To:	Follica, Inc. (tmadministrator@clarkelbing.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 77665184 - FOLLICA - 50481/013001
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/665184

MARK: FOLLICA

77665184

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Follica, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
50481/013001

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Follica, Inc., has appealed the trademark examining attorney's final refusal to register the proposed trademark on the Principal Register for the standard character mark FOLLICA for pharmaceutical preparations for hair growth treatments in International Class 5. Registration was refused pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark in U.S. Registration No. 3453331, the standard character mark PROFOLLICA, for shampoos; hair care kits comprising non-medicated hair care preparations, namely, a shampoo and activator gel; hair gel in International Class 3, that it is likely to

cause confusion, or to cause mistake, or to deceive as to the source of the goods. It is respectfully requested that the final refusal be affirmed.

STATEMENT OF FACTS

On February 6, 2009, applicant filed this application to register the standard character mark FOLLICA for pharmaceutical preparations for hair growth treatments in International Class 5; medical devices, namely, medical modalities to induce epidermal disruption, for hair growth treatments in International Class 10 and medical services for hair growth treatments in International Class 44.

On April 28, 2009, the examining attorney issued an Office action refusing registration of the proposed mark under Section 2(d) because of a likelihood of confusion with the standard character mark PROFOLLICA in U.S. Registration No. 3453331 for shampoos; hair care kits comprising non-medicated hair care preparations, namely, a shampoo and activator gel; hair gel. The initial Office action also required clarification of the identification of goods.

On June 17, 2009, the examining attorney withdrew the refusal to register the mark under Section 2(d) for the goods and services listed in International Classes 10 and 44. This appeal follows the examining attorney's final Office action on June 17, 2009, and denial of request for reconsideration on January 4, 2010, maintaining the Section 2(d) refusal for the goods listed in International Class 5.

ISSUE

The issue on appeal is whether the mark, when used in connection with the recited goods, so resembles the mark in Registration No. 3453331 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

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.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The marks create a confusingly similar commercial impression.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

Furthermore, in determining likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558,

558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus 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). In the present case, the marks, PROFOLLICA and FOLLICA, create the same overall impression.

The dominant portion of registrant's mark is the term FOLLICA which is identical to applicant's mark. Therefore, the marks create a similar commercial impression. Although, the marks are compared in their entireties under a Trademark Act Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *see* TMEP §1207.01(b)(viii), (c)(ii). The registrant's mark contains the frequently used noun PRO. This noun is readily recognized as the informal word for "professional". The word "pro" is defined as follows:

Main Entry: **4pro**
Function: *noun or adjective*
Date: 1866
: professional *Merriam-Webster Online Dictionary,* (11th ed. 2010)

"Judicial notice" refers to a court or adjudicating body's authority to accept as evidence well-known and indisputable facts for the purpose of convenience and without requiring a party's proof. *Black's Law Dictionary* 863 (8th ed. 2004). The Trademark Trial and Appeal Board can take judicial notice of definitions obtained from dictionaries in printed format. In addition, the Board can also take judicial notice of online dictionaries available in printed format or online dictionaries that are readily available and

capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. *See* Fed. R. Evid. 201; 37 C.F.R. §2.122(a); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); TBMP §1208.04; TMEP §710.01(c). It is respectfully requested that the Board take judicial notice of the above definition.

Since PRO is such a commonly used term and is found throughout everyday language, the average purchaser would focus on the term unusual term FOLLICA and would retain that portion of the mark. Therefore, the dominant portion of registrant's mark is the term FOLLICA which is identical to applicant's proposed mark. Therefore, the marks create the same overall commercial impression.

Applicant asserts that the addition of the word PRO in registrant's mark is enough to distinguish the two marks. However, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); *In re Cosvetic Labs., Inc.*, 202 USPQ 842 (TTAB 1979) (HEAD START and HEAD START COSVETIC); TMEP §1207.01(b)(iii).

Furthermore, since the noun PRO is recognized as the informal word for "professional", the average purchaser would reasonably assume that PROFOLLICA refers to the professional line of registrant's goods while FOLLICA refers to the non-professional line of registrant's goods. Upon seeing these marks, the purchaser would believe that the goods originate from the same source and would be confused as to

the source of the goods.

