

This Opinion is Not a
Precedent of the TTAB

Mailed: January 4, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Probiohealth, LLC

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Serial No. 88933368

Alexander JSW Johnson of LegalZoom Legal Services,
for Probiohealth, LLC.

Caitlin Watts-FitzGerald, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Lykos, Coggins and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Probiohealth, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark PROBIOHEALTH for (as amended) “dietary probiotic supplements for pets; nutritional probiotic supplements” in International Class 5.¹

¹ Application Serial No. 88933368 was filed on May 26, 2020, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere at least as early as January 1, 2002, and first use in commerce at least as early as January 2, 2002.

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods identified in the Application, so resembles the marks  for “dietary and nutritional supplements” in International Class 5,² and  for “animal feed supplements; dietary pet supplements in the form of pet treats; dietary supplements for animals; dietary supplements for pets; dietary supplements for cats and dogs” in International Class 5,³ both registered on the Principal Register, to separate entities, as to be likely to cause confusion, mistake, or deception.

After the Trademark Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register based on likelihood of confusion with the  mark of the '998 Registration.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. The Examining Attorney requests that we take judicial notice of the online

² Registration No. 4214998 (the “998 Registration”) issued on September 25, 2012. Declaration of Use accepted; Declaration of Incontestability acknowledged. The registration contains the following description statement: “Color is not claimed as a feature of the mark. The mark consists of [a] Circle with [a] wave symbol inside followed by literal element ‘BioHealth’.”

³ Registration No. 4410202 (the “202 Registration”) issued on October 1, 2013; “Solutions” disclaimed. The registration contains the following description statement: “The color(s) blue, gray, and yellow is/are claimed as a feature of the mark. The mark consists of ‘bio’ in light blue, small letters with a yellow atomic symbol with a transparent interior at the dot of the ‘I’, with the word ‘health’ in dark blue, small letters, and with the word ‘SOLUTIONS’ capitalized, in gray and bracketed by gray, vertical bars.”

MERRIAM-WEBSTER dictionary definitions of PRO and PROBIOTIC attached to her brief. The request is granted. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014) (“The Board may take judicial notice of dictionary definitions ..., including online dictionaries that exist in printed format or have regular fixed editions.”), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Premiere Distillery LLC*, 103 USPQ2d 1483, 1484 n.2 (TTAB 2012) (judicial notice taken of definition submitted with examining attorney’s brief after appeal filed).

II. Likelihood of Confusion - Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331

(1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

Varying weights may be assigned to the various *DuPont* factors depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)) (citations omitted).

III. Likelihood of Confusion - Analysis

We now consider the arguments of Applicant and the Examining Attorney, the applicable law and the evidence of record. We find the  **BioHealth** mark in the '998 Registration for “dietary and nutritional supplements” to be the most relevant for our *DuPont* analysis, and we proceed accordingly. Since this is the most relevant registration, if we find a likelihood of confusion, we need not find it as to the  mark in the '202 Registration as well. On the other hand, if we do not reach that conclusion, we would not find likelihood of confusion as to the '202 Registration either. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity or Dissimilarity of Goods

The second *DuPont* factor considers “[t]he similarity or dissimilarity and nature of the goods ... described in an application or registration ...” 177 USPQ at 567. *See also, Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”).

Applicant’s goods are identified as “dietary probiotic supplements for pets; nutritional probiotic supplements.” Registrant’s goods are identified in the ’998 Registration as “dietary and nutritional supplements.” The Examining Attorney argues that the cited Registration uses broad wording that presumably encompasses all goods of the type described, including Applicant’s more narrow types of dietary and nutritional supplements which contain probiotics in their ingredients; such goods are well within the categories of Registrant’s goods.⁴ *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018). Thus, says the Examining Attorney, Applicant’s and Registrant’s goods are considered legally identical and therefore

⁴ Examining Attorney’s Brief, 13 TTABVUE 16. Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018).

overlapping.⁵ We agree. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)). Applicant does not dispute the legally identical nature of Applicant's and Registrant's goods in its brief.

