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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Neways, Inc.

Serial No. 76/223,029

Albert L. Schmeiser of Schmeiser, Olsen & Watts LLP for
Neways, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 12, 2001, applicant the filed the above-
referenced application to register the mark PROMEGA on the
Principal Register for "nutritional and herbal
supplements," in Class 5. The application was based on
applicant's assertion that it possessed a bona fide
intention to use the mark in commerce in connection with
the goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark PROOMEGA, which is registered for "natural dietary omega-3 fish oil supplement, derived from fish,"¹ in Class 5, that if applicant were to use its mark in connection with nutritional and herbal supplements, confusion would be likely. She² reasoned that the marks are similar and that the goods identified in both the application and the cited registration are nutritional supplements.

Responsive to the refusal to register, applicant amended the application to identify the goods as an "herbal weight loss supplement," in Class 5, and argued that confusion would not be likely because the mark applicant seeks to register is not similar to the cited registered mark and the marketing activities surrounding the goods will not lead to confusion as to origin.

The Examining Attorney accepted the amendment to the identification-of-goods clause, but was not persuaded by applicant's arguments on the issue of whether confusion would be likely, and in the second Office Action, he made

¹ Reg. No. 2,077,609, issued on the Principal Register on July 8, 1997 to Westport Scandinavia, a partnership under California law.

² The original Examining Attorney, Joyce A. Ward, was subsequently replaced by Examining Attorney Brown.

the refusal to register under Section 2(d) of the Act final. He discussed the similarities between the marks and argued that even as amended, the goods in question are the same or closely related.

In support of this contention he submitted a copy of a page from the website of GNC, a business that sells health-related items such as vitamins, minerals, herbs and other nutrients. Under the heading "GNC PRODUCTS," the following items, among others, are listed: "Vitamins & Minerals," "Herbs," "Natural Remedies" and "Weight Management." Under the heading "HEALTHNOTES," the following topics, among others, are listed: "Vitamin Guide," "Herbal Remedies" and "Weight Management."

Also submitted in support of the refusal to register were three excerpts from articles the Examining Attorney retrieved from a computer database of articles from publications. The Examining Attorney contended that the excerpts establish the fact that the major ingredient in the supplements of the registrant, omega-3 fish oils, "can be used to maintain and lose weight." (Second Office Action, p. 2). As applicant subsequently pointed out, however, although each of the excerpts does show use of the terms "weight loss" and "omega-3 fish oils" in different sections of the article, the two terms are not used in

conjunction with each other, and, contrary to the express contention of the Examining Attorney, the excerpts do not establish that omega-3 fish oils can be used to maintain and/or lose weight.

Applicant timely filed a Notice of Appeal, which was followed in timely fashion by applicant's appeal brief. The Examining Attorney then filed his appeal brief, but applicant did not request an oral hearing before the Board.

In the case of *In re E. I. Du Pont Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among those factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods as set forth in the application and the registration, respectively.

In the instant case, we agree with the Examining Attorney that confusion is likely because the marks at issue are highly similar and the goods with which applicant intends to use the mark it seeks to register are closely related to the goods specified in the cited registration.

While not identical to each other, the marks PROMEGA and PROOMEGA have obvious similarities which far outweigh distinctions which may be drawn from the fact that one mark

has an additional letter "O" in it. The issue is not whether the marks can be distinguished based on a side-by-side comparison, but rather, whether the marks create similar overall commercial impressions. *Visual Information Institute, Inc. v. Vicom industries Inc.*, 209 USPQ 179 (TTAB 1980). We must consider the perception and recollection of the average purchaser of the respective products, who normally retains a general, rather than a specific, impression of trademarks. *Chemtron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979). While it is possible that the pronunciations of the two marks could vary, the deletion of one of the "O"s from the registered mark does not result in a mark that is very different in appearance or spelling. Contrary to applicant's argument that the connotations of the two marks differ when the marks are considered in connection with the goods in the cited registration and those set forth in the application, respectively, without engaging in more analysis of these two marks than the average purchaser of dietary supplements is likely to conduct, these marks have similar connotations. Both combine the prefix "PRO" with the word for the Greek letter "OMEGA." Applicant's version just compresses the two terms so that they share one "O." When PROMEGA and PROOMEGA are considered in their

entireties, rather than dissected and evaluated part by part, the commercial impressions engendered by these marks are very similar. Clearly, their use in connection with the same or closely related products would be likely to cause confusion within the meaning of Section 2(d) of the Lanham Act.

The goods set forth in the cited registration and those identified in this application are, if not the same, closely related. As amended, the application identifies the goods with which applicant intends to use its mark as an "herbal weight loss supplement," whereas the product identified in the registration is a dietary fish oil supplement. As the Web page made of record by the Examining Attorney demonstrates, businesses which offer health-related products sell not only vitamins, minerals and herbs, but also products used to help customers control their weight. Thus, even if herbal weight loss supplements are not encompassed within the term "natural dietary omega-3 fish oil supplements" specified in the cited registration, if similar marks were used in connection with both such supplements, prospective purchasers would assume a common source.

Applicant argues that it is a direct sales company. marketing its product through distributors to consumers who

know applicant's distributors personally, whereas registrant's goods are sold through traditional channels of trade such as grocery stores and health/nutritional stores. It is well settled, however, that the determination of whether confusion would be likely must be made based on the goods as they are identified in the application and the cited registration, respectively, without limitations or restrictions that do not appear therein. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). When we employ these principles in our analysis of the case before us, the distinctions applicant asserts do not come into play.

Applicant's argument with regard to the strength of the registered mark is not well taken. Based on the results of a search applicant conducted of the Patent and Trademark Office database, which applicant argues indicated that thousands of registrations and applications to register involve marks which incorporate the term "PRO," and over seven hundred others which use the term "OMEGA," applicant takes the position that the cited registered mark is weak in source-identifying significance. To begin with, none of the applications or registrations upon which applicant's argument is predicated is even argued to be for the mark PROMEGE or PROOMEGA. In any event, none of the alleged "PRO" or "OMEGA" registrations or applications was

made of record by applicant. Furthermore, neither applications nor registrations are evidence of use of the marks therein, much less that such use has been so extensive that prospective purchasers look to other elements in marks incorporating terms common to them in order to distinguish among them, so even if applicant had made of record a substantial number of marks similar to the cited registered mark in connection with commercially related goods, such evidence would be of little probative value in determining whether confusion would be likely. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Moreover, as the Examining Attorney points out, even if applicant had demonstrated that PROOMEGA is a weak mark in the field of dietary supplements, even weak marks are entitled to protection against the registration of similar marks for closely related products. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Finally, any doubt as to whether confusion would be likely must be resolved in favor of the prior user and registrant, and against the applicant, who, as the second comer, has a duty to select a mark which is not likely to cause confusion with one that is already in use in the same field of commerce. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 60 USPQ2d 1025 (Fed. Cir. 1998).

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DECISION: The refusal to register under Section 2(d)
of the Lanham Act is affirmed.