When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." Esso Standard Oil Co. v. Sun Oil Co., 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); TMEP §§1207.01(d)(i).

The goods travel in the same channels of trade.

Applicant's goods are pharmaceutical preparations for hair growth treatments. Registrant's goods are shampoos; hair care kits comprising non-medicated hair care preparations, namely, a shampoo and activator gel; hair gel. The purpose of both applicant's and registrant's goods are identical – to promote hair growth. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). In the present case, the applicant's goods and registrant's goods are related in that they are both products used to promote hair growth. The fact that one is a pharmaceutical preparation and the other is a non-medicated preparation does not obviate the fact that consumers would be confused as to the source of the goods. The purchasers for both of these products would be the same in that they would be seeking products that promote hair growth.

In the final refusal, the examining attorney attached numerous third party registrations that contain similar products as the applicant's pharmaceutical preparations and registrant's non-medicated goods. For example, U.S. Registration No. 2887091 includes both non-medical preparation for stimulation of hair growth and hair growth stimulants; U.S. Registration No. 3155372 includes both shampoos and men's hair growth stimulants and U.S. Registration No. 2804259 includes both non-medicated shampoos and medicated hair growth stimulants and lotions for the treatment of hair loss. These registrations have probative value to the extent that they serve to indicate that applicant's goods and registrant's goods may originate from a single source and are marketed under the same trademarks. In re Infinity Broad. Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Consumers are well aware that these types of goods can and are produced by the same manufacturers. Therefore, the average purchaser, upon seeing the similar trademark, would reasonably assume that applicant's goods are produced by the registrant.

In addition, any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from, or are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; *see* TMEP §1207.01(a)(v). In the present case, based on the many third registrations, it is clear that applicant's pharmaceutical preparations for hair growth treatments are in the registrant's normal field of expansion and are related.

In its brief, applicant contends that registrant's website tells a potential purchaser that registrant's goods are not pharmaceutical preparations and therefore, the registrant's products are distinct from the applicant's goods. However, that contention assumes that the potential purchaser will actually take the

trouble to go to the registrant's website and read the information about the product. There is no guarantee that a purchaser will ever see the referenced website. In fact, purchasers frequently do not go onto a manufacturer's website when buying a product. Therefore, the purchaser in the present would not be aware of the differences in the marketing of the products. The average purchaser will only know that pharmaceutical preparations for hair growth treatments and non-medicated preparations for the promotion of hair growth can and do originate from the same source and would be reasonably confused as to the source of the goods.

Applicant asserts that a purchaser of pharmaceutical preparations is sophisticated. Therefore, the sophistication of the purchaser mitigates any likelihood of confusion. However, 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. TMEP §1207.01(d)(vii); *see In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). Even if one assumes that the purchaser of applicant's pharmaceutical product is sophisticated, the purchaser of registrant's non-pharmaceutical goods includes the general public. Therefore, the purchaser of registrant's goods is not sophisticated. Furthermore, the Trademark Trial and Appeal Board and its appeals court have applied a higher standard to likelihood of confusion cases involving medicinal and pharmaceutical products. Although physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceutical products, they are not trained to recognize the difference between similar trademarks used on such products. Any confusion involving such goods could give rise to serious and harmful consequences such as mistakenly choosing wrong medication. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386, 173 USPQ 19, 21 (C.C.P.A. 1972); *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1305-06 (TTAB 2004); *Blansett Pharmacal Co. v. Camrick Labs., Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992). Thus, a lower threshold of proof is applied in assessing confusing similarity with respect to drugs and medicinal products.

The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); TMEP §1207.01; s*ee Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is clear from the evidence that, although the goods are not identical, consumers would reasonably be confused as to the source of pharmaceutical preparations and non-medicated preparations that are used in the treatment of the identical condition.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, 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

Applicant's mark, FOLLICA, and registrant's mark, PROFOLLICA, create a similar commercial impression. Moreover, the record reflects that the parties' respective goods travel in the same channels of trade. For the foregoing reasons, the examining attorney respectfully requests that the Board affirm the final refusal to register the mark on the basis of a likelihood of confusion with the mark in U.S. Registration No. 3453331, under Section 2(d) of the Trademark Act.

Respectfully submitted,

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