IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TTAB

Applicant: Naturally Scientific, Inc.

Serial No.: 76/509,051

Filed: April 23, 2003

Mark: FAT BEATER

Law Office: 114

Trademark Attorney: Brendan D. McCauley

To: Commissioner for Trademarks
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22202-3514 July 24, 2004

BRIEF FOR APPELLANT

Introduction

Applicant hereby appeals from the Examiner's refusal to register the above-identified mark dated February 9, 2004, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner's decision. An oral hearing is not requested.

Applicant's Trademark

Applicant seeks registration on the Principal Register of its mark.

FAT BEATER

for nutritional and dietary supplements, the word "FAT" being disclaimed apart from the mark as shown.

Prior Registration Cited By The Examiner

Registration No. 1509852 "STARCH BEATER" DIET for vitamins and food supplements.

The Rejection

The Examiner has refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) on the ground that Applicant's mark when used on or in connection with the identified goods, nutritional and dietary supplements, so resembles the mark in Registration No.1509852 as to be likely to cause confusion, to cause mistake or to deceive. The cited mark is "STARCH BEATER" DIET and is used for "vitamins and food supplements."

The Examiner's position is that "the marks are similar in sound, appearance and meaning or connotation because of the common use of the term BEATER. The marks use descriptive terms in connection with the term BEATER which creates a similar sound and appearance based upon the common usage of the term" The Examiner further notes that "the meaning or connotation is similar because the commercial impression that is conveyed is that of a BEATER, either a beater of fat or beater of starch".

The finding of likelihood of confusion by the instant Examiner is based on his conclusion that both marks share the term "BEATER" and in view, that in his opinion, the goods are related and/or the conditions surrounding their marketing are 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.

Applicant respectfully disagrees with the Examiner for the following reasons.

Argument

The Applicant's mark must be considered in its entirety.

creates the commercial impression upon potential customers. They neither know nor care whether or not a part of a mark is disclaimed. Disclaimers have no effect on purchasers. They do not know about "disclaimers", "dominant portions" or "distinguishing features." They are impressed by the mark as they see it or hear it, and they do not ordinarily stop to analyze it. *Ex Parte Maya De Mexico*, 103 U.S.P.Q. (BNA) 158, *1954* WL *5556* (Comm'r Pat. & Trademarks 1954); *Supply Mfg. Co. V. King Trimmings, Inc.*, 220 F. Supp. 947, 139 US.P.Q. (BNA)163 (S.D. N.Y. 1963).

The cited mark is "STARCH BEATER" DIET.

The Applicant's mark is FAT BEATER. The term FAT which is present in Applicant's mark has considerable significance and cannot be overlooked in any comparison of the marks in issue.

Thus the proper test is whether Applicant's entire mark is likely to cause confusion as to source with the entire marks of the prior cited registrations, not whether confusion is likely between features of marks. *Ex Parte Harzfe/d's, Inc.*, 100 U.S.P.Q. (BNA) 31, 1953 WL 5171 (Comm'r Pat. & Trademarks 1953); *The Juvenile Shoe Corporation ofAmerica V. Vocational Footwear, Inc.* 99 U.S.P.Q. (BNA) 174, 1953 WL 5125 (Comm'r Pat. & Trademarks 1953).

When properly viewed, it is obvious that the only similarity between the marks resides in the word "BEATER." In the nutritional and dietary supplement field, that word normally suggests to reduce, defeat and overcome...

Accordingly, the word "BEATER" has little significance in and of itself as an indicia of origin in the nutritional and dietary supplement field. It would be expected that the word "BEATER" would be widely adopted in the trade to suggest reduction of unwanted nutrients, etc. and this cannot be ignored in determining the likelihood of confusion. The fact that it hasn't been widely adopted does not detract from Applicant's arguments.

In making an evaluation of likelihood of confusion under the "antidissection" rule, (supra) marks are to be considered in their entireties, not split up into component parts and only parts compared. The commercial impression of a mark is derived from it as a whole, not from its elements separated and considered and considered in detail. *Estate of P.D. Beckwith, Inc. V. Commissioner of Patents,* 252 U.S. 538 (1920). However it is not a violation of the antidissection rule to separately view the component parts of a composite as a preliminary step on the way to an ultimate determination of possible customer reaction to the composite mark as a whole. *McCarthy's Desk Encyclopedia of Intellectual Property, J.* Thomas McCarthy; (entry "composite mark.") In other words, it is appropriate in determining the confusion issue to separately view the component parts of a composite and to further give greater weight to the dominant part of the mark for it is that which make the greatest impression on the ordinary customer.

FAT and STARCH are so different in sound, meaning and appearance that it is not likely that the customer would be confused as to the source of the marks containing these different components i.e., FAT BEATER, "STARCH BEATER" DIET.

