UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/130604

APPLICANT: Naturally Scientific, Inc.

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MARK: ENERGY MENDER

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

RE: Serial Number 76/130604

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	**Naturally Scientific, Inc.**	:	BEFORE THE
Trademark:	**ENERGY MENDER**	:	TRADEMARK TRIAL
Serial No:	76130604	:	AND
Attorney:	Evelyn M. Sommer	:	APPEAL BOARD
Address:	825 Third Ave. 30th Floor New York, New York 10022	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark **ENERGY MENDER** for "nutritional and dietary supplements" on the grounds that the

mark, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is likely to be confused with U.S. Registration No. 2,494,588.

I. FACTS

Applicant, Naturally Scientific, Inc., applied for registration on the Principal Register of the trademark **ENERGY MENDER** in typed form, for "nutritional and dietary supplements." The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act based on the similar mark **MOOD MENDER** for "health and performance foods, namely, ready-to-eat food bars, chewing gum and tea-based beverages." While agreeing to a disclaimer of "**ENERGY,**" the Trademark Examining Attorney issued a final refusal regarding the likelihood of confusion. On January 29, 2003, the Trademark Examining Attorney subsequently denied the applicant's Motion for Reconsideration. This appeal now follows the final refusal and denial of the applicant's Motion for Reconsideration under Sections 2(d) of the Trademark Act.

II. ARGUMENT

THE MARKS OF THE APPLICANT AND REGISTRANT ARE SIMILAR AND THE GOODS ARE RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks and the similarity of the goods. The other factors cannot be considered because no relevant evidence concerning those factors is contained in the record. *See In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

A. THE MARKS ARE CONFUSINGLY SIMILAR

In the analysis, the respective marks must be compared for similarities in sound, appearance, meaning or connotation. *Supra*. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

Also, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus in the analysis is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979).

With that in mind, applicant seeks registration of the mark **ENERGY MENDER** in typed form. The mark in the cited registration, also in typed form, is **MOOD MENDER**. The two marks are therefore confusingly similar for the following reasons.

First, the respective marks share the term "**MENDER**" and are therefore similar in appearance and connotation. Secondly, as "**ENERGY**" is disclaimed from the applicant's mark, "**MENDER**" is the dominant and primary source-indicating portion of the applicant's mark.

Next, as the search statements from the Office's XSearch 1.1 database reveal, "**MENDER**" is "*strong*" in the field of dietary supplements and food bars or teas (attached to the Final Office Action). In fact, the only registered mark identifying goods that are similar or even remotely related to the goods listed in the application is **MOOD MENDER**, the cited registration. Moreover, given that a person's "mood" and "energy" level are related or connected in some

fashion, the marks also project similar commercial impressions. Essentially, the respective marks convey to consumers that the respective products are used to "mend" or "fix" one's self or well being.

Additionally, both marks are in typed form and lack design elements that could potentially aid in distinguishing the marks. Since the "points of similarity are of greater importance than the points of difference," a sufficient resemblance exists between the marks to deny registration. *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied,* 351 U.S. 973, 109 USPQ 517 (1956).

B. THE GOODS ARE RELATED

Initially, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Here, the application as well as the cited registration identify related goods. In fact, the goods of the applicant (dietary supplements) and those of the registrant (food bars and tea based beverages) are often used, sold or purchased together by the same class of consumer in the same channels of trade.

More importantly, the definitive issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *See In re Rexel Inc.*, 223 USPQ 830, 831; TMEP §§1207.01 *et seq.* As such, enclosed with the Final Office Action denying registration were copies of nine (9) current registrations showing entities offering and using the same mark on or in connection with both "supplements" and "ready-to-eat food bars" or "teas."

The following are examples from these registrations: **FATIQUEAID** (U.S. Reg. No. 2,424,988) for "ready to eat, cereal-derived natural food bars" and "nutritional supplements;" **MULTIPOWER** (U.S. Reg. No. 2,499,541) for "dietary food supplements, dietary supplements in powder drink form" and "ready to eat food bars;" **ENERGY, ENDUANCE, RECOVERY** (U.S. Reg. No. 2,464,487) for "nutritional supplements" and ready to eat, grain derived energy food bars;" **ULTIMATE PERFORMANCE** (U.S. Reg. No. 2,443,362) for "dietary and nutritional supplements, dietary supplements" and "ready to eat food bars;" **PLAY HEALTHY** (U.S. Reg. No. 2,390,276) for "dietary and nutritional supplements" and "energy and endurance preparations, namely, food bars;" **SPORTS NUTRITION** (U.S. Reg. No. 2,379,927) for "dietary and nutritional supplements" and "energy and endurance preparations, namely, food bars; **TRI-ECHS** (U.S. Reg. No. 2,563,626) for "dietary supplements, namely, herbal teas" and "herbal teas;" **BLUE-MAX** (U.S. Reg. No. 2,470,150) for "nutritional supplements" and "teas made from blue-colored fruits;" and **THROAT CARE** (U.S. Reg. No. 2,308,056) for "dietary and nutrition supplements" and "herb teas for beverage use." Such third-party registrations have probative value to the extent that they serve to suggest that certain goods or services are of a type, which can emanate from a single source. *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Continuing, it is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Since the identification of the applicant's goods is very broad, it is presumed that they move in all normal channels of trade and that they are available for all potential customers. TMEP §1207.01(a)(iii).

Likewise, 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Therefore, a purchaser familiar with the registrant's "health and performance foods" who encounters the applicant's "nutritional and dietary supplements," with the mark **ENERGY MENDER** affixed to them, is likely to believe that the goods emanate from the same source. Moreover, the applicant could be perceived as the source of the registrant's goods; the registrant could be perceived as the source of the applicant's supplements.

What's more, if the goods of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). TMEP §1207.01(b). Finally, the examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i). Therefore, this examining attorney finds that the similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion.

III. CONCLUSION

The marks are similar and the goods are related. Consumers encountering applicant's mark and the cited mark in the marketplace are therefore likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should therefore be affirmed.

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