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Sent: 3/5/2019 6:05:52 PM

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87455242

MARK: VITAL FLORA



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Vital Planet, LLC

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the trademark examining attorney's¹ refusal to register the proposed trademark VITAL FLORA (Standard Characters) for "Dietary supplements for pets for supporting intestinal flora for digestive health" in International Class 005 based on a likelihood of

¹ The Office reassigned this application to the undersigned trademark examining attorney for the purpose of writing this brief.

confusion with the registered mark FLORAVITAL for “dietetic food supplements” in International Class 005 in U.S. Registration No. 2295973 under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

STATEMENT OF THE FACTS AND PROCEEDINGS

On May 18, 2017, applicant filed a use-based application to register the mark VITAL FLORA (Standard Characters) for “Dietary supplements for pets for supporting intestinal flora for digestive health” in International Class 005.

On August 15, 2017, an examiner’s amendment was issued to add a disclaimer of the wording “FLORA” to the application. On September 12, 2017, upon an additional review of the application, an Office Action was issued and the examining attorney refused registration under Section 2(d) of the Trademark Act, based on a likelihood of confusion with the mark in U.S. Registration No. 2295973.

On March 12, 2018, applicant submitted arguments in response to the Section 2(d) Refusal. On April 13, 2018, the examining attorney issued a final refusal under Section 2(d) as applicant’s arguments were unpersuasive.

On October 15, 2018, applicant submitted a notice of appeal and a request for reconsideration where applicant offered additional arguments in support of registration. On November 03, 2018, the Office informed the applicant that the request for reconsideration was denied as applicant’s arguments were unpersuasive.

On January 04, 2019, applicant filed an appeal challenging the final refusal and the file was forwarded to the Examining Attorney for statement on January 10, 2019 and reassigned to the undersigned Examining Attorney that same day.

ISSUE

The issue on appeal is whether the applied-for mark, VITAL FLORA (Standard Characters), when used in connection with the identified goods, so resembles the mark FLORAVITAL in U.S. Registration No. 2295973 (Standard Characters) as to be likely to cause confusion, mistake, or deceive under Trademark Act Section 2(d).

ARGUMENT

THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK AND THE GOODS ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

SIMILARITY OF THE MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317,

1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

In this case, applicant’s mark VITAL FLORA, is confusingly similar to the registrant’s mark, FLORAVITAL, because the marks are highly similar in sound, appearance, connotation, and commercial impression. Specifically, applicant’s mark simply transposes the two word elements of registrant’s mark. Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design for wine club membership services including the supplying of printed materials likely to be confused with AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

Additionally, applicant’s mark and registrant’s mark create the same commercial impression. FLORA is defined as “the bacteria and other microorganisms that normally inhabit a bodily organ or part: intestinal flora”. *See Exhibits to Office Action dated September 12, 2017*. VITAL is defined as “necessary to the continuation of life; life-sustaining: a vital organ; vital nutrients”. *Id.* When used together in both applicant’s and registrant’s marks, these terms convey that the dietary supplements sold under the respective marks contain or provide vital flora (i.e.,

necessary intestinal bacteria). Transposing the wording in these marks does not change this commercial impression, and thus, the marks are confusingly similar.

Response to Applicant's Arguments

Applicant argues that the registrant's mark is weak and only "entitled to a narrow scope of protection." See *Applicant's Appeal Brief* at 3 (citing *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015)). In support of this argument, applicant relies on the *Juice Generation* case cited above and submitted evidence of dozens of third-party registrations using the terms "FLORA" and "VITAL" in International Class 005 on the Principal Register. The Federal Circuit in *Juice Generation* reversed the Trademark Trial and Appeal Board's affirmance of a finding of a likelihood of confusion between the marks PEACE & LOVE in standard characters and PEACE LOVE AND JUICE and design, both for food services. The Federal Circuit found that the Board had not considered whether the three-word phrase in applicant's mark might convey a distinct meaning from the two-word phrase in the registrant's mark. The facts of the *Juice Generation* case are not applicable here as both applicant's and registrant's marks contain just two words, FLORA and VITAL. While applicant has submitted evidence of many registered marks including the term FLORA, and many registered marks including the term VITAL, there is no registered mark other than the cited mark that includes both of these terms.

Applicant additionally highlights differences between several of the cited marks and applicant's mark to support an argument that the registrations are not similar to the applicant's mark. The applicant notes that the applicant's mark consists of two words while the registrant's mark consists of one word, the term "VITAL" appears first in applicant's mark, and the marks have a different commercial impression. See *Applicant's Appeal Brief* at 6-8. The fact that the applicant's mark is two words and the registrant's mark is a compound word mark does not obviate the likelihood of confusion. While there

are indeed differences between the cited marks and applicant's mark, applicant has merely engaged in a side-by-side comparison of applicant's mark and the registered mark. However, when comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971)); TMEP §1207.01(b). When viewing the overall commercial impression between the applicant's mark and the registrant's mark, both marks use the same exact terms, "VITAL" and "FLORA" which creates a similar overall commercial impression, namely that the supplements provided by the parties contain flora that is vital to health, making confusion between the marks likely. This confusion exists whether or not there is a space between the words VITAL and FLORA or not.

