To:	SHERRY FLAX(sherry.flax@saul.com)
Subject:	U.S. Trademark Application Serial No. 88825450 - - Examiner Brief
Sent:	October 13, 2023 09:10:18 AM EDT
Sent As:	tmng.notices@uspto.gov

Attachments

Class5.jpg
Analgesic
Anti-inflammatory
SkinCare

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88825450

Mark:

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Applicant: FUSION CBD PRODUCTS LLC

Reference/Docket No. N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the leaf design mark for goods in class 3 on the grounds that the specimen does not show the identified goods.

STATEMENT OF FACTS

On March 7, 2020, applicant Fusion CBD Products LLC applied under Section 1(a) of the Trademark

Act to register a design ultimately described as "an image of a leaf in light green and dark green" for goods ultimately identified as "Non-medicated topical skin care preparations, all of the aforementioned goods containing or derived from CBD derived from hemp with a delta-9 THC concentration of not more than 0.3% on a dry weight basis" in class 3.[1] With the application, applicant provided a specimen of use showing the mark used on a point-of-sale webpage for goods labeled as "CBD Pain Relief Cream for Muscles and Joints".

On June 5, 2020, the examining attorney[2] issued a non-final Office action, which included a refusal of the specimen for not providing the website date of access. The applicant responded on October 19, 2020, providing a substitute specimen that is identical to the originally-submitted specimen, save for the inclusion of the access date in the second submission.

On November 17, 2020, the examining attorney issued a combined Priority Action and Examiner's Amendment, in which the Priority Action portion consisted of a specimen refusal on the grounds that the specimen did not show use of the mark with the identified class 3 goods but only with class 5 pain relief creams. This refusal was initially withdrawn, but on April 20, 2022, the examining attorney issued a new non-final Office action stating that the withdrawal was in error and reinstating the refusal on the grounds that the specimen did not show use of the mark with the identified class 3 goods.

On September 25, 2022, applicant responded by arguing that the product pictured in the specimen should qualify as a class 3 non-medicated skin care preparation. The examining attorney found this argument insufficient to overcome the specimen refusal, which was made final on November 7, 2022. Applicant appealed and requested reconsideration on May 5, 2023, again arguing that the pictured product is not medicated.[3]The Request for Reconsideration was denied on June 30, 2023, and this appeal was resumed. The applicant timely filed an appeal brief, which was forwarded to the examining attorney.

EVIDENTIARY ISSUES

Applicant has submitted new evidence with its appeal brief, specifically, a number of TESS records for third-party registrations not previously made part of the application record. 6 TTABVUE 4-15. The

record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re tapio GmbH*, 2020 USPQ2d 11387, at *3-4 (TTAB 2020); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *2 (TTAB 2020); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

In its appeal brief, applicant also requests that the Board take judicial notice of the Nice Agreement, specifically the class headings for classes 3 and 5. 6 TTABVUE 3. As the Board is permitted to take judicial notice of "international conventions and treaties," the examining attorney does not object to this request. TBMP §1208.04. However, the examining attorney hereby requests that the Board also take judicial notice of the presence of "analgesics" and "anti-inflammatories" in the Nice Alphabetical List for class 5 (highlighted screenshot from WIPO attached for reference). The examining attorney also requests that the Board take judicial notice of the attached definitions of "analgesic" and "anti-inflammatory" from the Merriam-Webster dictionary, and the attached definition of "skin care" from the Cambridge Dictionary. *See* TBMP §1208.04.

ISSUE

The sole issue on appeal is whether applicant has shown use of the mark for the goods identified in the application, "Non-medicated topical skin care preparations, all of the aforementioned goods containing or derived from CBD derived from hemp with a delta-9 THC concentration of not more than 0.3% on a dry weight basis".

ARGUMENTS

APPLICANT HAS NOT SHOWN USE OF THE MARK FOR THE IDENTIFIED GOODS BECAUSE SKIN CARE IS NOT THE PRIMARY PURPOSE OF THE GOODS IN THE SPECIMEN

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods identified in the application. 15