The marks differ in sight, sound and meaning. When similar marks are used in connection with the same or related goods, confusion does not automatically result. In this case, the marks cannot be considered similar because they differ in sight, sound and meaning. Consumers encountering the two marks in the marketplace will not associate the products offered under each as deriving from the same source.

The term "FAT" is defined in The Random House Collegiate Dictionary, Revised Edition, Random House, Inc., as "1: any of several white or yellowish greasy substances composed of carbon, hydrogen, and oxygen, that form the chief part of adipose tissue of animals and also occur in plants: used in the manufacture of soap and paints and in cooking. 2: animal

tissue containing much of this substance. 3: the richest or best part of anything. 4. the condition of being obese; corpulence. 5: superfluity; an overabundance or excess." STARCH is defined by the same dictionary as "1: a white tasteless, solid carbohydrate $(C_6H_{10}O_5)$~, occurring in the form of minute granules in the seeds, tubers, and other parts of plants, and forming an important constituent of rice, corn, wheat, beans, potatoes, and many other vegetable foods. 2. a commercial preparation of this substance used to stiffen textile fabrics in laundering. 3. starches, foods rich in natural starch. 4. *informal.* vigor; energy; boldness." Dictionary definitions are relevant evidence of the ordinary significance of words. *Hancock V. American Steel and Wire Co.*, 203 F.2d 737 (C.C.P.A. *1953).*

Further the registered mark containers the word "DIET" which is absent in applicant's mark. DIET is defined by the same dictionary as "1. food considered in terms) of its qualities, composition, and effects on health. 2. a particular selection of food, esp. as prescribed to cure a disease, gain or lose weight, etc. 3. the usual or regular foods a person eats most frequently. 4. food habitually provided. 5. anything that is habitually provided or partaken of."

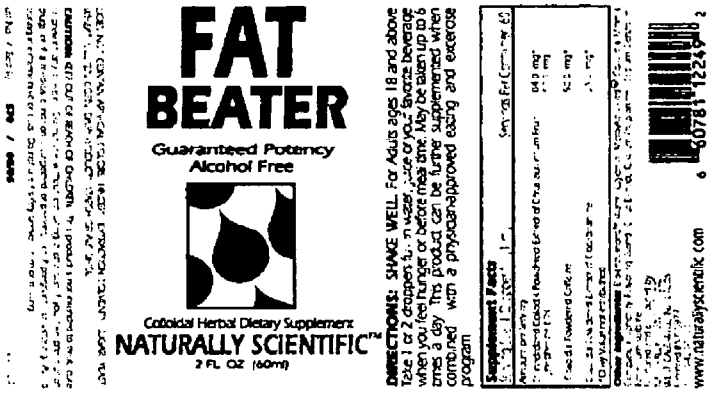
As of July 17,2004, the applicant is unable to find any reference to the "STARCH BEATER" DIET mark or product on the registrant's website (http://www.naturesbounty.com) or GOOGLE even though this mark is listed by USPTO as a live mark, first used in 1987 and registered with USPTO in 1988. Therefore, the applicant has no information on the exact nature of the product in connection with which "STARCH BEATER" DIET mark is used. However, the word DIET in the registered mark offers a general impression that it refers to food and drink products as replacement for regular foods and drinks, while applicant's mark does not induce such an impression.

The goods as cited by applicant and registrant in fact are very different as can be appreciated from

the attached label. FAT BEATER is administered as one or two droppers full in water, juice or

beverages, and is not likely to be confused with food or drink products.

A copy of Applicant's label is attached below.



The average purchaser of Applicant's and other like products might be considered reasonably informed. Typically, he has been informed of the existence and nature of the product before he chooses to purchase or consume. He reads the labels, he makes his purchases from stores that display such goods by their manufacturer, i.e. all of the dietary and nutritional aids of one "brand" are conventionally kept together on one or more shelves. Food or drinks are not part of the Applicant's product line. The products of the Registrant would be displayed in a separate aisle or on different shelves.

This in itself serves to minimize, if not eliminate source confusion.

Further, the purchasers of nutritional and dietary aids or supplements are a particular type of purchaser. They read the labels, they are in fact well informed, and they can be assumed to know about the products prior to encountering them on the shelf. They are less likely to be confused than the ordinary purchaser.

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Still further, there has been tremendous publicity devoted to diets and the highly organized programs championed by those who favor low fat diets as opposed to low starch diets. Those dieters, the diet gurus, the media, the advertisers, the marketers are not confused as to whether they are anti fat or anti carbohydrate. They know down to the smallest detail, including as to supplements, whether they are to be purchased or consumed by which group. In this regard, the significance of the term DIET in "STARCH BEATER" DIET takes on even more significance as a distinguishing feature.

Conclusion

For the reason set forth hereinabove, Applicant submits that there is no likelihood of confusion, mistake or deception between Applicant's mark and the prior cited registration. Accordingly, Applicant's

mark is entitled to registration.

The board is therefor respectfully requested to reverse the Examiner's decision refusing registration of Applicant's mark.

Respectfully submitted,

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