The second *DuPont* factor supports a finding that confusion is likely.

B. Similarity or Dissimilarity of Trade Channels and Purchasers

The third *DuPont* factor assesses the similarity or dissimilarity of the parties' established, likely-to-continue trade channels and the class(es) of buyers to whom sales are made. *DuPont*, 177 USPQ at 567. Because Applicant's and Registrant's goods are legally identical, without restrictions as to nature, type, channels of trade, or classes of purchasers, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”). Thus, without regard to any evidence or argument of marketplace use, we must presume the trade channels and target purchasers are the same for Applicant's and Registrant's goods.

The third *DuPont* factor supports a finding that confusion is likely.

C. The Marks at Issue

In our evaluation of the similarity or dissimilarity of Applicant's and Registrant's marks, the first *DuPont* factor, *DuPont*, 177 USPQ at 567, we first consider the

⁵ *Id.*

strength of Registrant's mark and then compare the respective marks in their entireties.

1. Strength of the Cited Mark

Turning to the strength of Registrant's  **BioHealth** mark, which affects the scope of protection to which it is entitled, we consider the conceptual strength of Registrant's mark, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."). The commercial strength of Registrant's  **BioHealth** mark also is affected by the number and nature of third-party use of similar marks for similar goods. *DuPont*, 177 USPQ at 567.

As Registrant's mark is registered on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), it is presumed to be inherently distinctive for "dietary and nutritional supplements." *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). Nonetheless, Applicant asserts a multi-faceted argument in challenging the inherent distinctiveness of Registrant's mark.

First, Applicant contends that the BIO portion of Registrant's mark is inherently weak because it belongs to a crowded field of registered marks including this element in connection with supplements.⁶ There is merit to this part of Applicant's argument.

⁶ Applicant's Brief, 8 TTABVUE 15-16.

In support, Applicant made of record 82 use-based registrations of marks including the term BIO for dietary supplements.⁷ “Third-party registration evidence ... may bear on conceptual weakness if a term is commonly registered for similar goods ...” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017). That is, third-party registrations may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted). In view of Applicant’s submitted third-party registration evidence, we find that BIO is inherently weak and highly descriptive as a trademark element when used in connection with dietary supplements.

Second, Applicant asserts that HEALTH is merely descriptive, if not generic, and therefore “legally weak” (i.e., conceptually weak) in connection with Registrant’s goods.⁸ In support, Applicant made of record the definition of HEALTH from the online MERRIAM-WEBSTER dictionary as meaning “the condition of being sound in body, mind, or spirit; especially: freedom from physical disease or pain” or “a condition in which someone or something is thriving or doing well; well-being.” Since dietary and nutritional supplements purport to contribute to one’s health, the term HEALTH is, at a minimum, merely descriptive in connection with Registrant’s goods, and

⁷ Office Action Response of October 18, 2020, at TSDR 24-105.

⁸ Applicant’s Brief, 8 TTABVUE 16-17.

therefore conceptually weak. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (“[A] mark [or, in this case, a portion of a mark] is merely descriptive if it conveys information regarding a function, or purpose, or use of the goods.”) (internal quotations and citation omitted).⁹

Third, Applicant concludes in its brief that “the ubiquity of BIO marks in **use** on supplements weakens any protection the term is afforded, and HEALTH is legally weak, thus leaving a very weak combination capable of only minimal protection.”¹⁰ (Emphasis added). Regarding the trademark element BIO, this is an inaccurate reflection of the record. Actually, as discussed, Applicant’s proof is that BIO has been ubiquitously **registered** for supplements, which pertains to alleged conceptual weakness, not purported commercial weakness, of Registrant’s mark.

