

UNITED STATES PATENT &  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 4, 2007

Cancellation No. 92047601  
Reg. No. 2654565

78/100, 475

Bittner, Craig A.

15721 North Greenway Hayden Loop, Suite 203  
Scottsdale, AZ 85260 UNITED STATES

Galderma S.A.

V.

Bittner, Craig A.

G. Mathew Lombard, P.C.  
Law Offices of G. Mathew Lombard, P.C.  
255 West 36th Street, Suite 8506  
New York, NY 10018 UNITED STATES

Monique Tyson, Paralegal Specialist:

A petition, a copy of which is attached, has been filed to  
cancel the above-identified registration.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof.  
(See Trademark Rule 2.196 for expiration date falling on  
Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the  
Trademark Rules of Practice, set forth in Title 37, part 2,  
of the Code of Federal Regulations. Notices concerning the  
rules changes, as well as the *Trademark Trial and Appeal  
Board Manual of Procedure* (TBMP), are available on the  
TTAB's web page at [www.uspto.gov/web/offices/dcom/ttab/](http://www.uspto.gov/web/offices/dcom/ttab/).

The parties are particularly referred to Trademark Rule  
2.126 pertaining to the form of submissions. Paper

06-20-2007

submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open: 6/24/07

Discovery period to close: 12/21/07

30-day testimony period for party  
in position of plaintiff to close: 3/20/08

30-day testimony period for party  
in position of defendant to close: 5/19/08

15-day rebuttal testimony period  
for plaintiff to close: 7/3/08

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See TBMP § 502.06(a) (2d ed. rev. 2004).

If the parties to this proceeding are (or during the pendency of this proceeding, become) parties to another Board or civil proceeding involving related marks or other common issues of law or fact, they shall notify the Board immediately, so that the Board can consider consolidation or suspension of proceedings, if appropriate.

#### **New Developments at the Trademark Trial and Appeal Board**

For faster handling of all papers, the TTAB strongly encourages electronic filing whenever possible. TTAB forms

for electronic filings are available at  
<http://estta.uspto.gov>. Images of TTAB proceeding files  
can be viewed using TTABvue at <http://ttabvue.uspto.gov>.

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

In the Matter of Registration No. 2,654,565  
Issued November 26, 2002

-----X  
GALDERMA S.A., |  
 |  
 Petitioner, |  
 |  
 v. | Cancellation No. \_\_\_\_\_  
 |  
 CRAIG A. BITTNER, |  
 |  
 Registrant. |  
-----X

PETITION TO CANCEL

Petitioner, Galderma S.A. ("Petitioner"), a société anonyme organized under the laws of Switzerland, having a place of business at Zugerstrasse 8, 6330 Cham, Switzerland, believes that it is and will continue to be damaged by the above-identified registration, and pursuant to 15 U.S.C. § 1064 *et seq.* and 37 C.F.R. § 2.111 *et seq.*, hereby petitions to cancel Registration No. 2,654,565.

As grounds for cancellation it is alleged:

BACKGROUND

1. Petitioner is engaged in the business of the research, manufacture, distribution and sale of pharmaceutical products preparations, skin care preparations, dermatological medical devices and related products. Petitioner also offers to consumers and

medical professionals services relating to dermatological diseases, conditions, therapies, treatments and general medical information.

2. Petitioner has invested significant time and energy in promoting Petitioner's business and the quality of its products and services, and continues to spend substantial sums of time and money in the promotion of the same.

3. On September 11, 2006, Petitioner filed intent-to-use Application Serial No. 78/970,968 for the mark EVERY BODY BENEFITS for *providing on-line electronic bulletin boards for transmission of messages among computer users concerning skin care* in International Class 38; and *providing health care information in the field of dermatology* in International Class 44. Petitioner's application was refused by the U.S. Patent & Trademark Office on the grounds that there exists a likelihood of confusion between Petitioner's applied-for mark and Registrant's mark covered under Registration No. 2,654,565. See Exhibit "A".

4. Also on September 11, 2006, Petitioner filed intent-to-use Application Serial No. 78/970,967 for the mark EVERY BODY BENEFITS for *cosmetics and skin care preparations, namely, face, hand and body soaps, cleansers and moisturizers; hair shampoos and conditioners* in Class 3; and *pharmaceutical preparations for use in the treatment of dermatosis and for use as skin and scalp emollients and vehicles for use in the preparation of medicaments* in Class 5. Petitioner's application was refused by the U.S. Patent & Trademark Office on the grounds that there exists a likelihood of confusion between Petitioner's applied-for mark and Registrant's mark covered under Registration No. 2,654,565. See Exhibit "B".

