

I. INTRODUCTION

This Office Action Response is submitted in response to the USPTO Office Action dated February 9, 2010 in which the trademark examining attorney initially refused registration of Application Serial. No. 77858072 for DRINK WELL (the "**Mark**") of IW Holdings Corporation (the "**Applicant**") for registration on the Principal Register. The refusal was based on the contention that there is a *similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services*, ultimately causing a likelihood of confusion between Applicant's Mark and Reg. No. 2867970; 2923762; 2998614 for dietary supplements. The examining attorney further contends that with the contemporaneous use of applicant's mark with the cited registered mark, consumers are likely to mistakenly believe that the goods/services emanate from the same source.

First, the examining attorney states the following factors with citations that are most relevant: "similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*"

Second, the examining attorney states that: "In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *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). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b)."

The examining attorney further states that; "Here, the marks are highly similar in sound, appearance and commercial impression with the shared use of DRINK WELL as the first part of each mark. Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-*

Pak Prods., Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). While one of registrant’s marks features additional wording, such wording has been disclaimed. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).”

Lastly, the examining attorney states that: "The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion". *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The examining attorney concludes the refusal with exhibits in the form of “copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case”. It is further contended that “these printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely “dietary and nutritional supplements” and “bottled water” are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 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).”

ARGUMENT SUMMARY

Applicant respectfully disagrees with the examining attorney's refusal to register the mark based on a likelihood of confusion finding a *similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services*. It is the examining attorneys conclusion that the use of Applicants mark with the cited registered mark(s) may lead consumers to mistakenly believe that the that goods/services emanate from the same source. Accordingly, Applicant submits for consideration the following arguments and authorities, which Applicant believes support registration of Applicant's Mark. Applicant will address all of the above areas of concern and the relevant factors in the order of their importance to this case.

II. ARGUMENT

Applicant contends that there is no per se rule that dietary and nutritional supplements in international class 005 and bottled drinking water international class 032 are sufficiently related to create a likelihood of confusion. This is particularly true in the case of dietary supplements and bottled water. In further support of Applicant's position, several registrations co-exist on the Principal Register today covering marks for dietary and nutritional supplements on the one hand and bottled water on the other. Each case must be decided on its facts and, on the facts of this action, there is no likelihood of consumer confusion.

Although a portion of the cited Registered marks share the same spelling as the Applicant's marks, there is no likelihood of confusion between their respective goods. Respectfully, Applicant believes that the examining attorney overreaches his/her interpretation in the many registrations cited in support of this action. Contrary to the examining attorney's position, there is no relationship between dietary and nutritional supplements and bottled drinking water, and there is no conclusive evidence in the cases cited that specifically support that "the same consumers are likely to purchase and use the respective goods."

III. REFUSAL BASED ON LIKELIHOOD OF CONFUSION

In spite of any similarities between Applicant's Mark and the Cited Registration(s), no likelihood of confusion exists and grounds are as follows:

A. Evaluating the Likelihood of Confusion Test

In determining likelihood of confusion, the trademark attorney must analyze each case in two steps. First, the trademark attorney must look at the marks themselves in their entireties to ascertain similarities and dissimilarities in appearance, sound, connotation and commercial impression, and must also evaluate the fame or lack of fame of the cited marks. *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Second, the trademark attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *See August Storck KG*, 218 USPQ 823 (TTAB 1983). Additionally, in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098 (CCPA 1976). Lastly, a determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts that are relevant to the factors bearing on the likelihood of confusion issue. *See E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The examining attorney must also assess the likelihood of confusion by focusing on the question whether the marks, ***as applied to the respective goods***, so resemble each other that the same source as the goods in the cited registration. *See Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). The determination is made on a case-by-case basis, *On-line Careline, Inc. v. America Online, Inc.*, 299 F.3d 1080, 1084, 56 USPQ2d 1471, 1474 (Fed. Cir. 200), guided by the application of the familiar factors from *In re E.I.*

DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Those factors are:

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use.

The similarity or dissimilarity of established, likely-to-continue trade channels.

The conditions under which and buyers to whom sales are made, i.e. “impulse” v. careful, sophisticated purchasing.

The fame of the prior mark.

The number and nature of similar marks in use on similar goods.

The nature and extent of any actual confusion.

The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

The variety of goods on which a mark is or is not used.

The market interface between the applicant and the owner of a prior mark.

The extent to which Applicant has a right to exclude others from use of its mark on its goods.

