

ESTTA Tracking number: **ESTTA771262**

Filing date: **09/17/2016**

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

Proceeding	86841672
Applicant	Nature Redefined, LLC
Applied for Mark	THE FIXMD TRIAD
Correspondence Address	MARK BORGHESE BORGHESE LEGAL, LTD. 10161 PARK RUN DRIVE, SUITE 150 LAS VEGAS, NV 89145 UNITED STATES mark@borgheselegal.com, docket@borgheselegal.com
Submission	Appeal Brief
Attachments	The_FIXMD_Triad_Appeal_Brief.pdf(665930 bytes)
Filer's Name	Mark Borghese
Filer's e-mail	mark@borgheselegal.com, docket@borgheselegal.com
Signature	/MB/
Date	09/17/2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IN RE: Nature Redefined, LLC

Serial No.: 86/841672

Filing Date: December 7, 2015

Mark: The FIXMD Triad

BRIEF OF APPELLANT (Applicant)

Mark Borghese, Esq.
mark@borgheselegal.com
BORGHESE LEGAL, LTD.
10161 Park Run Drive, Suite 150
Las Vegas, Nevada 89145
Tel. (702) 382-0200
Fax (702) 382-0212
Attorney for Appellant (Applicant)

INDEX OF CASES

<i>Case Name</i>	<i>Pages</i>
<u>Champagne Louis Roederer, S.A. v. Delicato Vineyards</u> , 148 F.3d 1373 (Fed. Cir. 1998).....	2
<u>Colgate-Palmolive Company v. Carter Wallace Inc.</u> , 167 USPQ 529 (C.C.P.A. 1970).....	3
<u>Cumberland Packing Corp. v. McMahan Products. Inc.</u> , 189 USPQ 428, 430 (TTAB 1975).....	4
<u>H. D. Lee Co. v. Maidenform, Inc.</u> , 87 USPQ2d 1715 (TTAB 2008).....	4
<u>Hewlett-Packard Co. v. Packard Press, Inc.</u> , 281 F.3d 1261 (Fed. Cir. 2002).....	2
<u>In re E.I. DuPont de Nemours & Co.</u> 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).....	2
<u>In re Lar Mor Int', Inc.</u> , 221 USPQ 180 (TTAB 1983).....	4
<u>Kellogg Co. v. Pack'Em Enters., Inc.</u> , 14 USPQ2d 1545 (TTAB 1990) aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).....	2
<u>Franklin Mint Corp. v. Master Mfg. Co.</u> , 667 F.2d 1005 212 USPQ 233 (C.C.P.A. 1981).....	3
<u>Lever Brothers Company v. The Barcolene Company</u> , (174 USPQ 392 (C.C.P.A. 1972).....	3
<u>Opryland USA, Inc. v. Great Am. Music Show</u> , 970 F.2d 847 (Fed. Cir. 1992).....	3
<u>Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondee En 1772</u> , 396 F.3d 1369 (Fed. Cir. 2005).....	5
<u>Presto Products Inc. v. Nice-Pak Products, Inc.</u> , 9 USPQ2d 1895, 1897 (TTAB 1988).....	3
<u>Safeway Stores. Inc. v. Dunkirk Ice Cream Co.</u> , 455 F.2d 576, 173 USPQ 10 (C.C.P.A. 1972).....	4
<u>StonCor Grp., Inc. v. Specialty Coatings, Inc.</u> , 759 F.3d 1327, 111 USPQ2d 1649 (Fed. Cir. 2014).....	6

Taco Time International Inc. v. Taco Town. Inc., 217 USPQ 268 (TTAB 1982),
aff'd in unpublished opinion, Appeal Nos. 83-617, 83-618 (Fed. Cir. May 26, 1983).....4

Tricia Guild Assocs. Ltd. v. Crystal Clear Indus. Inc.,
38 USPQ2d 1313, 1316 (TTAB 1994)5

STATUTES

15 U.S.C. § 1052(d)1

APPLICANT'S APPEAL BRIEF

Applicant, Nature Redefined, LLC (“Applicant”), submits the following brief in support of its appeal of the Examining Attorney’s refusal to register the applied-for mark on the ground that the mark THE FIXMD TRIAD is likely to be confused with the mark TRIAD PADS.

I. ISSUE

Is the Applicant’s mark, THE FIXMD TRIAD, when compared in sight, sound, meaning and overall commercial impression, likely to be confused with the mark TRIAD PADS?

II. PROCEDURAL MATTERS

On December 7, 2015, Applicant filed an intent-to-use trademark application for the mark THE FIXMD TRIAD in Class 3 for, “Beauty serums; Eye cream; Skin cleansers; Skin creams; Skin emollients; Skin masks; Skin moisturizer; Skin toners; Sun block; Sun screen; Non-medicated anti-aging serum” (“Applicant’s Mark”).

On March 12, 2016, the Examining Attorney issued an Office Action refusing registration of Applicant’s mark on the ground that the mark was likely to be confused with Registration No. 3,757,649 for the mark TRIAD PADS in Class 3 for, “Cosmetic pads; Cosmetics; Face creams for cosmetic use; Facial cleansers; Skin toners; Toners” (“Cited Mark”).

