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

Proceeding	91221888
Party	Defendant Mad Maverick, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

SALUS Haus Dr. med. Otto Greither Nachf. GmbH & Co. KG Opposer, v. Mad Maverick, LLC Applicant	Opposition Nos.: 91221418 (Parent) 91221888 91222545 Serial No. 86/396,175
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APPLICANT’S MOTION TO AMEND ITS ANSWER

Applicant, Mad Maverick, LLC (“Mad Maverick”), pursuant to Rule 15(a) of the Federal Rules of Civil Procedure (“FRCP”) and Section 507.01 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), hereby moves for leave to amend its answer to add the affirmative defense of judicial estoppel. Applicant is submitting in conjunction with this motion an amended answer in Opp. Nos. 91/221,418 and 91/221,888.

PRELIMINARY STATEMENT

Opposer Salus Haus Dr. med. Otto Greither Nachf. GmbH & Co. KG (“Salus Haus”) is judicially estopped from arguing that there is a likelihood of confusion between U.S. Reg. No. 1,740,638, U.S. Reg. No. 1,568,679 and U.S. App. Ser. No. 79/115,624 (the Salus Haus SALUS marks) and U.S. App. Ser. Nos. 86/369,175 and 86/368,933 (the Mad Maverick SALUS marks) since Salus Haus successfully argued during the prosecution of the ‘624 mark that the ‘638 and ‘679 registrations “are for marks identical or nearly identical” to the ‘624 mark, “cover goods identical or substantially identical to

the goods covered by” the ‘624 mark, and that Mad Maverick’s SALUS marks were not likely to be confused with the ‘624 mark. The Trademark Office agreed with Salus Haus during prosecution of the ‘624 mark and removed the Section 2(d) refusal based on Mad Maverick’s SALUS marks. Now, nearly three years after Salus Haus argued against confusion with Mad Maverick’s SALUS marks, Salus Haus is asking the Trademark Trial and Appeal Board (the “Board”) to find that there is a likelihood of confusion between the Salus Haus SALUS marks and the Mad Maverick SALUS marks, in direct contradiction to the prior Salus Haus statements to the Trademark Office.

BACKGROUND OF PRIOR PROCEEDINGS

On July 6, 2012 Salus Haus filed U.S. Trademark Serial Number 79/115,624 for the mark SALUS, listing the goods of “Cosmetics, essential oils, cosmetic preparations for baths; sauna infusions” in Class 03; “Paraffin oils” in Class 04; “Medicines, sanitary preparations, dietetic products adapted for medical use; medicinal teas, particularly medicinal herbal teas; plant and fruit juices and vegetable juices as dietetic products for medical use; medicinal confectionery, particularly herbal sweets, vitamin tablets, compressed tablets for chewing and mineral compressed tablets; medicinal concentrates for baths, medicinal elixirs made with herbs and plants; medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicated soil; medicinal liniments, particularly aromatic pine alcohol; medicated bath preparations; therapeutic preparations for the bath” in Class 05; “Belts for massages” in class 10; “Vegetable juices for cooking” in class 29; “Teas, particularly aromatic teas, confectionery” in class 30; and “Fruit juices, vegetable juices as beverages, these products also as dietetic beverages not for medical purposes” in class 32.

On November 5, 2012, the Trademark Office issued an office action, rejecting the '624 mark based on U.S. Reg. Nos. 3,362,991 and 3,370,114 for the mark SALUS, among other cited registrations. Pages 1-9 of the office action are attached as Exhibit A. Specifically, the office action stated that “[t]he registrant’s commonly owned marks are: U.S. Registration No. 3362991 SALUS for retail store services featuring personal care products and cosmetics; U.S. Registration No. 3370114 SALUS for personal care products, essential oils and cosmetics.” The office action further stated that “the applicant’s goods are closely related to the registrants’ goods and services because the goods and services listed include cosmetics, personal care products, medical, pharmaceutical and therapeutic preparations, beverages and/or retail services featuring cosmetics and personal care products” and that “the applicant’s identification of cosmetics and cosmetic preparations is broad and may encompass the registrant’s more specific type of cosmetics, e.g. eye shadow, mascara, nail polish, lip gloss, etc. in U.S. Registration Nos. 3362991 and 3370114.”

As seen in attached Exhibit B, in response to the above rejection, on May 6, 2013, Salus Haus modified the goods in the '624 mark by deleting the Class 03 goods and changing the goods listed in Classes 05, 30, and 32, to: “Medicines for the treatment of aiding sleep and promoting digestion, sanitary preparations for medical use, dietetic products adapted for medical use, namely, dietetic supplement beverages for aiding sleep and promoting digestion and dietetic foods, namely, dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics; medicinal teas, namely, medicinal herbal teas; dietetic products, namely, plant and fruit juices and vegetable juices adapted for medical use; medicinal

confectionery, namely, herbal sweets, vitamin tablets, compressed vitamin and mineral tablets for chewing and mineral compressed tablets; medicinal concentrates for baths, medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicinal liniments, namely aromatic pine alcohol; medicated bath preparations; therapeutic medicated preparations for the bath, said goods excluding products for treating skin disorders or for use in dermatology,” “Teas, namely, aromatic and herbal teas” and “Fruit juices, vegetable juices as beverages, dietetic beverages, namely, fruit juice and vegetable juice not for medical purposes,” respectively. In the response, Salus Haus also states that Salus Haus’ ‘638 and ‘679 registrations “are for marks identical or nearly identical to the mark at issue and cover goods identical or substantially identical to the goods covered by the current application” and that “with the amendment, its mark is not likely to be confused with the mark in the ‘991 and ‘114 Registrations and that those registrations pose no obstacle to the registration of Applicant’s mark.” As seen in attached Exhibit C, the ‘991 and ‘114 registrations were registrations owned by Mad Maverick. The ‘991 and ‘114 registrations comprise the same goods and services as listed in the Mad Maverick SALUS marks.