The extent of potential confusion.

Any other established fact probative of the effect of use.

Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and “any one of the factors may control a particular case.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQd 1531, 1533 (Fed. Cir. 1997). The fundamental inquiry in the likelihood of confusion analysis is the cumulative effect of differences in the essential characteristics of the goods and differences in the marks. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928, 198 USPQ 151 (C.C.P.A. 1978). Additionally the focus on the perception and recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975) Going

even one step further, The Trademark Trial and Appeal Board has concluded that "If the goods are not related or not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.d 1238, 73 USPQ2D 1350, (Fed. Cir. 2004).” Applicant submits that there is no likelihood of confusion between the Cited Registration and the Mark.

B. Applicant’s Bottled Drinking Water are Not Likely to Cause Confusion With Dietary and/or Nutritional Supplements

There is no per se rule that dietary and nutritional supplements and bottled drinking water are either related or unrelated. *In re Jakob Demmer KG*, 219 USPQ 1199, 1201 (TTAB 1983). Also see e.g., *Best Flavors, Inc. v. Mystic River Brewing Co.*, 886 F. Supp. 908, 36 USPQ2d 1247 (D. Me. 1995) (MYSTIC SEAPORT for beer not confusingly similar to MISTIC for non-alcoholic beverages); *Foremost Dairies, Inc. v. Foremost Sales Promotions, Inc.*, 158 USPQ 360 (TTAB 1968) (FOREMOST for whisky or liquor store services not confusingly similar to FOREMOST for milk, cream, orange juice, fruit drinks, and other dairy products); see also *La Compagnie Fermiere De L’Etablissement Thermal De Vichy, Societe Anonyme, v. Celestine, Ltd.*, 112 F.2d 825 , 46 USPQ 58 (C.C.P.A. 1940) (CELESTIN’S for mineral water not confusingly similar to CELESTIN’s for cognac and brandy); *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 107 F.2d 699, 43 USPQ 262 (10th Cir. 1939) (CENTURY for distilled alcoholic liquors not confusingly similar to CENTURY for nonalcoholic cereal malt beverages); *Carnation Co. v. California Growers Wineries, Inc.*, 37 USPQ 735 (C.C.P.A. 1938) (CARNATION for wine and brandy not confusingly similar to CARNATION for milk); *Mohawk Milk Products Co. v. General Distilleries Corp.*, 95 F.2d 334, 37 USPQ (C.C.P.A. 1938) (GOLD CROSS for milk not confusingly similar to GOLD CROSS for gin).

The proper analysis to be made is of the whole mark, not just portions of it. *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985) (“California Cooler’s mark is a composite term, and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is determined by viewing the trademark as a whole”). Similarly, as stated by the

U.S. Supreme Court:

“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920).

This “anti-dissection rule” requires that the mark be viewed as a whole based upon how it appears in the marketplace. See *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.* 198 F.3d 1143, 1149-50 (9th Cir. 1999).

As a corollary of the anti-dissection rule, it is improper to find that one portion of the composite mark has no trademark significance, leading to direct comparison of that which remains. *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 U.S.P.Q. 35 (C.C.P.A. 1974); see also *Schering Corp. v. Alza Corp.*, 207 U.S.P.Q. 504 (T.T.A.B. 1980).

In view of the foregoing authorities, the examining attorney wrongly argues that the marks are highly similar in sound, appearance and commercial impression with the shared use of DRINK WELL as the first part of each mark. Therefore, the examining attorney’s conclusion that consumers are generally more inclined to focus on the first word, prefix, syllable, or even one feature of a mark being more significant in creating a commercial impression should be deemed moot or at the very least given much less weight or consideration as one of the test factors.

In addition, bottled water and dietary and nutritional supplements clearly are not complementary goods like coffee and cream. See *Kraft, Inc. v. Country Club Food Indus., Inc.*, 230 USPQ 549 (TTAB 1986). There is no conclusive evidence that bottled drinking water and dietary and/or nutritional supplements are *likely* to be associated as complementary goods in the mind of a consumer. *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984) (MARTIN’S confusingly similar for bread and cheese partly because the goods are often used and consumed together). The fact that bottled water and dietary and/or nutritional supplements *may* be supplied or available together proves nothing.

