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

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|------------------------|--|
| Proceeding             | 78937342   |
| Applicant              | Jarrow Formulas, Inc.  |
| Correspondence Address | MARK D GIARRATANA<br>MCCARTER & ENGLISH LLP<br>185 ASYLUM ST<br>HARTFORD, CT 06103-3495<br>UNITED STATES |
| Submission             | Applicants Request for Remand and Amendment  |
| Attachments            | req for amd.pdf ( 4 pages )(302312 bytes )<br>CarnitALL_logo_0619081.pdf ( 1 page )(13828 bytes )        |
| Filer's Name           | Mark D. Giarratana, Esq.   |
| Filer's e-mail         | mgiarratana@mccarter.com, eswift@mccarter.com, jwhitney@mccarter.com                                     |
| Signature              | /mark d giarratana/  |
| Date                   | 06/19/2008   |

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Request for Remand and Amendment

In the Final Office Action, the Examining Attorney maintained refusal of registration of this mark under Trademark Act Section 2(d), alleging that there is a likelihood of confusion between Applicant's mark CARNITALL and the mark of U.S. Reg. No. 2,189,110, CARNITYL. Applicant has submitted Notice of Appeal of the final refusal.

The Applicant thanks the Examining Attorney for the courtesy of discussing the permissibility of an amendment from block letters to a stylized form of the mark on June 9, 2008. The application is herewith amended as discussed, and Applicant respectfully requests remand of the application to the Examining Attorney for entry of this amendment and reconsideration of the final refusal in view thereof. Specifically, Applicant has amended the mark to a stylized form in which the letters C and A appearing at the beginning of the prefix and the suffix, respectively, appear in a larger size than the other letters, as follows: CARNITALL. For the reasons stated herein, it is respectfully submitted that this amendment obviates the grounds for refusal.

REQUEST FOR REMAND

Applicant respectfully requests that the Board remand the application for entry of the following amendment prior to consideration of the Appeal. Amendments after appeal which are intended to obviate the ground for refusal are generally considered to have good cause. See TBMP 1205. Applicant believes that the following amendment from a block letter form to a stylized form, in which the mark has two larger letters which accentuate the syntactic elements of the mark, will obviate the ground for refusal. Specifically, by showing use of a larger "A" at the beginning of the mark's suffix, the drawing as amended further emphasizing the suffix "All" and the differences in sight, sound, and commercial impression between it and the suffix of the cited mark. Since the prefixes of the respective marks are comprised of the highly descriptive element "Carni", which is shared by many other marks in the same marketplace, further emphasis on the suffix of Applicant's mark further emphasizes the differences in sight, sound, and commercial

impression between its mark and the cited mark. This amendment therefore obviates the ground for refusal, and there is good cause for remand to the Examining Attorney for entry of this amendment and reconsideration.

#### AMENDMENT AND DECLARATION

Please amend the drawing of the mark from block letter form to a stylized form as in the attached drawing, so that the drawing in the application appears as follows:

CARNITALL

As agreed by the Examining Attorney, this amendment does not constitute a material alteration to the mark as defined in TMEP 37 CFR 2.72. Applicant further hereby declares, by and through the undersigned attorney, as required under 15 USC 1051(a), that it is using the mark as amended in commerce on or in connection with the identified goods, and has used the mark in this manner since at least the date of filing of the present application, and since at least the date of use claimed in the application.

#### ARGUMENT

Applicant respectfully submits that, particularly in view of the present amendment, there is no reasonable likelihood of confusion between the marks, and requests that this application proceed to publication.

Specifically, the CARNIT- prefix of the marks at issue carries no source-identifying significance, but is merely descriptive of the goods. The CARNIT- prefix refers to various forms of carnitine molecules which are ingredients of both Registrant's and Applicant's nutritional supplements. In light of the number and nature of such third party registrations (as submitted and discussed in previous responses), and further knowledge of the Registrant's and Applicant's own goods, the conclusion is inescapable that purchasers of Registrant's, Applicant's and third parties' goods sold under various CARNI-formative marks are not confused by the common, descriptive element. These marks are entirely able to coexist on the register and in the marketplace, and Applicant's mark is no more similar to Registrant's mark than any of the

currently coexisting marks are to each other. Registrant's mark CARNITYL differs minimally from coexisting registration CARNITOR, which itself differs only minimally from coexisting registrations for CARNISOR, which itself differs only minimally from Applicant's own coexisting registration for CARNISORB. Therefore, if the prefix CARNI- has any trademark value in itself, consumers of nutritional supplements have been conditioned to distinguish between various CARNI-formative marks used on identical goods by reference to the suffix of each mark.

Accordingly, any distinctiveness or source-identifying significance which resides in Registrant's mark must be generated by the suffix TYL, or by the combination of this particular suffix with the descriptive prefix CARNI-. Only this suffix distinguishes Registrant's mark from at least six other marks on the register, all of whom sell nutritional supplements comprised primarily of carnitine complexes. The suffix of Applicant's mark, on the other hand, is recognizable and distinctive, and generates a very different commercial impression which differentiates Applicant's mark from Registrant's mark and all other marks on the register by at least as much as the currently coexisting marks differ from each other.

Specifically, the suffix ALL of Applicant's mark is a recognizable word, with a separate and recognized meaning to consumers which in turn suggests or conveys to consumers that its product uniquely contains a variety of carnitine complex molecules. This impression is furthered by the additional information on the product label in the specimen of record, namely, that the product is a "full spectrum carnitine complex". In contrast, Registrant's suffix is, like its prefix, merely parsed from the name of the molecule which is the primary ingredient of the nutritional supplement, Acetyl-L-Carnitine. Registrant's mark contains no coined element other than the marginally-inventive transposition of this descriptive prefix and suffix to convey still more specifically to consumers the sole active ingredient of its product. Indeed, as previously argued, consumers might not view Registrant's mark as a mark at all, but rather as the ordinary scientific term for that ingredient, and certain scientific literature (previously submitted for consideration) has used the term "Carnityl" in generic fashion to refer to a carnitine compound. Therefore, the commercial impression of Registrant's mark is very weak, whereas Applicant's mark has a distinct implication and commercial impression which obviates any reasonable likelihood of confusion.

By the present amendment, Applicant has further emphasized the distinctive suffix of its mark, and the commercial impression generated thereby, in that, as it is presented on the product label in the specimen, the initial "A" of the suffix "All" is emphasized, and the suffix thereby emphasized as a unit. The Examining Attorney has indicated informally that the cited registration might also be used in stylized form. However, Applicant emphasizes that, if the cited registration were used in a form stylized as Applicant's present amendment, it would only further emphasize the differences between the respective suffixes, and the commercial impressions generated thereby. Specifically, Registrant's mark so stylized would appear as CARNITYL. The augmented "T" of the Registrant's mark so stylized would further differ in sight from the augmented "A" of Applicant's mark, and would further emphasize the different pronunciation of the marks. Most emphatically, a similarly stylized form of Registrant's mark would emphasize the different connotation generated by the suffix.

Therefore, in view of the above arguments and those made previously, and particularly in view of the amendment to the mark made herewith, Applicant respectfully submits that there is no reasonable likelihood of confusion between its mark and the cited mark. Reconsideration of the final refusal is therefore respectfully requested.

If the Examining Attorney or the Board wishes to discuss any of the issues raised herein, or if further discussion or any proposed amendments might expedite processing of this application, they are invited to contact the undersigned attorney at the numbers provided.

Respectfully submitted,

Mark D. Giarratana, Esq.

860-275-6719

**CARNITA**