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Subject: U.S. TRADEMARK APPLICATION NO. 86454618 - 6000-0372 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86454618

MARK:

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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: W.F. Young, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

6000-0372

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register its design mark, which consists solely of a blank ribbon-shaped banner. Registration was refused under (1) Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 4653735 and 4724070 as to be likely to cause confusion, to cause mistake, or to deceive; (2) Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, because the applicant's mark, as used on the specimens of record, fails to

function as a trademark because it is merely a background design that functions as part of a composite mark that incorporates additional wording; and (3) Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, because the International Class 21 specimen of record does not show the applicant's mark in use in commerce in connection with any of the International Class 21 goods specified in the amendment to allege use.[1]

FACTS

The applicant has applied to register a design mark consisting solely of a blank ribbon-shaped banner for "Non-medicated cleaning preparations for livestock, horses and domestic animals, namely, shampoos, hair polish, detanglers, conditioners, fragrance sprays, stain removers; coat, mane and tail whiteners; mane and tail cleaners; non-medicated hoof care products namely conditioners, moisturizing creams and polish" in International Class 3; "Veterinary preparations for livestock, horses and domestic animals, namely, liniments, antimicrobials for dermatologic use, medicated shampoos, topical analgesics and anti-inflammatory creams, ointments and sprays; animal feed supplements and feed additives for use as dietary supplements and animal health supplements; medicated hoof ointments; hoof packing for reducing hoof heat, pain, swelling and for killing and preventing growth of bacterial and fungal infections; insecticides, insect repellents and flea and tick control products in the form of liquids, sprays, creams, shampoos, powders, spot-ons and dips" in International Class 5; "Bag netting for covering eyes and head for livestock and horses" in International Class 18; and "Sponges, combs and brushes;

[1] The specimen refusal under Trademark Act Sections 1 and 45 applies only to International Class 21.

shedding combs and brushes; cleaning mitts for grooming livestock horses and domestic animals" in International Class 21.[2]

Registration was refused because the applicant's mark is confusingly similar to U.S. Registration Nos. 4653735 and 4724070. U.S. Registration No. 4653735 consists of the stylized wording "HEAD TO TAIL" and the design of a blank ribbon-like banner for "Dietary supplements for pets" in International Class 5. U.S. Registration No. 4724070 consists of the stylized wording "BIOMANE" appearing in the center of a ribbon-shaped banner for "Topical body lotion" in International Class 3 and "Veterinary preparations in the form of equine pellets for the thickening of horse manes" in International Class 5.

Registration also was refused under Trademark Act Sections 1, 2, and 45 because the applicant's mark, as used on the specimens of record, is merely a background design that functions as part of a composite mark that incorporates additional wording. As such, it does not function separately as a trademark.

With respect to International Class 21 only, registration was refused under Trademark Act Sections 1 and 45 because the specimen of record does not show the applicant's mark in use in commerce in connection with any of the International Class 21 goods specified in the amendment to allege use.

On April 9, 2016, all of the foregoing refusals were made final. On June 1, 2017, a subsequent final Office action was issued which maintained the finality of the Section 2(d) likelihood of confusion refusal, the Sections 1, 2, and 45 failure to function as trademark refusal, and the Sections 1 and 45 specimen refusal. The issues to be decided on appear are (1) whether the applicant's mark is likely to

[2] U.S. Application Serial No. 86/454618, filed on November 14, 2014, based on applicant's bona fide intention to use the mark in commerce under Trademark Act §1(b), 15 U.S.C. §1051(b). On September 2, 2015, the applicant filed an amendment to allege use (AAU), which alleges a date of first use anywhere and a date of first use in commerce of January 9, 2014 for all goods and all international classes.

cause confusion with the U.S. Registration Nos. 4653735 and 4724070; (2) whether the applicant's mark is merely a background design that functions as part of a composite mark that incorporates additional wording; and (3) whether the International Class 21 specimen of record shows the use of the applicant's mark in commerce in connection with any of the International Class 21 goods specified in the amendment to allege use.

ARGUMENTS

I. THE APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH U.S. REGISTRATION NOS. 4653735 AND 4724070 UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods of applicant and registrants. *See* 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, "[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601. F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir 2010)). The USPTO may focus its analysis "on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services]." *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

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