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Subject: U.S. TRADEMARK APPLICATION NO. 87332368 - NEWMERA - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87332368

MARK: NEWMERA



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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: SWISS TECH BIOLABS, INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## EXAMINING ATTORNEY'S APPEAL BRIEF

### STATEMENT OF THE CASE

Swiss Tech Biolabs, Inc. ("Applicant") has appealed the Trademark Examining Attorney's final refusal to register the applied-for mark **NEWMERA** in standard characters for "Dietary supplements for the alleviation of edema and pain" in International Class 5 on the ground the applied-for mark is likely to cause confusion, mistake, or deception under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark in U.S. Registration No. 4934480, **NEMERA** in standard characters for, *inter alia*,

“Pharmaceutical products for the treatment of ophthalmic disorders, respiratory disorders, dermatological disorders, ophthalmologic and inflammatory disorders; Medical preparations for use in the treatment of ophthalmic disorders, respiratory disorders and inflammatory disorders; Sanitary preparations for medical purposes; Dietetic substances for medical use, namely, meal replacement bars and meal replacement drink mixes” in International Class 5, and the mark in U.S. Registration No. 4857255, **NEMERA** in stylized form for, *inter alia*, “Pharmaceutical products for the treatment of ophthalmic disorders, respiratory disorders, dermatological disorders, ophthalmologic and inflammatory disorders; Medical products, namely, pharmaceutical preparations for use in the treatment of ophthalmic disorders, respiratory disorders and inflammatory disorders; Sanitary products for medical purposes, namely, sanitary preparations for medical use; Dietetic substances for medical use, namely, meal replacement bars and meal replacement drink mixes” in International Class 5. Both of the cited registrations are owned by the same registrant, Devix Midco. It is respectfully requested that the refusal be affirmed.

#### **FACTS**

Applicant filed this application on February 10, 2017, applying to register the mark **NEWMERA** in standard characters for “Dietary supplements and preparations for the alleviation of edema and pain” in International Class 5 on the Principal Register. In the first Office Action dated May 5, 2017, a refusal to registration was issued under Section 2(d) of the Trademark Act on the ground that the mark, when used on or in connection with the referenced goods, so resembles the marks in U.S. Registration Nos. 4857255 and 4934480 as to be likely to cause confusion, to cause mistake, or to deceive as to the source of the goods of the applicant and registrant.

On November 5, 2017, the applicant filed its response, arguing that the refusal to register the applied-for mark under Section 2(d) should be withdrawn because the marks and goods were not

confusingly similar. On November 10, 2017, the refusal to register the mark pursuant to Trademark Act Section 2(d) for a likelihood of confusion with U.S. Registration Nos. 4857255 and 4934480 was maintained and made final.

On May 10, 2018, the applicant filed a request for reconsideration, amending its identification of goods to “Dietary supplements for the alleviation of edema and pain” in International Class 5 and reasserting its position that the marks and goods were not confusingly similar. On May 16, 2018, the examining attorney denied the applicant’s request for reconsideration and the present appeal followed.

### **ISSUE**

The sole issue on appeal is whether the mark, when used in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 4857255 and 4934480 as to be likely to cause confusion, to cause mistake, or to deceive as to the source of the goods of the applicant and registrant under Trademark Act Section 2(d).

### **ARGUMENT**

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 the applicant and registrant. *See* 15 U.S.C. §1052(d). A likelihood of confusion determination 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, 1361, 177 USPQ 563, 567 (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). In this case, the following factors are most relevant: the similarity of the marks, the similarity and nature of the goods, and the 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); TMEP §§1207.01 et seq.

Because the applicant's mark **NEWMERA** is similar in sound and appearance to the registered marks for **NEMERA** and the goods offered by the applicant and registrants are related, registration of the applied-for mark is likely to create consumer confusion as to source.

#### A) COMPARISON OF MARKS

##### The Applied-For Mark and Registered Marks are Similar

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); TMEP §1207.01(b). In conducting this analysis, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether an average purchaser, who retains a general rather than specific impression of trademarks, would mistake or confuse the source of the goods. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); TMEP §1207.01(b).

In this instance, the applicant's mark **NEWMERA** and the registrant's marks **NEMERA** are substantially similar in appearance as both begin with the letters "NE" and end with the term "MERA". The only difference between the marks is the applied-for mark includes the letter "W" after the letters "NE". Despite that slight alteration in spelling, the marks in question could be pronounced the same. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); TMEP §1207.01(b)(iv).

The inclusion of stylization in U.S. Registration No. 4857255 does not diminish the likelihood of confusion. The word portion of a mark is more likely to indicate the origin of the goods because it is that

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