

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

September 19, 2013

Applicant: 1ViZN, L.L.C.  
Serial No.: 85629338  
Filing Date: May 18<sup>th</sup>, 2012  
Mark: 1VIZN MAXIMUM VELOCITY  
Examining Attorney: Odessa Bibbins  
Law Office: Law Office 105

**REQUEST FOR RECONSIDERATION**

The Examining Attorney has refused registration of the proposed trademark, **1VIZN MAXIMUM VELOCITY** pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that the mark is likely to be confused with **VELOCITY** (Reg. No. 3272225 ). It is Applicant's position that there is no likelihood of confusion between Applicant's mark and the cited mark based on the large differences within the marks, the differences in the goods, the sophistication of purchasers in regard to the relevant goods, and the weakness and descriptive nature of the shared material. As such, Applicant respectfully asks that the Examining Attorney reconsider her refusal to register and allow Applicant's mark to proceed to publication.

**LIKELIHOOD OF CONFUSION**

In a likelihood of confusion determination, the question is whether the goods or services are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ 2d 1471 (Fed. Cir. 2000). This question is answered on a case-by-case basis, taking into account all relevant factors. *In re E.I. du Pont De Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). The two key considerations are the similarity of the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re E.I. du Pont De Nemours & Co.*, 177 U.S.P.Q. at 567. Among other factors, further considerations include the sophistication of the respective purchasers and the strength of the shared material within the respective marks. *Id.* at 567. In analyzing all relevant factors, one finds that there is no likelihood of confusion between the marks.

## **I. 1VIZN MAXIMUM VELOCITY IS DIFFERENT FROM VELOCITY**

In the Examining Attorney's Office Action dated March 21, 2013, the Examining Attorney refused registration of 1VIZN MAXIMUM VELOCITY, asserting that the mark is too similar to VELOCITY. The Examiner stated that the “the mere addition of a term to a registered mark generally obviate the similarity between the marks nor does it overcome a likelihood of confusion”. However, the mere fact that marks share elements does not mean that a likelihood of confusion exists. *General Mills, Inc. v. Kellogg Co.*, 3 USPQ 2d. 1442, 1445 (8<sup>th</sup> Cir. 1987). “A variety of factors may be material in assessing the likelihood of confusion and no one of these factors by itself is dispositive of the confusion question”. *McGraw-Edison Co. V. Walt Disney Productions*, 787 F.2d 1163, 1167 (7<sup>th</sup> Cir. 1986). Under *DuPont*, the mark comparison includes, among other factors, appearance, sound, meaning, commercial impression. *In re E.I. du Pont De Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973). In properly analyzing the cited marks under *DuPont*, Applicant submits that one finds no likelihood of confusion.

### **A. Appearance**

Despite the shared wording, Applicant's mark, 1VIZN MAXIMUM VELOCITY, is fundamentally different in appearance from Registrant's mark, VELOCITY. In a case where one mark contains additional features that distinguish its overall appearance from another, confusion is less likely, even when the two marks also contain similar features. *See e.g., Miller Brewing Co. v. Premier Beverages, Inc.*, 210 USPQ 43, 48-49 (T.T.A.B. 1981) (no likelihood of confusion found in MILLER and OL' BOB MILLER'S for beverages). Simply because two marks share wording does not mean that likelihood of confusion exists. *General Mills*, 3 USPQ 2d. at 1445. Even slight differences can distinguish two marks. *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ 2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary supplement was held not likely to be confused with K+EFF (stylized) for dietary potassium supplements).

Here, there are more than slight variations to distinguish the two marks. Applicant's mark is 1VIZN MAXIMUM VELOCITY and Registrant's mark is VELOCITY. Applicant's mark and Registrant's mark both contain VELOCITY. However, Applicant's mark is not likely to be confused with Registrant's mark in appearance, due to the distinguishing material 1VIZN MAXIMUM. The Examiner points out that the mere addition of a term to a registered mark generally does not obviate the similarity between two marks. However, it is well recognized that “marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight”. *In re Hearst Corp.*, 25 USPQ 2d 1238, 1239 (Fed. Cir. 1992).

