To:	TIMOTHY D PECSENYE(pecsenye@blankrome.com)
Subject:	U.S. Trademark Application Serial No. 90460533 - INTRINSIC - 160809-00101 - Examiner Brief
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Attachments

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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 90460533

Mark: INTRINSIC

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Applicant: INTRINSIC BRANDS, INC.

Reference/Docket No. 160809-00101

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark INTRINSIC for, as amended, "consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands; online retail store services featuring consumer health and wellness products; advertising and marketing, in Class 35; private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands; consultation and development services for health and wellness eCommerce businesses and brands, in Class 36." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052 (d) in

part as to "consumer product and brand acquisition" and "private equity, namely, private equity investment services, asset and investment acquisition and development and consulting services related thereto" for the mark having a likelihood of confusion with three prior registrations. Registration was also refused because applicant's specimens do not show the applied-for mark as actually used in commerce in connection with any of the relevant services. Additionally, applicant was required to provide a definite recitation of services which is within the scope of the original recitation of services.

INITIAL OBJECTION

As an initial matter, applicant has submitted new evidence with its appeal brief. Specifically, internet screenshots including those of applicant's website and of lists of other businesses.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re tapio GmbH*, 2020 USPQ2d 11387, at *3-4 (TTAB 2020); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *2 (TTAB 2020); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

The examining attorney does not object to applicant's submission of the dictionary definition.

FACTS

Applicant filed the instant application, Serial No. 90/460533, on January 12, 2021 seeking to register the mark INTRINSIC for "consumer product and brand acquisition; private equity; consumer products and online retail store services featuring consumer goods; advertising and marketing" in Class 35. Applicant filed an amendment to allege use on March 24, 2021.

On July 22, 2021, the examining attorney issued an Office action refusing registration under Trademark Act Section 2(d) in part as to "consumer product and brand acquisition; private equity" based upon a likelihood of confusion with three prior registrations. The three prior registrations are:

(1) Reg. no. 3974139 INTRINSIC RESEARCH SYSTEMS INC. and design for services which include "Providing an on-line computer database in the field of stock/securities market information; Providing investors with financial information; Providing stock/securities market information."

(2) Reg. no. 4255196 INTRINSIC WEALTH COUNSEL for "Financial planning; Investment advisory services."

(3) Reg. no. 3689820 INTRINSIK for services which include "Business consulting services in the field of pharmaceuticals, food and health; business management services; business consulting services in the field of the environment; risk assessment services, namely, business risk assessment; risk management services, namely, business risk management."

An advisory was also provided in regards to two prior pending applications which later abandoned, and so any issue as to those applications was later withdrawn as moot. Further, applicant was notified that applicant's recitation of services was so broad that it was extremely difficult to do a full search of Office records for confusingly similar marks. Applicant ultimately limited the recitation of services in such as way that no future search of Office records was necessary. Thus, the notice regarding a future search of Office records was rendered moot. Additionally, registration was refused because the specimen did not show the applied-for mark as actually used in commerce in connection with any of the relevant services in classes 35 or 36. Applicant was required to submit a definite recitation of services and was advised that as to "consumer products" in the phrase "consumer products and online retail store services featuring consumer goods" that identification would not, if it comprised the entire identification, be sufficiently specific enough to entitle the application to a filing date, thus, that wording was not considered part of the application.

On January 24, 2022, applicant amended its services to "consumer product and brand acquisition, namely, consultation in the field of business acquisitions and product acquisitions being the negotiation and procurement of contracts for the purchase and sale of consumer products and brands; online retail store services featuring consumer products; advertising and marketing; private equity, namely, private equity investment services, asset and investment acquisition and development and consulting services

related thereto." Applicant did not present any other evidence, argument or specimen.

