Mailed: July 12, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

Health Plus, Inc.
v.
Tran Enterprises, LLC

_____

Opposition No. 91190785
to application Serial No. 77710866

_____

C. Dennis Loomis and Karen Law of Baker and Hostetler, LLP for Health Plus, Inc.

Lan Q. Ngo of Ngo Law PLLC for Tran Enterprises, LLC.

_____

Before Seeherman, Cataldo and Wolfson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On April 9, 2009 applicant, Tran Enterprises, LLC, filed an application to register on the Principal Register the standard character mark COLON CLEANSE MOVE IT, based upon its assertion of a bona fide intent to use the mark in commerce for "dietary food supplements," in International Class 5.[1]

[1] Application Serial No. 77710866. Applicant has disclaimed "COLON CLEANSE."

Registration has been opposed by Health Plus, Inc. ("opposer"). As grounds for opposition, opposer asserts that it is the owner of the following family of famous COLON CLEANSE marks, previously used and registered on the Principal Register:

COLON CLEANSE (typed drawing)[2]

for "bulk forming fiber laxative" in International Class 5;[3]

SUPER COLON CLEANSE DAY (typed drawing) for "vitamins, nutritional supplements and herbal supplements for use as beauty aids" in International Class 5;[4]

SUPER COLON CLEANSE (typed drawing)

for "vitamins, nutritional supplements and herbal supplements for use as beauty aids" in International Class 5;[5] and

SUPER COLON CLEANSE NIGHT (typed drawing) for "vitamins, nutritional supplements and herbal supplements for use as beauty aids" in International Class 5.[6]

---

[2] Marks displayed in typed drawing form currently are referred to as being displayed in "standard characters."
[3] Registration No. 1600268 issued on June 12, 1990. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Second renewal.
[4] Registration No. 2337303 issued on April 4, 2000 with a disclaimer of SUPER and DAY. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.
[5] Registration No. 2337304 issued on April 4, 2000 with a disclaimer of SUPER. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.
[6] Registration No. 2339827 issued on April 11, 2000 with a disclaimer of SUPER and NIGHT. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

Opposer alleges that it has made use of its COLON CLEANSE marks in connection with the above listed goods since prior to any date of first use upon which applicant may rely; and that applicant's mark, when used in connection with applicant's goods, so resembles opposer's family of COLON CLEANSE marks for its recited goods as to be likely to cause confusion, to cause mistake, and to deceive. Opposer further alleges that its COLON CLEANSE marks are famous and became famous long prior to applicant's acquisition of any rights in its involved mark; and that use by applicant of its involved mark is likely to cause dilution of the distinctive quality of opposer's famous COLON CLEANSE marks.

Applicant, in its informal answer, generally denies the salient allegations contained in the notice of opposition and presents arguments which are construed as amplifications of such denials.

The Record

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case consists of the pleadings and the file of the involved application. In addition, during its assigned testimony period opposer submitted the testimony depositions, with exhibits, of its chief operating officer and vice president, Mr. Sunil Kohli; its legal counsel, Ms. Shelly Kohli; and the chief executive officer of third-party health food and nutritional supplement companies BNG

Enterprises and Fusion Formulations LLC, Mr. Bradley Grossman. In addition, opposer submitted a notice of reliance upon two printed articles.

During its assigned testimony period, applicant submitted the testimony deposition, with exhibits, of its president, Mr. Bau Tran.[7]

Only opposer filed a brief.

Opposer's Standing and Priority of Use

Because opposer has properly made its four pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's mark. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods covered in those registrations. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

[7] Opposer's evidentiary objections to an exhibit introduced by applicant during the cross-examination of Mr. Kohli and the direct examination of Mr. Tran are noted. However, the exhibit sought to be excluded is not outcome determinative. Given this fact, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the objections raised by opposer, and we have accorded whatever probative value the subject testimony and exhibits merit.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Family of Marks

Opposer has pleaded and argues that it owns a family of COLON CLEANSE marks for the goods recited in its pleaded registrations. However, the requisite showing of a family of marks has not been made. The fact that opposer has used and registered several marks incorporating the wording COLON CLEANSE is not in itself sufficient to establish the existence of a family of marks. See J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). As stated by the Court: "There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." J & J Snack Foods, supra at 1891. Accordingly, opposer must demonstrate that the marks asserted to comprise

the family, or a number of them, have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See Truescents LLC v. Ride Skin Care LLC, 81 USPQ2d 1334 (TTAB 2006) citing American Standard, Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978).

