

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77182435
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Office Action, the Examining Attorney refused registration of Applicant's mark "DESIGNER WEIGHT CONTROL" for nutritional supplement preparations in international classes 29 and 32. The basis of the Examining Attorney's refusal is (1) Applicant's mark is likely to confuse the public in that it consists entirely of the previously registered mark "DESIGNER" and adds only "highly descriptive matter, i.e. "WEIGHT CONTROL," (2) Applicant's mark seeks registration for goods that are identical to the goods identified under the "DESIGNER" mark, and (3) Applicant's allegation of a family of marks is insufficient to establish the existence of such a family of marks. Any other information not addressed is deemed satisfied or withdrawn. Thus, registration in classes 05 and 30 is appropriate.</p> <p>Reconsideration is requested in view of the following amendments and comments:</p> <p><u>LIKELIHOOD OF CONFUSION</u></p> <p>A composite trademark is not judged by an examination of its parts, but rather its validity and distinctiveness is determined by viewing the trademark as a whole, as it appears in the marketplace. See, <u>Office Airline Guides, Inc. v. Gross</u>, 6 F.3d 1385, 1392 [28 USPQ2d 1641] (9th Cir. 1993). The mark must also be considered with reference to the manner in which it is used and would be encountered by purchasers in the marketplace. In <u>re Hampshire-Designers, Inc.</u>, 199 USPQ 383 (1978) [Court considered term "DESIGNER" as it relates to clothing and apparel.]</p> <p>Further, although it is proper to indicate that more weight is given to a particular component of the mark, it does not excuse consideration of the other components of the</p>	

mark as a whole. See, Packard Press, Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1357-1358 [56 U.S.P.Q.2d 1351] (Fed. Cir. 2000); Sleepmaster Products Co. v. American Auto-Felt Corp., 241 F.2d 738, 741 [113 USPQ 63, 66] (1957); In re National Data Corp., 753 F.2d 1056, 1058 [224 USPQ at 751] (explaining the effect of disclaimer and descriptive words in likelihood of confusion analysis). Indeed, there are numerous cases in which marks were held not to be conflicting because the similarity between them rested solely in a descriptive or generic term which formed part of each mark. Seven-Up Co. v. Tropicana Products, 356 F.2d 567, 568 [148 USPQ 604, 606] (CCPA 1966); Sears, Roebuck & Co. v. Hofman, 258 F.2d 953, 954 [119 USPO 137, 138] (CCPA 1958); Lauritzen & Co. v. Borden Co., 239 F.2d 405, 407 [112 USPQ 60, 61-62] (CCPA 1956); Goldring, Inc. v. Town-Moor, Inc., 228 F.2d 254, 255 [108 USPQ 234, 235] (CCPA 1955); In re Blue Lake Producers Coop., 194 F.2d 126, 128 [92 USPQ 334, 336] (CCPA 1952); Nestle's Milk Products v. Baker Importing Co., 182 F.2d 193, 196 [86 USPQ 80, 82-83] (CCPA 1950); Franco-Italian Packing Corp. v. Van Camp Sea Food Co., 142 F.2d 274, 276 [61 USPQ 369, 370-71] (CCPA 1944).

The case cited by the Examining Attorney, In re Mobay Chemical Co., 166 USPQ 218 (1970), also supports the proposition that consideration of the marks in their entirety is necessary before a determination of likelihood of confusion can be made. In that case, which is very similar on its facts to this case, Mobay Chemical Company applied to register the mark "CUSHION-CLOUD" for bedding, mattresses and box springs. There were already registrations for bedding, mattresses and box springs for the root word, "CLOUD", as well as several iterations – "WHITE CLOUD", "SILVER CLOUD", "NEW WHITE CLOUD", "BLUE CLOUD", "FLEECY CLOUD", "GRAY CLOUD", "BABY CLOUD", "DREAM CLOUD", and "CLOUD-O-PEDIC". In reversing the refusal to register Mobay Chemical's mark, the Court stated:

Considering the marks in their entirety, as we must, and the nature of the term "cloud" as applied to the involved goods, we conclude that "CUSHION CLOUD" is different in appearance and sound from the single word mark "CLOUD" and from each of the other nine marks which include the term "CLOUD" to the extent that confusion or mistake or deception is unlikely to occur.

