To: I DID IT, Inc. (EBuff@EDBuff.Com)

Subject: TRADEMARK APPLICATION NO. 76651675 - DRINK YOURSELF THIN - 0200-16

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/651675

APPLICANT: I DID IT, Inc.

[redacted]

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CORRESPONDENT EMAIL ADDRESS:
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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..

Serial Number 76/651675

The Office has reassigned this application to the undersigned trademark examining attorney.

On February 20, 2007, the Trademark Trial and Appeal Board remand this application to the examining attorney for consideration of applicant's request for reconsideration.

In the request for reconsideration, applicant amended the Identification and Classification of Goods and traversed the Section 2(d) refusal. The applicant's amended Identification and Classification of Goods is acceptable and has been made of record. However, with respect to the Section 2(d) refusal, the trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the points at issue in the final action. TMEP §715.03(a). Therefore, the request for reconsideration is **denied** and the final refusal under Section 2(d) is continued and maintained. 37 C.F.R. §2.64(b); TMEP §715.04.

The filing of a request for reconsideration does *not* extend the time for filing a proper response to the final action, which runs from the date the final action was mailed. 37 C.F.R. §2.64(b); TMEP §§715.03 and 715.03(c).

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LIKELIHOOD OF CONFUSION REFUSAL UNDER § 2(D)

For the reasons set forth below, the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with respect to U.S. Registration No. 2717129 is **continued and maintained**. 37 C.F.R. §2.64(a). A copy of this registration was previously sent.

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Comparison of the Marks

In the present case, the applicant's mark DRINK YOURSELF THIN is highly similar to the registered mark FEED YOURSELF THIN because the marks are similar in appearance. Marks may be confusingly similar in appearance where there are similar terms appearing in both applicant's and registrant's mark, here the terms YOURSELF THIN. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 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) and (b)(iii).

Both marks suggest that their products promote weight control. Applicant merely deleted the term FEED from the registered mark and replaced it with the term DRINK. The difference between the term FEED and DRINK does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d) since both terms convey a manner of consumption. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR GOLD"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); TMEP §1207.01(b)(iii).

The applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, YOURSELF THIN, and there is no other wording or design to distinguish it from registrant's mark. Thus, the marks are confusingly similar.

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Comparison of the Goods

In comparing the goods and/or services of the parties, goods and/or services 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 are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or 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 the present case, the applicant seeks to register the mark DRINK YOURSELF THIN for nutritionally fortified beverages, specifically the following amended goods:

- Nutritionally fortified, breath freshening, *carbonated*, green tea beverages for weight control

The registrant has the mark FEED YOURSELF THIN registered for following goods:

- Vitamins, nutritional and dietary supplements

Applicant contends that the two marks will not likely cause confusion because the registrant's product suggests a solid or food product such as meal supplements or pills, where as the applicant's product suggests an association with a liquid or beverage. However, the distinction between pill form and liquid form does it overcome a likelihood of confusion. Consumers would likely believe that the goods from a common source because the same company can provide overlapping goods identified in the application and the registration. For instance, Kyäni makes nutritional drinks as well as supplements. See attached from PR Leap and Kyäni website. AgroLabs also makes nutritional drinks as well as supplements. See attached from the AgroLabs website. Likewise, Bally Total Fitness makes both nutritional drinks as well as supplements. See attached from Bally Total Fitness website. Jamba Juice offers a variety of beverages, including green tea beverages, and supplements in their stores. See attached from the Jamba Juice website. The examining attorney also relies on the arguments and evidence previously made of record and incorporates the same herein.

Moreover, dietary supplements, vitamins, and nutritionally fortified beverages (whether carbonated or non-carbonated) move in the same channels of trade. For instance, both are sold at grocery stores like Whole Foods and Safeway. See attached from Whole Foods and Safeway website. Thus, since consumers are likely to mistakenly believe that nutritional drinks and supplements emanate from a common source.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Accordingly, the applicant's mark must be refused under Trademark Act Section 2(d) because the applicant's mark is likely to be confused with the registered mark.

IDENTIFICATION AND CLASSIFICATION OF GOODS

Applicant has provided the following identification and classification of goods in its application:

- Dietary beverage containing a breath freshener and balanced nutrients that promote weight control (in INT. CLASS 32)

In its request for reconsideration, applicant amended identification and classification of goods to the

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following:

- Nutritionally fortified, breath freshening, *carbonated*, green tea beverages for weight control (in INT. CLASS 5)

The amendment is acceptable and has been made of record.

APPEAL

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

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