On May 25, 2013, the Trademark Office issued the suspension notice as seen in attached Exhibit D, stating that “after further consideration of the applicant’s arguments, deletion of Class 003 and amended identification of goods in Class 005, the Section 2(d) *Likelihood of Confusion* refusal is withdrawn with respect to U.S. Registration Nos. 3362991 [and] ...3370114...” By asserting the Salus Haus SALUS marks against the Mad Maverick SALUS marks on April 8, 2015 and May 12, 2015, respectively, Salus Haus is asking the Board to expend significant resources and ignore the prior decision

in the '624 mark to arrive at a conclusion opposite to the decision reached in the May 25, 2013 suspension notice. The judicial system, including administrative proceedings and this Board, do not allow a litigant in the position of Salus Haus to play so fast and loose with the courts. In order to maintain the integrity of the Trademark Office, Salus Haus must be held to its earlier position.

ARGUMENT

A. Applicant Should be Granted Leave to Amend its Answer to Add the Affirmative Defense of Judicial Estoppel.

Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as the pleadings in a United States District Court civil action. 37 C.F.R. § 2.107(a). Pleadings in a United States District Court civil action may be amended with the court's leave. FRCP 15(a). Leave to amend shall be freely given by the court when justice so requires. FRCP 15(a). In interpreting this rule, the Supreme Court has stated:

If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason—such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing part by virtue of allowance of the amendment, futility of amendment, etc. —the leave sought should, as the rules require, be “freely given.”

Foman v. Davis, 371 U.S. 178, 182 (1962). In view of this position, the Trademark Trial and Appeal Board (TTAB) has liberally granted leave to amend when doing so would

not violate settled law and is not prejudicial to the other party. *ChaCha Search Inc. v. Grape Technology Group Inc.* 105 USPQ2d 1298, 1300 (TTAB 2012) (stating that “the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires...”) and *Microsoft Corp. v. Qantel Bus. Sys. Inc.*, 16 USPQ2d 1732, 1733 (T.T.A.B. 1990) (acknowledging that “the policy of granting leave is to be a liberal one”).

Leave to amend should be granted as there is no conceivable prejudice to Opposer in allowing Applicant to add judicial estoppel as an affirmative defense. Allowing the amendment will not prejudice Salus Haus because, as a party to the prosecution of the ‘624 mark, Salus Haus possesses all information relevant to the judicial estoppel defense. Furthermore, since Applicant is filing its motion for leave to amend before the opening of discovery, and promptly after the case was unsuspending and discussing the judicial estoppel defense during the discovery conference, the motion is timely. See, e.g., *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993); and *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992).

Granting leave to amend should also be granted as doing so would not violate settled law. Judicial estoppel applies to administrative proceedings. See *Data General Corp. v. Johnson*, 78 F.3d 1556 (Fed. Cir. 1996). Furthermore, “[a]lthough the Trademark Trial and Appeal Board is not a court, the Board has authority to apply the doctrine of judicial estoppel in appropriate cases.” *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999)(internal citations omitted). Finally, whether or not the moving party can actually prove the allegation(s) sought to

be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment. TMEP 507.02, citing *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989).

CONCLUSION

For the forgoing reasons, Applicant respectfully requests leave to amend its answer to add the affirmative defense of judicial estoppel.

Respectfully submitted,

Dated: /February 19, 2016/

By: /Shane Percival/

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EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 79115624

MARK: SALUS

79115624

CORRESPONDENT ADDRESS:

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CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jspx

APPLICANT: SALUS Haus Dr. med. Otto
Greither; Nachf ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 0570231

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Trademark Act Section 2(d) – Likelihood of Confusion Refusal

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3159326, with the commonly owned marks in U.S. Registration Nos. 3362991 and 3370114, and with the commonly owned marks in U.S. Registration Nos. 3677674 and 3677679. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); TMEP §1207.01; *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or 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, (a)(vi).

The applicant's mark is SALUS for various cosmetic and personal care preparations, medicines and medicinal products, teas, and fruit and vegetable juices.

The registrant's mark in U.S. Registration No. 3159326 is SALUS for drinking water.

The registrant's commonly owned marks are: U.S. Registration No. 3362991 SALUS for retail store services featuring personal care products and cosmetics; U.S. Registration No. 3370114 SALUS for personal care products, essential oils and cosmetics.

The registrant's commonly owned marks are: U.S. Registration No. 3677674 NEOSALUS plus design and U.S. Registration No. 3677679 NEOSALUS, both for dermatological pharmaceutical products; pharmaceutical preparations for treating skin disorders; pharmaceutical preparations for use in dermatology; pharmaceutical skin lotions.

Similarity of the Marks

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

Here, the applicant's mark is similar to the registrants' marks because the marks contain the similar term SALUS. In fact, the applicant's mark SALUS and the registered marks SALUS, SALUS and SALUS

are identical.

Although two of the registered marks also contain the prefix NEO, the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii).

Next, although one of the registered marks contains a design element, this portion of the mark is less significant under a Section 2(d) analysis. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such 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, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Both the applicant's mark and the registrants' marks feature the similar term SALUS, thereby creating the same overall commercial impression. Therefore, the marks are confusingly similar.

