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Subject: U.S. TRADEMARK APPLICATION NO. 79122787 - PAIN AWAY PAIN RELIEF THERAPY - SPR004 T301 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79122787

MARK: PAIN AWAY PAIN RELIEF THERAPY

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: One Zero Pty Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

SPR004 T301

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1141862

Applicant has appealed the examining attorney's refusal to register applicant's mark under Section §2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(d).

FACTS

Applicant seeks registration based on a request for extension of protection based on an Australian registration (Reg. No. 1141862 registered October 25, 2012), thereby giving the present application an effective filing date of October 25, 2012 for the mark PAIN AWAY PAIN RELIEF THERAPY (and design) for the following goods in International Class 005 as amended: "Pharmaceutical preparations for topical use being herbal creams and sprays for the treatment of arthritis, pain, circulation and inflammation." The examining attorney has refused registration of applicant's mark based on a likelihood of confusion under Section 2(d) of the Trademark Act, citing Registration No. 1881813 for PAIN-AWAY in stylized text with a small diamond design, registered March 7, 1995 and most recently renewed on May 6, 2014, for the following goods in International Class 005: "oral analgesics." This appeal follows the trademark examining attorney's first refusal under Section 2(d) of March 1, 2013 wherein a disclaimer of "PAIN RELIEF THERAPY", an amended color claim and description of the mark, and a new copy of the drawing omitting the TM symbol were also required, applicant's response of September 3, 2013 arguing against the refusal wherein the phrase "PAIN RELIEF THERAPY" was disclaimed and a proper color claim, description of the mark, and drawing of the mark were provided, and the trademark examining attorney's final refusal under Section 2(d) of September 16, 2013.

ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark so resembles the registered mark, when used in connection with their respective identified goods, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

ARGUMENT

APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARK WHEN USED IN CONNECTION WITH THE SPECIFIED GOODS

Applicant's mark is highly similar to registrant's mark and, when combined with the relatedness of the associated goods, is likely to cause confusion in consumers who are likely to mistakenly believe that applicant's goods and registrant's goods come from the same source or are affiliated goods from the same entity.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co*., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc*., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc*., 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of

record. *Citigroup Inc. v. Capital City Bank Grp., Inc*., 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co*., 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co*., 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc*., 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc*., 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 et seq.

A. The Marks Provide a Similar Commercial Impression

Applicant's mark creates a confusingly similar impression to that of registrant's marks based on common dominant wording.

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). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd*., 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc*., 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A*., 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP

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