

To: OTTO O. LEE(tm_docket@iplg.com)
Subject: U.S. Trademark Application Serial No. 97370131 - INVISISHIELD - - 6397
Sent: February 29, 2024 12:31:31 PM EST
Sent As: tmng.notices@uspto.gov

Attachments

[6063404](#)
[5960959](#)
[4522174](#)
[6971777](#)
[screenshot-pharmacie-com-products-puressentielrespiratory-decongestant-nasal-spray-15ml-17092242566621](#)
[screenshot-pharmacie-com-products-puressentiel-purifying-antibacterial-lotion-spray-hands-surfaces-with-3-essential-oils-250ml-17092242851311](#)
[screenshot-mhpvitamins-com-collections-all-products-silver-biotics-nasal-spray-2-oz-17092244248921](#)
[screenshot-mhpvitamins-com-collections-all-products-silver-biotics-1-5oz-17092244438371](#)
[screenshot-www-thevalleyhive-com-products-propolis-nasal-spray-17092259595421](#)
[screenshot-www-thevalleyhive-com-products-bee-rejuvenated-facial-cream-1oz-tvh-17092259895511](#)
[screenshot-www-thevalleyhive-com-products-propolis-oil-1-fl-oz-tvh-17092260123061](#)
[MAJOR 1.jpg](#)
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[MAJOR 4.jpg](#)
[screenshot-beehealthyfarms-com-brand-2-kontak-17092263047301](#)

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

U.S. Application Serial No. 97370131

Mark: INVISISHIELD

Correspondence Address:

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UNITED STATES

Applicant: INVISISHIELD TECHNOLOGIES LTD.

Reference/Docket No. 6397

Correspondence Email Address: tm_docket@iplg.com

REQUEST FOR RECONSIDERATION AFTER FINAL ACTION DENIED

Issue date: February 29, 2024

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).

Accordingly, the following refusal made final in the Office action dated August 11, 2023, is **maintained and continued**:

- Section 2(d) Refusal - Likelihood of Confusion

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

The previous arguments and attachments are hereby incorporated by reference.

In its February 12, 2024, request for reconsideration, applicant has submitted thirteen third-party registrations containing the term "INVISI" to show that the mark in the cited registration is inherently or conceptually weak and should not be afforded a broad scope of protection. See *Jack Wolfskin Ausrüstung Fur Draussen Gmbh v. New Millennium Sports, SLU*, 797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Sabhani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)); TMEP §1207.01(d)(iii).

A large number of active use-based third-party registrations including the same or similar term or mark segment for the same or similar goods may be relevant to prove, in the same way dictionaries are used, that a term or mark segment has "a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak" and entitled to only a narrow scope of protection. *Jack Wolfskin Ausrüstung Fur Draussen Gmbh v. New Millennium Sports, SLU*, 797 F.3d at 1374, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1675); *Sabhani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (citing *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1057).

However, the additional third-party registrations applicant submitted only feature a portion of the relevant wording, namely, "INVISI", while the applicant's mark and the mark in the cited registration are virtually identical with the term "INVISI" and "SHIELD" used together. Evidence comprising only a small number of active use-based third-party registrations including the same or similar component is generally entitled to little weight in determining the strength of a mark. Here, the third-party registrations only feature a *portion* of the shared wording in the applicant's mark and the cited 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 few registrations are "not evidence of what happens in the marketplace or that customers

are familiar with them.” *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269).

Thus, the nine use-based third-party registrations submitted by applicant are insufficient to establish that the mark or portion of the mark is inherently or conceptually weak. It is noted that only nine of the third-party registrations are use-based. Registrations that are not based on use in commerce, such as those registered under Trademark Act Section 66(a) or solely under Trademark Act Section 44, and for which no Section 8 or 71 affidavits or declarations of continuing use have been filed, have “very little, if any, persuasive value.” TMEP §1207.01(d)(iii) (citing *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020)).

