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TTAB

November 20, 2012

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U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: SYNUTRA PURE
Application No. 85/501,285 filed December 21, 2011
Our File: 41285-00101

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Dear Sir/Madam:

In connection with the above-referenced application, enclosed for filing is a Brief on Appeal.

Please charge Sidley Austin LLP's deposit account #18-1260 if any fee is required for the filing of the Brief.

Respectfully submitted,

Charles S. Cotropia

CSC:mw

11-21-2012

U.S. Patent & TMO/OTM Mail Rcpt Dt. #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Application of: Synutra International, Inc.
Serial No.: 85/501,285
Filed: December 21, 2011
International Class: 005
Examiner: Tashia Bunch Henderson
Trademark Examining Attorney
Law Office 105
571-272-3941
Tashia.bunch@uspto.gov

Mark: SYNUTRA PURE

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Dear Sir/Madam:

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BRIEF ON APPEAL

I. INTRODUCTION

In an Office Action dated June 11, 2012, the trademark Examining Attorney issued a final rejection with respect to the above-identified application. The Examining Attorney has refused registration of Applicant's mark SYNUTRA PURE, as used on "dietary and nutritional supplements" under The Trademark Act, Section 2(d), 15 USC § 1052(d), on the basis of likelihood of confusion with the cited mark ZENUTRA, U.S. Reg. No. 3,190,212 for "nutritional supplements".

The Examining Attorney's rejection has been appealed by filing a Notice of Appeal with the Trademark Trial and Appeal Board on November 19, 2012.

II. THERE IS NO LIKELIHOOD OF CONFUSION WHEN RELEVANT DUPONT FACTORS ARE CONSIDERED.

Applicant submits that there is no likelihood of confusion between Applicant's mark and the cited marks because the relevant *DuPont* factors weigh in Applicant's favor. As recognized by the Examining Attorney, *In re E.I. DuPont de Nemours & Co.*¹ sets forth 13 factors for Examining Attorneys to consider in determining likelihood of confusion between two marks. An Examining Attorney must decide each case on its own facts because there is no litmus test rule providing a ready guide to all cases.² While the Court in *DuPont* noted many factors for possible consideration, not all the factors are necessarily relevant in each case or of equal weight. Hence, to test for likelihood of confusion under Section 2(d) of The Trademark Act,³ a trademark examiner must consider the relevant factors which in this case requires particular focus on a two-part analysis, namely (1) comparing the similarity of the marks in appearance, sound, connotation and commercial impression and (2) comparing the goods.

Based on the facts of this case, Applicant submits that the relevant *DuPont* factors weigh strongly in Applicant's favor primarily in view of the substantial dissimilarity of the marks.

A. Applicant's mark and the cited mark are dissimilar in appearance, sound, connotation and commercial impression.

The Applicant and the Examining Attorney agree that a comparison of the marks in their entireties for similarities in appearance, sound, connotation and commercial impression is required as one of the factors set forth in the seminal decision *In re DuPont* in determining whether there is likelihood of confusion under § 2(d) of The Trademark Act. The Examining Attorney and the Applicant agree that similarity and dissimilarity is one of the most relevant factors.⁴

¹ 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

² *See id.* at 1361.

³ 15 U.S.C. §1052(d).

⁴ Examining Attorney's Response, page 2, citing *In re Viterra, Inc.*, 671 F.3d 1358, 1361-62 (Fed. Cir. 2012).

It is undeniable that comparing the mark visually is critically relevant under the *DuPont* standard and yet the Examining Attorney fails to give appropriate weight to the critical differences between the marks. When it comes to comparing the two marks, the Examining Attorney completely disregards the striking visual differences between them. On their face, the two marks are not only not similar but are strikingly dissimilar in appearance, a fact which is unaddressed by the Examining Attorney. Namely, the marks are:

SYNUTRA PURE

ZENUTRA

Thus, it is undeniable that the two marks have striking dissimilarities when viewed visually. Not only are the marks clearly distinct visually, the visual impression conveyed and any possible connotation attributable to the two marks are significantly different. Applicant's mark begins with the syllable "SY" while the cited mark begins with the syllable "ZEN". These differences present a dramatically distinct appearance and give a completely different commercial impression to the two marks.

To erroneously support her conclusion that there is likelihood of confusion, the Examining Attorney attributes an unrealistic mispronunciation of the marks – concluding that the marks could be pronounced similarly. However, the marks will clearly be differentiated when verbalized by consumers. In view of the striking dissimilarity in appearance, the marks will be pronounced correctly and thus differently. The real difference and distinction in the two marks is seen when the correct pronunciations of the two marks are considered. The first syllable of Applicant's mark, namely "SY", is pronounced Sī with a long "i" (rhyming with "spy"). To emphasize, the "Y" is pronounced as a long "i".

In sharp contrast, the cited mark's first syllable, namely "ZEN", is pronounced Zěn with a short "e" (rhyming with "sin"). Thus, given their correct pronunciations, namely the pronunciation that would be accorded them by consumers, the marks are distinctively dissimilar in appearance, sound and commercial impression. As result, Applicant respectfully submits that its mark would not be confused with the cited mark.