The most that can be said on these examples is that bottled water and dietary and/or nutritional supplements may be sold in some of the same stores. This simple fact is insufficient to support a likelihood of confusion as food stores carry a variety of food, beverages, and other consumable

products of which some display the same or similar mark but in different classes. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 554 F2d 1098, 1102-03, 192 USPQ 24 (C.C.P.A. 1973) (being sold in same area of grocery store does not create nexus in the minds of consumers between products emanating from different industries); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171-72 (TTAB 1987) (food products are not related goods by virtue of the fact that they are sold in the same food markets). There is no evidence that the parties' products would be sold in proximity to each other in any retail stores.

C. Identical Marks Often Co-Exist for Food, Beverages, and Other Consumable Products

The obvious dissimilarity between the parties' goods is highlighted by the fact that they are separated into different international classes: 032 for bottled drinking water and 005 for dietary and nutritional supplements. This is likely one reason why many identical marks co-exist on the principal Register for food, beverages, and other consumable products. *See Chart below, which demonstrates co-existing registrations and pending applications with the mark "Drink Well" that currently exist in the USPTO database;*

MARK	REGISTRATION #	GOODS
Drink Well	3336691	Providing information about the goods and services of others by providing a rating system that rates the quality of services and drinks in bars and restaurants.
Drink Well	3336521	Business consultation services to bar, restaurant, and hotel management and staff in the field of bar management, bartending, and alcoholic beverages Providing training to bar, restaurant, and hotel management and staff in the field of bar management, bartending, and alcoholic beverages.
Drink Well Premium Liquid Dietary Supplement	2867970	Dietary and nutritional supplements

Drink Well. Live Well.	3661917	Association Services, namely, promoting the interests of fluid milk processors; promoting public awareness of the benefits of milk through advertising; promoting public awareness of the benefits of fluid milk products via the Internet and other means
Drinkwell	3273717	Pet Dishes
Eat Well Drink Well Be Well	2375307	Restaurant Services
Drinkwell	2259216	Mechanized watering units for animals

MARK	SERIAL #	GOODS
Drink Well, Do Good	77918860	Wine

None of the above marks are sufficiently similar to Applicant’s mark to create a likelihood of confusion. However, the co-existence of such marks demonstrates that the cited registration is only entitled to a very narrow scope of protection. *See Castle Oil Corp. v. Castle Energt Corp.*, 26 U.S.P.Q.2d 1481, 1489 (E.D. Pa. 1992) (explaining that “third party uses narrow the scope of protection a mark is afforded.”); *Freedom Savings & Loan Association*, 757 F.2d at 1183, 226 U.S.P.Q. at 127 (explaining “[i]f a name is used by third parties... then it is less strongly protected than it would be otherwise.”). The fact that the word “Drink Well” as applied to food products, beverages, consumable items, and other food related services is so dilute, it reduces the likelihood of confusion between the parties’ goods. *See In re Du Pont*, F.2d at 1361, 177 U.S.P.Q. at 567. Because the common component between Applicant’s mark and the cited mark is diluted, the two marks can co-exist without causing consumer confusion.

Bottled drinking water and dietary and nutritional supplements are dissimilar goods. None of the cases or exhibits cited by the examining attorney prove *conclusively* that consumers would assume Applicant’s bottled drinking water is associated with dietary and nutritional supplements, or that Applicant's Mark, and the cited Registration originate from the same source. Therefore, both the second *DuPont* factor (dissimilarity of the goods) and the twelfth (extent of

potential confusion) weigh heavily against a likelihood of confusion in this case.

Applicant's Trademark is not confusingly similar to the trademarks 2867970, 2923762, and 2998614 registration. The cases cited in this response provide numerous examples where no likelihood of confusion exists even where trademarks differ by no more than one letter, and the goods in both trademarks are different types of food, beverage, or other consumable products. *In re Mars, Inc.*, 741 F.2d 395, 222 U.S.P.Q. 938 (Fed. Cir. 1984) (identical marks on different food products)[4] *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292 (Fed. Cir. 1990) (similar design on different types of alcoholic beverages)[5]; *See National Distillers and Chemical Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719 (CCPA 1974) (one letter difference between different types of alcoholic beverages).[6]

D. Applicant's Goods and Services Substantially Differ From Those Covered by the Registered Trademarks and the Pending Applications