5. On December 31, 2001, Registrant, a United States individual, filed § 1(a) use-based Application Serial No. 78/100,475 for the mark EVERY BODY BENEFITS for *medical services and medical testing services* in International Class 42. Said application matured to registration on November 26, 2002 under Registration No. 2,654,565.

6. At the time of filing and registration, Registrant identified his address as 15721 North Greenway Hayden Loop, Suite 203, Scottsdale, Arizona 85260.

7. On the filing date, Registrant submitted a sworn declaration to the U.S. Patent & Trademark Office in which he affirmatively stated that:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

8. Also on the filing date, Registrant submitted a sworn declaration to the U.S. Patent & Trademark Office in which he affirmatively stated that:

Applicant is using or is using through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section

105(a), as amended.). Application attaches one SPECIMEN for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services.

Registrant described the specimen as "Use in commerce specimen of a print copy advertisement previously placed in a magazine and that includes the mark." The services for which Registrant claimed use are "medical services and medical testing services". See Exhibit "C".

9. Registrant claimed the date of first use as December 5, 2001. See Exhibit "C".

10. On December 5, 2006, the U.S. Patent & Trademark Office refused registration of Petitioner's mark EVERY BODY BENEFITS covered by Application Serial Nos. 78/970,968 and 78/970,967, claiming there exists a likelihood of confusion between Applicant's Mark and Registrant's Mark.

NON-USE  
(CLAIM #1)

11. Upon information and belief, Registrant has not used his EVERY BODY BENEFITS for at least three (3) years or since at least November 4, 2003, and has no intention of resuming use of the mark.

12. With regard to Registrant's specimen filed in support of its claim of use in commerce (See Exhibit "F"), neither the offered toll-free number, 1-866-4 MY SCAN, nor the web site [www.ameriscan.org](http://www.ameriscan.org) is operational as of the date of filing of the instant petition.

13. Moreover, the limited liability company which, upon information and belief, actually used the mark is no longer in good standing with the Arizona Secretary of State. See Exhibit

“D”.

14. Upon information and belief, Registrant closed the last location which used or could have used the EVERY BODY BENEFITS on or before November 4, 2003. *See* Exhibit “E”.

FRAUD ON THE U.S. PATENT & TRADEMARK OFFICE  
(CLAIM # 2)

15. Upon information and belief, the specimen filed by Registrant (Exhibit “F”) shows use of the mark by a business entity named “AmeriScan” - not the Registrant.

16. According to the Arizona Secretary of State records, AmeriScan, L.L.C. was “incorporated” on May 22, 2001; however, shortly thereafter on January 20, 2002, the limited liability company changed its name to Sequoia Technologies, L.L.C. *See* Exhibit “D”.<sup>1</sup>

17. A legally incorporated limited liability company is a separate and distinct legal entity from the incorporator, the member(s), the employees, the investors and the employees.

18. According to the Arizona Secretary of State’s records, the only member of the L.L.C. was “Bittner Family Rev Liv Trust”.

19. According to the Arizona Secretary of State’s records, the only manager of the L.L.C. was “Bittner Family Rev Liv Trust”.

20. Registrant was never a manager or member of the L.L.C. in his personal, individual capacity.

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<sup>1</sup> For the sake of convenience unless a distinction is required, “AmeriScan,” “the limited liability company,” “the L.L.C.” or similar references shall refer to Sequoia Technologies, L.L.C. or AmeriScan, L.L.C. interchangeably.



21. Registrant's sworn declaration indicated that "Applicant is using or is using through a related company the mark in commerce...." was untrue at the time it was made.

22. Under U.S. trademark law, "either a natural person or a juristic person may be a related company." 15 U.S.C. § 1127. While Registrant's assertion that use could be through a related company, Registrant, Craig Bittner, was neither a member nor manager of AmeriScan, L.L.C. The only member or manager was a distinct legal entity, the Bittner Family Rev Liv Trust. Therefore, Registrant, Mr. Bittner cannot be presumed to exercise the necessary control over the nature and quality of the goods or services on or in connection with the mark is used. *See* TMEP § 1201.03. Use by related companies is permitted, but the registration owner is presumed to *control* how the related company uses the mark. Here, absent some written agreement, no presumption may be made among Mr. Bittner (the *owner* of the mark), AmeriScan, L.L.C. or Sequoia Technologies, L.L.C. (the *user* of the mark), and the Bittner Family Rev Liv Trust – the only *member* or *manager* of AmeriScan, L.L.C.

23. Although "the Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark," TMEP § 1201.03(b) & TMEP § 1201.04, nothing in the *Trademark Manual of Examining Procedure* prevents third parties with standing from challenging the veracity of the representations made by the applicant in its declarations.

