

Refusal of Registration of the Mark Based on the Likelihood of Confusion

The Examining Attorney has refused registration of Applicant's trademark MILLENNIUM & Design, , on the Principal Register under Section 2(d) of the Trademark Act in view of the two registrations, namely 1) U.S. Reg. No. 3,458,658 for "THIRD MILLENNIUM MEDICINE"; and 2) U.S. Reg. No. 4,849,334 (). Applicant respectfully submits that the cited two registered marks and Applicant's mark, , are not similar in visual appearance, sound, connotation or overall commercial impression as to cause a likelihood of confusion and requests the Examiner's reconsideration in view of the discussions provided below.

Applicant notes that the Applicant's Design Mark, , and the THIRD MILLENNIUM MEDICINE and  marks may at first appear to be somewhat similar, only due to the fact that all three marks include the word, MILLENNIUM. However, Applicant respectfully submits that this is only one consideration and concurrent use of the trademarks in question (as well demonstrated in the coexistence of the two cited registrations, THIRD MILLENNIUM MEDICINE and ) would not likely lead to confusion, mistake, or deception of purchasers. As further explained below, there is no likelihood of confusion between the three marks at issue based on the readily distinguishable visual appearance and commercial impression created by each mark when compared in their entireties.

It is well established that the degree of similarity of marks is tested on three levels as encountered in the marketplace – sight, sound, and meaning. Universal Money Centers v. AT&T, 30 USPQ 2d 1930 (10th Cir.), cert denied, 513 U.S. 1052 (1994). In analyzing the similarities of sight, sound and meaning between two marks, one must look to the overall impression created by the marks and not merely compare individual features, Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc., 4 USPQ2d 1942 (6th Cir. 1987), as it is important to consider all factors that would leave an impression on potential customers. McGregor-Doniger, Inc. v. Drizzle, Inc., 202 USPQ 81, 89 (2d Cir. 1979). Because the similarity or dissimilarity of the marks is determined based on the marks, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. In re National Data Corp., 224 USPQ 749, 751 (Fed. Cir. 1985). The fact that marks share common elements does not compel a conclusion of likelihood of confusion. General Mills, Inc. v. Kellogg Co., 3 USPQ2d 1442, 1445 (8th Cir. 1987).

On the other hand, different features may be analyzed to determine whether the marks are similar. Price Candy Company v. Gold Medal Candy Corporation, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight

has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the mark in their entirety. In re National Data corp., 224 USPQ at 751. However, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains. Spice Island Co. v. Frank Tea & Spice Co., 184 USPQ 35 (CCPA 1974).

Applicant respectfully disagrees with the Examining Attorney's assertion that  Design Mark and THIRD MILLENNIUM MEDICINE and  are "confusingly similar" because "the marks all share the word MILLENNIUM" and that "marks may be confusingly similar in appearance where similar terms or phrases ... create a similar overall commercial impression." The inclusion of the common term MILLENNIUM by the three marks in the instant case, however, does not sufficiently rise to the level of "confusing similarity" between the marks in comparison. Courts have stated, "[T]he use of an identical word, even a dominant word, does not automatically mean that two marks are similar." Freedom Savings & Loan Assoc. v. Way, 757 F. 2d 1176, 1183 (11th Cir. 1985). Also, courts have repeatedly found that the decision for "confusing similarity" must be based on the entire marks, not just part of the marks, and by looking at the overall impression created by the mark and not merely compare individual features. It is well settled that the marks at issue should be compared in their entirety, as it is improper to dissect the marks being considered. In re Loew's Theatres, Inc., 218 USPQ 956 (TTAB 1993), aff'd, 226 USPQ 865 (Fed. Cir. 1985).

Therefore, when considering the respective marks in comparison in their entirety, the differences between all three (3) marks are prominently visible as to not create similar appearance or commercial impressions. First, in terms of sight, there is no similarity or resemblance between the visual representations of the respective marks since Applicant's mark, , is a highly stylized, composite design mark, embodying certain font type for the literal term and incorporating a graphic element in its own unique way. In contrast, the THIRD MILLENNIUM MEDICINE registration is for a word mark with no particular visual representation, but with the inclusion of two additional terms THIRD and MEDICINE, while the  registration, with two words MILLENNIUM and HEALTH, has its own stylization and additional pictorial elements. All three marks, based on their own unique and disparate, distinct features, are completely distinguishable from each other.

