

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

In re Application of:	:	
MURAD, INC.	:	Int'l. Class 3
Serial No. 77/551,163	:	Examiner R. L. Gilbert
Filed: August 20, 2008	:	Law Office 103
For: RESILIENT-C COMPLEX	:	

CERTIFICATE OF MAILING

The undersigned declares under the penalty of perjury the within **APPELLANT'S REPLY BRIEF (in triplicate)** was forwarded to BOX NO FEE - TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, via first class mail, postage prepaid, this 19th day of June, 2009.



 SHERYL R. CONAWAY

APPELLANT'S REPLY BRIEF



06-22-2009

I

THE POSITION TAKEN BY THE EXAMINER IGNORES
THE SUBSTANTIAL DIFFERENCES BETWEEN
APPELLANT'S MARK AND THE CITED REFERENCES

The trademark of Appellant that is sought to be registered is RESILIENT-C COMPLEX. The Examiner has refused registration based upon two registrations of the mark RESILIENT (Registration Nos. 1,884,181 and 1,946,865) and the registered trademark RESILIENCE LIFT (Registration No. 2,486,645). The '181, '865 and '645 registrations are all owned by the same party. The final refusal to register Appellant's mark is based on an analysis of the Examiner that is limited solely to comparing the word "resilient" to the word "resilience." It is submitted the Examiner ignored the differences between Appellant's mark and the cited references and thereby refused registration of Appellant's mark based on an analysis that is contrary to both prevailing authority and prior action by the United States Patent and Trademark Office.

II

AN ANALYSIS THAT IGNORES PORTIONS
OF APPELLANT'S MARK IS ERRONEOUS

Appellant concedes the dominant portion of the subject mark is the word RESILIENT. However, though the term C COMPLEX may be considered to be less significant, it is an important part of Appellant's mark and is entitled to be given appropriate weight. The Court of Appeals for the Federal Circuit has held that no element of a mark is to be ignored merely because it is less dominant, or would not have trademark significant if used alone. *In re*

Electrolyte Laboratories, Inc., 929 F.2d 645, 647 (Fed. Cir., 1990). The analysis of the Examiner was limited to comparing the word RESILIENT of Appellant's mark with the word RESILIENCE in the '181, '865 and '645 references. It is submitted that is evident from the manner in which the Examiner considered the '645 reference for the mark RESILIENCE LIFT.

The Examiner stated:

“The dominant feature of the third cited registered mark ['645 registration] is RESILIENCE because LIFT is the second term in that mark and because LIFT is highly suggestive of skin care products lifting the skin.”

The problem with the Examiner's analysis is that the goods identified in the '645 registration make no mention whatsoever of “skin care products lifting up the skin.” Most importantly, there is no disclaimer of the word LIFT in the '645 registration. In the same way the Examiner ignored the word LIFT in the '645 reference, the Examiner ignored the term C COMPLEX in Appellant's mark.

In making her analysis, the Examiner relied on the Federal Circuit Decisions in the cases of *In re Dixie Rests, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir., 1977) and *In re National Data Corp.* 753 F.2d 1056, 224 USPQ 749 (Fed. Cir., 1985). It is submitted these decisions are based on facts that are distinguishable from those in the present case. In both decisions, the application that was refused registration was for a mark that totally appropriated dominant portions of the cited references. In the *In re Dixie* case, it was found the mark THE DELTA CAFÉ created a likelihood of confusion with DELTA. In the *National Data Corp.* case, it was found the mark THE CASH MANAGEMENT EXCHANGE created a likelihood of confusion with CASH MANAGEMENT ACCOUNT. Those facts do not exist in the present

case. Appellant's mark includes the word RESILIENT, the references all comprise or include the word RESILIENCE. The words are not the same. It is therefore submitted that, in addition to comparing the purportedly dominant portions of the marks, a proper comparison requires that meaningful consideration be given to the portions of Appellant's mark that have absolutely no counterpart in any of the references. That was not done in the present case.

The analysis performed by the Examiner in this case treated the term C COMPLEX in Appellant's mark as if it had absolutely no significance whatsoever. Contrary to the analysis performed in this case, it is submitted a proper comparison of marks is defined in the seminal decision of *Spice Islands, Inc. v. The Frank Tea & Spice Company*, 505 F.2d 1293, 184 USPQ 35 (CCPA, 1974). In the *Spice Islands* case, the CCPA reversed the decision of the Trademark Trial and Appeal Board which had affirmed an analysis that was substantially the same as was performed in this case. The CCPA stated:

“Arguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between only what remains is an erroneous approach.” 505 F.2d at 1295.

It is submitted the Examiner has presented nothing to the Board that would indicate her analysis gave meaningful consideration to the differences between Appellant's mark and the references. The only statement is that “the addition of the weak term -C COMPLEX in Applicant's mark does not obviate the likelihood of confusion.” That statement is merely a conclusion, not an explanation of the consideration given to the portion of Appellant's mark that had no counterpart in the references. It is submitted this is precisely the type of analysis that was found to be erroneous.

Examples of marks registered on the Principal Register demonstrate the erroneous analysis that was performed in the present case. The following marks are a representative sample of marks registered on the Principal Register in International Class 41 that include the word RESILIENT or formatives thereof:

<u>Mark</u>	<u>Registration No.</u>	<u>Goods/Services</u>
RESILIENCE 101	3,314,208	conducting workshops and seminars in self awareness
THE RESILIENT EDUCATOR	3,144,925	educational services, namely, providing courses of instruction at the primary, secondary and college level and distributing source material in connection therewith
WILD RESILIENCY	3,068,212	workshops and seminars in the field of physical, psychological and spiritual wellness and wholeness
RESILIENCE STRATEGIES	3,142,902	conducting workshops, classes, conferences and seminars in personal and professional awareness
RESILIENCY PLUS	3,498,588	education services, namely, providing live and on-line classes workshops and seminars in the field of resiliency skill development and promotion for employees in travel including aviation and hospitality and retail

The five marks are owned by different parties. The services designated by the marks are the same or are highly related. It is submitted that registration of these marks is indicative of a proper analysis of marks in their entirety, a method that is contrary to what occurred in the present case. If Appellant's mark and the references are compared in their entirety, it is submitted the differences are sufficient to preclude a likelihood of customer confusion.

III

CONCLUSION

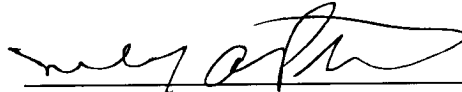
For the reasons set forth hereinabove, it is submitted Appellant's mark is entitled to registration on the Principal Register on the ground there is no likelihood of mistake or deception between Appellant's mark and those set forth in the cited registrations if all marks are compared in their entireties.

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's mark.

Respectfully submitted,

ISAACMAN, KAUFMAN & PAINTER, P.C.

By:



Michael A. Painter

MAP:src
Dated: June 19, 2009
8484 Wilshire Boulevard, Suite 850
Beverly Hills, California 90211
(323) 782-7700