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COMPLEX - 06889.164

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/551163

MARK: RESILIENT-C COMPLEX



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

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APPLICANT: MURAD, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

06889.164

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant filed the instant application Serial No. 77/551163 on August 20, 2008 to register the mark RESILIENT-C COMPLEX, in standard character format, for “Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels.”

In an Office Action dated December 2, 2008, the examining attorney refused registration under Trademark Act Section 2(d) on the grounds that the applied-for mark so resembles the marks in Registration Nos. 1884181 (RESILIENCE, in typed format, for “skin moisturizer”); 1946865 (RESILIENCE, in typed format, for “eye cream and skin lotion”); and 2786645 (RESILIENCE LIFT, in typed format, for “Non-medicated

skincare products, namely, moisturizing cremes, lotions and balms”) as to result in a likelihood of confusion among consumers as to the source of the identified goods. The examining attorney also required applicant to provide a disclaimer of COMPLEX. Applicant’s response of December 4, 2008 provided the disclaimer and set forth arguments in favor of registration.

In an Office Action dated December 8, 2008, the examining attorney made final the refusal to register under Section 2(d) as to all of the referenced registrations. On April 20, 2009, applicant filed a Notice of Appeal. On April 24, 2009, applicant filed an appeal brief and on May 22, 2009, the Office reassigned the application file to the undersigned examining attorney.

ISSUE

The only remaining issue in this case is whether there is a likelihood of confusion between applicant’s mark, RESILIENT-C COMPLEX, in standard character format, for “non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels” and the cited registered marks, all owned by the same registrant, RESILIENCE, in typed format, for “skin moisturizer”; RESILIENCE, in typed format, for “eye cream and skin lotion”; and RESILIENCE LIFT, in typed format, for “non-medicated skincare products, namely, moisturizing cremes, lotions and balms.”

ARGUMENT

Registration of the mark RESILIENT-C COMPLEX for “Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels” will result in a likelihood of confusion with the prior registered marks, RESILIENCE, RESILIENCE and RESILIENCE LIFT, for nearly identical skincare products.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. *See In re Opus*

One, Inc., 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Turning first to a comparison of the goods, applicant's goods are "non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels." The goods listed in the cited registrations are, respectively, "skin moisturizer"; "eye cream and skin lotion"; and "non-medicated skincare products, namely, moisturizing cremes, lotions and balms." Registrant's skin moisturizers, skin lotions and non-medicated skincare products, namely, moisturizing cremes, lotions and balms encompass applicant's non-medicated skin care creams, lotions and gels. The remainder of applicant's goods would be sold in the same cosmetic and skin care stores as registrant's goods. Accordingly, the goods would be provided to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the goods originate from the same source. Applicant does not argue against the similarity of the goods or the trade channels of the goods.

Turning next to a comparison of the marks, the first two cited registered marks are both RESILIENCE in typed format. The third cited registered mark is RESILIENCE LIFT in typed format. The dominant feature of the third cited registered mark is RESILIENCE

because LIFT is the second term in that mark and because LIFT is highly suggestive of skincare products lifting up the skin.

Applicant's mark is RESILIENT-C COMPLEX in standard character format. As required, applicant has provided a disclaimer of the descriptive term COMPLEX. COMPLEX is a highly descriptive disclaimed term and applicant does not appear to contest that applicant's skincare products contain vitamin C as an antioxidant. Therefore, the dominant feature of applicant's mark is RESILIENT.

The dominant feature of applicant's mark, RESILIENT, is highly similar in sound, appearance, meaning and commercial impression as the term RESILIENCE in the cited registered marks.

Applicant contends that the marks are distinguishable when viewed in their entireties because of the addition of -C COMPLEX in applicant's mark and because of the differences in meaning and sound between the words RESILIENT and RESILIENCE.

As to the addition of -C COMPLEX in applicant's mark, applicant correctly argues that the marks must be viewed in their entireties when comparing their commercial

impression. However, although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. See *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). As noted above, COMPLEX is a highly descriptive disclaimed term and C merely refers to Vitamin C, an ingredient in applicant's products. Thus, the addition of the weak term –C COMPLEX in applicant's mark does not obviate the likelihood of confusion.

As to the differences in the meanings of RESILIENT and RESILIENCE, “resilient” is commonly defined as:

1. Marked by the ability to recover readily, as from misfortune.
2. Capable of returning to an original shape or position, as after having been compressed. See synonyms at flexible.¹ (See the definition included in the December 8, 2008 Final Office action.)

“Resilience” is commonly defined as:

1. The ability to recover quickly from illness, change, or misfortune; buoyancy.
2. The property of a material that enables it to resume its original shape or position after being bent, stretched, or compressed; elasticity.² (See the definition included in the December 8, 2008 Final Office action.)

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As used in relation to skincare products, both terms give the impression of giving skin the ability to readily recover from stresses and to return to its original shape. Applicant provides similar definitions of the terms and argues that "...'resilient' relates to a body's capability of withstanding shock...[and that] 'Resilience' specifically relates to a body's recovery from deformation by compressive stress, not shock." Applicant's Brief at Page 5. Consumers of these skincare products would not be likely to take note of any slight nuances in meaning between RESILIENT and RESILIENCE. The focus as to whether the marks create a highly similar overall impression 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, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). Here, consumers would have the same general impression from the marks that using the products would give their skin the ability to recover quickly.

As to the minor audible difference between RESILIENT and RESILIENCE, these words are very similar in overall sound, differing only by the ending sound of T or CE. This very slight difference in sound is not sufficient to obviate the likelihood of confusion. Further, there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning*,

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Inc., 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Assoc.*, 222 USPQ 350, 351 (TTAB 1983). In the case of applicant's mark, the term RESILIENT-C could easily be perceived as a play on and pronounced very similarly to "resiliency", which is extremely close in pronunciation to "resilience".

Additionally, the Trademark Trial and Appeal Board has found that if the goods and/or services of the respective parties 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 would be required with 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). In the instant case, as discussed above, the goods are nearly identical. Therefore, the degree of similarity between the marks required to support a likelihood of confusion is not as great as if these marks were used on very different goods or services.

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed.

Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

CONCLUSION

Due to the highly similar nature of the marks and the goods, confusion is likely among consumers as to the source of those goods. Accordingly, the examining attorney requests that the refusal to register the mark under Trademark Act Section 2(d) be affirmed.

Respectfully submitted,

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