Applicant is in the business of selling non-alcoholic beverages, namely, bottled water. That is all that the description of goods and services on Applicant's pending application covers. Applicant's product, "bottled water", is not related to the dietary and nutritional products covered by the cited Registration(s). Numerous cases confirm that the mere fact that two trademarks are used in association with food, beverages, and other consumable goods generally, or even different kinds of dietary supplements specifically, does not mean that a likelihood of confusion will result. For example, the Federal District Court held that there was no likelihood of confusion between an applicant's trademark CANYON for fresh citrus fruits compared to the owner's registered trademark CANYON for candy bars. These two products can be sold in the same store, however, as Applicant argues in several areas of this response, this does not prove conclusively that there would be a likelihood of confusion. Again *See In re Mars, Inc.*, 741 F.2d 395, 222 U.S.P.Q. 938 (Fed. Cir. 1984). Likewise, a court also held that there was no likelihood of confusion between MYSTIC SEAPORT for alcoholic beverages and MYSTIC for spring water and fruit drinks. *See Best Flavors, Inc. v. Mystic River Brewing Co.*, 886 F. Supp. 908, 36 U.S.P.Q.2d 1247 (D. Me. 1995).

Confusion may result if the particular food products or beverages covered by two trademarks are

traditionally related to one another. *See, e.g., Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926 (CCPA 1978)(no likelihood of confusion between ZINGERS for cakes and RED ZINGER for herb tea); also *See Bongrain International Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626 (TTAB 1986)(likelihood of confusion between ALOUETTE cheese and ALOUETTE wine which one would think that wine and cheese would in fact be complementary, or certainly more so than bottled drinking water and dietary supplements); *see generally, McCarthy on Trademarks*, § 24:48. Under these authorities, even where two trademarks are used in similar classes of beverages, likelihood of confusion is not inevitable. In fact, the Federal Court also determined there was no likelihood of confusion between arguably similar trademarks for different types of beverages. *See, e.g. G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292 (Fed. Cir. 1990) (RED STRIPE and design for beer was not confusingly similar to a design of a red stripe for wines and sparkling wines); *see also National Distillers and Chemical Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719 (CCPA 1974) (DUET on prepared alcoholic cocktails, some of which contained brandy, and DUVET for French brandy and liqueurs not confusingly similar).

Bottled drinking water is not traditionally related to dietary and nutritional supplement beverages; *see Bongrain International, supra* (likelihood of confusion between *identically* named wine and cheese products). Likewise, related products to coffee may include tea or potentially pastries. Products related to dietary and nutritional supplements could include herbal medicines, teas, vitamins, etc. However, there is no relationship between bottled water and dairy products, bottled water and coffee, or ***bottled water and dietary and/or nutritional supplement***. *Cf. Interstate Brands Corp., supra* (no connection between cakes and herb tea). These products are not found together in grocery stores and would not be associated with one another in the minds of consumers. Therefore, the goods and services in the cited Registration(s) are not sufficiently related to Applicant's product to create a likelihood of confusion.

Applicant's goods and services also differ from the cited Registration(s) because Applicant is in the business of selling bottled water. As a bottled water manufacturer, Applicant is not selling products comparable to dietary and nutritional supplements. Consequently, there is no likelihood of confusion between the cited Registration(s) and Applicant's Trademark.

Also significant is the fact that the visual variations among the Trademarks at issue are not of the type to suggest that Applicant's products are a product line or subset of products offered by the owners of the Registered Trademarks as cited by the examining attorney, or the applicants in the Pending Application. *See, e.g. In re Jaquez, 2005 TTAB LEXIS 334 (TTAB Aug. 10, 2005)* (CARRIBBEAN RED ROCK might be viewed as a slightly different or new product sold under the RED ROCK trademark). Again *See, e.g. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292 (Fed. Cir. 1990)* (RED STRIPE and design for beer was not confusingly similar to a design of a red stripe for wines and sparkling wines)

Consequently, Applicant's Trademark is inherently and visually different from the trademark(s) cited in the Office Action even when considered without reference to the goods and services descriptions of the respective trademarks. The dissimilarity of Applicant's Trademark compared to the cited Registration(s) in the Office Action alone justifies reversal of the section 2(d) refusal. *See, e.g., In re LBI Brands, Inc., 2006 TTAB LEXIS 216 (TTAB June 16, 2006)* (no likelihood of confusion even where fruit juice and flavored water goods were identical because the trademarks were not confusingly similar).