24. An applicant may make use of its mark through a controlled licensee, provided that such use is pursuant to a contract or agreement. *Pneutek, Inc. v. Scherr*, 211 USPQ

824, 833 (TTAB 1981), TMEP § 1201.03(f).

25. Upon information and belief, no agreement existed between Registrant and AmeriScan, L.L.C. regarding use of the mark. Likewise, upon information and belief, no agreement existed between Registrant and the Bittner Family Rev Liv Trust regarding use of the mark.

26. Even assuming the mark was in use at the time the application was filed and the declaration signed, absent an appropriate agreement between the L.L.C., Mr. Bittner and/or the Bittner Family Rev Liv Trust, no unity of control may be presumed.

27. Accordingly, Registrant's sworn statement on December 31, 2001 that he was using the mark directly or through a related company was false and/or fraudulent.

**REGISTRANT'S SPECIMEN EVIDENCING USE IS UNACCEPTABLE**  
(CLAIM # 3)

28. TMEP § 904.04 mandates that "the specimen may not be a 'picture' of the mark, such as an artist's drawing or a printer's proof that merely illustrates what the mark looks like and is not actually used on or in connection with the goods in commerce." (emphasis added) *See* TMEP § 904.04 and 37 C.F.R. § 2.56(c).

29. Upon information and belief, Registrant's specimen is a mock-up, final proof or print-out of a digital version of the *proposed* advertisement rather than a reproduction of an *actual* advertisement from a magazine or other print medium. *See* Exhibit "F".

30. Accordingly, Registrant's specimen fails to meet the requirements of 37 C.F.R. §

2.56(c) and TMEP § 904.04 and is in fact unacceptable as a appropriate specimen and does not now or at the time it was filed support registration of the mark.

CONCLUSION

31. In view of the above allegations, Registrant is not entitled to continue registration of its alleged mark since Registrant 1) has not used his mark for three (3) consecutive years and has no intention of resuming use of the mark, 2) committed fraud in the procurement of the subject registration, and 3) submitted specimens in support of registration that do not meet the requirements of trademark law or the U.S. Patent & Trademark Office.

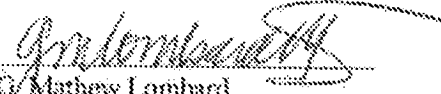
32. As a result of the fraudulent misrepresentations made at the time the Registrant's application was filed, Registration No. 2,654,565 is void *ab initio*.

WHEREFORE, for the reasons stated above, the Petitioner respectfully prays that Registration No. 2,654,565 be cancelled and/or declared void *ab initio*.

June 4, 2007

Respectfully submitted,

LAW OFFICES OF G. MATHEW LOMBARD, P.C.

By:   
G. Mathew Lombard  
255 West 35<sup>th</sup> Street  
Suite 850G  
New York, New York 10018

*Attorney for Opposer*

mlombard@gml-law.com

From: ECom109 [ecom109@USPTO.GOV]  
Sent: Tuesday, December 05, 2006 8:49 PM  
To: mlombard@gml-law.com  
Subject: TRADEMARK APPLICATION NO. 78970968 - EVERY BODY BENEFITS - 102.0508  
Attachments: 78100475P001OF001.JPG; web-1.jpg; web-2.jpg; skin-1.jpg; skin-2.jpg  
TimeMattersID: MA28098AA48B8373  
TM Contact: Alan RAGUENEAU  
TM Matter No: 102.0508  
TM Matter Reference: US TM App for EVERY BODY BENEFITS in Classes 38 & 44

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/970968

APPLICANT: Galderma S.A.

**\*78970968\***

CORRESPONDENT ADDRESS:

G. MATHEW LOMBARD  
LAW OFFICES OF G. MATHEW LOMBARD, P.C.  
255 W 36TH ST STE 8506  
NEW YORK, NY 10018-7555

RETURN ADDRESS:  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

MARK: EVERY BODY BENEFITS

CORRESPONDENT'S REFERENCE/DOCKET NO: 102.0508

CORRESPONDENT EMAIL ADDRESS:

mlombard@gml-law.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/970968

The assigned examining attorney has reviewed the referenced application and determined the following.

Registration Refused - Likelihood of Confusion

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2654565. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

The applicant's mark is EVERY BODY BENEFITS for, "providing on-line electronic bulletin boards for transmission of messages among computer users concerning skin care" in International Class 38; and "providing health care information in the field of dermatology" in International Class 44. The registered mark is EVERY BODY BENEFITS for, "medical services and medical testing services".

The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

Comparison of Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

In this instance, the applicant's mark and registered mark are identical.