Similarity of the Goods and Services

The goods and/or services of the parties 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) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); *see On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Where the marks of the respective parties are identical or virtually identical, the relationship between the relevant goods and/or services need not be as close to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); TMEP §1207.01(a).

Here, the applicant's goods are closely related to the registrants' goods and services because the goods and services listed include cosmetics, personal care products, medical, pharmaceutical and therapeutic preparations, beverages and/or retail services featuring cosmetics and personal care products. Please see the identification of goods and services listed in the instant application and cited registrations.

The use of similar marks on or in connection with both products and retail-store services has been held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. *See In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (holding the use of similar marks both for jewelry and for retail-jewelry and mineral-store services was likely to cause confusion); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks both for coats and for retail outlets featuring camping and mountain climbing equipment, including coats, was likely to cause confusion, noting that “there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion”); *In re U.S. Shoe Corp.*, 8 USPQ2d 1938, 1939 (TTAB 1988) (holding the use of nearly identical marks both for leather cowboy boots and for retail western-, outdoor-, and leisure-clothing-store services featuring boots was likely to cause confusion); TMEP §1207.01(a)(ii).

Next, please see attached Internet from www.drinkarizona.com. This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods, i.e. teas, drinking water, juice drinks, diet juice drinks, and markets these goods under the same mark, the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and the goods are similar or complementary in terms of purpose or function. Therefore, applicant’s and registrant’s goods in U.S. Registration No. 3159326 are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Next, the applicant’s identification of medicines and dietetic products for medical use is broad and may encompass the registrant’s more specific type of pharmaceutical preparations for treating skin disorders or for use in dermatology in U.S. Registration Nos. 3677674 and 3677679. The Trademark Trial and Appeal Board and its primary reviewing court have used a stricter standard to determine likelihood of confusion for pharmaceuticals or medicinal products due to the potential harm or serious consequences that could be caused if the public confused one drug or medicinal product for another. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386-87, 173 USPQ 19, 21-22 (C.C.P.A. 1972); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB 1980); *Ethicon, Inc. v. Am. Cyanamid Co.*, 192 USPQ 647, 651-52 (TTAB 1976); TMEP §1207.01(d)(xii). Although physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceuticals or medicinal products, they are not immune from mistaking similar trademarks used on these goods. *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1305-06 (TTAB 2004); *Blansett Pharmacal Co. v. Carmrick Labs., Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); *Schering Corp.*, 207 USPQ at 509. Thus, in this case where confusion could result in harm or other serious consequences to consumers, this potential harm is considered an additional relevant factor and a lesser degree of proof may be sufficient to establish a likelihood of confusion. *See Glenwood Labs., Inc.*, 455 F.2d at 1386-87, 173 USPQ at 21-22; *Schering Corp.*, 207 USPQ at 509; *Ethicon, Inc.*, 192 USPQ at 651-52; TMEP §1207.01(d)(xii).

Additionally, the applicant’s identification of cosmetics and cosmetic preparations is broad and may encompass the registrant’s more specific type of cosmetics, e.g. eye shadow, mascara, nail polish, lip gloss, etc. in U.S. Registration Nos. 3362991 and 3370114.

When analyzing an applicant’s and registrant’s goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services stated in the application and

registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application has no restrictions as to channels of trade or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods and/or services of the type described, including those in registrants' more narrow identification.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

Accordingly, because confusion as to source is likely, registration is refused under Trademark Act Section 2(d) based on a likelihood of confusion.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or 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, 1025 (Fed. Cir. 1988).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

Applicant should note the following potential additional ground for refusal.

Prior Pending Application

The filing date of pending U.S. Application Serial No. 77889377 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final

disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Applicant must respond to the requirements set forth below.

Identification of Goods

Particular wording in the identification of goods is unacceptable for reasons explained below. Applicant must specify the common commercial or generic name for the goods. See TMEP §1402.01. Please see particular requirements explained below in italicized lettering and suggested wording below in bold lettering.

Next, the identification of goods is indefinite and must be clarified because it includes the open-ended wording "particularly." See TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "namely." Please see suggested wording below in bold lettering.

Applicant may adopt the following wording if accurate. See TMEP §1402.01.

Class 003: "Cosmetics, essential oils, cosmetic preparations for baths; { *specify further the nature/type of sauna infusions because this wording may encompass goods in multiple classes, e.g. sauna infusions, **namely, bath herbs***"

Class 005: "{ *specify type of medicine or disease/condition for which medicine is used to treat, e.g. Medicines **for the treatment of gastrointestinal diseases**; {specify purpose or use of sanitary preparations, e.g. sanitary preparations **for medical use**; {specify the common commercial name(s) of the dietetic products adapted for medical use, e.g. dietetic products adapted for medical use, **namely, dietetic sugar for medical use and dietetic foods, namely, pasta and crackers adapted for medical use**; medicinal teas, **namely, medicinal herbal teas**; {specify that these dietetic products are adapted for medical use, e.g. **dietetic products, namely, plant and fruit juices and vegetable juices adapted** for medical use; medicinal confectionery, **namely, herbal sweets, vitamin tablets, {specify type of tablets, e.g. compressed **vitamin and mineral** tablets for chewing and mineral compressed tablets; medicinal concentrates for baths; {specify disease or condition to be treated, e.g. medicinal elixirs made with herbs and plants **for the treatment of dermatological conditions**; medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs; {specify purpose or treatment, e.g. medicated soil **for use as a medical topical preparation for treatment of dermatological conditions**; medicinal liniments, **namely, aromatic pine alcohol**; medicated bath preparations; {specify medicated, e.g. therapeutic **medicated** preparations for the bath***"

Class 030: "Teas, **namely, aromatic teas**; { *specify nature/type of confectionery, e.g. confectionery, **namely, pastilles***"

Class 032: "Fruit juices, vegetable juices as beverages, { *specify nature of products, e.g. **dietetic***

beverages, namely, fruit juice and vegetable juice not for medical purposes”

An applicant may amend an identification of goods and/or services only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

In addition, in a Section 66(a) application, an applicant may not change the classification of goods and/or services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c).

