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**Subject:** U.S. Trademark Application Serial No. 88155341 - SOLÜTION - 130432-4002  
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**United States Patent and Trademark Office (USPTO)**  
**Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.**  
88155341

**Mark:** SOLÜTION

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**Applicant:** Share Skincare  
Inc.

**Reference/Docket No.**  
130432-4002

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**FINAL OFFICE ACTION**

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS) and/or Electronic System for Trademark Trials and Appeals (ESTTA). A link to the appropriate TEAS response form and/or to ESTTA for an appeal appears at the end of this Office action.

Issue date: **December 03, 2020**

## **INTRODUCTION**

In a final office action dated October 16, 2019, registration was refused based on a partial refusal under Section 2(d). Applicant filed a request for reconsideration dated April 15, 2020, in which applicant argued against the Section 2(d) refusal and requested to divide the services of record. On May 10, 2020, the examining attorney issued a suspension letter that continued and maintained the refusal under Section 2(d), advised applicant of the proper means to divide the services of record, and suspended the application pending the filing of registration maintenance documents in the cited cases for U.S. Registration Nos. 2309323 and 3700519.

Registration maintenance documents were filed in U.S. Registration No. 2309323 on or about August 26, 2020 and in U.S. Registration No. 3700519 on or about June 29, 2020. As a result, the cited registrations remain valid. Accordingly, examination is herein resumed and the final refusal is re-issued.

After careful consideration of applicant's evidence and arguments, the trademark examining attorney maintains and now makes FINAL the refusal in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

## **SUMMARY OF ISSUES MADE FINAL THAT APPLICANT MUST ADDRESS:**

- PARTIAL REFUSAL: SECTION 2(d) – LIKELIHOOD OF CONFUSION
- PARTIAL REFUSAL: SECTION 2(e)(1) – MERELY DESCRIPTIVE
- ADVISORY: APPLICATION NOT ELIGIBLE FOR SUPPLEMENTAL REGISTER- AS TO PARTIAL SECTION 2(e)(1) REFUSAL
- ADVISORY: FAILURE TO RESPOND TO PARTIAL FINAL OFFICE ACTION
- ADVISORY: PARTIAL REFUSAL OPTIONS

## **REFUSAL: PARTIAL REFUSAL: SECTION 2(d) – LIKELIHOOD OF CONFUSION**

ALL PRIOR ARGUMENTS AND EVIDENCE ARE MAINTAINED AND INCORPORATED HEREIN

**The partial refusal with respect to registration number 4332362 applies to applicant's identifications for "Online business risk assessment and business consultation services in the field of health and lifestyle; Market analysis and research services, namely, collecting, analyzing, processing and providing customer preference and product usage data in the field of health, lifestyle, fitness and food products" in International Class 035 only.**

**The partial refusal with respect to registration numbers 2309323, 3989747, and 3700519 applies to the entirety of applicant's International Class 044 only.**

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2309323, 3989747, 3700519, and 4332362. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* *See* previously attached registrations.

The applied-for mark is "SOLÜTION" with design for the relevant- amended services:

- |                         |   |
|-------------------------|---|
| International Class 035 | Online business risk assessment and business consultation services in the field of health and lifestyle; Market analysis and research services, namely, collecting, analyzing, processing and providing customer preference and product usage data in the field of health, lifestyle, fitness and food products   |
| International Class 044 | Providing a website featuring information on maintaining a healthy lifestyle, health and nutrition, and wellness; Providing a website featuring nutritional information about food; Personalized health and skin assessment and health and skin consultation services based on a consumer's lifestyle, health, microbiome, DNA, and genetic information |

The registered marks in U.S. Registration Nos. 2309323 and 3989747 are "SOLUTIONS" in typed and standard characters for "Medical

The registered mark in U.S. Registration No. 3700519 is “**SOLUTIONS**” in standard characters for “**Geriatric health care management services; Health care; Healthcare; Home health care services; Home nursing aid services; Nursing care**” in International Class 44. The foregoing is owned by United HomeCare Services, Inc.

The registered mark in U.S. Registration No. 4332362 is “**SOLUCION**” with design for “**Business management services**” in International Class 35. The foregoing is owned by United HomeCare Services, Inc.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

In this case, a likelihood of confusion is present because there are similarities between the compared marks and relatedness of the compared services.

#### SIMILARITY OF THE MARKS

The applicant’s and registrants’ respective marks, “**SOLÜTION**”, “**SOLUTIONS**”, and “**SOLUCION**”, are similar in appearance, sound, connotation, and commercial impression.

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) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

#### U.S. Registration Nos. 2309323, 3989747, and 3700519

In this instance, the wording in the applied-for mark “**SOLUTION**” is the singular form of the registered marks “**SOLUTIONS**”. An applied-for mark that is the singular form of a registered mark is essentially identical in sound, appearance, meaning, and commercial impression, and thus the marks are confusingly similar. *Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding “it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar”).

Furhter, the overline, underline, and umlaut in applicant’s mark do not obviate the noted similarities because such are likely to be perceived by consumers as designs that surround the literal elements in applicant’s mark. When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining

whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Vittera Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In this case, "SOLUTION" would be accorded greater weight because it is the literal element of applicant's mark that is likely to impress upon consumers, be remembered by them, and be used by them to refer to or request applicant's services. The overline, underline, and umlaut in the mark do not obviate the noted significant of "SOLUTION" in applicant's mark because such are designs that merely accent the literal element "SOLUTION". Thus, "SOLUTION" is the dominant feature and literal element of applicant's mark that is likely to be perceived by consumers as confusingly similar to registrants' marks for "SOLUTIONS".