On February 11, 2022, the examining attorney issued an Office action making final (1) the partial Section 2(d) refusal; (2) the specimen refusal and (3) the requirement for a definite and properly classified recitation of services. The partial Section 2d refusal was noted to be limited to the following, based upon the manner in which applicant amended its recitation of services: “consumer product and brand acquisition” and “private equity, namely, private equity investment services, asset and investment acquisition and development and consulting services related thereto.” The examining attorney also explained that "consumer product and brand acquisition, namely, consultation in the field of business acquisitions and product acquisitions being the negotiation and procurement of contracts for the purchase and sale of consumer products and brands" was beyond the scope of the original recitation because there is no consultation listed in the original recitation and such was limited to actual consumer product and brand acquisition itself.

Applicant filed a request for reconsideration on August 11, 2022, amending the services to "consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands; online retail store services featuring consumer health and wellness products; advertising and marketing, in class 35; private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands; consultation and development services for health and wellness eCommerce businesses and brands, in class 36." Applicant also provided a substitute specimen and argued against the partial Section 2(d) refusal.

Applicant also filed a notice of appeal on such date.

The examining attorney denied the request for reconsideration as to all issues on August 16, 2022. As to the services, the examining attorney noted that as to "consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands", the activities of "launching, building and growing" again exceeded the scope of the original recitation. Further, the wording "consultation and development services for health and wellness eCommerce businesses and brands" exceeded the scope of the original recitation.

After various procedural filings, on November 8, 2022, applicant filed an appeal brief which was accepted by the Board. The case was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.142(b) on November 14, 2022.

ISSUES

The three issues on appeal in this case are (1) whether there is a likelihood of confusion between applicant's mark and three prior registered marks as to a portion of applicant's services; (2) whether applicant's recitation of services is sufficiently definite and within the scope of the original recitation of services; and (3) whether applicant's specimens show proper use of the mark in commerce with the relevant services.

ARGUMENT

I. CONFUSION IS LIKELY BETWEEN APPLICANT'S MARK COMPRISED SOLELY OF "INTRINSIC" AND THE PRIOR REGISTERED MARKS "INTRINSIC RESEARCH SYSTEMS INC.", "INTRINSIC WEALTH COUNSEL" AND "INTRINSIK."

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). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at

1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

A. COMPARISON 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 Fondee 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)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant's mark is INTRINSIC.

The first two cited registered marks are:

3974139 INTRINSIC RESEARCH SYSTEMS INC. and design
4255196 INTRINSIC WEALTH COUNSEL

Applicant's mark is entirely incorporated in the registered marks. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (holding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at

*6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Applicant argues that the added wording in these marks is sufficient to obviate the likelihood of confusion. This argument is not persuasive. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). In this case, all of the wording but for INTRINSIC in the registered marks is descriptive and disclaimed. Therefore, the most significant part of the marks to consumers is INTRINSIC, which is the entirety of applicant's mark.

Applicant argues that the design element in reg. no. 3974139 is sufficient to avoid confusion between the marks. When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *41 (TTAB 2022) (quoting *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Thus, the design element in this registered mark is

insufficient to obviate the likelihood of confusion.

The mark in reg. no. 3689820 is INTRINSIK. The marks INTRINSIK and INTRINSIC are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv). Applicant argues that the change from K to C avoids confusion here. These marks differ by only one letter and that change does not alter the meaning or connotation of the marks. The minor spelling difference does not avoid confusion between these phonetically equivalent marks.

Therefore, the marks are confusingly similar in commercial impression.

Applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording INTRINSIC to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. These registrations appear to be predominantly for goods and/or services similar to those identified in applicant's application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

Here, although the marks all contain INTRINSIC, the other wording in nearly all of the third-party registrations changes the commercial impression of those marks. The vast majority of them

feature the well known phrase "INTRINSIC VALUE," which has a meaning as a phrase which alters the connotation of those marks separate and apart from INTRINSIC. One mark is an entirely different phrase "INTRINSIC CALM IN THE CHAOS DM 2." Indeed, the only truly close mark is reg. no. 4574446 INTRINSIC SERVICES, which is for the highly dissimilar services "Providing cost-effective residuals management solutions for municipal and industrial water and wastewater treatment plant." Applicant has not shown that the word INTRINSIC is so diluted for these services as to be entitled to minimal protection. Further, as to the cited registrations themselves co-existing, INTRINSIK is for different services than the other two cited registrations and those two cited registrations have differing wording from one another. Applicant's mark does not contain any other wording and is comprised solely of INTRINSIC.

