

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	AFIMILK Agricultural Cooperative Ltd.)
)
Application No.:	88/679,165)
)
Filed:	November 4, 2019)
)
Mark:	SYNERGY)
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Response to Office Action

In the Office Action issued February 19, 2020 (“Office Action”) the examining attorney cited Registration No. 5,342,366 (“Cited Registration”) in a likelihood of confusion refusal.

The Cited Registration is for the mark SYNERGIS (“Cited Mark”) in standard characters and covers various goods for the production of semiconductors in Classes 7 and 9.

This application is for the mark SYNERGY in standard characters and covers goods in Class 9.

Initially, it should be noted that a common term, much less merely arguably similar wording, between two marks does not mean there is a likelihood of confusion between the two, even when one mark contains the entirety of the other. *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529, 530 (CCPA 1970) (“the mere presence of the word [and opposer’s mark] “peak” in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion”). In this case, the marks are not identical and must be compared in their entireties as to appearance, sound, connotation, and commercial impression.

Applicant’s mark differs significantly in meaning, connotation, and commercial impression from the Cited Mark. Even changing a single letter may change the commercial impression of a mark. *See In re Warren Petroleum Corp.*, 192 USPQ 405, 407 (TTAB 1976) (““XTRA”, although the phonetic equivalent of “EXTRA”, is not “EXTRA”, per se; that while the difference is the omission of one letter, this slight variation cannot be overlooked because one can never predict the effect of this difference coupled with constant exposure over a considerable period of time as the only indicia of origin for certain goods or services.”).

This is especially true in a case like this one, where Applicant’s mark is a real word with a particular meaning, connotation, and commercial impression. The Cited Mark is not an English word. Consumers are likely to differentiate real words they are familiar with, namely, “SYNERGY,” from the unfamiliar, namely, a made up word like SYNERGIS. *See Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards v. Georgallis Holdings, LLC*, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“the Board correctly found that the unfamiliar MAYARI is distinguishable from the familiar MAYA, and that the marks, considered in their entireties, are dissimilar as to appearance, sound, meaning, and overall commercial impression.”). A made up word creates an impression that is distinct and noticeably different from a real word. A real word has meanings and associations with consumers and those would be significantly different from the impression created by a made up word with no set meaning.

The two marks do not convey the same idea or create the same reaction. The differences in the meaning, connotation, and commercial impression between Applicant's mark and the Cited Mark are so significant that there can be no likelihood of confusion. Even when two marks are identical, such a difference in meaning would eliminate the likelihood of confusion. *See In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) ("As a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance."). But again, in this case the marks are not identical at all, further illuminating the differences in meaning, connotation, and commercial impression.

In addition to the differences discussed above, Applicant's mark differs in appearance and sound from the Cited Mark. Given the entirely different meanings of the marks, the lack of similarity in appearance and sound further demonstrates that confusion is unlikely.

While the differences between Applicant's mark and the Cited Mark are sufficient by themselves to obviate any likelihood of confusion, Applicant's Class 25 goods are unrelated to the goods in the Cited Application. *See Kellogg Co. v. Pack'em Enterprises, Inc.*, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("In the present case, the Board ruled that the dissimilarity of "the marks in their entirety" itself made it unlikely that confusion would result from the simultaneous use of the marks. We cannot say that the Board committed any legal error in so holding.").

In addition to the differences in the marks, Applicant's goods for dairy farming are wholly unrelated to the semiconductor manufacturing products offered under the Cited Mark.

The TMEP provides that, "[c]onversely, if the goods and services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP § 1207.01(a)(i). In *Quartz Radiation Corp. v. Comm/Scope Co.*, cited in TMEP § 1207.01(a)(i), the Trademark Trial and Appeal Board ("TTAB") held that although two marks were identical, when they were for goods that were "different in nature," "used for different purposes," "promoted differently," and "purchased by different discriminating purchasers" there was no likelihood of confusion. *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1996).

Dairy farming and semiconductor manufacturing are completely different endeavors and entirely different in nature. The associated products are used for different purposes and would, accordingly, be promoted differently. They would also be targeted at entirely different sets of prospective customers and both sets of customers would be sophisticated as these products are for commercial use.

Because Applicant's mark differs significantly from the Cited Mark in meaning, connotation, and commercial impression and Applicant's goods are not so related to the goods identified in the Cited Registration, there is no likelihood of confusion between them. Applicant respectfully requests that the likelihood of confusion refusal be withdrawn and Applicant's application approved for publication.

The Office Action inquires about Applicant's entity type. Applicant is an Israeli cooperative society and this description has been accepted in previous USPTO filings. A copy of a registration owned by Applicant where this entity description is accepted is attached. Applicant submits that this description should be accepted in this case as well.

Respectfully submitted,

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Dated: August 19, 2020

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