



## ARE Trademark Law Alert: In a Precedental Decision, TTAB Accepts Appeal on the Section 2(d) Refusal of Trademark Application

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(December 20, 2010) An important TTAB precedental decision was rendered on September 23, 2010, discussing factors of the *In re E.I. DuPont de Nemours & Co., Inc.*, 476 F.2d 1357 (C.C.P.A. 1973), pertaining to determination of likelihood of confusion at the examination stage.

Typically, a USPTO Examining Attorney or a trademark practitioner would refer in the Office Action letter or the corresponding response thereto to the *In re E.I. DuPont de Nemours* case when dealing with the Section 2(d) refusal.

In recent practice, the USPTO Examining Attorneys have, arguably, applied a more conservative interpretation of the *In re E.I. DuPont de Nemours* factors, and it is more than ever important for trademark owners and their counsel to bring to the USPTO attention the argument that marketplace reality should not be replaced with the Examining Attorney's subjective opinion, in particular when legal determination of likelihood of confusion is based on interpretation of factual nuances and when any one of the factors of *In re E.I. DuPont de Nemours* may be decisive.

In the present case, *In re HerbalScience Group, LLC* (Serial No. 77519313), the TTAB has reversed refusal of applicant's mark and rejected the Examining Attorney's position.

Applicant sought registration of its mark MINDPOWER in Class 1 covering botanical extracts and the like for use in the manufacture of pharmaceuticals and nutraceuticals and related goods. The cited mark is MIND POWER RX, also in Class 1, covering dietary and nutritional supplements.

The Examining Attorney provided, in her opinion, a significant number of third parties' registrations showing that many entities have adopted the single mark for use on goods of the type listed in applicant's and registrant's marks, and the applicant did not dispute that the respective goods can emanate from a single source under a single mark. However, applicant argued that its goods are intended for manufacturers of nutraceuticals, whereas goods encompassed by the cited registered mark are end-products and are not targeted at manufacturers, and, therefore, there is sufficient distance between the targeted consumer groups.



The Examining Attorney countered this argument by stating that the registered mark does not specify or limit the industries or consumer groups and, therefore, the goods under the registered mark may also appeal to the same consumers as those intended to be addressed by applicant's mark.

The TTAB stated that what applicant does dispute is use of the *In re E.I. Dupont de Nemours* factors of channels of trade and classes of purchasers. Applicant's position as to their respective distance was accepted. Specifically, the TTAB held that even if the identification in the registered mark describes the goods without any limitations of trade channels, the presumption is that the goods move in the normal channels of trade for such items. Therefore the TTAB rejected the Examining Attorney's position and held that there is nothing in the record to show that normal channels of trade for dietary and nutritional supplements are the same as those for applicant's goods. The TTAB disagreed with the Examining Attorney's rejection of applicant's characterization of its customers as "sophisticated purchasers" and held that applicant's identification of goods, mentioning manufacturers of pharmaceuticals and nutraceuticals, should be sufficient to show that buyers of such goods are knowledgeable and careful purchasers.

Since under the *In re E.I. Dupont de Nemours* decision any of the thirteen factors may play a dominant role, varying from case to case, the TTAB did not consider the marks' similarities. Therefore, the finding was based on the fact that there was no evidence of overlap between the channels of trade and between purchasers of applicant's and registrant's respective products and that, therefore, there is virtually no risk of confusion between the marks.

Indeed, when the goods and services are targeted at different consumer groups and trade channels, these two factors alone may suffice in order to provide for marks' coexistence, even if the first part of the *In re E.I. Dupont de Nemours* test (similarity of marks) may be met. It is therefore important that the USPTO Examining Attorneys carefully weigh their interpretation and, not less importantly, application, of the thirteen factors of the *In re E.I. Dupont de Nemours* case and express higher level of openness to the marketplace realities that directly influence the outcome of the second part of the test.

This is certainly the precedent that trademark owners and practitioners should welcome and consider referring to in their responses to Office Actions.

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