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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91199191
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:

Serial No.: 79/076,683

Mark: "NATROX" and design

International Class 1

CHEMICALS AS RAW MATERIALS FOR COSMETICS AND THE FOOD AND PHARMACEUTICAL INDUSTRIES, MAINLY COMPRISING PLANT EXTRACTS; ACTIVE CHEMICAL INGREDIENTS USED IN COSMETIC FORMULATION; MINERAL SALTS, NAMELY, MAGNESIUM SALTS

International Class 3

SOAPS; PERFUMES; COSMETICS; ESSENTIAL OILS; ODORIFEROUS SUBSTANCES, NAMELY, BODY SPRAYS USED AS PERSONAL DEODORANTS AND AS FRAGRANCE, PERFUMERY; COSMETICS IN GALENIC FORM AND MAINLY CONTAINING PLANT EXTRACTS, NOT FOR MEDICAL PURPOSES; PLANT AND HERB EXTRACTS SOLD AS COMPONENTS OF COSMETICS FOR BEAUTY AND SKIN, BODY, FACIAL, HAIR OR NAIL CARE, IN THE FORM OF CAPSULES, TABLETS, AMPULES, YEAST, POWDERS, BARS, CREAMS OR BEVERAGES

Published: September 28, 2010

KEMIN INDUSTRIES, INC.,)	
)	
Opposer)	
)	Opposition No. 91199191
v.)	
)	
NATUREX S.A.,)	
)	
Applicant)	

OPPOSER’S BRIEF

I. INTRODUCTION

On March 28, 2011, pursuant to 37 C.F.R. § 2.101, Kemin Industries, Inc. (hereinafter “Opposer” or “Kemin”) filed the instant Opposition to the registration of the proposed mark “NATROX,” and Design in International Classes 1 and 3, Application Serial Number 79/076,683, by NATUREX, S.A., (hereinafter “Applicant”) in light of Opposer’s mark “NATUROX.” NATUROX has clear priority over NATROX, and the two marks are highly similar and likely to cause confusion in the marketplace.

There is a likelihood of confusion when the relevant goods or services are related, especially if the marks are identical or nearly identical. Both Opposer’s and Applicant’s marks cover chemical preparations used in animal feeds, which are sold in the same channels of trade to the same consumers. Opposer thus seeks an Order from the Board denying registration of Applicant’s confusingly similar NATROX mark.

II. STATEMENT OF FACTS

Kemin Industries is a corporation organized and existing under the laws of the State of Iowa with its principal office located at 2100 Maury Street, Des Moines, Iowa 50301. Kemin is a provider of a wide variety of human and animal health and nutrition products, including ingredients used in human foods and animal feeds, which are sold under the mark NATUROX. Kemin first used the mark NATUROX in connection with its goods and services at least as early as September 30, 1992, and applied for registration of NATUROX with the USPTO on July 14, 2003, and registration was subsequently granted on June 15, 2004 as United States Trademark Registration No. 2,853,283.

Applicant, Naturex S.A. filed a trademark application on October 1, 2009 for the proposed mark “NATROX” for “chemicals as raw materials for cosmetics and the food and pharmaceutical industries, mainly comprising plant extracts; active chemical ingredients used in cosmetic formulation; mineral salts, namely, magnesium salts,” in International Class 1 and “soaps; perfumes; cosmetics; essential oils; odoriferous substances, namely, body sprays used as personal deodorants and as fragrance, perfumery; cosmetics in galenic form and mainly containing plant extracts, not for medical purposes; plant and herb extracts sold as components of cosmetics for beauty and skin, body, facial, hair or nail care, in the form of capsules, tablets, ampules, yeast, powders, bars, creams or beverages” in International Class 3.

On March 28, 2011 Opposer filed its opposition to the registration of the proposed mark in light of Opposer’s mark NATUROX in Class 1 for “human food and animal feed preservatives in the nature of a natural antioxidant” which has a first use date of September 30, 1992 and a registration date of June 15, 2004. The instant action followed.