Visually, the absence (or presence) of additional elements, even if they are descriptive terms in need of disclaimer (as is the case for both registered marks), can still bring about a significant impact on the overall impression and appearance of the marks in comparison. While Applicant's Design Mark , as discussed above, is a composite mark consisting of

several distinctive elements, the registered  mark is also a composite mark consisting of its own several distinctive elements, namely, the stylized lettering of MILLENNIUM HEALTH, with almost circular lines to embrace some kind of waterlily flower design displayed prominently next to the literal elements. These stark differences in every feature respectively incorporated in  and  are so visibly and prominently displayed to render the marks dissimilar from each other. In addition, these are design marks and as such, the registered mark should be afforded that narrow scope of protection in which every element (and not just the literal terms) included therein should be considered and weighed in for the likelihood of confusion comparison. Furthermore, the standard is to compare the marks in their entirety, and therefore, the differences created by the disclaimed portion of the  mark, i.e., HEALTH, should not be so easily discredited when that element also can have a significant impact on the overall appearance and commercial impression of the marks.

Just comparing the “Description of Mark” sections in the respective marks, the differences in the overall appearance between the two marks are apparent and obvious. Applicant’s “mark consists of the wording “MILLENNIUM” in stylized lettering with a curve line appearing above the wording “MILLENNIUM,” drawn from the first letter “I” to the second letter “I.” The  registered “mark consist of the word MILLENNIUM in all caps located above the word HEALTH, also in all caps, with the words being in right-alignment. A partial circle encloses the ends of the words. The circle has a three-petal flower as part of its circumference, the flower being located after the word MILLENNIUM.” It is the mark as a whole design mark, inclusive of all these different design elements, that makes impression on the relevant purchasers, and not just by its separate component parts. The Examining Attorney has given no weight to the design portion of the registered mark in comparing the mark with Applicant’s mark. It is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains. Spice Island Co. v. Frank Tea & Spice Co., 184 USPQ 35 (CCPA 1974). Applicant respectfully pleads that none of the design elements in both marks should be dismissed nor given less weight in the comparative analysis for likelihood of confusion. Based on this analysis, the marks at issue simply do not create the same commercial impression in the minds of the relevant purchasers encountering these marks and, therefore, there is no likelihood of confusion.

In terms of sound, the differences created by the respective marks are also not *insignificant*. In particular, when Applicant’s Design Mark  and the registered phrase mark THIRD MILLENNIUM MEDICINE are compared as a whole (and without being improperly dissected for comparison of component parts only), the acoustic differences are even

more substantial and pronounced, thereby, further distinguishing the marks from each other. For example, supposing that MILLENNIUM is the dominant term in the registered mark and if this were to be taken away from both marks, there is no point of similarities whatsoever between “THIRD MEDICINE” and the curve line with two dots at each end of the line in Applicant’s mark. In other words, one cannot speculate that any reasonable consumer would believe the services provided by these two disparate marks come from the same source. The registered phrase mark THIRD MILLENNIUM MEDICINE is completely different and distinguishable from MILLENNIUM, visually, acoustically and in overall appearance, because of the inclusion of the additional wording THIRD and MEDICINE, while Applicant’s design mark includes no additional wording. As such, the respective marks have very distinctive rhythms and cadences when they are spoken. These acoustic differences contribute to the commercial impressions the marks create in the minds of consumers, even when they are presented visually. See In re Great Lakes Canning, Inc., 227 USPQ 483, 484 (TTAB 1985) (the sound of a mark plays a role in the commercial impression created by the mark in the minds of purchasers, even when the mark is presented visually).

Moreover, there is no evidence, and therefore, no reason to presume that the term THIRD is any less dominant than MILLENNIUM in the registered phrase mark, particularly when the term is not a descriptive term and has not been disclaimed in the registration. Even if certain terms were to have been disclaimed, the relevant consuming public is *not* aware of this fact and would not necessarily view the disclaimed terms to be less dominant or significant. Rather, in creating a commercial impression of the registered mark, these disclaimed “descriptive” terms are very telling and give away information about the function and nature of the registered marks, (i.e., that the registered mark THIRD MILLENNIUM MEDICINE has something to do with the medical industry) to the purchasing public encountering the marks.