Not only is 1VIZN MAXIMUM a dramatic addition, 1VIZN is the dominant portion of Applicant's mark and therefore must be given due consideration. *See Association of Co-op. Members, Inc. v. Farmland Industries, Inc.*, 216 USPQ 361, 367 (5<sup>th</sup> Cir.1982); *See also, e.g., Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ 2d 1313 (T.T.A.B. 2005) (Applicant's mark NORTON MCNAUGHTON ESSENTIALS for women's clothing was not confusingly similar to Registrant's mark ESSENTIALS for clothing, as the shared term ESSENTIALS was weakened through third-party use. As such, the house mark NORTON MCNAUGHTON was deemed the most distinctive element of the composite mark). *See also, Presto Prods., Inc. v. Nice-Pak Prods., Inc.* 9 USPQ 2d 1895, 1897 (TTAB 1998) (“It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

In the present case, the first element of Applicant's mark is 1VIZN. Not only does this portion appear first, this element is clearly the most visually dominant, as 1VIZN is an inherently distinctive term. Further, the term is an eye catching mix of a numeral and the visually enticing letters, “V” and “Z”. As such, this element would undoubtedly be impressed upon the mind of consumers and is the portion most likely to be remembered. Further, MAXIMUM is additional distinguishing material appearing in Applicant's mark. Moreover, the fact that the shared material, VELOCITY, is weakened through third-party use (as demonstrated below) strongly indicates that it is not the dominant portion of Applicant's mark. Therefore, Applicant's and Registrant's marks are drastically different in appearance.

In the Office Action dated March 21, 2013, the Examining Attorney cites three TTAB cases as persuasive precedent to support the assertion that the mere addition of a term to a registered mark generally does not obviate the similarity between marks. *See In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (T.T.A.B. 2009) (TITAN and VANTAGE TITAN); *In re U.S. Shoe Corp.*, 229 USPQ 707 (T.T.A.B. 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (T.T.A.B. 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE). However, reliance on these decisions is misplaced, as each of the three cases differs from the present case in a critical way. In the present case, the subsequent filer is adding material that is strong, 1VIZN MAXIMUM, to something that is weak, VELOCITY. Relative to its field, VELOCITY is descriptive and weakened through extensive third-party use.

In the case of *In re U.S. Shoe Corp.*, the subsequent filer attempted to apply for a weak trademark, CAREER IMAGE, which overlapped the prior registration, CREST CAREER IMAGE. 229 USPQ 707. In that case, the prior registration contained, CREST, an additional, inherently distinctive, and therefore strong element. *Id.* In the case of *In re Toshiba Med. Sys. Corp.*, the subsequent filer attempted to register VANTAGE TITAN, adding a word, but overlapping with the previously registered, inherently distinctive mark, TITAN. 91 USPQ2d 1266. Finally, in the case of *In re Riddle*, ACCUTUNE, was a suggestive, yet strong mark. The subsequent filer merely attempted to adopt the mark while prefacing it with his famous name, RICHARD PETTY’S ACCU TUNE. *See Id.*

Contrastingly, in the instant case, the subsequent filer's mark contains 1VIZN MAXIMUM, a strong, dramatic addition to the weak element, VELOCITY. As such, the cited cases differ considerably.

## **B. Sound**

The two marks are also extremely different in sound. Differences in sound can obviate a likelihood of confusion finding, even when the services are related. *See Coca-Cola Co. v. Essential Products Co.*, 164 USPQ 628, 630 (C.C.P.A. 1970) (“Coca Cola” and “Coco Loco” were aurally dissimilar, likelihood of confusion was avoided).

As described above, Registrant's mark is VELOCITY and Applicant's mark is 1VIZN MAXIMUM VELOCITY. Registrant's mark is one word, four syllables. Applicant's mark shares the term “VELOCITY”, but as the last element of the mark, preceded by two additional words with a combined six syllables. The first element of Applicant's mark, 1VIZN (likely pronounced “One Vision”), contains memorable, sharp consonants. The second element “MAXIMUM” is an aurally dramatic, strong word that calls for attention when spoken aloud. As such, Applicant's mark and Registrant's mark bare little resemblance when spoken aloud, due the additional material found at the

beginning of Applicant's mark. As such, Applicant's mark would not likely cause confusion with the cited mark in regard to sound.