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

Claim of Ownership

If applicant owns U.S. Registration Nos. 1568679 and 1740638, then applicant must submit for the application record a claim of ownership of these registrations. *See* 37 C.F.R. §2.36; TMEP §812. See the attached copies of the registrations. *See* TMEP §812.

Applicant may use the following format to claim ownership of these registrations:

Applicant is the owner of U.S. Registration Nos. 1568679 and 1740638.

Foreign Attorney May Not Represent Applicant (Advisory)

The application indicates that a foreign attorney either represents applicant and/or has been identified as the correspondent in this application. When responding to this Office action, please note that the only attorneys who may sign responses and otherwise practice before the USPTO in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO

See 37 C.F.R. §§2.17(a), (e), 2.62(b), 11.1, 11.14(a), (c); TMEP §§602, 712.01.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(c).

Unless the identified foreign attorney can establish that he or she is authorized under 37 C.F.R. §11.14, then this attorney is not authorized to practice before the USPTO in trademark matters and may not sign responses or otherwise represent applicant in this application. *See* 37 C.F.R. §2.62(b); TMEP §602.03(e). Any power of attorney to this foreign attorney is void *ab initio*. TMEP §602.03(e).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

/Natalie Polzer/
Natalie Polzer
Trademark Examining Attorney
Law Office 108
(571) 272-4103
natalie.polzer@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this**

Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

EXHIBIT B

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 07/31/2017)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79115624
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION	
MARK FILE NAME	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=79115624
LITERAL ELEMENT	SALUS
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.

ARGUMENT(S)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: SALUS Haus Dr. med. Otto Greither; Nachf. GmbH & Co. KG

Mark: **SALUS**

Serial No.: 79/115,624

Filed: July 6, 2012

Trademark Attorney: Natalie Polzer

Law Office: 108

Docket No.: 52317-3430

RESPONSE TO OFFICE ACTION

Claim of Ownership

Applicant is the owner of U.S. Registrations Nos. 1568679 and 1740638.

Amendment

Please amend the identification of goods in the above-referenced application as follows:

(1) Please delete the goods in International Class 003 from the application.

(2) Please amend the identification of goods in International Class 5 to read:

Medicines for the treatment of aiding sleep and promoting digestion, sanitary preparations for medical use, dietetic products adapted for medical use, namely, dietetic supplement beverages for aiding sleep and promoting digestion and dietetic foods, namely, dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics; medicinal teas, namely, medicinal herbal teas; dietetic products, namely, plant and fruit juices and vegetable juices adapted for medical use; medicinal confectionery, namely, herbal sweets, vitamin tablets, compressed vitamin and mineral tablets for chewing and mineral compressed tablets; medicinal concentrates for baths, medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicinal liniments, namely aromatic pine alcohol; medicated bath preparations; therapeutic medicated preparations for the bath, said goods excluding products for treating skin disorders or for use in dermatology

(3) Please amend the identification of goods in International Class 30 to read:

Teas, namely, aromatic and herbal teas

(4) Please amend the identification of goods in International Class 32 to read:

Fruit juices, vegetable juices as beverages, dietetic beverages, namely, fruit juice and vegetable juice not for medical purposes

Remarks

In the November 6 office action, the Examining Attorney refused registration of Applicant's mark on the grounds that the mark was likely to be confused with the marks in the following registrations.

U.S. Trademark Registration No. 3,159,326 for "SALUS" covering Drinking water, namely table water, mineral waters, non carbonated water and sparkling water, none of which contain herbs or herbal ingredients, sold in supermarkets, convenience stores, grocery stores, in restaurants, but not in health food stores in IC 0032 and owned by Compañía Salus S.A. ("326 Registration");

U.S. Trademark Registration No. 3,362,991 for "SALUS" covering retail store services, mail order retail services, online retail store services and shop-at-home parties all in the field of personal care products, cosmetics, home fragrance products and accessories in IC 035 and owned by Mad Maverick, LLC ("991 Registration");

U.S. Registration No. 3,370,114 for "SALUS" covering Personal care products, namely, aftershave, antiperspirant, artificial nails, astringent for the face for cosmetic purposes,