As the United States Court of Appeals for the Federal Circuit has pointed out in In re the Hearst Corporation, 982 F.2d 493, 494 (Fed. Cir. 1992), marks tend to be perceived in their entireties in which case all components thereof must be given appropriate weight, and the marks must be considered in the way they are used and perceived. As explained by the Federal Circuit in the Hearst opinion:

The appearance, sound, sight and commercial impression of VARGA GIRL derive significant contribution from the component “girl.” By stressing the portion “varga” and diminishing the portion “girl,” the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word “girl.” When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely. Id.

The Hearst court held that the Board erred in finding that “varga” was the dominant element of the VARGA GIRL mark and that “girl” was merely descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with the registered mark VARGAS. Id. The court reversed the Board’s finding of likelihood of confusion and, instead, held that VARGA GIRL and VARGAS were sufficiently different in sound, appearance, connotation, and commercial impression, to negate likelihood of confusion. Id.

Applying the Hearst court’s reasoning to the instant case, when we consider each mark as a whole in the way they are used and perceived in the marketplace since the marks tend to be perceived in their entireties, not only is Applicant’s mark MILLENNIUM visually dissimilar and

distinguishable from the cited registered  mark, but also is sufficiently dissimilar and distinct in sound from the THIRD MILLENNIUM MEDICINE mark. All components of the marks in comparison, including the specific stylized font, the order and arrangement of the literal elements within the design, appearance of the additional wording THIRD, MEDICINE, and HEALTH and the sound these make, and the prominent display of the curve line element in Applicant’s mark, contribute to render the marks to function as different and distinguishable trademarks. The differences in the sound and visual of all literal and non-literal elements combined as a whole must all be given appropriate weight to derive the true connotation and overall impression created by each mark. Based on the Hearst court’s reasoning, it then logically follows that Applicant’s Design Mark, as a whole, is sufficiently dissimilar to both cited registrations as to negate any likelihood of confusion among the relevant purchasing public.

Because of the differences created by the added matters in all marks in comparison, they create very different commercial impression and, therefore, there is no likelihood of confusion. See Bell Labs, Inc., v. Colonial Prods., Inc., 231 USPQ 569 (S.D. Fla. 1986) (no likelihood of confusion between FINAL and FINAL FLIP, both for rodenticide); Pacquin-Lester Co. v. Pharmaceuticals, Inc., 179 USPQ 45, 46 (C.C.P.A. 1973) (no likelihood of confusion between SILK’N’SATIN and SILK, both for beauty lotions and creams). Also, even a slight difference between marks will distinguish them when the matter they share has a well-known meaning. See Wooster Brush Co. v. Prager Brush Co., 231 USPQ 316, 318 (TTAB 1986) (marks with common words may be distinguished by additional matter in the marks); Freedom Savings & Loan Ass’n, supra (minor alterations effectively negated any confusing similarity between marks containing the term FREEDOM). In the instant case, the added terms “THIRD” “MEDICINE” “HEALTH” in registered marks should still be considered in the overall analysis of determining likelihood of confusion. See Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc., 205 USPQ 981, 984 (9th Cir. 1980) (ALPHA and ALPHA STEEL not confusingly similar because added terms are significant and indicate different origin).

In sum, in view of the foregoing, Applicant respectfully submits that its Design Mark, MILLENNIUM, is simply a different and distinguishable mark from the two cited registrations, just as much as the two registered marks are different and distinguishable from each other to be able to maintain their coexistence and concurrent use. While Applicant's mark and two different Registrants' marks share the word MILLENIUM, when the marks are considered in their entireties, these individual marks are sufficiently dissimilar in overall appearance and commercial impression as to preclude any reasonable likelihood of confusion.

Therefore, Applicant respectfully requests that the Examining Attorney reconsiders her determination and withdraw the refusal of likelihood of confusion in view of the aforementioned to allow the subject application to proceed to publication. Applicant also respectfully invites the Examining Attorney to call the undersigned if any further materials or clarification regarding this application are needed.