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

Proceeding	78937342
Applicant	Jarrow Formulas, Inc.
Applied for Mark	CARNITALL
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Applicant:	Jarrow Formulas, Inc.	Trademark Examining Attorney:
Serial No:	78/937,342	Seth A. Rappaport
Filed:	July 25, 2006	Law Office 103
Trademark:	CarnitALL (stylized)	

APPLICANT'S REPLY BRIEF

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I. STATEMENT OF THE ISSUES

The issue on appeal is whether Applicant's mark, as amended to the stylized form CARNITALL, is likely to cause confusion with the mark CARNITYL of prior registration no. 2,189,110.

Applicant Jarrow Formulas, Inc. (hereinafter, "JFI" or "Applicant") filed the present application under Trademark Act Section 1(a) on July 25, 2006, claiming use of the mark CARNITALL on dietary and nutritional supplements since at least May 26, 2005. The Examining Attorney has finally refused registration under Trademark Act Section 2(d). With permission of the Board, Applicant amended the drawing of the mark to a stylized form, to reflect the form in which it is used in commerce, in which stylized form the initial "C" and the final syllable "ALL" are in larger font and thereby emphasized, and requested reconsideration of the refusal by the Examining Attorney. The Examining Attorney has maintained refusal on the same grounds notwithstanding Applicant's arguments and evidence against the refusal, and notwithstanding the amendment to Applicant's mark further strengthening such arguments.

Applicant timely filed its Appeal Brief, and the Examining Attorney his Appeal Brief. Applicant respectfully submits this Reply Brief to address certain new points raised in the Examining Attorney's Appeal Brief.

II. ARGUMENT

A. The Examining Attorney's Reliance on the Impression Generated by the Initial Element of the Marks is Misapplied

In the Examining Attorney's Appeal Brief, the Examining Attorney reiterates his argument that the marks are likely to be confused because "consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark".

Examining Attorney's Appeal Brief at Page 4. Applicant respectfully reiterates that, in the marks at issue, the initial syllables comprise the generic combining form which refers to the ingredient of the dietary supplements sold under both marks, which is incapable of source-identifying significance and not capable of being relied upon by consumers as a source-identifier. Thus, while the stated principle holds in the cases cited by the Examining Attorney, in each of those cited cases the marks at issue include initial elements which are inherently distinctive, or arbitrary and strongly source-identifying. For instance, in the Examining Attorney's cited reference *Palm Bay Imps., Inc., v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 72 USPQ2d 1689 (Fed. Cir. 2005), at 1693, the Federal Circuit weighed the conceptual strength of the arbitrary initial element VEUVE as a factor in its finding of likelihood of confusion between the marks VEUVE CLIQUOT and VEUVE ROYALE.

The Examining Attorney's string of additional citations at page 4 of his brief refer to similarly distinctive prefixes and common elements, including COMM- with respect to banking services, *Crocker Nat'l Bank v. Canadian Imperial bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 1 USPQ2d 1813 (Fed. Cir. 1987); "21" for restaurant services, *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986); "CONFIRM-" for diagnostic reagents, *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); "COLLEGIAN" for apparel, *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984), "MILTRON-" for microprocessors for operating machinery, *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983), and LUTEX- for chemicals used in dyeing of textiles, *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975). The cited principle that the initial syllables or elements of a mark may be considered to make a strong commercial

impression has been developed with reference to initial elements which are strong and distinctive.

In contrast, the prefix in the marks at issue, CARNI- is the scientific prefix of the primary ingredient of the supplements sold, and as evidenced by the coexistence of third party marks incorporating this element and as well established in case law, this element is incapable of conferring source-identifying significance. *American Cyanamid Corporation v. Connaught Laboratories, Inc.*, 231 USPQ 128, 129 (2d Cir. 1986) (No confusing similarity could be based on the use of the generic or descriptive prefix HIB in the marks HibVAX and HIB-IMMUNE, notwithstanding its initial-position in the marks); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) (The initial term “fiber” appearing in the parties’ marks is readily understood and commonly used in the industry to refer to the primary ingredient of the goods; notwithstanding the similar construction of the marks FIBER ONE and FIBER 7, use in connection with identical goods, and the initial element being identical, there is no likelihood of confusion.)

As in *General Mills*, the marks at issue, considered as a whole, generate significantly different commercial impressions which are indicative of the differences in the goods. Indeed, whereas the marks at issue in *General Mills* merely implied or suggested possible superlatives or attributes, the Registrant’s mark at issue distinctly specifies that the goods offer a specified form of carnitine, while Applicant’s goods offer several or “ALL” forms of carnitine. Notwithstanding any similar use of the generic element of the marks, the marks as a whole differ sufficiently in sight, sound, meaning, and commercial impression to avoid any reasonable likelihood of confusion.

B. There Is No Reasonable Likelihood Of Confusion Between Applicant's CARNITALL Mark and the Cited Carnityl Mark.

Applicant respectfully requests that the refusal be reversed and the application proceed to publication and registration, for the following reasons:

1. The prefixes of the marks carry no trademark significance in themselves. *See also* Applicant's Appeal Brief at 4-5.
2. By virtue of the different suffixes -TYL and -ALL employed by the Registrant and the Applicant respectively, the marks in their entireties differ in sight and sound, and generate very different connotations and overall commercial impressions with respect to the goods to which they are applied. Applicant's Appeal Brief at 6-7, 9. Registrant's mark simply suggests the provision of Acetyl-L-Carnitine, while Applicant's mark suggests the provision of "ALL" forms of carnitine complex. Applicant's Appeal Brief at 5, 7.
3. Applicant's mark as stylized further reemphasizes these differences in sight, sound, and meaning generated by the marks. Applicant's Appeal Brief at 7, 9.
4. Consumers in the relevant marketplace differentiate between dietary supplements, and even between products comprised of carnitine complexes, based on relatively minor differences in the trademarks applied thereto. In view of this, and particularly in view of the simply suggestive nature of the cited mark, it should be recognized that the cited registration has a narrow scope of recognition among the relevant consumers. Applicant's Appeal Brief at 5, 7-8.

5. Applicant's mark is no more similar to Registrant's mark than Registrant's mark is to a variety of prior marks on the register, and no more than several other marks which coexist on the register and in the marketplace. Applicant's Appeal Brief at 7-8. In view of its distinct and distinctive appearance, sound, connotation, and commercial impression, Applicant's mark is not likely to cause confusion with Registrant's mark or any other mark in the marketplace.

CONCLUSION

For these reasons and those argued in its prior responses, Applicant respectfully requests that the Board overturn the Examining Attorney's refusal, and remand the application for publication and registration.

Respectfully submitted,



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February 2, 2009

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In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983)

In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986)

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(Fed. Cir. 2005)