astringent for the skin for cosmetic purposes, bath beads, bath oil, non-medicated bath salts, blush, body glitter, body oil, body scrub, bubble bath, cologne, cream for the body, cream for the cuticles, cream for the eyes, cream for the face, cream for the hands, deodorant, essential oils, exfoliators for the skin, eye gels, eye makeup pencils, eye shadow, face highlighter, facial masks, face mist, face scrub, non-medicated foot soak, foundation, fragrant body splash, fragrant body mist, hair conditioner, hair dyes, hair glitter, hair highlighter, hair mascara, hair pomade, hair rinses, hair removing creams, hair shampoo, hair spray, hair straightener, hair styling gel, hair styling mousse, lotion for the body, lotion for the hands, lotion for the face, lip balm, lip gloss, lip liner, lip makeup pencils, lip stick, makeup for the body, makeup for the face, makeup remover, mascara, nail corrector pens, nail polish, nail polish remover, nail stencils, non-medicated blemish stick, non-medicated cleanser for the face, non-medicated foot spray, non-medicated mood enhancing massage ointment, non-medicated mood enhancing skin cream, oil blotting sheets for the skin, perfume, powder for the body, powder for the face, powder for the feet, pumice stones for personal use, salt scrubs for the skin, shaving cream, shower gel, skin bronzing cream, soap for the body, soap for the face, soap for the hands, sun block for the body, sun block for the face, suntan lotion for the body, suntan lotion for the face, sunless tanning lotion for the body, sunless tanning lotion for the face, pre-suntanning lotion for the body, pre-suntanning lotion for face, post-suntanning lotion for the body, post-suntanning lotion for the face and talcum powder and home fragrance products, namely, potpourri, room fragrancing gels, scented room fragrances, scented room fragrance sprays and refills for electric room fragrance dispensers in IC 003 and owned by Mad Maverick, LLC (“114 Registration”);

U.S. Registration No. 3,677,674 for “NEOSALUS” covering Dermatological pharmaceutical products; pharmaceutical preparations for treating skin disorders; pharmaceutical preparations for use in dermatology; pharmaceutical skin lotions in IC 005 and owned by Quinnova Pharmaceuticals, Inc. (“674 Registration”); and

U.S. Registration No. 3,677,679 for “NEOSALUS” covering Dermatological pharmaceutical products; pharmaceutical preparations for treating skin disorders; pharmaceutical preparations for use in dermatology; pharmaceutical skin lotions in IC 005 and owned by Quinnova Pharmaceuticals, Inc. (“679 Registration”)

A. Applicant’s Mark Is Not Likely To Cause Confusion in Law or in Fact

With The Mark in the ‘326 Registration

Although the Examining Attorney did not specify, Applicant assumes the Examining Attorney believes that Applicant’s mark is likely to be confused with the mark in the ‘326 Registration because the goods covered by that registration (“table water, mineral waters, non carbonated water and sparkling water”) are somewhat similar or related to Applicant’s goods in class 30 (“[t]eas, particularly aromatic teas, confectionery”) and Class 32 (“[f]ruit juices, vegetable juices as beverages, these products also as dietetic beverages not for medical purposes”). The Examining Attorney’s refusal, however, fails to take into consideration the fact that Applicant already owns two U.S. registrations for SALUS marks covering teas and dietetic beverages.

As noted above, Applicant is the owner of U.S. Registration No. 1568679 for SALUS APPLETIME HERBAL TEA covering “[h]erbal teas for food purposes” and U.S. Registration No.

1740638 for SALUS covering “dietary supplements and dietetic foods and beverages; namely, tonics, plant and herb extracts in liquid form; tea” (collectively, “Applicant’s prior SALUS registrations”). Applicant’s prior SALUS registrations, both of which predate the ‘326 registration, are for marks identical or nearly identical to the mark at issue and cover goods identical or substantially identical to the goods covered by the current application. As such, Applicant’s mark in the current application cannot cause a likelihood of confusion with the mark in Registration ‘326. *See, e.g., Morehouse Mfg. Corp. v. J. Strickland Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1971).

This is especially true here, where Applicant’s prior SALUS registrations predate the ‘326 registration. In particular, Applicant notes that the SALUS mark covered by the ‘326 Registration was permitted to register in the face of the Applicant’s Registration No. 1740638 for the identical mark, SALUS, covering dietetic beverages and teas, the very goods at issue in the current application. The co-existence of Applicant’s 1740638 registration and the ‘326 Registration is *prima facie* evidence that the marks contained therein are not confusingly similar. Since the marks are identical, the only basis for finding confusion unlikely was the difference in the goods – “table water, mineral waters, non carbonated water and sparkling water” (‘326 Registration) vs. “dietary supplements and dietetic foods and beverages; namely, tonics, plant and herb extracts in liquid form; tea” (Registration No. 1740638).

Applicant’s current application covers teas, fruit juice dietetic beverages, and vegetable juice dietetic beverages, which are identical or nearly identical to the teas, tonic dietetic beverages and plant extract dietetic beverages in Applicant’s prior registrations. If the mark in the ‘326 Registration did not create a likelihood of confusion with the mark in Applicant’s Registration No. 1740638, then it is not likely to be confused with the mark in the current application, which like Applicant’s Registration No. 1740638, covers teas and dietetic beverages. *See In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) (no confusing similarity between Applicant’s ANYWEAR mark covering footwear and cited ANYWEAR mark covering clothing in view of Applicant’s pre-existing registration for ANYWEARS covering footwear). Moreover, to allow the ‘326 registration for SALUS covering waters in the face of Applicant’s pre-existing registration for SALUS covering teas and dietetic beverages and then to block registration of Applicant’s subsequent application for SALUS covering teas and dietetic beverages in view of the ‘326 registration would render Applicant’s prior SALUS registrations meaningless, unfairly inflate the

scope of the '326 registration, and grossly pervert the federal system of trademark registration based upon priority of rights.

B. With the Deletion of the Class 3 Goods from the Application, Applicant's Mark Is Not Likely To Be Confused With the Marks in the '991 and '114 Registrations

Although the Examining Attorney did not specify, Applicant assumes the Examining Attorney refused registration of Applicant's mark in light of the '991 and '114 Registrations because of a belief that the Class 3 goods in the application, namely, "[c]osmetics, essential oils, cosmetic preparations for baths; sauna infusions" render the mark confusingly similar to the mark in the '991 and '114 Registrations. Applicant has responded to that refusal by amending the identification of goods to delete the Class 3 goods from its application. Applicant respectfully submits that, with the amendment, its mark is not likely to be confused with the mark in the '991 and '114 Registrations and that those registrations pose no obstacle to the registration of Applicant's mark.

