow identification. The registrant's broad identification of "balms for medical purposes" and "balms for pharmaceutical purposes" is seen to include the applicant's analgesic balm. Similarly, the applicant's broad identification of "analgesic preparations" is seen to include goods such as the registrant's analgesic balm and analgesic muscle relaxant pharmaceutical preparations. In addition, see the additional attached evidence illustrating common producers of both adhesive bandages or bands and analgesic cream.

A search of Office records illustrates a more specific connection between the differing identified goods. The trademark examining attorney has previously attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, "analgesic preparations" and "analgesic balm" or "adhesive bandages" goods, are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii).

Finally, it should be noted that the overriding concern in likelihood to cause confusion determinations 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); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). Accordingly, it is the examining attorney's opinion that the marks are similar, that the goods are related, and that there is a likelihood of consumer confusion if the two marks are used contemporaneously.

In the present case, applicant's request has not resolved all the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue 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.

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).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

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