⁹ Applicant also provided a list of 734 third-party use-based registrations for marks containing the term HEALTH and identifying supplements in International Class 5. Office Action Response of October 18, 2020, at TSDR 106-107. Third-party registrations may not be made of record by merely listing them in response to an Office Action. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2021) and cases cited therein. The proper way to submit third-party registrations into the record is to submit a copy of the registrations themselves, or the electronic equivalent thereof from the USPTO’s electronic databases. See *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record). We will, however, consider this information provided by Applicant because the Examining Attorney did not object to the list and did not inform Applicant that it could cure the insufficiency by submitting copies of the registrations prior to filing its appeal. See TBMP § 1208.02 (under such circumstances, “the examining attorney will be deemed to have waived any objection to consideration of the list itself”). “The Board[, however,] will not consider more than the information provided by the applicant.” *Id.* Since Applicant did not provide the goods identified in each of these listed registrations, the list has very limited probative value. See *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 n.6 (TTAB 2011) (Board considered TESS listings for whatever probative value they had).

¹⁰ Applicant’s Brief, 8 TTABVUE 17.

In any event, we cannot agree with Applicant's syllogistic logic. Merely because Applicant demonstrated that the element BIO is conceptually weak on the federal register for supplements, and that the element HEALTH (by way of a dictionary definition) is merely descriptive of supplements and also conceptually weak, does not mean that the combination BIOHEALTH is inherently or conceptually weak as a trademark for these goods.

As we stated above, because Registrant's mark of the '998 Registration is registered on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), it is presumed to be inherently distinctive for dietary and nutritional supplements. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (“[I]nasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least suggestive and we cannot entertain applicant's argument that the registered mark is descriptive of registrant's services.”). The cited '998 Registration thus carries with it presumption that Registrant's mark “conveys a[] distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515-16 (TTAB 2016) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2003)). Applicant has not made evidence of record sufficient to convince us that that the literal portion of Registrant's mark as a whole (the combined term BIOHEALTH) is anything but inherently distinctive for dietary and nutritional supplements.

Even if Applicant had succeeded in convincing us that Registrant's mark is inherently weak (which it has not), such marks are nevertheless still entitled to protection under Trademark Act Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) ("Confusion is confusion. The likelihood thereof is to be avoided, as much between 'weak' marks as between 'strong' marks ...").

As to the fame (or commercial strength) of Registrant's  mark, in an ex parte appeal the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). For that reason, "in an ex parte analysis of the *DuPont* factors for determining likelihood of confusion ..., the 'fame of the mark' factor is normally treated as neutral when no evidence as to fame has been provided." TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(ix) (2021); *see also In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006) (fame is not normally a factor in ex parte proceedings).

Turning now to the commercial strength of Registrant's mark, we look to the evidence regarding the number and nature of third-party use of similar marks for similar goods. *DuPont*, 177 USPQ at 567. Applicant, however, provided no evidence as to the third-party use of any marks having both BIO and HEALTH as combined elements in connection with dietary or nutritional supplements. Thus, because there

is no evidence of record to diminish the commercial strength of the cited  mark, this factor is neutral.

We therefore find that Registrant's mark of the '998 Registration is afforded the normal scope of protection provided to an inherently distinctive mark.

2. The Similarity or Dissimilarity of the Marks

We determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). "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) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must instead rely upon their recollections, which may be imperfect. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). "The proper test[, therefore,] 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 persons who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted).

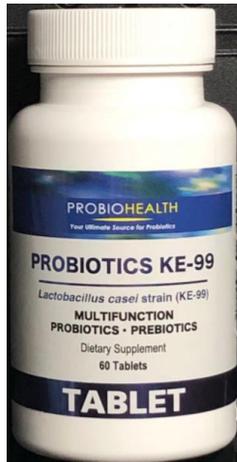
The respective marks "must be considered ... in light of the fallibility of memory" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014)

(quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, the focus is on the recollection of the average purchaser, here, a buyer of dietary or nutritional supplements (whether for human consumption or for pets), who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Further, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Applicant and the Examining Attorney express very different viewpoints on how we should consider Applicant's mark under the so-called "anti-dissection rule" and its exceptions as outlined above. Applicant argues that we should contemplate the commercial impression of its mark as "PROBIO HEALTH," connoting gastrointestinal and digestive wellbeing; whereas the literal portion of Registrant's mark, BIOHEALTH, connotes general life health.¹¹ In support of its position, Applicant made the following evidence of record:

- The definition of PROBIOTIC from MERRIAM-WEBSTER, as meaning "a microorganism ... that when consumed (as in a food or a dietary supplement) maintains or restores beneficial bacteria to the digestive tract; also[,] a product or preparation that contains such microorganisms."¹²
- A copy of Applicant's specimen of use submitted in support of its Application:



13

¹¹ Applicant's Brief, 8 TTABVUE 8-10.

¹² Office Action Response of October 18, 2020, at TSDR 108-112. Applicant provided a similar definition from Google search results. Request for Reconsideration of May 4, 2021, at TSDR 43. One definition was sufficient.

¹³ Specimen, at TSDR 2; *see also* Request for Reconsideration of May 4, 2021, at TSDR 40-42.

- 17 third-party registrations (some accompanied by specimens of use) for marks including the term PROBIO for human and/or animal supplements, five of which specifically recite “probiotic” in the Identification of Goods.¹⁴
- Captures of 19 third-party websites promoting for sale probiotic dietary and/or nutritional supplements whose product names include the term PROBIO or PRO-BIO.¹⁵
- Google search results for the term PROBIO, wherein the results of the search mention the term PROBIOTIC.¹⁶
- Amazon search results for the term PROBIO, wherein the results of the search show the promotion for sale probiotic dietary and/or nutritional supplements whose product names include the term PROBIO or PRO-BIO.¹⁷
- Articles discussing probiotics products, their uses, and their benefits:
 - Brand campaigns from the producers of ACTIVA yogurt, SYNERGY raw kombucha, and CHOBANI yogurt.¹⁸
 - “Probiotics: What You Need To Know” from the National Center for Complementary and Integrative Health.¹⁹

¹⁴ Request for Reconsideration of May 4, 2021, at TSDR 45-76. We do not consider Reg. No. 3005793 for the mark PROBIO, *id.* at TSDR 44, because the mark is registered for unrelated goods (that is, not dietary or nutritional supplements for human or animal consumption). Collectively, we find these third-party registrations only show that PROBIO is a conceptually weakened trademark formative for dietary and nutritional supplements. This is not relevant because PROBIO is not part of the mark in the cited '998 Registration.

¹⁵ *Id.* at TSDR 77-122. Collectively, we find these third-party uses to be relevant only to show that PROBIO or PRO-BIO is a commercially weakened trademark formative for dietary and nutritional supplements. Again, this is not relevant because PROBIO is not part of the mark in the cited '998 Registration.

¹⁶ *Id.* at TSDR 123-124. We give little probative value to these search results in our analysis, however, because they do not contain sufficient context to be meaningful. *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations”); *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.4 (TTAB 2013) (Google search engine results had “limited probative value”; insufficient text to show context).

¹⁷ *Id.* at TSDR 125-143. Collectively, we find these third-party uses on Amazon to be relevant only to show that PROBIO or PRO-BIO is a commercially weakened trademark formative for dietary and nutritional supplements. Once more, this is not relevant because PROBIO is not part of the mark in the cited '998 Registration.

¹⁸ *Id.* at TSDR 144-160.

¹⁹ *Id.* at TSDR 161-165.