B. COMPARISON OF THE SERVICES

The services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared services 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).

The final Section 2(d) refusal in this application did not apply to applicant's "online retail store services featuring consumer health and wellness products; advertising and marketing, in class 35."

Applicant's remaining amended recitation of services is "consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands, in Class 35; private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands; consultation and development services for health and wellness eCommerce businesses and brands, in Class 36."

As discussed at length in the recitation of services section below, the following wording is beyond the scope of the original recitation of services and so is not properly part of the recitation of services: "launching, building and growing" and "consultation and development services for health and wellness eCommerce businesses and brands." Thus, the effective recitation of services at issue is "consumer product and brand acquisition, namely, acquiring health and wellness eCommerce businesses and brands, in Class 35; private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands, in Class 36."

The services in reg. no. 3974139 include "Providing an on-line computer database in the field of stock/securities market information; Providing investors with financial information; Providing stock/securities market information."

The services in reg. no. 4255196 are: "Financial planning; Investment advisory services."

Applicant has listed "private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands."

Private equity is:
"money invested in private companies whose shares cannot be bought on the stock exchange"

"Private equity (PE) typically refers to investment funds, generally organized as limited partnerships, that buy and restructure companies. More formally, private equity is a type of equity and one of the asset classes consisting of equity securities and debt in operating companies that are not publicly traded on a stock exchange."

"Securities" are: "documents showing that you own shares in a company."

See the dictionary definitions attached to the first and final Office actions.

The services in reg. no. 4255196, "Financial planning; Investment advisory services," are not limited by type and encompass those relating to private equity.

The "Providing investors with financial information" services in reg. no. 3974139 are not limited and encompass those related to private equity. As to this registrant's remaining services, "Providing an on-line computer database in the field of stock/securities market information; Providing stock/securities market information," it is apparent from the definitions above that "securities" encompass private equity, which is a type of security. Additionally, neither of the registrations has a limitation as to field, therefore, they must be considered to encompass such financial services in the health and wellness eCommerce field.

Applicant thus has overlapping private equity investment types of services. Therefore, these services must be considered highly similar if not identical to registrants' services.

The services in reg. no. 3689820 include "Business consulting services in the field of pharmaceuticals, food and health; business management services; risk assessment services, namely, business risk assessment; risk management services, namely, business risk management."

Applicant has "consumer product and brand acquisition, namely, acquiring health and wellness eCommerce businesses and brands." Applicant never properly amended this recitation of services and so it is not clear exactly what this service involves. In any event, registrant's business consulting and management services encompass business consulting and management regarding eCommerce brand and consumer product acquisition in the field of health and wellness. Therefore, the services must be considered to be highly similar.

Accordingly, the services would be provided to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the services originate from the same source.

Applicant argues that its services are in a different field and trade channel than registrants' services because its services are unique services in the eCommerce aggregation industry with only a few competitors in the market. Applicant alleges that registrants' services are not remotely related to this field. This argument is not persuasive.

Determining likelihood of confusion is based on the description of the services stated in the application and registrations at issue. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Registrants' services are broadly described and encompass those in the field of health and wellness eCommerce businesses and brands. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Thus, applicant's and registrants' services must be considered to be in the same field.

Additionally, the goods and/or services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *49. Thus, applicant's and registrants' services are related.

Applicant argues that no evidence was provided to support the refusals, but no evidence is required where by definition the services overlap. Furthermore, as to the class 35 services, applicant itself created a situation where evidence was impossible to gather because applicant refused to provide a definite and clear recitation of services. Applicant cannot then turn around and allege no evidence was provided when applicant itself has not provided proper services to compare.

Applicant also argues that confusion is avoided because the respective consumers are sophisticated.