C. With the Amendment of the Class 5 Goods in the Application, Applicant's Mark Is Not Likely To Be Confused With the Marks in the '674 and '679 Registrations

The Examining Attorney refused registration of Applicant's mark in view of the marks in the '674 and '679 Registrations because Applicant's inclusion of medicines and dietetic products for medical use in the identification was so broad that it could encompass the "pharmaceutical preparations for treating skin disorders or for use in dermatology" products in the '674 and '679 Registrations. Applicant has responded to the refusal by amending the Class 5 identification of goods to exclude expressly "products for treating skin disorders or for use in dermatology." Applicant respectfully submits that, with the amendment, its mark is not likely to be confused with the marks in the '674 and '679 Registrations, and that those registrations pose no obstacle to the registration of Applicant's mark.

D. Applicant's Mark Is Not Likely To Be Confused With the Mark Application No. 77889377

In the November 6, 2102 Office Action, the Examining Attorney also noted that Applicant's

mark may be confusingly similar to the mark in Application No. 77889377. That position is respectfully traversed.

Application No. 77889377 is for the mark VIASALUS covering “dietary supplements and natural skin therapy products formulated to promote healthy skin clear of conditions such as acne, roseacea and shingles.” Although the Examining Attorney did not specify, Applicant assumes the Examining Attorney believes Applicant’s mark is confusingly similar because the goods covered by the cited prior application are similar to the Class 5 medicines and dietary supplements in Applicant’s application.

In response, Applicant notes that its pre-existing Registration No. 1740638 for SALUS covers dietary supplements, which are identical or virtually identical to the dietary supplements in the current application. Registration of the mark in Application No. 77889377 in coexistence with the mark in Applicant’s Registration No. 1740638 will be *prima facie* evidence that the mark in Application No. 77889377 is not likely to be confused with the mark SALUS covering dietary supplements. In light of Applicant’s pre-existing registration for SALUS covering dietary supplements, the mark in Applicant’s current application is not likely to be confused with the mark in Application No. 77889377. *See In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) (no confusing similarity between Applicant’s ANYWEAR mark covering footwear and cited ANYWEAR mark covering clothing in view of Applicant’s pre-existing registration for ANYWEARS covering footwear). In addition, Applicant has amended the Class 5 identification of goods to exclude expressly “products for treating skin disorders or for use in dermatology.” With that amendment, Applicant has expressly excluded from its application the very goods covered by Application 77889377. For the foregoing reasons, Application respectfully submits that its mark is not likely to be confused with the mark in Application No. 77889377.

In the November 6 Office Action, the Examining Attorney also required Applicant to amend its identification of goods. Application has amended its identification of goods to conform to the Examining Attorney’s requirements.

Finally, the Examining Attorney required Application to claim ownership of Registrations U.S. Registrations Nos. 1568679 and 1740638. Applicant has complied with that requirement.

Conclusion

GOODS AND/OR SERVICES SECTION (005)(proposed)

INTERNATIONAL CLASS 005

TRACKED TEXT DESCRIPTION

~~Medicines, sanitary preparations, dietetic products adapted for medical use;~~ Medicines for the treatment of aiding sleep and promoting digestion, sanitary preparations for medical use, dietetic products adapted for medical use, namely, dietetic supplement beverages for aiding sleep and promoting digestion and dietetic foods, namely, dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics; ~~medicinal teas, particularly medicinal herbal teas;~~ medicinal teas, namely, medicinal herbal teas; ~~plant and fruit juices and vegetable juices as dietetic products for medical use;~~ dietetic products, namely, plant and fruit juices and vegetable juices adapted for medical use; ~~medicinal confectionery, particularly herbal sweets, vitamin tablets, compressed tablets for chewing and mineral compressed tablets;~~ medicinal confectionery, namely, herbal sweets, vitamin tablets, compressed vitamin and mineral tablets for chewing and mineral compressed tablets; ~~medicinal concentrates for baths, medicinal elixirs made with herbs and plants;~~ medicinal concentrates for baths, medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicinal liniments, namely aromatic pine alcohol; ~~medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicated soil;~~ medicated bath preparations; ~~medicinal liniments, particularly aromatic pine alcohol;~~ therapeutic medicated preparations for the bath, said goods excluding products for treating skin disorders or for use in dermatology; ~~therapeutic preparations for the bath~~

FINAL DESCRIPTION

Medicines for the treatment of aiding sleep and promoting digestion, sanitary preparations for medical use, dietetic products adapted for medical use, namely, dietetic supplement beverages for aiding sleep and promoting digestion and dietetic foods, namely, dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics; medicinal teas, namely, medicinal herbal teas; dietetic products, namely, plant and fruit juices and vegetable juices adapted for medical use; medicinal confectionery, namely, herbal sweets, vitamin tablets, compressed vitamin and mineral tablets for chewing and mineral compressed tablets; medicinal concentrates for baths, medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicinal liniments, namely aromatic pine alcohol; medicated bath preparations; therapeutic medicated preparations for the bath, said goods excluding products for treating skin disorders or for use in dermatology

GOODS AND/OR SERVICES SECTION (030)(current)

INTERNATIONAL CLASS 030

DESCRIPTION Teas, particularly aromatic teas, confectionery

GOODS AND/OR SERVICES SECTION (030)(proposed)