### **C. Meaning**

Applicant's mark also differs in meaning from Registrant's mark. The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of the trademarks. *See e.g., In re M. Sherman & Company, Inc.*, 233 USPQ 52, 53 (T.T.A.B. 1984). Even when marks are identical, likelihood of confusion can be avoided if there is a difference in meaning in respect to their goods and services. For example, CROSS-OVER for bras was held not likely to be confused with CROSSOVER for ladies' sportswear, as CROSS-OVER applied to bras suggests the physical construction of the bras, while CROSSOVER for ladies sportswear is suggestive of multi-sport goods. *See In re Sears, Roebuck and Co.*, 2 USPQ 2d. 1312 (T.T.A.B. 1987).

Here, the meaning between the two marks differs considerably when placed in context. A mark's meaning must be determined in relation to the goods and the overall context in which the mark is used and encountered by purchasers. *Elvis Presley v. Capece*, 141 F.3d 182 (5<sup>th</sup> Cir. 1998). The cited mark is VELOCITY for nutritional supplements. Applicant submits that the cited mark is descriptive in this context. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ 2d 1009 (Fed. Cir. 1987). Here, a valued function or characteristic of a nutritional supplement is that it works quickly to deliver the intended effect. *See Exhibit A*.

Not only is VELOCITY descriptive relative to nutritional supplements, it is also weakened through third-party use. Similarity of meaning is more important in cases concerning inherently strong marks. *See Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737 (C.C.P.A. 1953).

On the other hand, Applicant's mark is 1VIZN MAXIMUM VELOCITY. The dominant portion of the mark is 1VIZN. When used in connection with dietary supplements, the term has no meaning. It is therefore an arbitrary, inherently distinctive term. The more distinctive a trademark, the greater its strength. *Exxon Corporation v. Texas Motor Exchange of Houston*, 628 F.2d 500, 504 (5<sup>th</sup> Cir. 1980). Moreover, if a term is rarely used by parties other than the owner of the mark, it is considered strong. *Id.* A search of the PTO records reveals that the mark 1VIZN is used exclusively by Applicant. *See Exhibit B*. It therefore follows that the additional material, 1VIZN, greatly enhances the strength of Applicant's mark.

As such, purchasers are not likely to associate the meaning of the two marks with each other, due to the strength of the added material, the weakness of the shared material and the descriptive meaning of Registrant's mark in relation to Registrant's goods.

### **D. Commercial Impression**

Applicant's mark 1VIZN MAXIMUM VELOCITY and Registrant's mark VELOCITY create an entirely different commercial impression. The Examiner suggests there is a similar commercial impression in the marks based on the shared material, VELOCITY. However, in assessing the overall commercial impression, marks must be considered in their entireties. *Package Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 USPQ 1351, 1353 (Fed. Circ. 2000) (The court held that the

T.T.A.B. erred by relying only the shared material “Packard”, without evaluating the marks in their entirety). Merely because marks share material, does not mean that there is a likelihood of confusion. *General Mills, Inc. v. Kellogg Co.*, 3 USPQ 2d. 1442, 1445 (8<sup>th</sup> Cir. 1987). “It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole.” *Franklin Mint Corp. v. Master Manufacturing Co.*, 212 USPQ 233, 234 (C.C.P.A. 1981). In the present case, the focus is not merely on VELOCITY but on the mark in its entirety.

Furthermore, if the common portions between marks are weak, confusion is less likely. *See Pacquin-Lester Co. V. Charmaceuticals, Inc.*, 484 F.2d 1384 (C.C.P.A. 1973); *See also, Lever Brothers Co. v. Barcolene Co.*, 463 F.2d 1107, 1008, 174 USPQ 392, 393 (CCPA 1972) (no likelihood of confusion even though common term ALL was used by both parties, since different commercial impression were created between the the prior registrant's use of the mark ALL and applicant's use of ALL CLEAR!). Such is the case here, as the two marks create different commercial impressions, irrespective of common terms. Moreover, VELOCITY, the shared portion between the marks, is weakened from extensive third-party use on related goods. Thus, one cannot ignore that additional material, 1VIZN MAXIMUM, in Applicant's mark which would demand a purchaser's attention, outweighing the shared material and creating a vastly different commercial impression.