In this case, however, opposer has not submitted sufficient evidence that it has promoted its COLON CLEANSE marks together to the public. In that regard, opposer's evidence consists of copies of labels attached to its goods and what appear to be proofs for printed advertisements therefor,[8] as well as very limited testimony in support thereof.[9] While this evidence supports a finding that opposer tends to market goods under its COLON CLEANSE and SUPER COLON CLEANSE marks together, opposer has only introduced copies of three proofs for advertisements in which its pleaded SUPER COLON CLEANSE DAY and SUPER COLON CLEANSE NIGHT marks appear together or with its other marks. Further, opposer has only provided cursory testimony, lacking details regarding the manner and extent to which its pleaded marks are marketed together to create common

[8] Sunil Kohli Testimony, p. 15-16, Exhibits 5-31.
[9] Id., and Bradley Testimony, p. 11.

exposure thereto among consumers and recognition of common ownership based upon the COLON CLEANSE feature. See Truescents, supra. In short, there simply is insufficient evidence of public exposure to opposer's marks in such a manner that demonstrates recognition of common ownership thereof.

Therefore, we will determine the issue of likelihood of confusion based on the individual marks that are the subject of opposer's pleaded registrations. In our analysis, we will concentrate our discussion of the issue of likelihood of confusion on the registration of opposer's for the mark most similar to that of applicant, namely, Registration No. 1600268 for the mark COLON CLEANSE in typed form for "bulk forming fiber laxative" in International Class 5.

Fame of Opposer's COLON CLEANSE Mark

We turn next to the fifth du Pont factor, which requires us to consider evidence of the fame of opposer's COLON CLEANSE mark and to give great weight to such evidence if it exists. See Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); Recot Inc. v. Becton, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

> Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of

> balancing the DuPont factors," Recot, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." Id. This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. Id. Indeed, "[a] strong mark … casts a long shadow which competitors must avoid." Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." Id.

Bose Corp. v. QSC Audio Products Inc., supra, 63 USPQ2d at 1305.

Upon careful review of the record in this case, we are not persuaded that opposer's COLON CLEANSE mark is famous. It is the duty of a plaintiff asserting that its mark is famous to clearly prove it.

In support of the claim that its COLON CLEANSE mark is famous, opposer has testified and introduced evidence of the following: it has used COLON CLEANSE continuously since at least 1988 in connection with the goods recited in its pleaded registrations;[10] between 2002 and September 2009, opposer sold over $54 million worth of goods under the COLON CLEANSE mark;[11] opposer advertises in such general circulation magazines as Readers Digest, Oprah, Redbook, and Health, and on such nationally broadcast television shows as *Wheel of Fortune*, *Jeopardy*, *Oprah*, and *Entertainment*

[10] Sunil Kohli Testimony, p. 9-15.
[11] Sunil Kohli Testimony, Exhibit 35.

Tonight;[12] opposer further has promoted its COLON CLEANSE mark at between 12 and 20 trade shows annually since 1986;[13] opposer has spent over $1 million on trade advertising alone between 2002 and 2009;[14] in 2010, opposer spent approximately $57,000 on advertisements with its distributors and $500,000 on advertisements in trade magazines for retailers such as Whole Foods, Vitamin Retailer and Natural Products Marketplace as well as the consumer magazines *Taste for Life* and *Natural Solutions*;[15] in 2008, these advertisements and opposer's Internet advertisements resulted in over one billion consumer impressions;[16] opposer's COLON CLEANSE products have been discussed by third parties in articles appearing in *Remedies for Life*, *Chain Drugstore Marketplace* and *Vitamin Retailer*;[17] and representatives of health food stores such as General Nutrition Center recommend opposer's COLON CLEANSE products.[18]