Comparison of Services

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

In this instance, the applicant's services and the registrant's services appear to be related in that they may address identical issues. Specifically, the registrant's services are defined broadly and could encompass medical services and testing in the field of dermatology or skin care. The examining attorney has attached internet evidence illustrating that there are on-line forums which provide information regarding dermatology and skin care. (See attached)

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant has any questions or requires assistance in responding to this Office Action, please telephone the assigned examining attorney.

/Richard F. White/  
Trademark Examining Attorney  
Law Office 109  
Telephone: (571) 272-9442  
Fax: (571) 273-9109

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

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No virus found in this incoming message.

Checked by AVG Free Edition.

Version: 7.5.430 / Virus Database: 268.15.9/571 - Release Date: 12/05/2006 11:50 AM

mlombard@gml-law.com

From: ECom109 [ecom109@USPTO.GOV]  
Sent: Monday, December 11, 2006 3:17 PM  
To: mlombard@gml-law.com  
Subject: TRADEMARK APPLICATION NO. 78970967 - EVERY BODY BENEFITS - 102.0507  
Attachments: 78100475P001OF001.JPG; derma1.jpg; derma2.jpg; derm3-1.jpg; derm3-2.jpg; derm3-3.jpg; derm4-1.jpg; derm4-2.jpg; derm4-3.jpg; derm4-4.jpg  
TimeMattersID: MA53298AF3C43706  
TM Contact: Alan RAGUENEAU  
TM Matter No: 102.0507  
TM Matter Reference: US TM App for EVERY BODY BENEFITS

## UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/970967

APPLICANT: Galderma S.A.

**CORRESPONDENT ADDRESS:**

G. MATHEW LOMBARD  
LAW OFFICES OF G. MATHEW LOMBARD, P.C.  
255 W 36TH ST STE 8506  
NEW YORK, NY 10018-7555

**\*78970967\***

**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

MARK: EVERY BODY BENEFITS

CORRESPONDENT'S REFERENCE/DOCKET NO: 102.0507

CORRESPONDENT EMAIL ADDRESS:

mlombard@gml-law.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

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The applicant's mark is EVERY BODY BENEFITS for, "cosmetics and skin care preparations, namely, face, hand and body soaps, cleansers and moisturizers; hair shampoos and conditioners" in International Class 3 and "pharmaceutical preparations for use in the treatment of dermatosis and for use as skin and scalp emollients and vehicles for use in the preparation of medicaments" in International Class 5. The registered mark is EVERY BODY BENEFITS for, "medical services and medical testing services".

The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

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The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

In this instance, the applicant's mark and the registered mark are identical.

Comparison of Goods/Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *Online Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

In this instance, the applicant's goods and the registrant's services are clearly related. The examining attorney has attached internet evidence illustrating that medical professionals (typically dermatologist) common produce and market skin care preparations similar in nature to the types identified by the applicant. (See attached) Furthermore, the applicant should note that because the marks of the respective parties are identical, the relationship between the goods or services of the respective parties



need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

#### Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

#### Identification of Goods

The identification of goods is unacceptable because the term "vehicles" is indefinite and may reference goods that must be classified in an additional International Class. The applicant may adopt the following identification, if accurate: "Chemical additives for use in the manufacture of medicaments, in International Class 1.

Cosmetics and skin care preparations, namely, face, hand and body soaps, cleansers and moisturizers; hair shampoos and conditioners, in International Class 3.

Pharmaceutical preparations for use in the treatment of dermatosis and for use as skin and scalp emollients and dermatological pharmaceutical preparations for use in the manufacture of additional medicaments, in International Class 5." TMEP §1402.01.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

For assistance regarding an acceptable listing of goods and/or services, please see the on-line searchable *Manual of Acceptable Identifications of Goods and Services*, at [http://www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/).

#### Classification

If applicant adopts the suggested amendment of the goods, then applicant must amend the classification to International Classes 1, 3 and 5. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§1401 *et seq.*

#### Requirements of Combined or Multiple-Class Applications

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b):

(1) Applicant must list the goods by international class with the classes listed in ascending numerical order. TMEP § 1403.01; and

(2) Applicant must submit a filing fee for each international class of goods not covered by the fee

already paid (current fee information should be confirmed at <http://www.uspto.gov>). 37 C.F.R. §2.86(a)(2); TMEP §§810 and 1403.01.

If the applicant has any questions or requires assistance in responding to this Office Action, please telephone the assigned examining attorney.

/Richard F. White/  
Trademark Examining Attorney  
Law Office 109  
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**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE:** Do not respond by e-mail. **THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE:** The filing date of the response will be the *date of receipt in the Office*, not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

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