- Articles discussing popular probiotics products from SMARTER REVIEWS, WOMEN’S HEALTH, MEDICAL NEWS TODAY, HARVARD HEALTH PUBLISHING, MD LINX, and CLEVELAND CLINIC.²⁰
- An article titled “Probiotics: Reiterating What They Are and What They Are Not” from FRONTIERS IN MICROBIOLOGY.²¹
- A USPTO database search for and copies of 100 third-party trademark registrations in which probiotic food and supplement products are listed in the identification of goods.²²
- A USPTO database search for and copies of 100 third-party trademark registrations in which both human and animal supplements products are listed in the identification of goods.²³

The Examining Attorney argues that we should view the commercial impression of Applicant’s mark as “PRO BIOHEALTH,” which comprises the whole of the literal and pronounceable element of Registrant’s BIOHEALTH mark; with Applicant having merely added a modifier or prefix, PRO, to the registered mark.²⁴ Further, says the Examining Attorney, the added term PRO has a descriptive or prefix-like meaning when Applicant’s mark is taken as a whole, because (1) PRO is defined as shorthand for PROFESSIONAL, and (2) PRO is commonly understood by consumers as shorthand for PROFESSIONAL due to use in this fashion by supplements producers in the marketplace. Therefore, the addition of PRO to BIOHEALTH would not be sufficient to differentiate Applicant’s and Registrant’s marks in the eyes of

²⁰ *Id.* at TSDR 278-316.

²¹ *Id.* at TSDR 317-324.

²² *Id.* at TSDR 166-277. For the reasons discussed in note 9 above, we give very limited probative value to the database search results.

²³ *Id.* at TSDR 325-450. Again, for the reasons discussed in note 9 above, we give very limited probative value to the database search results. Collectively, we find these third-party registrations to be relevant only to show that human and animal supplements products for the same marks are of a type that may emanate from a single source.

²⁴ Examining Attorney’s Brief, 13 TTABVUE 5

consumers – particularly when the marks are associated with legally identical goods.²⁵ In support of the Examining Attorney’s position, the following evidence was made of record:

- Definition of the term PRO from the MERRIAM-WEBSTER online dictionary as meaning a shortened form of “professional.”²⁶
- Five examples in which suppliers of dietary and nutritional supplements (three for human consumption, two for animal consumption) add the term PRO to their marks for an apparently related line of products:²⁷
 - JYM / PRO JYM
 - XTEND / XTEND PRO
 - HYDROXYCUT / PRO CLINICAL HYDROXYCUT
 - PURINA / PURINA PRO PLAN
 - CANINE PLUS / CANINE MULTI PRO

The evidence of record supports Applicant’s argument that PROBIO is an accepted shortened form in the supplements industry of the term “Probiotic,” and that a probiotic product contains microorganisms which when consumed maintains or restores beneficial bacteria to the digestive tract. The evidentiary record also supports the Examining Attorney’s argument that PRO is a shortened form of the term “Professional,” and that at least some suppliers of dietary and nutritional supplements for human or animal consumption add the term PRO to their marks for an apparently related line of products. The Examining Attorney’s evidence, however, does not lead us to a finding or conclusion that these suppliers use the term PRO in

²⁵ *Id.* at 4 and 6.

²⁶ *Id.* at 20-30. Applicant concedes: “If the Examiner is looking to prove that PRO is often used to mean professional, that is fine. Applicant agrees, it is not even debatable.” Applicant’s Brief, 8 TTABVUE 13.

²⁷ Denial of Request for Reconsideration of May 27, 2021 at TSDR 8-54.

this fashion to indicate that their products are “professional” or are designated for “professional” (as opposed to ordinary consumer) use – much less that consumers understand this distinction from the suppliers’ uses of PRO.

Notwithstanding the evidentiary support for the arguments summarized immediately above, Applicant and the Examining Attorney are talking past one another; entirely missing the point when comparing marks for likelihood of confusion purposes. Applicant asks us to consider the commercial impression of its mark one way (i.e., “PROBIO HEALTH”), the Examining Attorney requests that we consider the commercial impression of the mark another way (i.e., “PRO BIOHEALTH”).