In re Mobay Chemical Company, 166 USPQ at 219.

In this case, as in Mobay Chemical, considering the entirety of Applicant's mark "DESIGNER WEIGHT CONTROL" and the nature of the term "DESIGNER" as applied to milk-based beverages containing protein, it is clear that there can be no likelihood of confusion between the registered mark and Applicant's composite mark. This is especially true since there are fourteen registrations and applications containing the word "DESIGNER" in International Classes 029, 030, and 032.

Moreover, it is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue. See, Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 673 (Fed.Cir.1984) ["Of paramount interest is not the descriptive nature of SPICE, but the overall commercial impression derived by viewing the marks in their entirety.... Arguments to the effect that one portion of a mark possesses no trademark significance leading to a direct comparison between only what remains is an erroneous approach."] Thus, even assuming the "WEIGHT CONTROL" component of the mark is highly descriptive, which we do not admit, the fact that this component of the total mark exists makes the entirety of the mark different in appearance, sound, connotation and commercial impression. Therefore, "DESIGNER WEIGHT CONTROL" is not confusingly similar to the single word mark "DESIGNER" and from the 14 other marks which include the "DESIGNER."

THE GOODS, THE COMPANIES, THE CUSTOMERS AND THE MARKETING CHANNELS ARE ALL DIFFERENT FOR THE REGISTERED MARK AND APPLICANT'S MARK

A. The Goods

The registered mark "DESIGNER" is used with various milks, creams, yogurts, butters, and cheeses that Registrant markets to milk processing plants and cheese plants in New Mexico and Texas. Applicant's mark "DESIGNER WEIGHT CONTROL" is used with goods such as protein-based beverages, powders and syrups. These types of goods are end products for retail sale – not raw materials for milk and cheese processing plants. Thus, there can be no consumer confusion between the goods described by the two marks.

B. The Companies

There are wide ranging differences between the companies who own the marks, the customer base for the goods sold under the marks, and the marketing channels of the goods described by each mark.

Specifically, the owner of the registered mark "DESIGNER", Select Milk Producers, Inc. is a group or cooperative of dairy producers in New Mexico and Texas. This group of dairy farms neither markets nor sells its products directly to the retail consumer. Attached as Exhibit 1 is a printout of the webpage for Select Milk Producers, Inc. showing that they are a membership group of regional dairy farms located in New Mexico and Texas. Unlike Next Protein, Inc., Select Milk Producers, Inc. does not sell whey protein supplements or high

protein drink products for the health conscious. Indeed, Select Milk Producers, Inc. does not sell to retail outlets, does not market to the everyday consumer, and is not in the high-end protein health food business.

On the other hand, Applicant, Next Proteins, Inc. is an industry leader in developing, manufacturing and distributing whey protein supplements and high protein drinks. The company offers protein supplements for men, women, athletes, and the health conscious. Next Proteins, Inc. is not a group of dairy farms and does not sell dairy products. It is clearly not a dairy farm.

Thus, there can be no consumer confusion as to the source of the goods described by Registrant's or Applicant's marks.

C. The Customers

As noted in their webpage, Select Milk Producers, Inc.'s customer base is primarily Class I dairy plants in New Mexico and Texas with the balance of their food products going to local cheese plants or their own facilities. These consumers – milk processing plants and cheese plants – are sophisticated buyers specializing in the production of milk and cheese products. They are not easily confused about the source of goods associated with Registrant's mark.

Next Protein, Inc.'s customers are the general public and common retail consumers seeking health food products containing whey protein. They are not Class 1 dairy processing plants.

Since the customers of Applicant and Registrant are completely different, there is no likelihood of confusion between the two marks.

D. Marketing Channels

Next Protein Inc.'s goods are also marketed through different channels than Registrant's goods. Next Proteins, Inc. markets its products through national grocery stores such as Albertson's and Whole Foods, retail fitness outlets such as General Nutrition Centers (GNC) and Vitamin Discount Centers, and online retailers such as Amazon.com, WellnessGrocer.com, and bodybuilding.com.

Registrant, Select Milk Producers, Inc., does not market through these same channels. Indeed, accordingly to Registrant's website, it does not even sell its products in the retail industry as does Next Protein. Instead, Registrant markets and sells its products to Class 1 milk processing plants and cheese makers.