III. ARGUMENT

A. Opposer's Mark NATUROX has Priority over NATROX.

NATUROX has clear priority over Applicant's mark. To establish priority, Opposer must establish proprietary rights. Otto Roth & Co v. Universal Foods Corp., 640 F.2d 1317 (CCPA 1981). These rights may arise from a prior registration, prior trademark use, prior use as a trade name, prior use analogous to trademark use, or any other use sufficient to establish proprietary rights. Id. Opposer has shown substantial use of its mark in interstate commerce well in advance of Applicant's priority date.

Opposer first used the mark NATUROX in connection with its goods and services at least as early as September 30, 1992, and used the mark in commerce at least as early as September 30, 1992. Opposer applied for, and was granted registration of NATUROX with the USPTO on July 14, 2003, and registration was granted on June 15, 2004. Applicants' mark NATROX has a priority date of April 17, 2009.

B. Under the DuPont Factors, There is a Likelihood of Confusion Between NATROX and NATUROX.

The registration of NATROX should be denied because the mark is confusingly similar to Opposer's NATUROX mark. Section 2(d) of the Trademark Act provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the Principal Register on account of its nature unless . . . (d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or to cause mistake, or to deceive. . .

Opposition actions are adjudicated under the same Federal Circuit approach used for § 2(d) likelihood of confusion analysis, because the Federal Circuit is the primary reviewing court

T.T.A.B. and has found the test to apply equally to both registration and the marketplace. Carl Karcher Enters., Inc. v. Stars Rests. Corp., 35 U.S.P.Q.2d 1125, 1133 (T.T.A.B. 1995), *citing Application of E. I. DuPont DeNemours & Co.*: “[u]nder the statute the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of the marks of an applicant and a prior user on their respective goods.” 476 F.2d 1357, 1360 (C.C.P.A. 1973). The Federal Circuit’s likelihood of confusion analysis of related goods is “a question of law, based on findings of relevant underlying facts, namely findings under the DuPont factors.” M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1381 (Fed. Cir. 2006); DuPont 476 F.2d at 1361. The enumerated DuPont factors used to determine a likelihood of confusion in a trademark opposition are:

(1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and (13) any other established fact probative of the effect of use.

See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 946 (Fed. Cir. 2000).

The relevant factors are analyzed below. Id. at 947 (Fed. Cir. 2000) (The Board can satisfy the “DuPont test by considering each of the DuPont factors for which evidence was presented in the record.”). The basic principle that the Court follows in determining confusion

between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985). The relevant DuPont factors indicate a strong likelihood of confusion between NATROX and NATUROX, particularly under the first, second, fifth and tenth DuPont factors, and Applicant's registration should therefore be denied.

(1) DuPont Factor One: The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression.

The first DuPont factor weighs heavily for a finding of likelihood of confusion because NATUROX and NATROX are highly similar in appearance, sound, connotation, and commercial impression as they differ by only a single letter "u" in the center of the mark. The similarity inquiry examines the relevant features of the marks, including appearance, sound, connotation, and commercial impression. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565 (Fed. Cir. 1983). This examination is done in light of the recollection of the average purchaser, who "normally retains a general, rather than a specific, impression of trademarks." Barbara's Bakery, Inc. v. Barbara Landesman, 82 U.S.P.Q.2d 1283 (T.T.A.B. 2007).