Applicant also argues that the "differences between Applicant's Mark and the Registrant's Mark are the same types of differences present in *Outdoor Kids, Inc. v. Parris Manufacturing Co., Inc.*, 2009 WL 871667, at *8 (TTAB Mar. 9, 2009) where the Board found that the marks OUTDOOR KIDS compared to KID'S OUTDOOR was not likely to cause confusion, because the transposition of the terms in weak mark were sufficient to quell any likelihood of confusion...". See *Applicant's Appeal Brief* at 8. The *Outdoor Kids* case is distinguishable from the facts here as the Board makes it clear that the presence of a design in one of the parties' mark was enough to distinguish the marks from one another. See *Outdoor Kids, Inc. v. Parris Manufacturing Co.*, 385 Fed. Appx. 992, 994 (Fed. Cir. 2010) ("The Board found that in

this case, where Outdoor Kids' mark is weak, and the word portion of Parris' mark is descriptive, the transposition of the words...**and the presence of the elk design** are sufficient to distinguish the OUTDOOR KIDS mark from the KID'S OUTDOORS mark.") (Emphasis Added). Unlike in *Outdoor Kids*, there is no design in either the applicant's or registrant's mark to distinguish the marks and instead both marks simply contain the same exact words for highly similar goods.

Similarly, applicant attempts to make comparisons between the present case and other unrelated cases decided by other examining attorneys noting that the "[e]xamining Attorney's initial finding of 'no conflicting marks'" is also in alignment with how her peers have approached identical issues." See *Applicant's Appeal Brief* at 9. However, trademark examining attorneys are not bound by the actions of past examining attorneys in prior registrations, even if the registrations have some characteristics similar to the application at issue; each case is decided on its own merits. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Even considering these additional cases, the present case is different because the transposition of the terms in the marks in each of those other cases, unlike in this case, created a different connotation and commercial impression.

Finally, applicant argues that the purchasers of applicant's products, pet owners, are sophisticated customers who will exhibit a greater degree of care when purchasing pet supplements. See *Applicant's Appeal Brief* at 11-12. In support of this argument, applicant relies on a Pet MD Article to support the proposition that pet owners are "routinely advised to consult with their veterinarian before provide [sic] any nutritional supplements to their pets" and that "consumers are counseled to purchase pet supplements only from reputable and accredited companies." *Id.* at 11. However, the article cited does not seem to support applicant's assertions and applicant has provided no direct language cited from the article indicating that pet owners are

sophisticated consumers. Indeed, the article seems to suggest the opposite, as it notes that pet supplements are completely unnecessary for pets. *See Exhibit 7 to Applicant's Request for Reconsideration* ("According to Dr. Susan G. Wynn, a nutrition specialist at BluePearl Georgia Veterinary Specialists and a diplomate of the American College of Veterinary Nutrition, most commercial pet foods provide dogs and cats with the nutritional balance they need, **rendering supplements unnecessary.**") (Emphasis Added). Contrary to applicant's assertions, it seems that supplements are not even necessary let alone a product that consumers would exercise a greater degree of care when buying. Furthermore, applicant's specimen of record shows that applicant's goods cost about \$30 to \$40. This price range is generally not associated with a high degree of consumer care during purchasing decisions.

Also, even if applicant's consumers can be considered sophisticated purchasers, which they are not, 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, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163).

For these reasons, when consumers encounter the parties' goods using marks with these similarities, they are likely to be confused as to the source of the goods. Therefore, the marks are confusingly similar.

SIMILARITY OF THE GOODS

The compared goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Here, the applicant’s “Dietary supplements for pets for supporting intestinal flora for digestive health” in International Class 005 are closely related to the registrant’s “DIETETIC FOOD SUPPLEMENTS” in International Class 005. Specifically, applicant is offering supplements for pets while the registrant is offering supplements for humans and the Office has provided considerable evidence demonstrating that third parties often offer these types of goods under the same mark. *See Exhibits to Initial Office dated September 12, 2017, Exhibits to Final Office Action dated April 13, 2018 and Exhibits to Request for Reconsideration Letter dated November 03, 2018.*

Response to Applicant’s Arguments

The applicant argues that the goods are not related because registrant’s “goods are for human not pet consumption, a different market than dietary supplements for pets, and do not contain dietary flora.” *See Applicant’s Appeal Brief* at 10. The applicant further notes that the Office only provided seven third party applications and five internet sites to establish the relatedness of the goods which applicant argues is insufficient, especially given the size of the supplement industry as a whole. *Id.*

The issue with applicant's argument is that the Office has provided evidence that dietary supplements for pets and humans are related goods as they are regularly marketed together and branded under the same trademark. *See Exhibits to Initial Office dated September 12, 2017, Exhibits to Final Office Action dated April 13, 2018 and Exhibits to Request for Reconsideration Letter dated November 03, 2018* providing a total of eleven (11) examples of real world evidence and numerous third party marks on the register demonstrating that companies often offer dietary supplements for humans and pets under the same mark.

Additionally, applicant's suggestion that the amount of evidence provided is insufficient because the supplement industry is a \$621 million a year industry is unconvincing where the amount of evidence provided by the Office in this case (eleven examples of real world evidence and numerous third party registrations) is consistent with the amount of evidence normally provided to establish the relatedness of the goods.

Overall, the evidence the Office submitted demonstrates that applicant's goods and the goods in the cited registration are closely related. Thus, because marks are confusingly similar and the goods are closely related, consumers are likely to be confused as to the source of the goods.

CONCLUSION

A consumer encountering the mark VITAL FLORA (Standard Characters) in connection with applicant's goods will incorrectly believe that the goods originate from the same source as the registrant's goods under the mark FLORAVITAL (Standard Characters). For the reasons specified above, it is respectfully requested that the refusal to register the applied-for mark on the basis of a likelihood of confusion.

Respectfully submitted,

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