This argument is not persuasive. 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), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019).

The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

II. APPLICANT'S AMENDED RECITATION OF SERVICES IS INDEFINITE AND BEYOND THE SCOPE OF THE ORIGINAL RECITATION OF SERVICES IN PART.

Applicants are required to provide definite and clear recitations of their services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Moreover, although an applicant's services may be clarified or limited, they may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06.

In the instant case, applicant's original recitation of services was:

consumer product and brand acquisition; private equity; consumer products and online retail store

services featuring consumer goods; advertising and marketing" in class 35.

The examining attorney found that "consumer products" in the phrase "consumer products and online retail store services featuring consumer goods" would not, if it comprised the entire identification, be sufficiently specific to entitle the application to a filing date. TMEP §1402.02. Accordingly, this wording was not considered part of the application and was disregarded for the purpose of determining the scope of permissible amendments to the identification. Id. Thus, the effective original recitation of services was:

consumer product and brand acquisition; private equity; online retail store services featuring consumer goods; advertising and marketing, in Class 35.

Applicant's latest amended recitation of services is:

consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands; online retail store services featuring consumer health and wellness products; advertising and marketing, in class 35

private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands; **consultation and development services for health and wellness eCommerce businesses and brands**, in class 36.
(problematic portions emphasized in bold)

The examining attorney determined that as to the class 35 services "consumer product and brand acquisition, namely, acquiring, launching, building and growing health and wellness eCommerce businesses and brands", the activities of "launching, building and growing" exceed the scope of the original recitation. The application originally identified the relevant services as "consumer product and brand acquisition." "Launching, building and growing" activities go beyond the "acquisition" of consumer products and brands. Thus, these activities must be deleted. In addition to the scope issue, the service of "acquiring" remains indefinite and applicant was required to clarify the actual service provided for others. Applicant was advised that acquiring consumer products and brands for one's own

company is not a service in trade. Based upon prior suggestions to applicant, this entry could be amended as follows, if accurate: procuring of contracts for the purchase and sale of consumer products and brands in the health and wellness eCommerce field, in class 35; negotiation of business contracts for others for the purpose of consumer product and brand acquisition in the health and wellness eCommerce field, in class 35.

The examining attorney notes that the following portion of class 35 is acceptable: online retail store services featuring consumer health and wellness products; advertising and marketing, in class 35

Applicant argues that "launching, building and growing" are "natural extensions" of acquiring products and brands as well as being the purpose of such activity. Scope is not determined by what is a natural extension or purpose of a service. It is determined by which wording applicant actually used to describe its services in the original recitation as such provides notice to others of what is being claimed. Following applicant's logic, the first step would be the product/brand acquisition and then the subsequent steps would be the launching, building and growing of the brand. Applicant applied listing only the first step. Applicant may not now claim all of the additional steps involved in the process. These subsequent activities are beyond the scope of "acquisition." As to whether "acquisition"/"acquiring" name a clear service, applicant provided a definition of acquisition as "the act of acquiring something; something or someone acquired or gained." The examining attorney does not object to this definition, however, such merely refers back to itself. To further clarify the meaning, the term "acquire" is defined as:

1. To gain possession of: acquire 100 shares of stock.
2. To get by one's own efforts: acquire proficiency in math.
3. To gain through experience; come by: acquired a growing dislike of television sitcoms.
4. To locate (a target) with an aiming device or a tracking system, such as radar.

The trademark examining attorney requests that the Trademark Trial and Appeal Board take judicial notice of the attached evidence from The American Heritage Dictionary of the English Language. TBMP §1208.04; *see also* Fed. R. Evid. 201; 37 C.F.R. §2.122(a). By definition, "acquire" does not

encompass launching, building or growing services. Thus, applicant's arguments are not persuasive.

The examining attorney determined that the class 36 services "consultation and development services for health and wellness eCommerce businesses and brands" exceed the scope of the original recitation of services. The application originally identified the relevant services as "consumer product and brand acquisition; private equity; advertising and marketing." There are no such consultation and development services listed in the original recitation. Thus, this wording must be deleted.