INTERNATIONAL CLASS 030

TRACKED TEXT DESCRIPTION

~~Teas, particularly aromatic teas, confectionery;~~ Teas, namely aromatic and herbal teas

FINAL DESCRIPTION Teas, namely aromatic and herbal teas

GOODS AND/OR SERVICES SECTION (032)(current)

INTERNATIONAL CLASS	032
DESCRIPTION	
Fruit juices, vegetable juices as beverages, these products also as dietetic beverages not for medical purposes	
GOODS AND/OR SERVICES SECTION (032)(proposed)	
INTERNATIONAL CLASS	032
TRACKED TEXT DESCRIPTION	
Fruit juices, vegetable juices as beverages, these products also as dietetic beverages not for medical purposes ; Fruit juices, vegetable juices as beverages, dietetic beverages, namely, fruit juice and vegetable juice not for medical purposes	
FINAL DESCRIPTION	
Fruit juices, vegetable juices as beverages, dietetic beverages, namely, fruit juice and vegetable juice not for medical purposes	
ADDITIONAL STATEMENTS SECTION	
ACTIVE PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 1568679 and 1740638.
NEW ATTORNEY SECTION	
NAME	Charles S. Murray, Jr.
FIRM NAME	Thomas Horstemeyer, LLP
INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER	52317-3430
INTERNAL ADDRESS	Suite 1500
STREET	400 Interstate North Parkway
CITY	Atlanta
STATE	Georgia
ZIP/POSTAL CODE	30339
COUNTRY	United States
PHONE	770-933-9500
FAX	770-951-0933
EMAIL	trademarks@thomashorstemeyer.com
AUTHORIZED EMAIL COMMUNICATION	Yes
CORRESPONDENCE SECTION	

ORIGINAL ADDRESS	WEICKMANN & WEICKMANN 81635 MÜNCHEN P.O. BOX 860 820 DE
NEW CORRESPONDENCE SECTION	
NAME	Charles S. Murray, Jr.
FIRM NAME	Thomas Horstemeyer, LLP
DOCKET/REFERENCE NUMBER	52317-3430
INTERNAL ADDRESS	Suite 1500
STREET	400 Interstate North Parkway
CITY	Atlanta
STATE	Georgia
ZIP/POSTAL CODE	30339
COUNTRY	United States
PHONE	770-933-9500
FAX	770-951-0933
EMAIL	trademarks@thomashorstemeyer.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Charles S. Murray, Jr./
SIGNATORY'S NAME	Charles S. Murray, Jr.
SIGNATORY'S POSITION	Attorney for Applicant, Washington, D.C. Bar Member
SIGNATORY'S PHONE NUMBER	770-933-9500
DATE SIGNED	05/06/2013
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon May 06 16:26:30 EDT 2013
TEAS STAMP	USPTO/ROA-XX.XX.XX.X-2013 0506162630133106-79115624 -5008b169352c875a68bb4281 1b896ebcd03154e2928cd259b e692f7c17103bd7-N/A-N/A-2

EXHIBIT C

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

Reg. No. 3,362,991

United States Patent and Trademark Office

Registered Jan. 1, 2008

**SERVICE MARK
PRINCIPAL REGISTER**

SALUS

MAD MAVERICK, LLC (COLORADO LTD LIAB
CO)
PO BOX 7
LARKSPUR, CO 80118

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: RETAIL STORE SERVICES, MAIL ORDER
RETAIL SERVICES, ONLINE RETAIL STORE SER-
VICES AND SHOP-AT-HOME PARTIES ALL IN THE
FIELD OF PERSONAL CARE PRODUCTS, COS-
METICS, HOME FRAGRANCE PRODUCTS AND
ACCESSORIES, IN CLASS 35 (U.S. CLS. 100, 101 AND
102).

THE FOREIGN WORDING IN THE MARK
TRANSLATES INTO ENGLISH AS HEALTH.

SN 77-060,708, FILED 12-9-2006.

FIRST USE 11-3-2005; IN COMMERCE 11-3-2005.

SANDRA MANIOS, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 3,370,114

United States Patent and Trademark Office

Registered Jan. 15, 2008

TRADEMARK
PRINCIPAL REGISTER

SALUS

MAD MAVERICK, LLC (COLORADO LTD LIAB
CO)
PO BOX 7
LARKSPUR, CO 80118

FOR: PERSONAL CARE PRODUCTS, NAMELY, AFTERSHAVE, ANTIPERSPIRANT, ARTIFICIAL NAILS, ASTRINGENT FOR THE FACE FOR COSMETIC PURPOSES, ASTRINGENT FOR THE SKIN FOR COSMETIC PURPOSES, BATH BEADS, BATH OIL, NON-MEDICATED BATH SALTS, BLUSH, BODY GLITTER, BODY OIL, BODY SCRUB, BUBBLE BATH, COLOGNE, CREAM FOR THE BODY, CREAM FOR THE CUTICLES, CREAM FOR THE EYES, CREAM FOR THE FACE, CREAM FOR THE HANDS, DEODORANT, ESSENTIAL OILS, EXFOLIATORS FOR THE SKIN, EYE GELS, EYE MAKEUP PENCILS, EYE SHADOW, FACE HIGHLIGHTER, FACIAL MASKS, FACE MIST, FACE SCRUB, NON-MEDICATED FOOT SOAK, FOUNDATION, FRAGRANT BODY SPLASH, FRAGRANT BODY MIST, HAIR CONDITIONER, HAIR DYES, HAIR GLITTER, HAIR HIGHLIGHTER, HAIR MASCARA, HAIR POMADE, HAIR RINSES, HAIR REMOVING CREAMS, HAIR SHAMPOO, HAIR SPRAY, HAIR STRAIGHTENER, HAIR STYLING GEL, HAIR STYLING MOUSSE, LOTION FOR THE BODY, LOTION FOR THE HANDS, LOTION FOR THE FACE, LIP BALM, LIP GLOSS, LIP LINER, LIP MAKEUP PENCILS, LIP STICK, MAKEUP FOR THE BODY, MAKEUP FOR THE FACE, MAKEUP REMOVER, MASCARA, NAIL CORRECTOR PENS, NAIL POLISH, NAIL POLISH REMOVER, NAIL STENCILS, NON-MEDICATED BLEMISH STICK, NON-MEDICATED CLEANSER FOR THE FACE, NON-MEDICATED FOOT SPRAY, NON-MEDICATED MOOD ENHANCING MASSAGE OINTMENT,

