To: ALEXANDER LAZOUSKI(al@lzlawoffice.com)
Subject: U.S. Trademark Application Serial No. 97028736 - NIMA
Sent: June 01, 2023 03:01:37 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

screencapture-www-cleanhappens-com-collections-hand-soaps-and-lotions-16856423771751
screencapture-www-cleanhappens-com-collections-all-16856424151481
screencapture-www-indigowild-com-collections-zum-face-products-16856425605371
screencapture-www-indigowild-com-collections-home-care-16856426028631
screencapture-methodproducts-com-personal-care-16856429686291
screencapture-methodproducts-com-home-care-16856429961051
screencapture-www-mrsmeyers-com-product-body-care-16856430235791
screencapture-www-mrsmeyers-com-product-household-cleaners-16856431073681
screencapture-www-mrsmeyers-com-product-laundry-16856431277551
screencapture-puracy-com-collections-personal-care-essentials-16856431783841
screencapture-puracy-com-collections-puracy-home-essentials-16856432188341
screencapture-www-nowfoods-com-products-beauty-health-16856433504181
screencapture-www-herbalife-com-our-products-skin-and-hair-care-16856434174011
screencapture-www-herbalife-com-our-products-core-nutrition-16856434516731
screencapture-www-paulaschoice-com-skin-care-products-cleansers-16856435012771
screencapture-www-paulaschoice-com-skin-care-products-supplements-16856435195111
screencapture-www-perriconemd-com-skincare-list-16856435655051
screencapture-www-perriconemd-com-collections-supplements-list-16856436007911

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 97028736

Mark: NIMA

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UNITED STATES

Applicant: NIRMA LIMITED

Reference/Docket No. N/A

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REQUEST FOR RECONSIDERATION AFTER FINAL ACTION DENIED

Issue date: June 1, 2023

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

In the June 27, 2022 Office action, registration was refused under Section 2(d) of the Trademark Act for likelihood of confusion with the marks in Reg. Nos. 6587433 and 6739897. Additionally, applicant was required to amend the identification of goods. Applicant provided an adequate identification in applicant's December 27, 2022 response and provided arguments in response to the Section 2(d) refusal that failed to overcome the refusal. Additionally, in the February 8, 2023 final Office action, the Section 2(d) refusal was made final. In applicant's May 8, 2023 Request for Reconsideration, applicant provided further arguments and evidence in response to the Section 2(d) refusal that does not overcome the refusal for the reasons discussed below.

SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

In applicant's response, applicant argues that the marks are not confusingly similar based on the sight, sound, and commercial impression of the marks. However, applicant has provided no arguments or evidence to support this statement. Even so, the difference between "NIMA", "NIIMA", and "NIEMA", does not obviate the similarity between the marks because these marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv).

Moreover, applicant argues that the mark is weak based on third-party registrations for similar marks with similar goods. Applicant has submitted 15 examples of third-party use of marks that applicant claims are similar to the applied-for and cited marks to show that the marks in the cited registrations are commercially weak and should not be afforded a broad scope of protection. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); TMEP §1207.01(d)(iii).

Evidence of third-party use falls under the sixth *du Pont* factor, which assesses the number and nature of similar marks in use on similar goods and/or services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Considerable or ubiquitous evidence of third-party use of similar marks on similar goods and/or services can be relevant to show that consumers have become conditioned by encountering so many similar marks in the marketplace that they distinguish between them based on minute distinctions, such that the mark or component should be considered relatively weak and entitled to only a narrow scope of protection. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373-74, 116 USPQ2d 1129, 1136-37 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1338-39, 115 USPQ2d at 1674 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d at 1373, 73 USPQ2d at 1693); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party uses of similar marks is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). The amount of evidence of third-party use provided by applicant in this case falls short of the "ubiquitous" or "considerable" use of similar marks found probative in the cases. *See In re i.am.symbolic, llc*, 866 F.3d at 1329, 123 USPQ2d at 1752 (citing *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d at 1374, 116 USPQ2d at 1136-37; *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1674). Thus, the evidence is insufficient to establish that a portion or all of applicant's mark is commercially weak and entitled to a narrow scope of protection. In this case, none of the attached registrations show the spelling of "NI-" for applicant's washing preparations or skin care goods. The only third-party registration with this spelling, "NIIMA", Reg. No. 6349315, is for sanitary napkins, pads, and tampons that are not as highly related as the goods in the applied-for and cited marks. Overall, almost all of the marks in third-party registrations are not phonetic equivalents to the registered mark or have additional wording that is not included in the applied-for or cited marks.

Further, the evidence of third-party use appears to be for goods and/or services that are predominantly different from or unrelated to those identified in the cited registration and applicant's application. Evidence comprising third-party use of similar marks for different or unrelated goods and/or services has "no bearing on the strength of the term in the context relevant to this case." See Tao Licensing, LLC v. Bender Consulting Ltd., 125 USPQ2d 1043, 1058 (TTAB 2017) (citing In re i.am.symbolic, llc, 866 F.3d at 1328, 123 USPQ2d at 1751). Thus, the third-party use evidence submitted by applicant is not probative on whether a portion or all of the mark is commercially weak and entitled to a narrow scope of protection.

Applicant did not provide arguments with regard to the relatedness of the goods. The compared goods and/or 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); *see Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)).

The attached Internet evidence, consisting of third-party websites, establishes that the same entity commonly manufactures, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark. Specifically, the evidence of record from Young Living, Honest, Avon, Brandless, Forever Living, and DoTerra show that the same entities commonly provide applicant's washing preparations and body soap as well as registrants' supplements and facial cleansers or lotions under the same mark. Moreover, the newly attached evidence from now, HerbaLife, Paula's Choice, and Perricone MD shows that the same entities commonly provide applicant's skincare goods and the supplements in Reg. No. 6739897 under the same mark and the newly attached evidence from Better Life, Indigo Wild, Method, Mrs. Meyers, and Puracy shows that the same entities commonly provide applicant's washing preparations and registrant's facial skincare goods in Reg. No. 6587433 under the same mark. Thus, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04

(TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated February 8, 2023 are **maintained and continued**:

- Section 2(d) Refusal - Likelihood of Confusion

See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the response period for the final Office action, applicant has the remainder of that time to (1) file another request for reconsideration that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B).

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