The two marks at issue in the present case are so highly similar that a likelihood of confusion is extremely likely. Under this factor, the "test is not whether the marks can be differentiated in a side-by-side comparison, but whether they are so similar in their overall commercial impression that confusion is likely to result." 4 McCarthy on Trademarks and Unfair Competition § 24:43 (4th ed.). That is certainly the case here: both marks begin with "NAT-," contain an "R" and end with the distinctive "-OX" letter combination, and differ by only one single letter. See Sabinsa Corp. v. Creative Compounds, LLC, 609 F.3d 175, 184 (3d Cir. 2010) cert. denied, 131 S. Ct. 960 (U.S. 2011) (Finding the marks "ForsLean" and "Forsthin"

phonetically and visually similar because they “share all but three letters, have the same dominant syllable and end letter, and have the same number of syllables.”), and Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 926 (10th Cir.1986) (finding “Beer Nuts” and “Brew Nuts” to be confusingly similar because “beer” and “brew” are both one-syllable words beginning with “b,” three of four letters are identical, and because the word “brew,” as used, means “beer”).

This factor weighs heavily in favor of a § 2(d) rejection, and relates to the second factor, because Applicant’s mark NATROX is both highly similar to Opposor’s NATUROX, and the two marks are both being used on animal feeds.

(2) DuPont Factor Two: The similarity or dissimilarity and nature of the goods or services as described in the application or registration of in connection with which a prior mark is in use.

There is strong likelihood of confusion between NATROX and NATUROX under the second DuPont factor because the goods to be covered by the NATROX mark are substantially identical to those described in the NATUROX registration as to animal feed additives. This second, “related goods” factor “compares the goods and services in the applicant's application with the goods and services in the Opposer's registration.” Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1267 (Fed. Cir. 2002). The goods designated by the mark need not be identical to create a likelihood of confusion, because “[e]ven if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.” Id. See also In re Save Venice New York, Inc., 259 F.3d 1346, 1355 (Fed. Cir. 2001) (“The ‘related goods’ test measures whether a reasonably prudent consumer would believe that non-competitive but related goods

sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.”).

At issue is whether the use of the goods as applied to animal feed additives will confuse the public as to the source of the goods, not whether the goods will be confused with each other. Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 1404 (C.C.P.A. 1975). Where the marks under consideration have similar appearance, sound, connotation, and commercial impression, as in the instant case, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. Amcor, Inc. v. Amcor Industries, Inc., 210 U.S.P.Q. 70, 78 (TTAB 1981).

Applicant is attempting to register the mark NATROX for use on the same type of goods being sold by Opposer: additives used in the preparation of food. The Federal Circuit has determined that where the Opposer owns a registration, one only compares the goods as listed in Opposer’s registration with the goods listed in the applicant’s application. See CBS, Inc. v. Morrow, 708 F.2d 1579 (Fed. Cir. 1983). Applicant applied for their mark for “chemicals as *raw materials* for cosmetics and the *food* and pharmaceutical industries, mainly comprising plant extracts; active chemical ingredients used in cosmetic formulation; mineral salts, namely, magnesium salts,” and “soaps; perfumes; cosmetics; essential oils; odoriferous substances, namely, body sprays used as personal deodorants and as fragrance, perfumery; cosmetics in galenic form and mainly containing plant extracts, not for medical purposes; plant and herb extracts sold as components of cosmetics for beauty and skin, body, facial, hair or nail care, in the form of capsules, tablets, ampules, yeast, powders, bars, creams or beverages” (emphasis added). Opposer’s registration is for “*human food and animal feed preservatives* in the nature of

a natural antioxidant” (emphasis added). There is thus a strong likelihood of confusion because Applicant seeks to register NATROX to be used as an additive to food during preparation, and thus the nature of the goods sought to be registered in the application are highly similar to those in the NATUROX registration.

Applicant’s proposed use of NATROX for additives used in food preparation is thus extremely similar to the established use of NATUROX for animal food additives and creates a strong likelihood of confusion as to the source of the goods. Coupled with the similarity of the marks, this weighs heavily in favor of a finding of likelihood of confusion under DuPont analysis. In re SL&E Training Stable, Inc., 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008) (“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.”). Therefore, Applicant’s registration should be refused.

(3) Factor Three: The similarity or dissimilarity of established, likely-to-continue trade channels.