On June 30, 2016, Applicant timely filed a response to the Office Action, arguing that the two marks are different and distinct and not likely to be confused with each other.

On July 22, 2016, the Examining Attorney issued a Final Office Action maintaining the refusal under Section 2(d), 15 U.S.C. § 1052(d) and again arguing that the mark THE FIXMD TRIAD is likely to be confused with the mark TRIAD PADS.

On September 17, 2016, this Appeal was timely filed.

III. FACTS IN EVIDENCE

Dictionary definition of “TRIAD” meaning a group of three (See Exhibit 1).

IV. ARGUMENT

The similarity of the marks at issue is a “predominant inquiry” in the likelihood of confusion analysis. Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002). In fact, this first factor alone may be determinative in cases where two marks are sufficiently dissimilar to preclude finding a likelihood of confusion. See Kellogg Co. v. Pack’Em Enters., Inc., 14 USPQ2d 1545, 1550 (TTAB 1990), *aff’d*, 951 F.2d 330,333, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (finding the differences in the marks FROOTEE ICE and FRUIT LOOPS sufficient such that no likelihood of confusion would arise even if other factors favored confusion); Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (a single factor “may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”).

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in one respect – sight, sound, or meaning – does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

When all elements of Applicant’s Mark are afforded proper weight, the entirety of Applicant’s Mark differs significantly from the Cited Mark in appearance, sound, meaning and overall commercial impression.

A. The Marks must be Considered in their Entireties

The Examining Attorney focused his attention on only a portion of Applicant's Mark, namely the single word "TRIAD," in evaluating whether the Cited Mark and the Applicant's Mark are confusingly similar. (See Final Refusal at p. 3). This was in error.

It is well-settled that marks must be viewed in their entirety and not dissected in considering whether there is a likelihood of confusion. See, e.g., Opryland USA, Inc. v. Great Am. Music Show, 970 F.2d 847, 851, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) (excluding the word "opry" and failing to consider the marks as a whole was error); Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007, 212 USPQ 233,234 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

The mere sharing of common elements between two marks does not *per se* give rise to a likelihood of confusion. This is true even where the common element consists of the entirety of one of the marks -- which is not the case here. See Colgate-Palmolive Company v. Carter Wallace Inc., 167 USPQ 529, 530 (C.C.P.A. 1970) (PEAK PERIOD for personal deodorants not confusingly similar to PEAK for dentifrice); and Lever Brothers Company v. The Barcolene Company, 174 USPQ 392 (C.C.P.A. 1972) (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods).

Here, Applicant's mark starts with the dominant and arbitrary term THE FIXMD followed by the one shared word, "triad." The prominent wording THE FIXMD is an extremely significant distinguishing feature between Appellant's Mark and the Cited Mark.

The TTAB and the courts have long recognized that the term in a multi-word mark is the most significant and dominant element in creating the overall commercial impression. See, e.g., Presto Products Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is

often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Thus, there are many cases finding no likelihood of confusion where, as here, the initial, dominant term of one mark distinguishes it from the allegedly similar mark. See In re Lar Mor Int’, Inc., 221 USPQ 180 (TTAB 1983) (no confusion found between TRES JOLIE and BIEN JOLIE, both for women’s clothing); Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998) (no confusion found between HARD ROCK CAFE and COUNTRY ROCK CAFE, for identical services).

Moreover, even where the initial word is the same -- and here it is not -- it is well established that a difference of even one word can be sufficient to obviate any likelihood of confusion. See H. D. Lee Co. v. Maidenform, Inc., 87 USPQ2d 1715 (TTAB 2008). (ONE FAB FIT held not likely to cause confusion with ONE TRUE FIT for similar goods); Safeway Stores, Inc. v. Dunkirk Ice Cream Co., 455 F.2d 576, 577, 173 USPQ 10 (C.C.P.A. 1972); (no likelihood of confusion between PARTY PRIDE and PARTY PARADE for ice cream products); Taco Time International Inc. v. Taco Town, Inc., 217 USPQ 268 (TTAB 1982), aff’d in unpublished opinion, Appeal Nos. 83-617, 83-618 (Fed. Cir. May 26, 1983); Cumberland Packing Corp. v. McMahan Products, Inc., 189 USPQ 428, 430 (TTAB 1975) (SWEET ‘N LEGAL for dietary frozen desserts and SWEET ‘N LOW for low calorie sugar substitute).

Here the Cited Mark lacks the term THE FIXMD and adds the term PADS after the common term “triad.” Although the term “pads” may be descriptive of Cited Mark’s goods, this term is an integral part of the two-word Cited Mark and is completely absent from Applicant’s Mark. When the Applicant’s Mark and the Cited Mark are compared in their entities, the marks are distinct and unlikely to be confused.

B. Applicant's Mark and the Cited Mark Create Significantly Different Commercial Impressions

The meanings and overall commercial impressions of the THE FIXMD TRIAD and the Cited Mark, are distinct as well. In particular, the phrase "THE FIXMD" adds meaning and alters the connotation of Applicant's Mark in a way that was not given appropriate credit by the Examining Attorney.