This testimony and evidence demonstrates that opposer has expended a great deal of effort in marketing its goods under its COLON CLEANSE mark, has enjoyed considerable

[12] Sunil Kohli Testimony, p. 29-30, Exhibit 35.
[13] Id.
[14] Sunil Kohli Testimony, Exhibit 32.
[15] Sunil Kohli Testimony, p. 35-38, Exhibits 33, 34.
[16] Sunil Kohli Testimony, p. 29-30, Exhibit 34.
[17] Sunil Kohli Testimony, p. 18, Exhibit 11; Notice of Reliance Exhibits A, B.
[18] Bradley Testimony, p. 14-16.

success for its efforts, and has received media recognition at least in trade and niche publications in its field. However, such evidence falls short of demonstrating the extent to which such efforts and recognition translate into widespread recognition of the COLON CLEANSE mark among the general public. In addition, opposer's annual sales and advertising figures are very low, compared to annual advertising figures for other marks we have found to be famous. See, for example, Motion Picture Association of America, Inc. v. Respect Sportswear Inc., 83 USPQ2d 1555 (TTAB 2007)(opposer's member annually spent 4 billion dollars on advertisements and promotion).

Accordingly, we find on this record that the evidence is insufficient to establish that opposer's COLON CLEANSE mark is famous for purposes of our likelihood of confusion determination. Nevertheless, we find that the evidence is sufficient to show that opposer's COLON CLEANSE mark has achieved at least some degree of recognition and strength in the nutritional supplement market and that the mark is therefore entitled to a broader scope of protection than might be accorded a mark with less recognition.[19]

[19] While we have discussed the evidence of fame relating to opposer's COLON CLEANSE mark, we also point out that the evidence regarding opposer's other marks is insufficient to show that they are famous.

Applicant's Mark and Opposer's COLON CLEANSE Mark

We turn then to the first du Pont factor, i.e., whether applicant's mark and opposer's COLON CLEANSE mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See Palm Bay Imports, Inc. v. Veuve Clicquot, supra. The test, under the first du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

In this case, applicant's COLON CLEANSE MOVE IT mark wholly incorporates opposer's COLON CLEANSE mark.[20] Likelihood of confusion is often found where the entirety of one mark is incorporated within another. In re Denisi, 225

[20] We note that applicant voluntarily disclaimed the wording "COLON CLEANSE" in its mark. As the wording of the disclaimer indicates (i.e., "no claim is made to the exclusive right to use … *apart from the mark as shown*" – *emphasis added*), the disclaimer of matter in a mark does not have the effect of removing the matter from the mark. *Bordon, Inc. v. W.R. Grace & Co.*, 180 USPQ 157 (TTAB 1973). Thus, a disclaimer is of no legal significance in determining likelihood of confusion, rather, the disclaimed matter must be considered. *See Kellogg Co. v. Pack "Em Enterprises Inc.*, 14 USPQ 2d 1545 (TTAB 1990); and *Glamorene Products Corporation v. Boyle-Midway, Inc., et. al.*, 188 USPQ 145 (DCSDNY 1975). Moreover, the public viewing the mark is unaware of what, if any, portions of a mark may be disclaimed in a federal registration. *See In re National Data Corp.,* 224 USPQ 749 (Fed. Cir. 1985).

USPQ 624, 626 (TTAB 1985); Johnson Publishing Co. v. International Development Ltd., 221 USPQ 155, 156 (TTAB 1982); and In re South Bend Toy Manufacturing Company, Inc., 218 USPQ 479, 480 (TTAB 1983).

Moreover, the significance of COLON CLEANSE in applicant's mark COLON CLEANSE MOVE IT is reinforced by its location as the first portion of the mark. Presto Products Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). See also Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Further, consumers are often known to use shortened forms of names, and it is foreseeable that applicant's goods will be referred to as COLON CLEANSE. Cf. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) [Rich, J., concurring: "the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words"].