There is a strong likelihood of confusion under the third DuPont factor: the similarity of the trade channels for NATROX and NATUROX because they are presumed to move in the same channels of trade. Without an express limitation in Applicant’s identification of the goods or services, the Board will presume that the goods move through all reasonable trade channels for such goods to all reasonable classes of consumers for such goods. 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:15 (4th ed.) (hereinafter “MCCARTHY”), Glamorene Products Corp. v. Procter & Gamble Co., 538 F.2d 894, 896 (C.C.P.A. 1976) (“The issue of likelihood of confusion must be resolved on the basis of the goods as broadly stated in [the] application for registration.”). Applicant provides no limitation in the application as to the trade channels for NATROX, and thus it is presumed to coexist with NATUROX in the

marketplace for companion animal food additives. There is thus a strong likelihood of confusion under the third DuPont factor.

(4) Factor Four: The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful sophisticated purchasing.

The sophistication of the consumers does not weigh against a finding of likelihood of confusion under the fourth DuPont factor. This factor normally attempts to determine the likelihood of confusion for a “reasonably prudent consumer.” In re Save Venice New York, Inc., 259 F.3d 1346, 1355 (Fed. Cir. 2001) (“The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.”). Opposer markets and sells NATUROX to manufacturers of companion animal feed to prevent oxidation in the animal foods. Based on Applicant’s registration, Applicant presumably seeks to market NATROX in animal feeds, i.e. the same market. Therefore, the reasonably prudent consumer in the instant case is a purchaser of additives for use in the manufacture of animal foods that may become confused as to the source of NATROX, and assume that it is either a substantially similar or complimentary animal food additive product manufactured by Opposer.

There is no evidence in the record to indicate the particular level of sophistication required to elevate these consumers to “discriminating purchasers” utilizing an enhanced level of care. Sally Beauty Co. v. Beautyco, Inc., 304 F.3d 964 (10th Cir. 2002) (“A sophisticated consumer is more likely to exercise a high level of care and less likely to be confused.”); MCCARTHY § 23:96 (“In making purchasing decisions regarding ‘expensive’ goods, the reasonably prudent person standard is elevated to the standard of the ‘discriminating

purchaser.’’). This lack of evidence (from either party) on the degree of care exercised by the purchasers thus does not favor either party in a determination of likelihood of confusion under the fourth DuPont factor.

(5) Factor Five: The Fame of Kemin’s Mark

The sales figures for Opposer’s mark indicate some degree of fame, and therefore the fifth DuPont factor weighs toward a finding of likelihood of confusion. The Federal Circuit has “consistently accepted statistics of sales and advertising as indicia of fame: when the numbers are large, we have tended to accept them without any further supporting proof.” Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002). As the evidence indicates, Opposer sold 4.8 million of pounds of NATUROX in 2011 alone. Opposer’s sales figures thus indicate a degree of fame in the mark, and thus there is thus a strong likelihood of confusion under the fifth DuPont factor. (Exhibits E and F).

(6) Factor Ten: The market interface between applicant and the owner of a prior mark

The tenth DuPont factor strongly favors the denial of registration for NATROX because Applicant agreed to a settlement with Opposer acknowledging the likelihood of confusion between the marks NATUROX and NATUREX, in which the Applicant agreed to “limit its use of its NATUREX trademark to house mark usage only (i.e., only in conjunction with other product names, and not as a separate product name) with respect to its antioxidant products[.]” (Exhibit I).

The tenth factor looks to evidence of, in relevant part “(b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party,” to determine if the parties’ conduct indicates a likelihood of confusion. When Applicant and Opposer agreed to the provisions of the settlement regarding the marks NATUROX and

NATUREX to preclude confusion strongly indicates that a likelihood of confusion exists between the marks at issue here, and that the Applicant's subsequent attempts to use the NATROX, which is equally similar to NATUROX, should not be allowed.