The common word "triad" generally means "a group of three" (See Exhibit 1). In Applicant's Mark, the word "triad" modifies THE FIXMD-- i.e. THE FIXMD (group of three). In the Cited Mark, "triad" modifies the word PADS which does not exist in Applicant's mark-- i.e. (a group of three) PADS. These entirely different connotations are sufficient, in themselves, to support a finding that there is no likelihood of confusion between the marks. See, e.g., Tricia Guild Assocs. Ltd. v. Crystal Clear Indus. Inc., 38 USPQ2d 1313, 1316 (TTAB 1994) ("[W]hile the marks DESIGNERS GUILD and THE DESIGN GUILD share similarities which are too obvious to discuss, nevertheless, the differences, however slight, are sufficient to 'convey different connotations and commercial impressions.'").

When considered in conjunction with the fact that unique dominant term THE FIXMD appears at the beginning of Applicant's Mark, the mark THE FIXMD TRIAD creates a commercial impression quite different from the Cited Mark. See Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (noting that VEUVE, as the first word in both marks, constituted not only a prominent feature, but a dominant feature in the commercial impression created by the marks).

///

///

C. Applicant’s mark and the Cited Mark Differ Significantly in Sound and Appearance

The Cited Mark, “TRAID PADS,” looks strikingly different from Applicant’s Mark, “THE FIXMD TRIAD.” In particular, the first part of Applicant’s Mark, “THE FIXMD,” gives Applicant’s mark a distinct look.

The marks also sound entirely different from the very beginning of the marks. In fact, the first four syllables of the Applicant’s Mark “THE FIXMD” are completely absent from the Cited Mark. In all, only two (2) of the seven (7) syllables appearing in both marks are common.

The uncommon syllables, as well as the differing placement of the two common syllables, makes confusion unlikely. See, e.g., StonCor Grp., Inc. v. Specialty Coatings, Inc., 759 F.3d 1327, 1332, 111 USPQ2d 1649 (Fed. Cir. 2014) (finding that the “differing placements of the [term STON or STONE] within the marks” and the “differing number of syllables in the two complete marks provide substantial evidence in support of the Board’s conclusion” that there was no likelihood of confusion).

V. CONCLUSION

The key and controlling DuPont factors here are the dissimilarity of the marks in sight, sound, meaning and overall commercial impression. The weight of these factors in relation to Applicant’s THE FIXMD TRIAD mark weighs heavily towards a finding of no likelihood of confusion. Based on the above reasons and authorities, Appellant respectfully requests that the

///

///

///

///

///

Board reverse the refusal to register and approve Applicant's Mark for publication.

Respectfully submitted,

Dated: September 17, 2016

By: 

Mark Borghese, Esq.
mark@borgheselegal.com
Borghese Legal, Ltd.
10161 Park Run Drive, Suite 150
Las Vegas, Nevada 89145
Tel: (702) 382-0200
Fax: (702) 382-0212
Attorney for Appellant (Applicant)

EXHIBIT 1

EXHIBIT 1

The
AMERICAN
HERITAGE®dictionary
of the
English
Language

Search

HOW TO USE THE
DICTIONARY

Learn what the dictionary tells you about words.

GET STARTED NOW! ▶

Some compound words (like *bus rapid transit*, *dog whistle*, or *identity theft*) don't appear on the drop-down list when you enter them into the search window. If a compound term doesn't appear in the drop-down list, try entering the term into the search window and then hit the search button (instead of the "enter" key). Alternatively, begin searches for compound terms with a quotation mark.



THE USAGE PANEL

tri·ad (tri'ād', -əd)

Share: [Tweet](#)

n.

1. A group of three.
2. *Music* A chord of three tones, especially one built on a given root tone plus a major or minor third and a perfect fifth.
3. A section of a Pindaric ode consisting of the strophe, antistrophe, and epode.

[Late Latin *trias*, *triad-*, from Greek, the number three; see **trei-** in the Appendix of Indo-European roots.]

tri·ad'ic (tri-ād'ik) *adj.*

(click for a larger image)

triad

left to right: C major, E minor, and D diminished triads

The American Heritage® Dictionary of the English Language, Fifth Edition copyright ©2015 by Houghton Mifflin Harcourt Publishing Company. All rights reserved.

The American Heritage Dictionary Blog

Check out our blog, updated regularly, for new words and revised definitions, interesting images from the 5th edition, discussions of usage, and more.

PURCHASE THE
DICTIONARY

The online searchable American Heritage Dictionary includes definitions, pronunciations, etymologies, and feature notes. You can purchase the dictionary as an iOS or an Android app—or buy the deluxe printed edition.

INDO-EUROPEAN &
SEMITIC ROOTS
APPENDICES

Thousands of entries in the dictionary include etymologies that trace their roots back to reconstructed proto-languages. You can obtain more information about these forms in our online appendices:

[INDO-EUROPEAN ROOTS](#) ▶