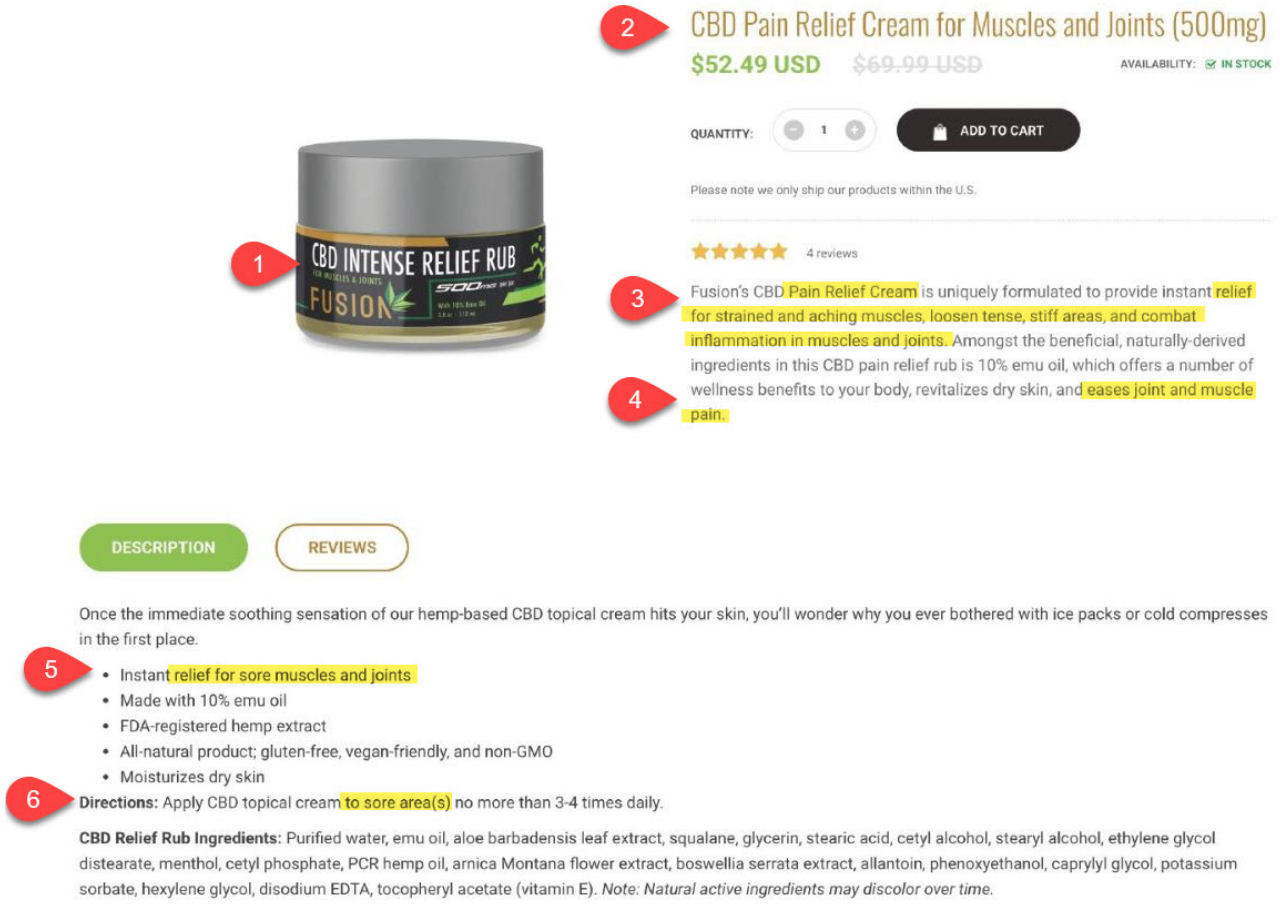
U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013). In this case, the specimen does not show use with the identified "Non-medicated topical skin care preparations, all of the aforementioned goods containing or derived from CBD derived from hemp with a delta-9 THC concentration of not more than 0.3% on a dry weight basis" in class 3.

Applicant's responses seem to focus on the "non-medicated" portion of the identification, arguing that the goods do not contain medications and that adding emu oil to a product does not make that product medicated. See Sept. 25, 2022 Response to Office Action, TSDR p.1; May 5, 2023 Request for Reconsideration, p. 1. While this may be true, the identification also specifies that the goods are "skin care preparations" - that is, that their primary purpose[4] is "to keep [the] skin healthy and attractive." *See* attached Cambridge Dictionary entry for "skin care". To show the goods identified in the application, therefore, the applicant's specimen would need to show a product with more than incidental skin care benefits. The specimen of record does not.

The product description in the specimen only briefly mentions a skin care purpose ("revitalizes dry skin") in a sentence that also promotes its pain relief benefits ("eases joint and muscle pain"). Indeed, even while attempting to argue that the product is "an unmedicated moisturizing cream" that contains "no medicated or analgesic substance," the applicant immediately states that it "may reduce pain by reducing swelling." Sept. 25, 2022 Response to Office Action, TSDR p. 1. The applicant's evidence regarding emu oil further reiterates that the fatty acids in emu oil are believed to "reduce pain and swelling (inflammation)." Sept. 25, 2022 Response to Office Action, TSDR p. 2. As shown by the attached definitions, a substance that reduces pain is an analgesic, and if it does so by reducing inflammation, it is also an anti-inflammatory. Both "analgesics" and "anti-inflammatories" are listed in the Nice Classification's alphabetical list of class 5 goods; they are not skin care products. The product shown in the specimen, therefore, which is primarily an analgesic and/or an anti-inflammatory, therefore, is not a "non-medicated topical skin care preparation" in class 3.

Furthermore, the specimen, an annotated portion of which is reproduced below for ease of reference, clearly demonstrates that the product is advertised to consumers as an analgesic for muscles and joints,

not as a skin care product.



Specifically, (1) the product jar pictured on the webpage is labelled "CBD INTENSE RELIEF RUB FOR MUSCLES & JOINTS" and (2) the product title on the page is "CBD Pain Relief Cream for Muscles and Joints". The product description (3) states that "Fusion's CBD Pain Relief Cream is uniquely formulated to provide instant relief for strained and aching muscles, loosen tense, stiff areas, and combat inflammation in muscles and joints", that emu oil "eases joint and muscle pain" (4), and that the product provides "instant relief for sore muscles and joints" (5). The directions for use (6) state to apply the product "to sore area(s)." The product is clearly promoted as having a primary purpose of relieving pain in muscles and joints, not as primarily keeping the skin healthy and attractive. Therefore, the specimen only shows use of the mark for a class 5 pain relief cream, not for the class 3 "Non-medicated topical skin care preparations, all of the aforementioned goods containing or derived from CBD derived from hemp with a delta-9 THC concentration of not more than 0.3% on a dry weight basis" identified in the application. Applicant has not provided the required specimen showing the

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