As we stated above, Applicant’s mark and Registrant’s mark must be compared in their entireties:

PROBIOHEALTH vs. 

in appearance, sound, connotation and commercial impression. Similarity as to any one of these elements may be sufficient to find the marks similar for likelihood of confusion purposes. Average consumers typically will not be able to make side-by-side comparisons between the marks, relying instead upon their imperfect, fallible recollections.

Our analysis cannot be based on dissecting the marks into their various components, which both Applicant and the Examining Attorney are asking us to do; just in different ways. The essential question we must answer is whether the marks, as a whole, are sufficiently similar when used in connection with legally identical

goods such that consumers are likely to confuse the sources of the products associated with the marks. We find that they are.

Applicant's addition of PRO to the literal portion of Registrant's mark generally does not obviate the visual or aural similarity between the compared marks, nor does it overcome a likelihood of confusion. *See In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar, despite the addition of an arbitrary term before the commonly held word TITAN). That Applicant intends its mark would be perceived otherwise is not controlling. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1412 (TTAB 2015) ("Regardless of how Applicant ... intends to promote its mark ..., we find that the marks, when used in connection with the goods as set forth in the identifications of goods, would be perceived similarly."), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

As to meaning, consumers who are familiar with Registrant's BIOHEALTH dietary and nutritional supplements who then encounter Applicant's PROBIOHEALTH mark for nutritional probiotic supplements may think Applicant's supplements are a product line extension of Registrant's supplements. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *7 (TTAB 2019) ("ROAD WARRIOR looks, sounds, and conveys the impression of being a line extension of WARRIOR"); *Joel Gott Wines LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) ("Purchasers of opposer's GOTT and JOEL GOTT wines are likely to assume that applicant's goods, sold under the mark GOTT LIGHT and design, are merely a line extension of goods emanating from opposer").

As noted above, Applicant also points to the additional textual matter appearing on the packaging (bottle) for its product, serving to educate consumers that PROBIOHEALTH means and pertains to probiotic products. This argument is of no assistance to Applicant's position. *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1147, 227 U.S.P.Q. 541, 543 (Fed. Cir. 1985) (“[A] distinction in trade dress cannot weigh against likelihood of confusion with respect to the registration of a simple word mark The reason is that such dress might well be changed at any time; only the word mark itself is to be registered.”).

Before we leave the subject of comparing Applicant's and Registrant's marks, two aspects deserve mention. First, the circle and wave design in Registrant's mark does not distinguish it from Applicant's mark, because is not likely to be perceived as a unique element given its subtle presentation. *See In re Max Capital*, 93 USPQ2d at 1248 (holding applicant's mark, MAX with pillar design, and registrant's mark, MAX, likely to cause confusion, noting that the “addition of a column design to the cited mark ... is not sufficient to convey that [the] marks ... identify different sources for legally identical insurance services”).

Moreover, where, as here, both words and a design comprise a mark, the words are normally accorded greater weight because they are more likely to make an impression upon purchasers, would be remembered by them, and would be used by them to call for or discuss the goods. *See In re Viterra*, 101 USPQ2d at 1912 (citing *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) (“[I]n a

composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”)).

Second, the stylization of the lettering in Registrant’s mark also does not distinguish it from Applicant’s mark. Because Applicant seeks to register its mark in standard characters, Applicant is not limited to any particular depiction of its mark; it may be displayed in any lettering style; the rights reside in the wording and not in any particular display. *Viterra*, 101 USPQ2d at 1909; *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009). Thus, Applicant may display its PROBIOHEALTH mark in the identical font style, size and color in which the literal element of Registrant’s mark is shown. *See* Trademark Rule 2.52(a); 37 C.F.R. § 2.52(a).

We find that when compared in their entirety, the similarities between Applicant’s and Registrant’s marks in appearance, sound, meaning and commercial impression support a finding that confusion is likely.

