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Subject: U.S. TRADEMARK APPLICATION NO. 86523344 - VF10 - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86523344

MARK: VF10



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Femelabs LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Attorney's refusal to register the mark VF10 under Section

2(d), 15 U.S.C. §1052(d), on the ground that such mark is likely to cause, confusion, mistake or deception

with the subject matter of U.S. Registration Number 4629583.

FACTS

Applicant has applied to register the trademark VF10 for “dietary supplements; dietary supplements for female urogenital health.” Registration was refused under Section 2(d) of the Trademark Act , 15 U.S.C. §1052(d), on the ground that said trademark was likely to cause confusion, mistake or deception in trade with U.S. Registration Number 4629583 for VF-360 used in connection with “vitamins [and] nutritional supplements.” This determination was based on the application papers and the specimens of record.

ARGUMENT

THE TRADEMARK VF10 WHEN USED IN CONNECTION WITH APPLICANT’S GOODS, SO RESEMBLES THE MARK VF-360 IN REGISTRATION NUMBER 4629583 AS TO BE LIKELY TO CAUSE CONFUSION, MISTAKE OR DECEPTION AS DEFINED UNDER SECTION 2(D), 15 U.S.C. §1052(d) OF THE TRADEMARK ACT.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *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).

Perhaps the first and most important thing to remember, and this cannot be emphasized strongly enough, is that as long ago as 1910, the Court of Appeals for the Second Circuit stated: "It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select from the entire material universe which is before him, symbols, marks and coverings, which by no possibility can cause confusion between his goods and those of his competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to a successful rival that the public may fail to distinguish between them." *Florence Mfg. Co. v J.C. Dowd & Co.*, 178 F. 73 (2ND CIR 1910). Thus, where the latecomer chooses a mark which so much as raises reasonable doubts about the likelihood of confusion with an established mark, those doubts will be resolved in favor of the first user. *See: The United States Time Corp. v. Jacob Tennenbaum*, 46 CCPA 895, 267 F.2d 327, 122 USPQ 15 (CCPA 1959).

Turning to the respective marks in this case, we find that applicant has taken the most prominent and salient feature of registrant's mark, the letters VF, and merely added a different number to it.

Moreover, applicant's mark places the letters "V" and "F" in the same order as registrant and in front of

the numerical designation “10.” This is quite important as consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Applicant is correct in its assertion that marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)).

It should also be remembered that when comparing marks that consist of a series of two or more letters, confusion may be likely even if the letters are not identical or in the same order. It is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures; that is, confusion is more likely between arbitrarily arranged letters than between other types of marks. *See, e.g., Weiss Assoc. v. HRL Assoc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM); *Dere v. Inst. for Scientific Info., Inc.*, 420 F.2d 1068, 164 USPQ 347 (C.C.P.A. 1970) (finding confusion between ISI and I.A.I.); *cf. In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001) (finding confusion between registrant’s KING FM and KING-TV and applicant’s KYNG).

This principle was set forth in *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 506, 25 USPQ 5, 6 (C.C.P.A. 1935), wherein the Court of Customs and Patent Appeals applied the following reasoning in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder: “We think it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely.”

Even lettered marks having only two letters in common, used on identical or closely related goods, have been held likely to cause confusion. *See, e.g., Feed Serv. Corp. v. FS Servs., Inc.*, 432 F.2d 478, 167 USPQ 407 (C.C.P.A. 1970) (finding confusion between FSC and FS); *Cluett, Peabody & Co. v. J.H. Bonck Co.*, 390 F.2d 754, 156 USPQ 401 (C.C.P.A. 1968) (finding confusion between TTM and T.M.T.); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Int'l GmbH*, 230 USPQ 530 (TTAB 1986) (finding confusion between EB and EBS); *see also* TMEP §1207.01(b)(ii)-(iii).

Compounding the problem for applicant, and weakening its argument that the marks are so dissimilar that confusion is unlikely is the fact that the goods of the respective parties are, in a very real sense, identical, or so closely related as to be identical. In fact, applicant, in its appeal brief, admits as much. And it is almost hornbook law that where the goods and/or services of an applicant and registrant 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 in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen*

Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Applicant contends, without offering any evidence to support this contention, that even given the identical nature of the goods here, confusion is unlikely as the purchasers of nutritional supplements and the like are quite sophisticated. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Finally, applicant requests that the Trademark Trial and Appeal Board overrule the trademark examining attorney's refusal as there is no evidence of record of actual confusion in the marketplace.

Notwithstanding this, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be

heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

CONCLUSION

For the foregoing reasons, then, the refusal of registration under Section 2(d) should be affirmed.

Respectfully submitted,

/dsalemi/

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