NON-MEDICATED MOOD ENHANCING SKIN CREAM, OIL BLOTTING SHEETS FOR THE SKIN, PERFUME, POWDER FOR THE BODY, POWDER FOR THE FACE, POWDER FOR THE FEET, PUMICE STONES FOR PERSONAL USE, SALT SCRUBS FOR THE SKIN, SHAVING CREAM, SHOWER GEL, SKIN BRONZING CREAM, SOAP FOR THE BODY, SOAP FOR THE FACE, SOAP FOR THE HANDS, SUN BLOCK FOR THE BODY, SUN BLOCK FOR THE FACE, SUNTAN LOTION FOR THE BODY, SUNTAN LOTION FOR THE FACE, SUNLESS TANNING LOTION FOR THE BODY, SUNLESS TANNING LOTION FOR THE FACE, PRE-SUNTANNING LOTION FOR THE BODY, PRE-SUNTANNING LOTION FOR FACE, POST-SUNTANNING LOTION FOR THE BODY, POST-SUNTANNING LOTION FOR THE FACE AND TALCUM POWDER AND HOME FRAGRANCE PRODUCTS, NAMELY, POTPOURRI, ROOM FRAGRANCING GELS, SCENTED ROOM FRAGRANCES, SCENTED ROOM FRAGRANCE SPRAYS AND REFILLS FOR ELECTRIC ROOM FRAGRANCE DISPENSERS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 9-3-2005; IN COMMERCE 9-3-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE FOREIGN WORDING IN THE MARK TRANSLATES INTO ENGLISH AS HEALTH.

SN 77-136,025, FILED 3-20-2007.

SANDRA MANIOS, EXAMINING ATTORNEY

To: SALUS Haus Dr. med. Otto Greither;
Nachf ETC. (trademarks@thomashorstemeyer.com)

Subject: U.S. TRADEMARK APPLICATION NO. 79115624 - SALUS - 52317-3430

Sent: 5/25/2013 9:28:48 PM

Sent As: ECOM108@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79115624

MARK: SALUS

79115624

CORRESPONDENT ADDRESS:

Charles S. Murray, Jr.
Thomas Horstemeyer, LLP
Suite 1500
400 Interstate North Parkway
Atlanta GA 30339

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

APPLICANT: SALUS Haus Dr. med. Otto Greither; Nachf
ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

52317-3430

CORRESPONDENT E-MAIL ADDRESS:

trademarks@thomashorstemeyer.com

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 5/25/2013

INTERNATIONAL REGISTRATION NO. 0570231

This Office action is in response to applicant's communication filed on 05/06/2013.

First, the following requirements have been satisfied: (1) *Identification of Goods*, (2) *Claim of Ownership*. TMEP §§713.02, 714.04.

Next, after further consideration of the applicant's arguments, deletion of Class 003 and amended identification of goods in Class 005, the Section 2(d) *Likelihood of Confusion* refusal is withdrawn with respect to U.S. Registration Nos. 3362991, 3370114, 3677674 and 3677679 only.

However, the applicant's arguments with respect to the *Likelihood of Confusion* refusal as to U.S. Registration No. 3159326 and to the prior pending application Serial No. 77889377 have been considered and are not persuasive. First, please see attached Internet evidence from www.snapple.com. This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods, e.g. drinking water, fruit juices and teas, markets the goods under the same mark, and the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, the goods are similar or complementary in terms of purpose or function. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). Therefore, the refusal is hereby **continued and maintained** under Section 2(d) with respect to U.S. Registration No. 3159326.

Next, the identification of "dietary supplements" in the prior pending applicant's application is broad and may encompass the applicant's more specific type of dietary supplements, viz. dietetic supplement beverages for aiding sleep and promoting digestion, and/or dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics. With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services 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)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Thus, the trademark examining attorney is suspending action on the application for the reasons stated below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. *See* TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the "Response to Suspension Inquiry or Letter of Suspension" form online at <http://teasroa.uspto.gov/rsi/rsi>.

The effective filing date of the pending application identified below precedes the filing date of applicant's application. If the mark in the referenced application registers, applicant's mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, action on this application is suspended until the earlier-filed referenced application is either registered or abandoned. 37 C.F.R. §2.83(c). A copy of information relevant to this referenced application was sent previously.

- Application Serial No. 77889377

/Natalie Polzer/
Trademark Examining Attorney
Law Office 108
Phone: (571) 272-4103
natalie.polzer@uspto.gov (not for formal responses)

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

CERTIFICATE OF SERVICE

I certify that on February 19, 2016, the attached document was both mailed and e-mailed to the Attorney of Record for this case at the following addresses, respectively:

Cynthia Lee
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/Shane Percival/
Shane Percival