The Examining Attorney simply disregards the clear differentiation that occurs when the marks are viewed and when pronounced. Instead, the Examining Attorney inappropriately relies

on the conclusion that “there is no correct pronunciation of a mark”.⁵ While such a statement might be applicable where marks could realistically be pronounced in ways that cause them to sound similar, this conclusion certainly does not apply in this case where the visual appearance of the two marks is so distinct as to lead a consumer to a very different pronunciation.

In the decision *In re Viterra, Inc.*, relied upon by the Examining Attorney, the marks indeed were visually very similar. Specifically, Applicant’s mark was ECEED for “agricultural seed”, while the cited mark was X-SEED (in design form), also for “agricultural seed”. This similarity led the Board to find that the mark might be similarly pronunciations. This is clearly not the case here where the Applicant’s mark SYNUTRA PURE begins with the syllable “SY” and is pronounced with a long “i”, and the cited mark ZENUTRA begins with the syllable “ZEN” and would be pronounced with a short “e”.

A decision from the Trademark Trial and Appeal Board which is more analogous to the present decision is that found in *In re Reach Electronics, Inc.*, 175 USPQ 743 (TTAB 1972). There, the Board found that the marks “reach” and the mark “reac” were not confusingly similar on related goods. The Board recognized that the two marks were different in spelling, pronunciation and fundamental meaning. *In re Reach Electronics, Inc.*, 175 USPQ 745. Thus, while the Examiner there argued that the marks could be pronounced the same, the Board considered the matter through real-world glasses, recognizing that where marks are visually different, it is inappropriate to conclude that they will be incorrectly pronounced.

Further, the Examining Attorney’s relied upon authority *In re Viterra, Inc.*, cites to an instructive decision by the Federal Circuit in *Citigroup Inc. v. Capital City Bank Group*, 637 F3d 1344 (Fed. Cir. 2011). In *Citigroup Inc.*, although the Court found many of the *DuPont* factors favored a finding of likelihood of confusion, the Court ultimately found no likelihood of confusion in large part because the Court found the mark CAPITAL CITY BANK was not confusingly similar to CITIBANK for identical services in view of the “dissimilarities in their entireties as to appearance, sound, connotation, and commercial impression.”⁶ This Federal

⁵ Examining Attorney’s Response, page 2, citing *In re Viterra, Inc.* at 1367.

⁶ *Citigroup Inc.*, 637 F 3d at 1356.

Circuit holding simply highlights the failure of the Examining Attorney to properly weigh the evaluation of the “dissimilarities in their entireties as to appearance, sound, connotation, and commercial impression” of the marks SYNUTRA PURE and ZENUTRA. Here, it is undeniable that the marks are visually distinct, leading to the conclusion that consumers will not confuse one with the other.

B. Marks Must be Compared in Their Entireties.

The Applicant’s mark is a two word mark “SYNUTRA PURE” while the cited mark is a single word “ZENUTRA”. This distinction has been completely neglected by the Examining Attorney. The entirety of the marks must be considered by the Examining Attorney.⁷ While Applicant has disclaimed the term “PURE”, such disclaimer does not remove the term from the mark. Applicant’s rights exist in the composite mark and the marks must be compared in their entireties.⁸ Clearly, the inclusion of the term PURE in Applicant’s mark adds further distinction which the Examining Attorney has failed to address. This term simply further distinguishes Applicant’s mark and further differentiates it from the cited reference.

C. Any Potential Confusion between Applicant’s Mark and the Cited Marks Would be de minimus.

DuPont factor no. 12 requires consideration of the extent of potential confusion, i.e., whether de minimis or substantial. Neither Applicant’s products nor those offered under the cited mark are products that would be purchased based on impulse. The products in question are dietary and nutritional supplements that a consumer would consider carefully before purchase. Rather than recognize that consumers of these products will take usual care in making their selection, the Examining Attorney disregards this factor and focuses only on the similarity of the products. However, here consumers would give due consideration to their purchase and would readily differentiate between the two, particularly in view of the substantial dissimilarity between

⁷ See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q. 2d 1687, 1688 (Fed. Cir. 1993); TMEP § 1207.01(c)(ii).

⁸ *Sprague Electric Company v. Erie Resistor Corporation*, 101 U.S.P.Q. 486, 486-87 (Comm’r Pat. & Trademarks 1954); TMEP § 1213.

the marks themselves. Given the substantial dissimilarity in appearance, sound and commercial impression, any confusion would be de minimus.

III. THE FINDING OF LIKELIHOOD OF CONFUSION SHOULD BE REVERSED.

Upon analysis of relevant *DuPont* factors, Applicant respectfully submits that confusion is not likely between Applicant's mark and the mark cited in the Official Action. The Examining Attorney's conclusion as to a finding of likelihood of confusion should be reversed and the application allowed.

Respectfully submitted,



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November 20, 2012
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