

6/27/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11  
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Vim & Vigor, Inc.

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Serial No. 75/937,091

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Anthony O. Cormier for Vim & Vigor, Inc.

Linda Orndorff, Trademark Examining Attorney, Law Office  
111, (Kevin Peska, Managing Attorney).

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Before Cissel, Hanak and Chapman, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Vim & Vigor, Inc. (applicant) seeks to register in  
typed drawing form VIM & VIGOR for "wholesale, retail and  
mail order catalog services featuring nutritional and  
dietary supplements, weight loss products and skin care  
products." The application was filed on March 6, 2000 with  
a claimed first use date of April 1, 1998.

Citing Section 2(d) of the Trademark Act, the  
Examining Attorney has refused registration on the basis  
that applicant's mark, as applied to applicant's goods, is  
likely to cause confusion with the identical mark VIM &

Serial No. 75/937,091

VIGOR, previously registered for a "health and fitness magazine." Registration No. 1,821,238.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, they are identical, as applicant acknowledges at page 4 of its brief. Thus, the first Dupont "factor weighs heavily against applicant" because applicant's mark is identical to the registered mark. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's services and registrant's goods, we note that because the marks are

Serial No. 75/937,091

identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in this case registrant's goods (a health and fitness magazine) and applicant's services (particularly its mail order catalog services featuring nutritional and dietary supplements and weight loss products) are clearly related. Obviously, any health and fitness magazine would feature articles on nutritional and dietary supplements as well as weight loss products.

In its briefs, applicant makes no serious attempt to dispute that as broadly described in the registration and application, registrant's goods and applicant's services are at least somewhat related. Rather, in an effort to "put some distance" between registrant's goods and its own services, applicant improperly attempts to prove that registrant's actual goods and its own actual services are dissimilar. For example, at pages 4 and 5 of its brief and again at page 2 of its reply brief, applicant argues that "the evidence in the record shows that the registration

Serial No. 75/937,091

cited by the Examining Attorney is for a magazine publication that is used to promote a hospital facility in the San Gabriel Valley, California." Likewise, despite the fact that the services set forth in the application include mail order catalog services featuring nutritional and dietary supplements and weight loss products, applicant at page 4 of its brief argues that it currently does not actually publish a catalog, or for that matter, a magazine.

The problem with applicant's argument is that in Board proceedings "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

We are of the firm belief that if a consumer were to see a VIM & VIGOR health and fitness magazine and were later to see a VIM & VIGOR mail order catalog featuring nutritional and dietary supplements and weight loss products, that he or she would be likely to assume that

Serial No. 75/937,091

both the magazine and the mail order catalog emanated from a common source.

Decision: The refusal to register is affirmed.