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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86523344
Applicant	Femelabs LLC
Applied for Mark	VF10
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Femelabs LLC

Serial No. 86523344

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BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant Femelabs LLC (hereinafter “Applicant”) and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

II. STATEMENT OF THE CASE

On or about February 3, 2015 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following goods: dietary supplements; dietary supplements for female urogenital health.

On or about May 10, 2015 the Examining Attorney refused registration of the Applicant’s trademark on the grounds that, if registered, it would create a likelihood of confusion with the registered trademark VF-360 more fully set forth in U.S. Registration No. 4629583.

On or about November 10, 2015 Applicant filed a response to the Office Action dated May 10, 2015 arguing in support of registration. However, ultimately Applicant’s argument was not deemed persuasive by the Examining Attorney and, accordingly, on or about November 17, 2015 the Examining Attorney made the refusal final.

The instant appeal now timely follows.

III. ARGUMENT

A. *The Standard for a Determination of a Likelihood of Confusion*

A determination of likelihood of confusion between marks is made on a case- specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed . Cir. 1997). The Examining Attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;

- (2) The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) The number and nature of similar marks in use on similar services; and
- (6) The absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

Id.

The Examining Attorney is tasked with evaluating the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the Examining Attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the

mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computergoods Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). *See generally* TMEP § 1207.01(a)(iii).

Even if the marks are similar, confusion is not likely to occur if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originate from the same source. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Purchasers who are sophisticated or knowledgeable in a particular field are not necessarily immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant's trademark and the trademark cited and, accordingly, the refusal to register VF10 should be withdrawn.

B. The Trademarks Are Dissimilar

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. Rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar, but a similarity of one factor is not dispositive of the entire analysis. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Additions or deletions to marks are often sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

If the respective trademarks create separate and distinct commercial impressions source confusion is not likely. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression).

In the instant case, Applicant's trademark is VF10. In the alternative, the registered trademark is VF-360. As such, it is easy to see that the only common element of the trademarks are the letters VF which originate each respective trademark. But here is where the similarities end.

Both marks are then followed by a number. In the case of the Applicant's mark, the number "10". In the case of the registered mark, the number "360". It is the distinctions between the connotations provided by these two numbers in conjunction with the hyphen utilized by the registrant which truly distinguish these two marks upon closer inspection.

First, Applicant's number is 10. The number 10 is associated generally with perfection as in the phrase "10 out of 10". As such, the Applicant's use of the number "10" in connection with VF creates a commercial impression of a VF that is perfect or a perfect 10. Moreover, if one examines the specimen of the Applicant provided with the application it reveals that the number is actually used in commerce in superscript as such: VF¹⁰. In this context, the other connotation that would be engendered in the minds of consumers viewing this mark would be VF to the tenth power. In this regard, the Applicant's mark either would create a connotation of perfection of strength.

To the contrary, the registrant's trademark is VF-360. The number 360 conjures up images of completeness as a reference to the entire degrees that it takes to complete a full circle or turn. As such, the number 360 engenders a connotation of completeness by using a number generally associated with this concept. Significantly, use of the mark as displayed in the specimens of registrant's mark use the mark exactly as it appears in the standard character form, namely in a side-by-side or linear manner VF-360. This is important as one could not nor would not read the number 360 as an exponent as would be the case for Applicant's use of the number 10. Specifically, as registrant uses a hyphen, or "-", this defeats the ability to use the number as an exponent as exponents do not use hyphens.

Accordingly, despite some superficial similarities as between the letters VF, Applicant's mark either creates a commercial impression of perfection or strength by using the number 10, a number with strong associative ties to those concepts. The registrant's mark, in the alternative, creates an impression of completeness and in no way could create an impression of perfection or strength given the separate and distinct uses of the number "10" versus the number "360" in our society.

Given these separate and distinct commercial impressions, it is submitted that this fact favors a finding of an absence of a likelihood of confusion under this *du Pont Factor*.

C. The Goods or Services of the Trademarks Overlap

Applicant must concede the similarity of the goods or services as recited in the Applicant's applied-for trademark as well as the registered trademark. Notwithstanding this concession, however, Applicant nevertheless submits that the remaining factors establish that even despite this similarity confusion is not likely for the reasons more fully set forth herein.

D. Sophistication of Purchasers

Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

In the instant case, Applicant provides dietary supplements and dietary supplements for female urogenital health. Registrant provides vitamins and nutritional supplements. Traditionally, consumers of these goods are sophisticated insofar as purchasers of vitamins are generally aware of the materials being ingested into their bodies and exercise great care in determining that which they will use as supplements.

As such, consumers exercise sufficient care in the purchase of the respective goods or services that clearly would minimize any potential for a likelihood of confusion as between the respective trademarks. As such, the *du Pont* factor also favors a finding of an absence of a likelihood of confusion.

E. Absence of Actual Confusion

Finally, there is no evidence of record indicating that there has been actual confusion in the marketplace as between Applicant's goods and the registrant's goods despite co-existence in the marketplace for nearly a year and a half.

The absence of any instances of actual confusion is a meaningful factor where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents

thereof would be expected to have occurred and would have come to the attention of one or all affected trademark owners. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

As the Examining Attorney has alleged, the Office believes that the Applicant's goods and those of the registered trademark travel in similar trade channels and are marketed in a similar enough manner to create a likelihood of confusion. While not conceding this point, provided that this is, in fact, the Office's position it would be contradictory to discount the absence of actual confusion as between the trademarks at issue where the Office contends there is an overlap in marketing and trade channels.

Accordingly, consistency in the Office's position, whether or not countered by the Applicant in the instant Argument, suggests that the Office should consider the absence of evidence of actual confusion to be a meaningful factor in the instant analysis, a factor which clearly supports registration of Applicant's Trademark under this *du Pont* factor.

IV. CONCLUSION

Based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney, remove as an impediment the cited trademark, and approve the instant Application for publication.

Respectfully submitted this 9th day of February, 2016,

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