Thus, the applied-for mark and the registered marks are sufficiently similar to find a likelihood of confusion.

#### U.S. Registration No. 4332362

The registered mark "SOLUCIÓN" is the foreign equivalent of the term in the applied-for mark "SOLÜTION". See attached internet evidence from <https://translate.google.com/>. Under the doctrine of foreign equivalents, a mark in a common, modern foreign language and a mark that is its English equivalent may be held confusingly similar. TMEP §1207.01(b)(vi); see, e.g., *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015). Consequently, marks comprised of foreign wording are translated into English to determine similarity in meaning and connotation with English word marks. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation may be sufficient to find such marks confusingly similar. See *In re Aquamar, Inc.*, 115 USPQ2d at 1127-28; *In re Thomas*, 79 USPQ2d at 1025.

The doctrine of foreign equivalents is applied when "the ordinary American purchaser" would "stop and translate" the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); TMEP §1207.01(b)(vi)(A). The ordinary American purchaser includes those proficient in the foreign language. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

Here, Spanish is a common, modern language in the United States. See *In re Aquamar, Inc.*, 115 USPQ2d 1122. For example, there are an estimated 41 million U.S. residents who speak Spanish. See the attached internet evidence from <https://www.cnn.com/>. The ordinary American purchaser would likely stop and translate the Spanish mark "SOLUCIÓN" to its English equivalent "SOLUTION" because the Spanish language is a common, modern language spoken by an appreciable number of consumers in the United States. Applicant's stylized mark contains the literal element "SOLUTION". Thus, applicant's and registrant's marks share equivalence in meaning and connotation, which renders the marks confusingly similar.

Because applicant's and registrants' marks for "SOLÜTION", "SOLUTIONS", and "SOLUCION" are similar in appearance, sound, connotation, and commercial impression, the marks are confusingly similar.

#### RELATEDNESS OF THE SERVICES

The applicant's relevant services are listed below:

The applied-for mark is "SOLÜTION" with design for the relevant- amended services:

- |                         |   |
|-------------------------|---|
| International Class 035 | Online business risk assessment and business consultation services in the field of health and lifestyle; Market analysis and research services, namely, collecting, analyzing, processing and providing customer preference and product usage data in the field of health, lifestyle, fitness and food products   |
| International Class 044 | Providing a website featuring information on maintaining a healthy lifestyle, health and nutrition, and wellness; Providing a website featuring nutritional information about food; Personalized health and skin assessment and health and skin consultation services based on a consumer's lifestyle, health, microbiome, DNA, and genetic information |

The registrants' relevant services are listed below:

The registered marks in U.S. Registration Nos. 2309323 and 3989747 are "SOLUTIONS" in typed and standard characters for "Medical information" in International Class 44. All the foregoing are owned by ConvaTec Inc.

The registered mark in U.S. Registration No. 3700519 is "SOLUTIONS" in standard characters for "Geriatric health care management services; Health care; Healthcare; Home health care services; Home nursing aid services; Nursing care" in International Class 44. The foregoing is owned by United HomeCare Services, Inc.

The registered mark in U.S. Registration No. 4332362 is “**SOLUCION**” with design for “**Business management services**” in International Class 35. The foregoing is owned by United HomeCare Services, Inc.

The applicant’s and registrant’s services are related and could give rise to the mistaken belief that they emanate from the same source.

The services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, applicant’s and registrant’s services could give rise to the mistaken belief that they emanate from the same source because they are commonly provided by the same entity. For example, the previously attached Internet evidence, consisting of third-party health related webpages, establishes that the same entity commonly provides the relevant services and markets the services under the same mark, the relevant services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and the services are similar or complementary in terms of purpose or function. *See* the previously attached internet evidence:

- <https://www.healthline.com/symptom-checker>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management; and medical information;
- <https://www.symptoma.com/en/about>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management; and medical information;
- <https://symptoms.webmd.com/default.htm>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services and medical information;
- <https://ada.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services and medical information;
- <https://www.mayoclinic.org/symptom-checker/select-symptom/itt-20009075>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management; and medical information;
- <https://symptomchecker.isabelhealthcare.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management; and medical information;
- <https://infermedica.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management; and medical information;
- <https://naturalwellnesscorner.com/services/wellness-counseling/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; medical information; and health care;
- <https://theministerofwellness.com/service/healthcoaching/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services and health care;
- <https://www.nourishmintwellness.com/product/initial-wellness-consultation/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services and health care;
- <https://heidilyndaker.com/consultations/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services and health care;
- <https://connorwellnessclinic.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; medical information; and health care;
- <https://www.the-dermatologist.com/content/geriatric-dermatology-generational-approach>; showing that geriatric dermatology is a rapidly growing field and cosmetic dermatology is increasingly becoming part of the culture for geriatric patients;
- <https://wendyrobertsmd.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management and cosmetic skin procedures to, in part, geriatric patients; medical information; and health care;
- <https://www.trinitydermatology.com/>, showing that the same entity provides medical, health, wellness, and nutrition analysis, assessment, consultation, and information services; healthcare information services, namely, providing information in the area of wound and skin care management and cosmetic skin procedures to, in part, geriatric patients; medical information; and health care;

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