

Applicant requests that the Examining Attorney consider the following “du Pont” factors in evaluating the issue of “likelihood of confusion” between the marks in issue:

The Differences in the Respective Marks

There are relevant differences in the respective trademarks. The applicant’s mark is the two-syllable term “MILEX” and the cited mark is the three-syllable term “IMILEX”. The prefix portion of applicant’s mark is pronounced “My”, while the prefix portion of the cited mark could be pronounced “I’m” or “I-mih”, or even simply “I”. The respective prefixes “MI” and “IMI” also look different. Thus, the respective marks are not “nearly identical” in the impression that they make, because the prefix portion of each mark is the dominant part thereof. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009).

The suffix term “LEX” is very common, with 555 showings of said term as a suffix in trademarks registered in Class 1, and third-party marks similar to the marks in issue have already been registered, e.g., AMYLEX, No. 3,107,826, INOLEX, No. 1,011,975, MOLEX, No. 1,271,419, MORLEX, No. 393,239, MYCELX, No. 2,423,909, and MYCALEX, No. 3,915,358. (Please see the annexed “TARR” extracts.) In view of the high level of sophistication of the buyers in the chemicals marketplace, the Trademark Office appears to accept a relatively narrow scope of protection for marks used therein.

Furthermore, there is no evidence of record that the cited mark is famous or highly-recognized even in its own marketplace, or that the registrant has extended its use of the mark (since 1985) beyond the narrow range of goods described in its registration. The registrant’s only variation in use of the mark appears to have been the addition of “-P” to the end of its mark, so that it appears as “IMILEX-P. (Please see the specimens of record in the USPTO file wrapper for “IMILEX”.) Use of the cited mark in this manner makes it even more distinguishable in sound and appearance from the applicant’s mark.

The relevant inquiry is not whether potential buyers will confuse the marks, but rather whether the marks are likely to confuse buyers, and the inquiry goes beyond a side-by-side comparison of the marks. They must be placed into their specific purchasing context, as described hereinafter.

The Differences in the Respective Goods

Applicant has revised and restricted its identification of goods, and has expressly excluded the “resin softeners” and “maleimide” from the cited registration in several parts of its modified wording of goods. Applicant does not use its trademark for the “N-phenyl maleimide” which is associated with the cited mark. If there is any theoretical overlap between applicant’s goods and the registrant’s goods, it is outweighed as a “du Pont” factor by the sophistication of the buyers and the complexity of the goods, as well as the absence of actual confusion during 10 years of concurrent use of the marks in issue. *See infra*.

The technical differences between “MILEX” and “IMILEX” products are set forth in the Memo entitled “Difference between MILEX and IMILEX”, which is annexed to the “Declaration” being filed with this response. These technical differences are of critical importance to buyers of the respective goods, whose familiarity with the goods and their properties will minimize any likelihood of source confusion.

The Nature of the Marketplace

The buyers of “MILEX” and “IMILEX” products are highly sophisticated and make their purchases only after exacting review of the chemical structures, properties and characteristics of the respective chemicals. The annexed “Declaration” illustrates the types of uses and buyers for applicant’s goods, especially in the automotive field where applicant’s phenolic resins are used in the manufacture of brake pads. The registrant’s website identifies pharmaceuticals and agricultural chemicals as examples of applications for “IMILEX” products. In each case, the marketplace for the goods involves industrial specialists who are likely to have a high level of familiarity with the sources of the chemicals they acquire, and who buy the goods by means of long-term contracts. “There is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (citing *Astra Pharmaceutical Products v. Beckman Instruments*, 220 USPQ 786, 790 (1st Cir. 1983)).

The buyers of the respective goods do not make snap judgments based on fleeting impressions of products and brand names obtained from mass advertising, as if they were buying beer or chips. They consult the extensive technical information available on the parties’ websites and in their promotional literature, they consult with sales representatives of the parties, and they conduct independent research about industrial practices and about product histories for other goods sold by the applicant and the registrant. “This is not the sort of purchasing environment in which confusion flourishes.” *Oreck Corp. v. U.S. Floor System, Inc.*, 231 USPQ 634, 640 (5th Cir. 1986).

The Absence of Actual Confusion

The annexed “Declaration” shows that applicant has made substantial sales of “MILEX” products in the U.S.A. since 2002, i.e., over \$25 million in sales. Applicant is unaware of any instances of confusion with the trademark “IMILEX” and the owner of said trademark has not objected to use of the mark (and it is unlikely that a successful objection to such use could be made at this late date). While it is unlikely that buyers of inexpensive consumer goods like candy bars or soap would go to the trouble of reporting trademark confusion to manufacturers, for products like “MILEX” and “IMILEX” it is much more likely that any confusion would have been brought to the attention of one or both of the trademark owners, since the consequences of the confusion would probably have been significant.

Applicant has established substantial common law rights in the trademark "MILEX" in the U.S.A., and its rights should be reflected on the register of the U.S. Patent and Trademark Office. The register should be a reliable repository of marks which have been used on a consistent and substantial basis for years, so as to give adequate notice to third parties of the existing rights in such marks. Applicant has made a significant investment in its mark and developed valuable goodwill therein, without trading on the registrant's goodwill. Applicant is equitably entitled to obtain a registration of its mark, and, accordingly, requests that the refusal of registration be withdrawn and that its mark be approved for publication in the *Official Gazette*.