As a result, we find that, taken as a whole, applicant's COLON CLEANSE MOVE IT mark and opposer's COLON CLEANSE mark are far more similar than dissimilar in appearance and sound. In addition, the marks convey a sense

of digestive regularity, both with regard to the common wording COLON CLEANSE as well as the wording MOVE IT in applicant's mark that reinforces the wording COLON CLEANSE as well as the result that the goods identified under the marks are intended to achieve. Accordingly, the marks are similar in connotation and convey highly similar overall commercial impressions.

In view thereof, this du Pont factor favors opposer.

The Goods

The goods identified in opposer's Registration No. 1600268 for the mark COLON CLEANSE are identified as a "bulk forming fiber laxative" in International Class 5. Applicant's goods under its mark are identified as "dietary food supplements," in International Class 5. We note that the labels and advertisement proofs for opposer's goods identify them as a "dietary supplement."[21] In addition, applicant has introduced testimony indicating that the "dietary food supplements" bearing its COLON CLEANSE MOVE IT mark are intended to promote "bowel movement."[22]

In other words, the record in this case supports a finding that opposer's narrowly identified "bulk forming fiber laxative" is a type of dietary supplement, and that applicant's more broadly identified "dietary food

[21] Sunil Kohli Testimony, p. 15-16, Exhibits 5-31.
[22] Tran Testimony, p. 10-13.

supplements" are in fact intended to be used as a laxative. We find, therefore, that applicant's goods under its mark encompass opposer's goods under its COLON CLEANSE mark.

In view of the legally identical nature of opposer's goods and applicant's goods, this du Pont factor also favors opposer.

Channels of Trade

Because we have found that applicant's identification of goods encompasses opposer's goods, and because there are no recited restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are or will be available in all the normal channels of trade to all the usual consumers of such goods, and that the channels of trade and the purchasers for the parties' goods overlap. See Interstate Brands Corp. v. McKee Foods Corp., 53 USPQ2d 1910 (TTAB 2000). See also Octocom Systems, Inc. v. Houston Computers Services Inc., supra ("The authority is legion that the 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 the sales of goods are directed.") See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases

involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

We find that, as a result of the foregoing, this du Pont factor also favors opposer.

Applicant's Intent

Next, opposer points out that applicant has admitted that its selection of the COLON CLEANSE MOVE IT mark, and the filing of its involved application, was made with actual knowledge of opposer, its COLON CLEANSE marks and businesses. To the extent that opposer is arguing that applicant adopted its mark in bad faith, there is insufficient evidence to show or from we which we can infer this. Mere knowledge of the existence of opposer's mark does not, in and of itself, constitute bad faith. See Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ 1307 (Fed. Cir 1989) ; Ava Enterprises, Inc. v. Audio Boss USA, Inc., 77 USPQ2d 1783 (TTAB 2006). The record in this case simply does not show that applicant intentionally sought to trade on opposer's good will.

Summary

We have carefully considered all of the evidence pertaining to priority of use and the relevant du Pont factors, as well as all of the arguments with respect

thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established its standing to bring this proceeding; its priority of use; and that consumers familiar with opposer's goods under its COLON CLEANSE mark would be likely to believe, upon encountering applicant's involved COLON CLEANSE MOVE IT mark for its recited goods, that the parties' goods originate with or are associated with or sponsored by the same entity. In making our determination, we have balanced the relevant du Pont factors. In particular, the factors of the similarity between the marks and the similarity of the goods weigh strongly in opposer's favor.

Dilution

Given our determination above that opposer has failed to prove the fame of its marks for purposes of its likelihood of confusion claim, opposer cannot show that its mark is famous for dilution purposes and thus cannot meet its burden of proving dilution. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); and Coach Services Inc. v. Triumph Learning LLC, 96 USPQ2d 1600, 1610 (TTAB 2010)("Fame for likelihood of confusion and dilution is not the same. Fame <u>for dilution requires a more stringent showing.</u>")

DECISION: The opposition is sustained on the ground of priority and likelihood of confusion.