NATROX is thus confusingly similar to NATUROX under the tenth DuPont factor because the same likelihood of confusion exists between NATUROX and NATROX that exists between NATUROX and NATUREX – they each differ by a single vowel and look and sound strikingly similar. Moreover, Applicant was obviously aware of the similarities in the marks prior to applying for the NATROX mark, having already agreed to the likelihood of confusion with regards to the NATUREX mark.

The tenth DuPont factor therefore strongly weighs in favor of a finding of likelihood of confusion because Applicant's own conduct indicates efforts to preclude confusion. When the NATROX mark is applied to goods similar or identical to those sold by Opposer, it so nearly resembles Opposer's mark as to be likely to be confused with and mistaken for Opposer's mark, just as Applicant agreed that NATUREX did. Applicant's mark is deceptively similar to Opposer's mark so as to cause confusion and lead to deception as to the origin of Applicant's goods displaying the mark. Through widespread, continuous, and substantially exclusive use, Opposer has developed valuable goodwill in respect to the NATUROX mark among purchasers of animal feed additives. In determining likelihood of confusion, Opposer's logical zone of expansion into Applicant's goods may also be considered. CPG Products Corp. v. Perceptual Play, Inc., 221 U.S.P.Q. 88 (TTAB 1983). Should Applicant now be allowed to successfully register the mark NATROX, there is a possibility that a likelihood of confusion would arise amongst prospective purchasers of additives for use in the manufacture of foods, in that they

would assume that NATUROX and NATROX are members of a family of antioxidant additives from the same source.

Applicant should further be denied registration because in the settlement agreement, it concedes the validity of Opposer's mark, which is well known amongst purchasers of additives for use in the manufacture of animal foods. Opposer has been using NATUROX in connection with its goods and services in commerce for more than 20 years, beginning at least as early as September 30, 1992. Through Opposer's efforts and the expenditure of money, advertising, and promoting its goods identified by its NATUROX mark, and through the high quality of such goods, Opposer has gained an excellent and valuable reputation amongst these consumers. If Applicant is permitted to use and register its mark for its goods as set out in the subject application, confusion in the marketplace will occur and result in damage and injury to Opposer due to the similarity between Applicant's mark and Opposer's mark. Persons familiar with Opposer's mark would be likely to purchase Applicant's goods as, and for, a product made and sold by Opposer. Any such confusion in the marketplace would inevitable result in loss of sales to Opposer. Moreover, any defect, objection, or fault found with Applicant's products marketed under the subject trademark would necessarily reflect upon and seriously injure the reputation which Opposer has established for its products promoted and identified under its mark.

There is scant evidence to present on the remaining DuPont factors, thus they are of limited value in this application of the test and should therefore be given limited or no weight. Cunningham v. Laser Golf Corp., 222 F.3d at 947 (The Board can satisfy the "DuPont test by considering each of the DuPont factors for which evidence was presented in the record."). And finally, while there is no evidence of actual confusion, "it is black letter law that actual confusion need not be shown." Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867 (2nd

Cir. 1986). If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark and such registration would be a source of damage and injury to Opposer. Applicant's mark must not be registered as it is likely to cause confusion with Opposer's mark.

IV. Conclusion

Based on the foregoing, Opposer respectfully submits that there is a likelihood of confusion in the present matter. It is likely that customers purchasing Applicant's goods will believe that they are buying Opposer's animal feed additives, or that Opposer has expanded their animal feed product line and would be confused as to the source of the goods in the marketplace.

Accordingly, Opposer respectfully urges that the opposition be granted and the registration of Applicant's mark be denied.

Respectfully submitted,

KEMIN INDUSTRIES, INC.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing BRIEF ON MERITS FOR PLAINTIFF was served upon Defendant's counsel by first class mail postage pre-paid on.

Signed: /NatalieJHowlett/
Name: Natalie J. Howlett
Date: September 17, 2012