

**To:** Parodi, Monica ([trademarks@legalforce.com](mailto:trademarks@legalforce.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86126250 - THE NUTRITIONISTA - 75734  
**Sent:** 3/11/2014 9:05:27 AM  
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**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 86126250

**MARK:** THE NUTRITIONISTA

**\*86126250\***

**CORRESPONDENT ADDRESS:**

RAJ ABHYANKER  
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**APPLICANT:** Parodi, Monica

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

75734

**CORRESPONDENT E-MAIL ADDRESS:**  
[trademarks@legalforce.com](mailto:trademarks@legalforce.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 3/11/2014**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

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. 3677783. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that 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). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors 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 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *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 this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 50 USPQ2d 1503, 1505-06 (TTAB 1999); TMEP §§1207.01 *et seq.*

## COMPARISON OF THE MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Applicant's mark is THE NUTRITIONISTA. The cited registered mark is NUTRITIONISTA. The dominant feature of applicant's mark, NUTRITIONISTA, is identical to the cited registered mark. The marks are highly similar in appearance, connotation and commercial impression. Applicant has merely added THE to registrant's mark. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term "the" at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS "virtually identical" marks; the inclusion of the definite article "the" is "insignificant in determining likelihood of confusion"). Thus, this minor difference is insufficient to obviate the likelihood of confusion.

## COMPARISON OF THE SERVICES

The goods and/or services of the parties 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) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); see *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant's services are "Providing a website featuring information about beauty, health and wellness, namely, nutrition and beauty tips and related articles."

Registrant's services are "Counseling services in the fields of health, nutrition and lifestyle wellness."

Registrant is providing counseling in the fields of health, nutrition and lifestyle wellness. Counseling is essentially providing information. Applicant is also providing information. Note that articles are also a means of providing information and that applicant has prefaced its recitation of services to clarify that it is providing information. Registrant is providing its information about subjects that encompass the information that applicant is providing; ie, health and nutrition encompass nutrition and lifestyle wellness encompasses physical beauty. Moreover, nutrition encompasses the use of nutrition to create beauty (eg taking supplements for skin vitality). Thus, the applicant's and registrant's services are highly similar and overlapping.

Accordingly, the services would be provided to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the services originate from the same source.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. Applicant must also respond to the requirement(s) set forth below.

### Recitation of Services

The identification of services is indefinite and overly broad and must be clarified. See TMEP §1402.01. Specifically, the information is classified in class 44 whereas the articles are classified as publications (downloadable in class 9 and non-downloadable in class 41).

Applicant may adopt the following identification, if accurate:

Providing a website featuring information about beauty, health and wellness, namely, nutrition and beauty tips, in class 44

Downloadable articles featuring information about beauty, health and wellness, namely, nutrition and beauty tips, in class 9

Providing a website featuring non-downloadable articles in the field of information about beauty, health and wellness, namely, nutrition and beauty tips, in class 41

An applicant may amend an identification of goods/services only to clarify or limit the goods/services; adding to or broadening the scope of the goods/services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

#### Classification

If applicant adopts the suggested amendment of the goods and/or services, then applicant must amend the classification to the International Class(es) noted. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§805, 1401.

Proper classification of goods and services is a purely administrative matter within the sole discretion of the United States Patent and Trademark Office. *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969).

#### Multiple Class Application Requirements-Section 1b

For an application with more than one international class, called a "multiple-class application," an applicant must meet all the requirements below for those international classes based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods and/or services by international class.
- (2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at [http://www.uspto.gov/trademarks/tm\\_fee\\_info.jsp](http://www.uspto.gov/trademarks/tm_fee_info.jsp)).

*See* 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

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trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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Print: Mar 10, 2014

77615276

**DESIGN MARK**

**Serial Number**

77615276

**Status**

REGISTERED

**Word Mark**

NUTRITIONISTA

**Standard Character Mark**

Yes

**Registration Number**

3677783

**Date Registered**

2009/09/01

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Haramis, Julia K. DBA Health Counselor INDIVIDUAL UNITED STATES 145  
Hicks Street Apartment B63 Brooklyn NEW YORK 112012326

**Goods/Services**

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Counseling  
services in the fields of health, nutrition and lifestyle wellness.  
First Use: 2009/04/07. First Use In Commerce: 2009/04/07.

**Filing Date**

2008/11/15

**Examining Attorney**

HESIK, APRIL

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