

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jason E. McMillan
DMD, PC
Application No. : 85/791,937
Filed : November 30, 2012
Mark : MINT
International Classes : 035; 041; 044
Examining Attorney : Kapil Kumar Bhanot
Law Office : 108
Docket No. : MDW12401
Date : April 15, 2014

Response to Notice of Suspension

In response to the Notice of Suspension issued on March 21, 2013, the Applicant, Jason E. McMillan DMD, PC (“Applicant”), respectfully requests removal of this application from suspension for further action by the Examining Attorney in view of the following remarks. Applicant hereby traverses the prior pending precaution asserted based on the prior filed application for the mark MINT HIVE (Serial No. 85/481,160).

Consent Agreement – Exhibit 1

Applicant submits the attached Consent to Use and Register Agreement (Exhibit 1) from the owner of U.S. Ser. No. 85/481,160 (“Registrant”). As provided in the Consent to Use and Register Agreement, the owner of the mark MINT HIVE believes there is no likelihood of consumer confusion or conflict between its mark and Applicant’s concurrent and contemporaneous use and registration of the mark MINT in connection with the applied for services.

Prior Pending Application

Applicant’s application has been suspended based on Application Serial No. 85/481,160. First, Applicant notes that the prior filed application for the mark MINT HIVE (Serial No. 85/481,160) was registered on October 15, 2013 as Reg. No. 4,419,112.

Applicant respectfully submits that due to the significant differences between Applicant’s mark and the cited mark and the sophisticated nature of the purchasers of the services, among other factors, there is no likelihood of confusion.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q.2d 563 (C.C.P.A., 1973) establishes various factors as a test for determining whether there is a likelihood of confusion. TMEP § 1207.01; *Du Pont*, 476 F.2d at 1360-62, 177 U.S.P.Q.2d at 566-67. In the present case, Applicant submits that the following are most relevant: (i) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (ii) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; and (iii) the market interface between Applicant and Registrant.

An analysis of the most relevant factors here shows that concurrent registration and use of Applicant’s applied-for mark for the recited services in International Classes 035, 041 and 044 and U.S. Registration No. 4,419,112 (“the cited registration”) for consulting services in the field of dental practice management in International Class 035 is not likely to cause consumer confusion as to the source or origin of the services provided under each mark.

i. The marks MINT and MINT HIVE are different in their entireties as to appearance, sound, connotation, and commercial impression.

First, Applicant notes that there are substantial differences between the cited mark and Applicant’s mark. As shown in the in the Consent Agreement, the Registrant agrees that the differences in the marks make confusion between the marks unlikely.

The points of comparison for word marks are appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1691 (Fed. Cir. 2005), citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. *Trak Inc. v. Trag Inc.*, 212 U.S.P.Q. 846, 850 (T.T.A.B. 1981).

In regards to appearance and sound, the cited registration MINT HIVE includes the term HIVE, in contrast to Applicant’s mark which does not include the term HIVE. Instead, Applicant’s mark is simply the word MINT. The addition of the term HIVE in the Registrant’s mark creates an entirely different appearance and sound from Applicant’s mark. The term HIVE consists of half the length of Registrant’s mark and is entirely absent from Applicant’s mark.

With regards to meaning, the cited mark MINT HIVE includes the term HIVE, which suggests a place of busy activity (e.g. a bee hive). Applicant's mark, lacking this term, has no such connotation.

Thus, Applicant's mark differs sufficiently with respect to appearance, sound, and meaning from the cited mark to create a distinct commercial impression in the minds of consumers. This factor therefore weighs strongly in Applicant's favor.

ii. Both marks are used in connection with services that are not purchased on impulse, but instead with care.

Applicant submits that the care with which consumers purchase dental services weighs against a likelihood of confusion in this case. In circumstances where consumers generally exercise care in making purchasing decisions, a likelihood of confusion may be minimized. See e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985). The Trademark Trial and Appeal Board has noted that "in purchasing healthcare services, even ordinary consumers are likely to exercise greater care and will know with whom they are dealing." *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1504 (TTAB 2005) (non-precedential opinion). Because consumers generally do not purchase dental or other oral health-related services on an impulse, but instead consider carefully to which clinic they are entrusting their dental health needs, consumers take care when purchasing Applicant's dental services. Likewise, buyers seeking consulting or educational services in the field of dentistry also take care, as such services are expensive and often tailored to a buyer. Thus, in all of the recited services for the MINT application and MINT HIVE mark, consumers can be expected to easily distinguish between Applicant's mark and Registrant's mark.

iii. Registrant and Applicant agree that there is no likelihood of confusion between Registrant's and Applicant's marks.

Applicant again refers to the attached Consent to Use and Register Agreement executed by Registrant, demonstrating that Registrant consents to the use and registration of Applicant's mark for the services in International Classes 035, 041 and 044.

Conclusion

Thus, in summary, Applicant respectfully submits that the differences between Applicant's mark and the cited mark in sight/sound/meaning and the sophisticated nature of the purchasers of Applicant's services are sufficient to avoid any likelihood of consumer confusion.

In view of the above, the Applicant respectfully requests the suspension of the Application Serial No. 85/132,880 be lifted and that the prior pending precaution be withdrawn. The Examining Attorney is encouraged to telephone the undersigned if a telephonic interview would be helpful to a prompt publication of the application.

Respectfully submitted,

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