D. The Absence of Actual Confusion

Applicant argues that its mark and Registrant’s mark have co-existed in the marketplace for nine years without evidence of actual confusion, and that this is a factor to be considered as pointing to a conclusion that confusion as being unlikely.²⁸ Normally, the lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965) (“Absence of

²⁸ Applicant’s Brief, 8 TTABVUE 8, 21; citing to the Declaration of a member of Applicant, testifying as to the absence of confusion. Request for Reconsideration of May 4, 2021 at TSDR 451.

proof of actual confusion is of minor relevancy in the resolution of the issue [of likelihood of confusion].”). The issue before us is the likelihood of confusion, not actual confusion. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018).

Moreover, “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). We have here no evidence of whether the extent and circumstances of Applicant’s and Registrant’s uses of their respective marks has been such as to give rise to meaningful opportunities for actual confusion to occur. *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). We find therefore find the absence of actual confusion to be a neutral factor as to whether confusion is likely.

E. Other Considerations

The thirteenth *DuPont* factor considers “[a]ny other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. Applicant argues that the co-existence of the  mark of the '998 Registration and the  mark of the '202 Registration on the Principal Register, issued to two different owners, shows that “neither registrant is the sole user of the term BIOHEALTH, and each ... [m]ark is evidence that the other is weak and deserving a narrow scope of protection, presumably based on the minor visual differences in the logos.”²⁹ Applicant further urges “[t]his is of particular importance because the ...

²⁹ Applicant’s Brief, 8 TTABVUE 19.

[registrations for the two m]arks claim goods that overlap or are at minimum highly related.”³⁰ On its face, Applicant’s argument is a further attempt to weaken the scope of protection to both cited marks based on the registration practices of the USPTO. The logical conclusion Applicant wishes us to draw from this argument is that Applicant’s PROBIOHEALTH mark and identified goods should be allowed to co-exist on the Principal Register as well.

There are two problems with Applicant’s argument. First, prior decisions and actions of other Examining Attorneys have little evidentiary value and are not binding upon the USPTO or the Board. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits. ... Even if some prior registrations had some characteristics similar to ... [the subject] application, the [US]PTO’s allowance of such prior registrations does not bind the Board”). While the USPTO strives for consistency, each case must be decided on its own facts and record. *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (quoting *In re Boulevard Entm’t*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003)). Second, as already mentioned, even marks that are deemed arguably “weak” are still entitled to protection under Trademark Act Section 2(d) against the registration by a subsequent user of a similar mark for goods that are legally identical, as is the case here. *See King Candy*, 182 USPQ at 109; *In re Max Capital*, 93 USPQ2d at 1246.

³⁰ *Id.*

We find the co-existence of the marks of the '998 and '202 Registrations on the Principal Register does not justify registration of Applicant's mark under the circumstances presented in this appeal.

IV. Likelihood of Confusion - Conclusion

Applicant's and Registrant's goods, as identified in the subject Application and '998 Registration, are legally identical, such that we may presume the marks travel in overlapping channels of trade, and are directed to the same general class of purchasers. Registrant's mark is inherently distinctive, thus being afforded the normal scope of protection given to such marks. Applicant's evidence fails to support a finding that the cited mark of the '998 Registration is conceptually or commercially weak. The marks at issue are similar in appearance, sound, meaning and commercial impression; particularly considering the close relationship between the identified goods. We find the absence of reported instances of actual confusion to be a neutral factor in our analysis. The co-existence on the Principal Register of the marks shown in the cited '998 and '202 Registrations does not justify the issuance of a registration to Applicant for a confusingly similar mark in connection with legally identical goods. Balancing these factors for which there has been evidence and argument, we find that confusion is likely between Applicant's mark and the cited mark of the '998 Registration in connection with the respective goods of interest.

Decision

The refusal to register Applicant's PROBIOHEALTH mark is affirmed under Trademark Act Section 2(d), on the ground of likelihood of confusion with the

Serial No. 88933368

 mark of the '998 Registration. In view of our determination, we need

not consider the  mark of the cited '202 Registration.