## **II. THE GOODS ARE DIFFERENT**

In a likelihood of confusion determination, the similarity in goods and services and channels of trade must also be considered. *In re E.I. du Pont De Nemours & Co.*, 177 USPQ at 567. Likelihood of confusion exists only if the goods are so related that purchasers mistakenly believe they come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565 (Fed. Circ. 1984).

In the present case, Applicant is seeking registration of its mark for “dietary supplements used for weight loss, performance, and energy for bodybuilders.” Applicant goods are used for the specific purpose of weight loss and performance in the niche arena of bodybuilding. The goods are targeted to bodybuilders for bodybuilding purposes, not for general nutritional and health purposes. By their nature, Applicant's goods are not marketed or intended to be used by the general public, thus serving a very different purpose than health and nutritional supplements marketed by Registrant. Confusion is not likely when goods serve a different purpose. *See S.C. Johnon & Son v. Lever Bros. Co.*, 10 USPQ 2d 1027, 1035 (E.D. Wis. 1991). Even when goods are similar and the marks are identical, confusion can be avoided if marketing and distribution is limited to a specific group, rather than the general public. *See Modular Cinemas of America, Inc. v. Mini Cinemas Corp.*, 175 USPQ 355 (S.D.N.Y. 1972) (No likelihood of confusion with identical mark MINI CINEMA for movie theaters, as one theater targeted general family audience and the other targeted an adult-only audience). As such, the goods offered by the two parties are quite different. Under the circumstances, purchasers would not mistakenly believe that the goods emanate from the same source.

In the Office Action dated March 21, 2013, the Examiner cites evidence of third-party marks to show that “dietary supplements used for weight loss, performance, and energy for bodybuilders” and “nutritional supplements” are of the kind that may emanate from the same source. However, Applicant finds this evidence unpersuasive. Such evidence merely supports the assertion that retailers often have a varied line of goods. For example, using the same type of analysis, there is evidence to support that “nutritional supplements” and “shirts” are goods that may emanate from the same source. *See Exhibit C* (six live registrations with goods and services identifications including both “nutritional supplements” and “shirts”). Along the same lines, there is even greater evidence to support that

“nutritional supplements” and “beer” are related and may emanate from the same source. *See Exhibit D* (twenty-one live registrations with goods and services identifications including both “nutritional supplements” and “beer”).

Moreover, because of the large differences in the Applicant's mark and Registrant's mark, a greater degree of similarity between the Applicant's goods and Registrant's services is necessary for a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ 2d 1812, 1815 (T.T.A.B. 2001).

### **III. BODYBUILDERS ARE SOPHISTICATED PURCHASERS RELATIVE TO THE GOODS**

The Examining Attorney gave too little weight to the sophistication of bodybuilders in regard to purchasing bodybuilding goods. Applicant submits that likelihood of confusion is eliminated, as the relevant purchasers are sophisticated purchasers in regard to bodybuilding goods. A group of purchasers is sophisticated when it spends time and money in choosing goods. *See Munters Corp. v. Matsui Am., Inc.*, 730 F. Supp. 790, 799, 14 USPQ 2d 1993, 2000 (N.D. Ill. 1989). It is well established that confusion is less likely to occur in a setting where goods are offered to highly discerning, sophisticated clientele. *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 21 USPQ 2d 1388, 1393 (Fed. Cir. 1992). Even when the marks are similar, careful examination by purchasers can obviate a likelihood of confusion. *In re Software Design, Inc.*, 220 USPQ 622 (T.T.A.B. 1983). The greater the degree of sophistication, the less likely that there will be confusion as to the source of goods or services. *See Palm Bay Imports v. Veuve Clicquot Ponsardin Masion Fondee En*, 1772, 396 F.3d 1369 (Fed. Cir. 2005).

