

Statement of the Case

The question presented in this case is whether “Medifil,” a design plus words mark, should be refused registration because of a likelihood of confusion with the mark in U.S. Registration No. 3457826, namely, “Medefil,” a standard character mark, respectively, under Trademark Act Section 2(d), 15 U.S.C. sec. 1052(d), relevant case law, and relevant precedents.

Statement of the Facts

The applicant filed their application on July 27, 2011, citing a first use in commerce in 1999, of the mark “Medifil” for “Dressings for acute and chronic wounds, burns, surgical wounds; Wound dressings.”

On November 16, 2011, the examining attorney issued a refusal claiming there was a likelihood of confusion with the mark in U.S. Registration No. 3457826 , under Trademark Act Section 2(d).

Issue

Is the mark “Medifil” likely to cause confusion with U.S. Registration No. 3457826, namely, “Medefil,” under Trademark Act Section 2(d), relevant case law, and relevant precedents?

Applicable Law

Same Overall Impression as understood by the general impression of the average purchaser

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side by side comparison. Rather, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

Marks must be compared in their entireties with the focus on the impression of the mark as a whole.

In comparing Applicant’s and Registrants’ marks, the marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. See e.g., *Massey Junior College Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”); *Dreyfus Fund Inc. v. Royal*

Bank of Canada, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981) (quoting treatise); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987) (“[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features.”); *Duluth New-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996) (“Rather than consider the similarities between the component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.”)

The literal portions are dominant.

The literal portions are generally the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554 (TTAB 1978). For this reason, greater weight is often given to the literal portions of marks in determining whether there is a likelihood of confusion. TMEP §1207.01(c)(ii).

Moreover, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). TMEP §1207.01(c)(ii).

Distinctive element (term or design) can avoid a likelihood of confusion.

A significantly different display of the same term or an addition of a distinctive element (i.e. term or design) can avoid a likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between First Bank and First Bank System (and design)). The use of a design as part of a mark minimizes any likelihood of confusion. *Harlem Wizards*, 952 F. Supp. At 1096 (citing McCarthy at sec.23: 15[5]). See Also *In re NBA Properties, Inc.*, 2000 TTAB Lexis 863 (TTAB 2000)

The Marks in Question

REGISTRATION

The mark cited against applicant for the likelihood of confusion is Registration Number No. 3457826, which is owned by Medefil, Inc, an Illinois corporation.

MEDEFIL

Word Mark **MEDEFIL**
Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Syringes sold filled with saline and syringes sold filled with heparin. FIRST USE: 19980217. FIRST USE IN COMMERCE: 19980217
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 77325534
Filing Date November 9, 2007
Current Basis 1A
Original Filing Basis 1A
Published for Opposition April 15, 2008
Registration Number 3457826
Registration Date July 1, 2008
Owner (REGISTRANT) **Medefil**, Inc. CORPORATION ILLINOIS 250 Windy Point Drive Glendale Heights ILLINOIS 60139
Attorney of Record Joseph T. Nabor
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

APPLICANTS MARK

The applicants mark, serial # 85494477, is a standard character mark:

Medifil

Word Mark **MEDIFIL**
Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Dressings for acute and chronic wounds, burns, surgical wounds; Wound dressings. FIRST USE: 19990000. FIRST USE IN COMMERCE: 19990000
Standard

Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 85382141
Filing Date July 27, 2011
Current Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Human BioSciences, Inc. CORPORATION MARYLAND
www.humanbiosciences.com 940 Clopper Road Gaithersburg MARYLAND 20878
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

Argument

In response to the Office Action issued on November 16, 2011, Human BioSciences, Inc , (Hereinafter “Applicant”) respectfully requests reconsideration of their application (Serial number 85382141) in view of the remarks that follow.

1. The overall general impression of the respective marks, when viewed in their entirety as a whole by the average purchaser is different because the distinctive elements and dominant elements, including the appearance, sound, and meaning of the marks clearly demonstrate different marks and thereby communicate clearly different sources of goods.

- a. Appearance

When considered in their entirety, as a whole, the marks differ in appearance and create distinctly different commercial impressions; applicant’s mark is the word “Medifil,” is a standard character mark utilizing both capital and lowercase letters, while the registrant’s mark, “Medefil,” is a standard character mark, utilizing all capital letters, all of which must be considered in determining the overall commercial impression the marks convey to the average purchaser. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side by side comparison. Rather, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b). The applicant’s mark uses both uppercase and lowercase letters. Attached are examples of the use of applicant’s mark in commerce. (See

Exhibit 1). The visual use of upper and lower case letters changes the overall impression of the mark as compared to the registrant's mark which uses only uppercase letters forming a more homogeneous appearance. Attached are two examples of the use of registrant's mark in commerce. (See Exhibit 2)

The applicant's mark appears distinct from the registrant's mark as they are used in commerce. The words appear differently to the eye, especially due to the use of lower and uppercase characters, and therefore, are not likely to be confused by the average consumer.

b. Sound

The sound of the Applicant's mark differs significantly from the Registrant's mark. Each mark consists of two syllables. Both syllables differ in their correct pronunciations. The two syllables of Medifil are divided as Medi-fil. Using the international phonetic alphabet (See Exhibit 3) Medifil would be represented as /Medi:fil/. The registrant's mark Medefil, however, is represented as /Medefil /. Looking at the phonemic representation of the sound of each word, it is clear that the words sound differently to the ear and are not likely to be confused by the average consumer.

c. Meaning

The dominant portion of each mark is the literal element. Because the literal element is simply one word in each mark, the meaning of that one word is the dominant element in the mark, being together the first part of the mark and the literal element, which are historically, and as a matter of precedent, considered the dominant portions of trademarks. (See Applicable Law, above) The definitions of the two marks in question are entirely different. (See Exhibits 4 & 5) The applicant's mark contains the first syllable "Medi." The definition of "Medi," as a prefix according to the definition listed on www.thefreedictionary.com is "middle." (see Exhibit 4)

In a search for the first syllable of the registrant's mark, "Mede," at www.thefreedictionary.com returns the definition of: "a member of an Iranian people, closely related to the Persians, inhabiting ancient Media." (see Exhibit 5).

A search for each mark as a whole returned results for the applicant's mark only and referenced the applicant's goods. (see Exhibit 6) The words, by their definitions, are not the same. The average consumer is not likely to be confused by words that are different in their dominant literal element.

2. Conclusion

In light of the differences in the marks when viewed in their entirety, including the different distinctive appearance of applicant's mark, the differences in how the marks sound when pronounced, and the difference in the dominant portions of the mark, namely, the meaning of their literal elements, applicant believes it has satisfactorily shown that there is no likelihood of

confusion between the Registered mark “Medefil” and Applicant’s mark “Medifil,” and respectfully requests the refusal to be withdrawn and the application to move on to publication.