

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

U.S. APPLICATION SERIAL NO. 79168618

MARK: LIVINKA

79168618

CORRESPONDENT ADDRESS:

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APPLICANT: Gorokhovskaya Tatyana Gernanovna

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1255393

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "1B- 1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

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. 3781412. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Applicant has applied to register the mark LIVINKA in standard character form for use on goods which include "albumin dietary supplements; alginate dietary supplements; albuminous preparations for medical purposes; albuminous foodstuffs for medical purposes; aloe vera preparations for pharmaceutical purposes; appetite suppressant pills; antioxidant pills; balms for medical purposes; biocides; biological preparations for medical purposes; by-products of the processing of cereals for dietetic or medical purposes; casein dietary supplements; diabetic bread adapted for medical use; decoctions for pharmaceutical purposes; dietary fiber; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; digestives for pharmaceutical purposes; enzyme dietary supplements; enzyme preparations for medical purposes; flour for pharmaceutical purposes; food for babies; glucose dietary supplements; hematogen; herbal teas for medicinal purposes; lacteal flour for babies; lecithin dietary supplements; liniments; linseed dietary supplements; linseed oil dietary supplements; lotions for pharmaceutical purposes; malted milk beverages for medical purposes; medicinal herbs; medicinal infusions; medicinal oils; medicinal roots; medicinal tea; milk ferments for pharmaceutical purposes; mineral food supplements; nervines; nutritional supplements; pharmaceutical preparations for skin care; pollen dietary supplements; preparations of trace elements for human and animal use; propolis dietary supplements; protein dietary supplements; royal jelly dietary supplements; royal jelly for pharmaceutical purposes; slimming pills; syrups for pharmaceutical purposes; vitamin preparations; wheat germ dietary supplements; yeast for pharmaceutical purposes."

The registered mark is LAVENKAI in stylized form for use on "pharmaceutical products, namely, preparations for the prevention and/or treatment of cardiovascular diseases; pharmaceutical products, namely, preparations for the prevention and/or treatment of cancer; pharmaceutical products, namely, preparations for the prevention and/or treatment of thrombosis; pharmaceutical products, namely, preparations for the prevention and/or treatment of diseases in the field of internal medicine, namely, treatment of infectious diseases; pharmaceutical products, namely, preparations for the prevention and/or treatment of disorders of the central nervous system; pharmaceutical products, namely, preparations for the prevention and/or treatment of respiratory diseases."

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 this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods.

See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (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. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). In this case, applicant's mark LIVINKA and the registered mark LAVENKAI are substantially similar in sound.

Comparison of the Goods and/or Services

With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in the registrant's more narrow identification. Both applicant and the registrant intend to use/use their respective marks on pharmaceutical preparations.

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In summary, the similarities between the marks and the goods of applicant and the registrant are so great as to create a likelihood of confusion.

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, 1026 (Fed. Cir. 1988).

Although the examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If applicant responds to the refusal to register, applicant must also respond to the following informalities.

INFORMALITIES

General Inquiry on Significance

Applicant must explain whether "LIVINKA" has any meaning or significance in the industry in which the goods are manufactured, or if such wording is a "term of art" within applicant's industry. See 37 C.F.R. §2.61(b); TMEP §814. Applicant must also explain whether this wording identifies a geographic place or identifies the surname of an individual associated with applicant. See 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to a request for information is an additional ground for refusing registration. See *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTIP'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

Inquiry on Wording in the Mark – Appears To Be Foreign

Applicant must specify whether "LIVINKA" in the mark has any meaning in a foreign language. See 37 C.F.R. §2.32(a)(9); TMEP §§809, 814. An applicant must submit an English translation of all foreign wording in a mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

Accordingly, if the wording has meaning in a foreign language, applicant should provide the following translation statement:

The English translation of the word "LIVINKA" in the mark is "[insert translation]".

TMEP §809.03.

Alternatively, if the wording does not have meaning in a foreign language, applicant should provide the following statement:

The wording “LIVINKA” has no meaning in a foreign language.

Id.

Identification of Goods

- Applicant must amend the identification of goods by clarifying the exact nature of the goods where indicated below. See TMEP §1402.01.