In the present case, Applicant sells to bodybuilders, a limited, discerning group of purchasers that is well aware of the products used as part of a physical training regimen. In fact, bodybuilders tend to spend an inordinate amount of money and time focused on diet and nutrition. *See Exhibit E* (Internet evidence showing examples of bodybuilders spending extraordinary time and money selecting relevant goods). Training regimens are constantly fine-tuned and amended as bodybuilders educate themselves on proper nutrition and training methods. A bodybuilder will exercise a high degree of care in selecting and purchasing products in this context in order to achieve a very specific result. As such, body builders are extremely sophisticated in regard to the purchasing of bodybuilding goods and would undoubtedly realize the source of the goods, despite any similarities within the respective marks. Therefore, this factor greatly weighs against a finding of likelihood of confusion in the instant case.

### **IV. THE SHARED TERM IS WEAK**

Applicant asserts that due consideration must be given to the weakness and descriptive nature of the shared element, VELOCITY. In the present case, confusion is avoided as the shared material is a weak indicator of source relative to the cited goods. The strength of the mark, or the relevant portion of the mark, is the central issue, as it dictates the breadth of the mark's protection. *CBS Inc. v. Liederman Likewise*, 33 USPQ 2d 1333, 1335 (S.D.N.Y. 1994). Courts and the T.T.A.B. have long recognized that merely descriptive and weak marks are entitled to narrower protection. *See, e.g., In re Central Soya Company, Inc.*, 220 USPQ 914 (T.T.A.B. 1984).

Elements of a mark are generally weaker if such elements are widely used or registered as a trademark by others in the same or related fields. *Daddy's Junky Music Stores Inc. v. Big Daddy's Family Music Center*, 42 USPQ 2d 1173, 1178 (6<sup>th</sup> Cir. 1997). Marks containing common elements are

not likely to be confused if the common matter of the marks are not likely to be perceived by purchasers as distinguishing source because it is diluted. *See e.g., Shen Mfg. Co.*, 393 F.3d at 1238.

Here, VELOCITY, the only shared term in Applicant's and Registrant's mark, is diluted through extensive third party use. Extensive use of a term in third party registrations may be offered as evidence of a term's weakness and dilution with respect to a particular field and may be used to "show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP § 1207.01(d)(iii).

As illustrated below, the term VELOCITY is diluted in regard to nutrition and dietary goods with the PTO. The following, third-party registrations, are evidence of the weakness and dilution of the VELOCITY as a source identifier. *See Exhibit F* (14 live, registered trademarks containing VELOCITY in the mark and Internal Class 005, or a goods and services identification containing "health", "supplements", "vitamins", or "fitness").

In addition, the following Internet evidence shows how highly diluted the term VELOCITY is in regard to nutrition and dietary goods. *See Exhibit G*.

Moreover, VELOCITY, is further weakened due to its descriptive nature relative to the cited goods. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ 2d 1009 (Fed. Cir. 1987). Here, a valued function or characteristic of a nutritional supplement is that it works quickly to deliver the intended effect. *See Exhibit A*.

As demonstrated above, the shared term in Applicant's and Registrant's mark, VELOCITY, is a weak, diluted designation that is entitled to a narrower scope of protection. As such, the additional material 1VIZN MAXIMUM should be given more weight in a likelihood of confusion analysis.

## **CONCLUSION**

In conclusion, a proper analysis of the relevant *DuPont* factors in the instant case requires a finding of no likelihood of confusion between Applicant's mark and Registrant's mark. As such, Applicant respectfully asks that the Examining Attorney reconsider her refusal to register and allow Applicant's mark to proceed to publication. A Notice of Appeal has been filed concurrently with this request to reconsider the refusal to register. Please suspend the appeal proceeding pending the reconsideration of the refusal to register.

If further information or response is required, please contact Applicant's attorney at 734 730 1450, or by email at [shannon@stahlinlaw.com](mailto:shannon@stahlinlaw.com)

### **Exhibits:**

Exhibit A: Speed as a Feature of Nutritional Supplements

Exhibit B: PTO Records for 1vzn

Exhibit C: PTO Registrations Relating "Nutritional Supplements" and "Shirts"

Exhibit D1-D3: PTO Registrations Relating "Nutritional Supplements" and "Beer"

Exhibit E: Evidence of Bodybuilders' Sophistication (Spending Money and Time in Choosing Goods)

Exhibit F: Relevant PTO Records for Velocity

Exhibit G: Online Occurrences of Velocity

