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Subject: U.S. TRADEMARK APPLICATION NO. 85943027 - OMEGA SOUL - D 155/13 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<p>U.S. APPLICATION SERIAL NO. 85943027</p> <p>MARK: OMEGA SOUL</p>	
<p>CORRESPONDENT ADDRESS: MARIJAN STEPHAN HUCKE HUCKE & HUCKE AN DER FUCHSKAUL 14 PULHEIM, 50259 GERMANY</p>	<p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p>
<p>APPLICANT: Nikos Alexakis AG</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO: D 155/13</p> <p>CORRESPONDENT E-MAIL ADDRESS: office@u-tm.com</p>	

EXAMINING ATTORNEY'S APPEAL BRIEF

Nikos Alexakis AG (hereinafter referred to as “Applicant”) has appealed the Office’s partial refusal to register the mark “OMEGA SOUL” (in standard characters) for use in Class 5 with “nutritional supplements.” Trademark Act Section 2(a), 15 U.S.C. §1052(a).

I. FACTS

On May 27, 2013, Applicant applied for registration on the Principal Register of the wording “OMEGA SOUL” (in standard characters) for use in Class 5 with “nutritional supplements.”

On July 17, 2013, the Office initially partially refused registration of the mark pursuant to Trademark Act Section 2(a) because the mark consists of or includes deceptive matter in relation to nutritional supplements in Class 5, notified Applicant about prior pending application U.S. Serial No. 85421303, required the disclaimer of the word “OMEGA” with respect to the identified goods in Class 5, required an amendment to the identification of goods in Class 5 to avoid the Trademark Act Section 2(a) deceptiveness refusal, which amendment required Applicant to indicate that its nutritional supplements contain in significant part omega fatty acids, and required Applicant to submit a written statement verifying that its nutritional supplements contain in significant part omega fatty acids.

On January 17, 2014, in its Response to Office action, Applicant noted that prior pending application U.S. Serial No. 85421303 had been abandoned, argued against the deceptiveness refusal as to its nutritional supplements, admitted its nutritional supplements do not contain omega fatty acids in significant part, did not amend its Class 5 identification of goods to include a representation that its nutritional supplements contain omega fatty acids in significant part, and disclaimed the exclusive right to use “OMEGA” apart from the mark as shown.

On February 5, 2014, the Office acknowledged that prior pending application U.S. Serial No. 85421303 had been abandoned, and maintained and made final the deceptiveness refusal as to Applicant's nutritional supplements pursuant to Trademark Act Section 2(a).

On August 5, 2014, in its Request for Reconsideration after Final Action, which was filed with its appeal to the Board, Applicant argued against the deceptiveness refusal as to its nutritional supplements.¹

On September 12, 2014, the examining attorney denied Applicant's Request for Reconsideration. Applicant's appeal resumed on September 29, 2014.

II. ISSUE

WHETHER THE APPLIED-FOR-MARK IS DECEPTIVE AS APPLIED TO THE CLASS 5 GOODS IN THE APPLICATION

III. ARGUMENT

As the Court of Appeals for the Federal Circuit explained in *In re Budge Mfg. Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), the test for whether a mark consists of or comprises deceptive matter is:

(1) Whether the applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods;

¹ The examining attorney notes that refusal on appeal pertains to class 5 only and were the applicant to be unsuccessful in its appeal, class 5 would be deleted from the application and class 28 would be approved for publication, which is contrary to the advisory in the Final action. 37 C.F.R. §2.65(a)(1),

(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods;

(3) If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase the goods.

See also In re E5 LLC, 103 USPQ2d 1578 (TTAB 2012) (holding a mark consisting of the alpha symbol and letters "CU" deceptive for dietary supplements not containing copper, a common ingredient in dietary supplements, which evidence showed is referred to as CU).

A. THE APPLIED-FOR-MARK CONSISTS OF OR CONTAINS A TERM THAT MISDESCRIBES THE COMPOSITION OF THE GOODS

The goods at issue here are nutritional supplements. Applicant's applied-for mark – OMEGA SOUL – includes the term "OMEGA," which indicates the goods contain omega fatty acids, a group of fats that are thought by a substantial number of consumers to have health benefits. *See* Office action dated July 17, 2013, at 4-17, 44-55. Regarding the health benefits of these substances, the National Institutes of Health recognized that "Omega-3 fatty acids are a group of polyunsaturated fatty acids that are important for a number of functions in the body." *Id.* at 48. The National Institutes of Health identified some of the functions for which Omega-3 fatty acids are important as "muscle activity, blood clotting, digestion, fertility, and cell division and growth." *Id.* The National Institutes of Health further explained that one type of omega-3 fatty acid "is important for brain development and function" and that another is "an 'essential' fatty acid, meaning that people must obtain it from food or supplements because the human body cannot manufacture it." *Id.*

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