Please note that in a Trademark Act Section 66(a) application, classification of goods and/or services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant may adopt the following wording, if accurate:

Adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; aloe vera preparations for cosmetic purposes; amber perfume; antiperspirant soap; astringents for cosmetic purposes; **balms other than for medical purposes, namely, non-medicated balms for [indicate nature of use, e.g., hair, skin lips]**; bath salts, not for medical purposes; beauty masks; breath freshening sprays; cakes of toilet soap; cleansing milk for toilet purposes; cosmetics; cosmetic creams; **cosmetic hair dyes**; **cosmetic kits consisting of [indicate primary components]**; cosmetic pencils; cosmetic preparations for baths; cosmetic preparations for eyelashes; cosmetic preparations for skin care; cosmetic preparations for slimming purposes; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; decorative transfers for cosmetic purposes; dentifrices; depilatory preparations; deodorants for human beings or for animals; deodorant soap; **douching preparations for personal sanitary or deodorant purposes, being toiletries**; eau de Cologne; eyebrow cosmetics; **fumigation preparations, namely, [specify, e.g., incense]**; greases for cosmetic purposes; hair dyes; hair lotions; hair spray; hair waving preparations; joss sticks; lip glosses; lipsticks; lotions for cosmetic purposes; make-up; make-up preparations; make-up powder; make-up removing preparations; mascara; massage gels other than for medical purposes; medicated soap; mouth washes, not for medical purposes; nail care preparations; nail polish; **neutralizers for permanent waving being [indicate, e.g., lotions, shampoos]**; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; perfumery; perfumes; pomades for cosmetic purposes; **potpourris, being fragrances**; **scented linen water**; scented wood; shampoos; skin whitening creams; soap; sunscreen preparations; **sun-tanning preparations, being cosmetics**; tissues impregnated with cosmetic lotions; **non-medicated toiletries**; toilet water, in INT. CLASS 3;

Albumin dietary supplements; alginate dietary supplements; albuminous preparations for medical purposes; albuminous foodstuffs for medical purposes; aloe vera preparations for pharmaceutical purposes; appetite suppressant pills; antioxidant pills; balms for medical purposes; biocides; **biological preparations for medical purposes for the treatment of [indicate disease, illness or condition used to treat]**; by-products of the processing of cereals for dietetic or medical purposes; casein dietary supplements; diabetic bread adapted for medical use; **decoctions for pharmaceutical purposes for the treatment of [indicate disease, illness or condition used to treat]**; dietary fiber to [indicate use, e.g., treat constipation, aid in digestion]; dietetic beverages adapted for medical purposes; dietetic foods, namely, [indicate type of foods, e.g., pasta, crackers] adapted for medical purposes; dietetic substances, namely, [indicate type of substances] adapted for medical use; digestives for pharmaceutical purposes; enzyme dietary supplements; enzyme preparations for medical purposes; flour for pharmaceutical purposes; food for babies; glucose dietary supplements; **hematogen in the nature of medicated candy**; herbal teas for medicinal purposes; lacteal flour for babies; lecithin dietary supplements; liniments; linseed dietary supplements; linseed oil dietary supplements; **medicated lotions for pharmaceutical purposes for the treatment of [indicate disease, illness, or condition used to treat]**; malted milk beverages for medical purposes; medicinal herbs; **medicinal infusions for treating [indicate disease, illness, or condition used to treat]**; medicinal oils; medicinal roots; medicinal tea; milk ferments for pharmaceutical purposes; mineral food supplements; nervines; nutritional supplements; pharmaceutical preparations for skin care; pollen dietary supplements; **preparations of trace elements for human and animal use in the nature of [indicate, e.g., vitamins, vitamin preparations]**; propolis dietary supplements; protein dietary supplements; royal jelly dietary supplements; royal jelly for pharmaceutical purposes; slimming pills; **syrups for pharmaceutical purposes for the treatment of [indicate disease, illness, or condition used to treat]**; vitamin preparations; wheat germ dietary supplements; yeast for pharmaceutical purposes, in INT. CLASS 5.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and 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.

TELEPHONE FOR ASSISTANCE

- If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/tcas/correspondence.jsp>.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailed date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned 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 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: Jul 28, 2015 79075158

DESIGN MARK

Serial Number
79075158

Status
REGISTERED

Word Mark
LAVENKAI

Standard Character Mark
No

Registration Number
3781412

Date Registered
2010/04/27

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner
SANOFI Société Anonyme FRANCE 54 rue La Boétie F-75008 Paris FRANCE

Goods/Services
Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
Pharmaceutical products, namely, preparations for the prevention
and/or treatment of cardio-vascular diseases; pharmaceutical products,
namely, preparations for the prevention and/or treatment of cancer;
pharmaceutical products, namely, preparations for the prevention
and/or treatment of thrombosis; pharmaceutical products, namely,
preparations for the prevention and/or treatment of diseases in the
field of internal medicine, namely, treatment of infectious diseases;
pharmaceutical products, namely, preparations for the prevention
and/or treatment of disorders of the central nervous system;
pharmaceutical products, namely, preparations for the prevention
and/or treatment of respiratory diseases.

Priority Date
2009/03/24

Colors Claimed
Color is not claimed as a feature of the mark.

Print: Jul 28, 2015

79075158

Filing Date
2009/08/28

Examining Attorney
WIENER, MICHAEL

LAVENKAI