Further, assessing conceptual strength is “based on the nature of the [component] itself,” that is, its level of distinctiveness in relation to the specified goods. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)). Evidence comprising third-party registrations of similar marks for different or unrelated goods 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 at 1058 (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). These registrations appear to be for goods and services that are predominantly different from or unrelated to those identified in the cited registration and applicant’s application. The goods and services in the submitted registrations range from vehicle cleaning services to fiber optic installation kits to medical apparatus to chemical coatings to software to business services. Thus, these third-party registrations submitted by applicant are not probative on whether a portion or all of the mark is inherently or conceptually weak.

Applicant also submits two additional third-party applications beside applicant's own application. Third-party applications are evidence only that the applications were filed; they are not evidence of use of the mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); see *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); TBMP §1208.02; TMEP §710.03.

Thus, applicant submits only three use-based registrations owned by only two different owners using only a portion of the mark. This evidence is insufficient to establish that the mark or portion of the mark is inherently or conceptually weak.

Furthermore, prior decisions and actions of other trademark examining attorneys in applications for other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

In addition to the significant amount of evidence of record demonstrating that the goods here are related, the trademark examining attorney attaches even more evidence showing entities that produce nasal sprays as well as antimicrobial or antibacterial lotions, establishing that the same entity commonly produces the relevant goods and markets the goods under the same mark (See attached evidence from pharmacie.com, mhpvitamins.com, thevalleyhive.com, medline.com, beehealthyfarms.com).

Moreover, the trademark examining attorney has attached even more evidence from the USPTO’s X-

Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, nasal sprays and antimicrobial/antibacterial lotions, are of a kind that may emanate from a single source under a single mark. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii).

In a third-party registration, the full scope of the goods must be considered. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *9 (TTAB 2019). Specifically, “a registration that describes goods broadly is presumed to encompass all goods or services of the type described.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *9 (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)). Accordingly, terms such as antibacterial pharmaceutical preparations in the third-party registrations are broad enough to encompass antibacterial lotions in the cited registration. Similarly, term antibacterial lotions in the cited registration is broad enough to encompass antibacterial cleaners, antibacterial waterless soap, antibacterial sanitizer gel, antibacterial hand wash, and antibacterial hand-sanitizing preparations in the third-party registrations.

Therefore, applicant's arguments are not persuasive.

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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6063404



Word Mark

DINAMICS HEALTHCARE INC. USA

IC 005 US 006 018 046 052 044 051

Pharmaceutical products and preparations, namely, injectables, **nasal spray** and mints, oral liquids, oral solids and topicals for sterile aqueous ophthalmic use; Pharmaceutical products and preparations for the treatment of respiratory conditions; Analgesic preparations; Spinal anesthetics; Anti-diarrheal agents; Prescription synthetic narcotics; Prescription anxiolytics; Anti-seizure medications; Topical anesthetics; Pharmaceutical products and preparations for the prevention and treatment of infectious or parasitic diseases, neoplasms, diseases of blood or blood-forming organs or disorders involving the immune mechanism, endocrine, nutritional and metabolic diseases or disorders; Pharmaceutical products and preparations for the prevention and treatment of mental or behavioural disorders in the nature of diseases of the nervous, neurological diseases and disorders, and neurodegenerative diseases and disorders; Pharmaceutical products and preparations for the prevention and treatment of diseases of the eye or adnexa, diseases of the ear or mastoid process, diseases of the circulatory system, diseases of the respiratory system, disease the digestive system, diseases of the skin or subcutaneous tissue; Pharmaceutical products and preparations for the prevention and treatment of diseases of the musculoskeletal system or connective tissue in the nature of diseases of the genitourinary system, and congenital malformations, deformations or chromosomal abnormalities; Pharmaceutical products and preparations for fertility in the nature of fertility enhancement preparations, birth control in the nature of contraceptive preparations, anesthetic for surgical purposes for use in and child birth and during puerperium; Pharmaceutical products and preparations for treating wounds and poisoning; Pharmaceuticals and pharmaceutical preparations in the nature of **antibacterial** pharmaceuticals for protection against bacterial agents resistant to antibiotics; Pharmaceutical products and preparations for the prevention and treatment of pain and neuropathic pain by pharmaceutical compounders.

Goods/Services

Register

PRINCIPAL

Serial Number

88657829

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