The examining attorney notes that the following portion of class 36 is acceptable: private equity, namely, private equity fund investment services for health and wellness eCommerce businesses and brands in class 36.

Applicant argues that "consultation and development services" are "natural extensions" of "consumer product and brand acquisitions," "advertising and marketing" and "private equity fund investment services." As discussed above, scope it not determined by what a natural extension of a service might or might not potentially be, but rather by what applicant actually listed. Applicant did not list any such consultation or development services. Applicant's argument is not persuasive.

III. APPLICANT'S SPECIMENS DO NOT SHOW PROPER USE OF THE MARK IN COMMERCE WITH APPLICANT'S RELEVANT CLASS 35 AND CLASS 36 SERVICES.

Registration was refused in this case because the specimens do not show the applied-for mark as actually used in commerce in connection with any of the definite and within scope services specified in classes 35 and 36. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

The following criteria have evolved for determining what constitutes a service: (1) a service must be a real activity; (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service. *See* TMEP §1301.01(a); *In re Canadian Pac. Ltd.*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Res., Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Commc'ns, Inc.*, 204 USPQ 692 (TTAB 1979). Applicant's original specimen appears to be an advertisement on applicant's own behalf to buy other companies/brands. See the following excerpts from such specimen: "We buy e-commerce brands focused on health and wellness..."; "We are consumer health experts and entrepreneurs, with over 100 years combined experience building, acquiring and growing companies in the health & wellness space." Advertising on one's own behalf is not a service in trade for others. Similarly, acquiring assets/products/brands for applicant's own use is not a service in trade. This specimen is merely applicant's method of trying to buy brands for its own use. This is not a service in trade performed for others. As such, applicant has not shown use with any of the services performed for others listed in the class 35 or class 36 recitation of services. *See* TMEP §§904.07(b), 1301.01 *et seq; In re Dr Pepper Co.*, 836 F.2d 508, 509-510, 5 USPQ2d 1207, 1208-1209 (Fed. Cir. 1987); *In re Canadian Pac. Ltd.*, 754 F.2d 992, 994-95, 224 USPQ 971, 973 (Fed. Cir. 1985).

Based upon applicant's assertion that the substitute specimens are not a website screenshot, the examining attorney withdraws any requirement for a specimen URL or date of access. However, the core problem remains. The substitute specimens also do not clearly refer to any of the actual definite services which applicant lists. While the specimens refer to an eCommerce acquisition and growth platform, "growth" is unclear and is also not properly part of applicant's recitation of services as discussed above. As also discussed above, "acquisition" is unclear and indefinite. As in the first specimen, this appears to be an activity performed for applicant's own benefit.

Applicant argues that the clarification to its recitation of services resolves the specimen issue. This is

because applicant amended the recitation to add additional services that are beyond the scope of the original recitation, in a clear attempt to encompass what is stated within the specimen. The specimens do not show use of the mark in commerce with any properly described services which are within the scope of the original recitation of services.

CONCLUSION

Based upon the foregoing, the examining attorney requests that the refusal to register under Trademark Act Section 2(d), the specimen refusal and the requirement for a definite recitation of services all be affirmed.

Respectfully submitted,

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ac·quire (ə-kwīr′)

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tr.v. **ac·quired, ac·quir·ing, ac·quires**

1. To gain possession of: *acquire 100 shares of stock.*
2. To get by one's own efforts: *acquire proficiency in math.*
3. To gain through experience; come by: *acquired a growing dislike of television sitcoms.*
4. To locate (a target) with an aiming device or a tracking system, such as radar.

[Middle English *acquere*, from Old French *aquerre*, from Latin *acquīrere*, to add to : *ad-*, ad- + *quaerere*, to seek, get.]

ac·quir′a·ble *adj.*
ac·quir′er *n.*

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on January 11, 2023 for
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A USPTO examining attorney has issued an appeal brief. Follow the steps below.

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