In sum, there are not only differences between the marks themselves, there are differences in the goods associated with the marks, the companies who own the marks, the customer base for the goods sold under the marks, and the marketing channels of the goods described by each mark.

THERE IS NO LIKELIHOOD OF CONFUSION RELATED TO APPLICANT'S FAMILY OF MARKS

Lastly, the Examining Attorney suggested that even if Next Proteins, Inc. owned a family of marks, purchasers would wrongly believe that the registrant's DESIGNER mark was a member of that family. We respectfully submit, however, that this is not true. As noted above, Registrant is a coalition of dairy producers in New Mexico and Texas that provides dairy products to Class 1 processing plants – a totally different industry and segment of population as Next Protein, Inc. Moreover, the "DESIGNER" marks used by Next Proteins, Inc. all have a whey protein element to them. Specifically, the technology and core of the "DESIGNER" marks used by Next Proteins, Inc. are related to the health and lifestyle benefits of whey protein – a completely different focus than Registrant's.

In view of the argument set forth above, Applicant respectfully requests the Examining Attorney withdraw the refusal to register the subject mark and pass this application to publication.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/08/20/20080820204142094347-77182435-001_001/evi_121757366-200324193_._Exhibit_1.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT3\IMAGEOUT3\771\824\77182435\xml2\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	a web page of Select Milk Producers, Inc. labelled as Exhibit 1

CORRESPONDENCE SECTION

NAME	Bernard L. Kleinke
FIRM NAME	Duckor Spradling Metzger & Wynne
STREET	3043 4th Avenue
CITY	San Diego
STATE	California
ZIP/POSTAL CODE	92103
COUNTRY	United States

PHONE	619-209-3000
FAX	619-209-3043
EMAIL	kleinke@dsmwlaw.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Bernard L. Kleinke/
SIGNATORY'S NAME	Bernard L. Kleinke
SIGNATORY'S POSITION	Attorney of record, California bar member
DATE SIGNED	08/20/2008
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Aug 20 20:41:42 EDT 2008
TEAS STAMP	USPTO/RFR-12.175.73.66-20 080820204142094347-771824 35-430395ff673c0fdb46f30b 076da13a77f-N/A-N/A-20080 820200324193006

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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77182435** has been amended as follows:

ARGUMENT(S)In response to the substantive refusal(s), please note the following:

In the Office Action, the Examining Attorney refused registration of Applicant's mark "DESIGNER WEIGHT CONTROL" for nutritional supplement preparations in international classes 29 and 32. The basis of the Examining Attorney's refusal is (1) Applicant's mark is likely to confuse the public in that it consists entirely of the previously registered mark "DESIGNER" and adds only "highly descriptive matter, i.e. "WEIGHT CONTROL," (2)

Applicant's mark seeks registration for goods that are identical to the goods identified under the "DESIGNER" mark, and (3) Applicant's allegation of a family of marks is insufficient to establish the existence of such a family of marks. Any other information not addressed is deemed satisfied or withdrawn. Thus, registration in classes 05 and 30 is appropriate.

Reconsideration is requested in view of the following amendments and comments:

LIKELIHOOD OF CONFUSION

A composite trademark is not judged by an examination of its parts, but rather its validity and distinctiveness is determined by viewing the trademark as a whole, as it appears in the marketplace. See, Office Airline Guides, Inc. v. Gross, 6 F.3d 1385, 1392 [28 USPQ2d 1641] (9th Cir. 1993). The mark must also be considered with reference to the manner in which it is used and would be encountered by purchasers in the marketplace. In re Hampshire-Designers, Inc., 199 USPQ 383 (1978) [Court considered term "DESIGNER" as it relates to clothing and apparel.]