E. There is No Similarity of Trade Channels of the Goods and/or Service (Third Factor)

With respect to the examining attorney's contention that the trade channels may have a potential for the purchasers of bottled drinking water and dietary and/or nutritional supplements to overlap, it is Applicant's position again to the contrary. It is not reasonable to assume that one can draw conclusions about whether, or the extent to which, there is a relationship between bottled drinking water and dietary and/or nutritional supplements. The mere fact that both products are consumable liquids that are sold to some of the same purchasers through some of the same retail outlets is insufficient to reach the conclusion that the goods are sufficiently related such that, as identified by identical marks, confusion as to source is likely. There is no evidence that, in the marketplace, dietary and nutritional supplements and bottled drinking water ever emanate from the same source, or that they are marketed under the same marks, or that the

circumstances surrounding the sales of dietary and/or nutritional supplements and bottled drinking water are such that consumers would believe that they come from the same source. While both dietary and/or nutritional supplements and bottled drinking water may be consumable items, there is no conclusive finding that they are complementary products. Nor is reasonable to conclude that these products are sold in proximity to each other in retail outlets. There is no per se rule regarding the relationship between bottled drinking water and dietary and/or nutritional supplements. In the matter here raised by the examining attorney, and based on Applicant's arguments and supporting citations, Applicant believes that bottled drinking water and dietary and/or nutritional supplements do not have an established relationship to be a determinative factor to refuse applicants application, despite the identity of the marks and the potential for overlapping channels of trade and common purchasers.

F. Consumers Buy Dietary and/or Nutritional Supplements More Carefully Than Water

Although consumers who purchase bottled drinking water may also purchase dietary and/or nutritional supplements, dietary and/or nutritional supplement is generally, at the very least, much more expensive than a bottle of drinking water. The fourth *DuPont* factor considers whether buyers are likely to purchase products on impulse or through "careful consideration" based in part on the diverse and numerous varieties that are offered for dietary and/or nutritional supplements, contrary to bottled water which has very limited variations. Dietary and/or nutritional supplements are a specialized product that are frequently sought after for specific health requirements and enhancements. Consumers are likely to buy dietary and/or nutritional supplements much more carefully than water due to the variation of remedies one would desire. This factor also weighs heavily against a likelihood of confusion and supports the forth *DuPont* factor in favor of the Applicant's argument.

G. The Marks are Not Used on a Variety of Goods

Both Applicant's and the cited Mark(s) are used only on a single type of product. The ninth *DuPont* factor weighs heavily against a likelihood of confusion in this regard as well.

H. The Cumulative Differences Result in No Likelihood of Confusion

The difference in sight, visual appearance, and overall impression of the Applicant's Trademark compared to the cited Registration(s) prevents a likelihood of confusion. This difference is increased when the differences in the goods and services are also considered. Considering these two factors together magnifies the conclusion that there is no likelihood of confusion. Based on these factors it is important to consider that the TTAB has found that "[t]he fundamental inquiry mandated by Section 2(d) goes to the *cumulative effect of differences* are the essential characteristics of the goods and differences in the marks" (emphasis added) also see *Federated Foods Inc. v. Fort Howard Paper Co.*, 544 F. 2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999). It would therefore be reasonable to conclude that the combination of the relevant inquiries leads to the finding that no likelihood of confusion exists in this case.

IV. CONCLUSION

Applicant argues, among all of the aforementioned, that there is no *per se* rule that dietary and/or nutritional supplements and bottled drinking water are related. Applicant further contends that 1) there is no evidence that bottled drinking water and dietary and/or nutritional supplements are complementary goods; 2) that it is unlikely that these goods are reliant on one another as complementary components to create a final desired product; 3) that if these goods are sold in some of the same stores, there is no evidence that they are sold in proximity to each other within the stores, and; 4) that if in fact they are available in the same stores, the consumer buys dietary and/or nutritional supplements much more carefully and with much more specificity than water due to its greater cost and associated function to cure or enhance. Therefore, it should be considered a dissimilar product. Applicant also contends that dietary and/or nutritional supplements and bottled drinking water are dissimilar because they are classified in different international classes. Based on all of the aforementioned contained herein, Applicant respectfully submits that this response (in its entirety) is fully responsive to all relevant points raised by the Trademark Examining Attorney, adequately refutes these points and accordingly, respectfully

requests reversal of the section 2(d) refusal so that the instant application may proceed to publication. Should the Trademark Examining Attorney require any additional information, the undersigned will be pleased to assist.

Respectfully Submitted,

IW Holdings Corporation

/Jordan S. Gielchinsky/

Jordan S. Gielchinsky

19241 N.E. 20th Ct.

N. Miami Beach, Florida 33179

Tel: 305-733-9300

Fax: 305-932-0292

Applicant