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Subject: U.S. TRADEMARK APPLICATION NO. 86801521 - GESUNDHEIT - TIPS-8017 - Request for  
Reconsideration Denied - Return to TTAB - Message 1 of 4

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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.** 86801521

**MARK:** GESUNDHEIT



**CORRESPONDENT ADDRESS:**

MARK D. SWANSON

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2800 WEST HIGGINS RD.SUITE 365

HOFFMAN ESTATES, IL 60169

**GENERAL TRADEMARK INFORMATION:**

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**APPLICANT:** Zaluvida Holdings Pte. Ltd.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

TIPS-8017

**CORRESPONDENT E-MAIL ADDRESS:**

PTO@pauleyjp.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 4/19/2017

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated September 19, 2017 are maintained and continue to be final: Refusal To Register under Sections 2(d) and 2(e)(1) and Identification of Goods and Services. See TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action are satisfied: Certificate of Foreign Registration. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

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

### **Refusal To Register Under Section 2(d)—Likelihood of Confusion**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3855216. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and 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) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In the present case, applicant's mark is GESUNDHEIT and registrant's mark is GESUNDHEIT. Thus, the marks are identical in terms of appearance and sound. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with the applicant's and registrant's respective goods and/or services. Therefore, the marks are confusingly similar.

Applicant's services, namely, advisory and consulting services relating to beauty treatment, namely, beauty consultation services in the selection and use of cosmetics, fragrances, beauty aids, personal care products, and hair, skin and body care products; advisory and consulting services relating to health care; advisory and consulting services relating to medical problems, namely, providing medical advice in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management; dietetic advisory services; health care, namely, providing health care services; health counseling; health spa advisory services for health and/or wellness of the body and/or spirit; hospitals;

hygienic and beauty care for human beings; information services relation to health care; medical advisory services; medical assistance; medical services; nutritional advisory and consultation services; pharmaceutical advisory services; preparation of reports relating to health care matters, namely, in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management; providing information relating to dietary and nutritional guidance; rental of medical and health care equipment; technical consultancy services relating to health and safety, namely, in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management; therapy services for the treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management are identical or closely related to registrant's services, namely, newsletters in the field of health and wellbeing. The evidence shows that these types of goods frequently originate from a single source and are marketed in the same channels of trade.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

In light of the similarities between the marks and the closely related nature of the goods and/or services, the examining attorney has determined that the mark cannot proceed to registration.

This refusal is limited to the following services in Class 044: "advisory and consulting services relating to beauty treatment, namely, beauty consultation services in the selection and use of cosmetics, fragrances, beauty aids, personal care products, and hair, skin and body care products; advisory and consulting services relating to health care; advisory and consulting services relating to medical problems, namely, providing medical advice in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management; dietetic advisory services; health care, namely, providing health care services; health counseling; health spa advisory services for health and/or wellness of the body and/or spirit; hospitals; hygienic and beauty care for human beings; information services relation to health care; medical advisory services; medical assistance; medical services; nutritional advisory and consultation services; pharmaceutical advisory services; preparation of reports relating to health care matters, namely, in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and

wound care, blood glucose management; providing information relating to dietary and nutritional guidance; rental of medical and health care equipment; technical consultancy services relating to health and safety, namely, in the field of treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management; therapy services for the treatment of obesity, prevention of obesity, anti-infection, anti-inflammatory, treatment and prevention of cardiovascular diseases, immunotherapy, cognitive health, nasal health, oral health, dental health, treatment of gastrointestinal health, joint health and wound care, blood glucose management.”

Applicant has stated that the cited registration will be cancelled in March 2017. The cited registration remains active until the full grace period has elapsed; therefore, the final refusal to register the mark under Section 2(d) must be continued and maintained.

### **Refusal To Register—Mark Is Merely Descriptive**

Registration is refused because the applied-for mark merely describes the purpose of applicant’s goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.* A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); see, e.g., *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see, e.g., *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition).

Under the doctrine of foreign equivalents, a mark that consists of or comprises a word or words from a modern foreign language will be translated into English to determine descriptiveness and/or genericness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (citing *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987)); see also *In re Cordua Rests., Inc.*, 823 F.3d 594, 602-03, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016); TMEP §1209.03(g).

The doctrine is applied when it is likely that an 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*

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