Further, although it is proper to indicate that more weight is given to a particular component of the mark, it does not excuse consideration of the other components of the mark as a whole. See, Packard Press, Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1357-1358 [56 U.S.P.Q.2d 1351] (Fed. Cir. 2000); Sleepmaster Products Co. v. American Auto-Felt Corp., 241 F.2d 738, 741 [113 USPQ 63, 66] (1957); In re National Data Corp., 753 F.2d 1056, 1058 [224 USPQ at 751 (explaining the effect of disclaimer and descriptive words in likelihood of confusion analysis). Indeed, there are numerous cases in which marks were held not to be conflicting because the similarity between them rested solely in a descriptive or generic term which formed part of each mark. Seven-Up Co. v. Tropicana Products, 356 F.2d 567, 568 [148 USPQ 604, 606] (CCPA 1966); Sears, Roebuck & Co. v. Hofman, 258 F.2d 953, 954 [119 USPO 137, 138] (CCPA 1958); Lauritzen & Co. v. Borden Co., 239 F.2d 405, 407 [112 USPQ 60, 61-62] (CCPA 1956); Goldring, Inc. v. Town-Moor, Inc., 228 F.2d 254, 255 [108 USPQ 234, 235] (CCPA 1955); In re Blue Lake Producers Coop., 194 F.2d 126, 128 [92 USPQ 334, 336] (CCPA 1952); Nestle's Milk Products v. Baker Importing Co., 182 F.2d 193, 196 [86 USPQ 80, 82-83] (CCPA 1950); Franco-Italian Packing Corp. v. Van Camp Sea Food Co., 142 F.2d 274, 276 [61 USPQ 369, 370-71] (CCPA 1944).

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In view of the argument set forth above, Applicant respectfully requests the Examining Attorney withdraw the refusal to register the subject mark and pass this application to publication.

EVIDENCE

Evidence in the nature of a web page of Select Milk Producers, Inc. labelled as Exhibit 1 has been attached.

Original PDF file:

http://tgate/PDF/RFR/2008/08/20/20080820204142094347-77182435-001_001/evi_121757366-

200324193 _ Exhibit_1.pdf
Converted PDF file(s) (1 page)
Evidence-1

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current: TEX PROWS NEXT PROTEINS, INC. 5050 AVENIDA ENCINAS STE 350 CARLSBAD, CA 92008-4386

Proposed: Bernard L. Kleinke of Duckor Spradling Metzger & Wynne, having an address of 3043 4th Avenue San Diego, California United States 92103, whose e-mail address is kleinke@dsmwlaw.com, whose phone number is 619-209-3000 and whose fax number is 619-209-3043.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Bernard L. Kleinke/ Date: 08/20/2008

Signatory's Name: Bernard L. Kleinke

Signatory's Position: Attorney of record, California bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: Bernard L. Kleinke
Duckor Spradling Metzger & Wynne
3043 4th Avenue
San Diego, California 92103

Serial Number: 77182435
Internet Transmission Date: Wed Aug 20 20:41:42 EDT 2008
TEAS Stamp: USPTO/RFR-12.175.73.66-20080820204142094
347-77182435-430395ff673c0fdb46f30b076da
13a77f-N/A-N/A-20080820200324193006

Select Milk Producers, Inc.

Southwest Dairy
Farmers

Good Cow Company

Southwest Cheese
Company

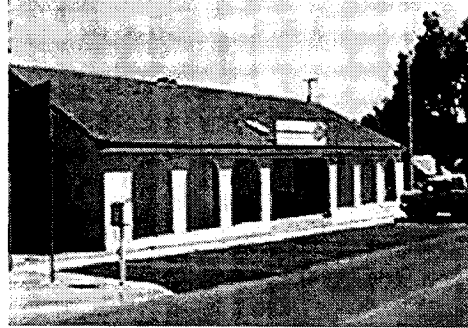
Online Information

username

Password

Login

Members Meeting Embassy
Suites Lubbock, TX
September 4, 2008



Setting a higher standard

Select Milk Producers, Inc. was formed in 1994 by a group of large dairy producers with high quality milk and efficient dairy farm operations. Our common goal is to provide the highest quality product in the market place and do so with the highest level of service. At the same time our objective is to operate the coop

in a very efficient manner to achieve the optimum pay price for our membership.

Select membership is based on two primary geographic areas. The New Mexico/West Texas division which includes the Roswell - Artesia area, the Albuquerque area, the Las Cruces - El Paso area, and the Clovis NM-Texas Panhandle area. The Central Texas division which is centered primarily around Stephenville and Dublin.

All together Select produces and markets over 3,300,000,000 pounds of milk annually.

Select's customer base is primarily Class I plants in New Mexico and Texas with the balance going to local cheese plants or utilized through our own Ultra Filtration or Reverse Osmosis facilities.