

## ARGUMENT

### MILLENNIUM (SERIAL NO. 86/796,578)

The Examining Attorney refused registration of Applicant's MILLENNIUM mark ("Applicant's Mark") for use in connection with "Distributorship services in the field of communications and electrical equipment," under Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the grounds that Applicant's Mark, when used on or in connection with the identified services, so resembles the mark THE MILLENNIUM STORE in U.S. Registration No. 4,953,750 and the mark MILLENNIUM WORLDWIDE in Serial No. 86/435,989 (the "Cited Marks") as to be likely to cause confusion, to cause mistake, or to deceive.

There is no likelihood of confusion between the Cited Mark and the Applicant's Mark as because the Applicant's goods, as amended, are different from those listed in the Cited Mark, because the marks differ in both sound and appearance, and because there has been no actual confusion in spite of a lengthy period of concurrent use.

The goods listed in both of the Cited Marks include:

*Online retail store services, and retail store services, featuring art supplies, musical instruments, phonographic turntables, turntable cartridges, replaceable stylii, turntable headshells, phonographic pre-amplifiers, phonographic accessories, professional audio and disk jockey equipment, including sound mixers, controllers, digital audio players, speakers, public address equipment, monitors, headphones, ear buds, synthesizers, stands for equipment, dust covers, cases and audio accessories, phonographic records, DVDs, hi-fidelity stereo systems, audio receivers, hi-fidelity audio amplifiers, home theater speaker systems, headphone amplifiers, compact disk players, digital vinyl simulation systems, replacement woofers, replacement tweeters, replacement faders, audio monitors, powered subwoofers, slipmats, studio production equipment, audio mixing boards, wireless speakers, wireless-enabled audio accessories and speakers, clothing, namely, T-shirts and sweatshirts*

As amended, Applicants goods include:

*Distributorship services in the field of communications and electrical equipment, namely pipe, marker posts, conduit, duct systems, locate balls, markers, flags, pipe fittings, cable and conduit location and installation equipment, junction boxes, enclosures for cable connections, wire and cable, testing and splicing equipment, aerial hardware and grounding equipment.*

Where the goods of the Applicant and Registrant are different, the Examining Attorney bears the burden of showing that Applicant's and Registrant's different goods would commonly be provided by the same source. *E.g., In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (Examining Attorney's argument that small segment of market would be familiar with both Applicant's use of PURITAN in connection with dry cleaning services and Registrants' uses of PURITAN in connection with dry cleaning equipment and dry cleaning chemicals rejected due to lack of proof of trade practices and failure to show likelihood, rather than possibility, of confusion; refusal reversed). There is no evidence of record that the two companies' respective goods are in any way related for purposes of the likelihood of confusion analysis.

Furthermore, although on its face Applicant's identification does not limit the class of purchasers for its distributorship services, in fact, the goods sold by Applicant are purchased by a very select group of customers, namely, contractors building traffic signals, street lights and intelligent transportation systems like traffic cameras, speed monitoring and communications and contractors installing and maintaining local area networks and connections. In contrast, the Cited Marks are used in connection with online retail store services selling instruments, stereo equipment and clothing to end consumers. Because there is no overlap, no commonality and no connection between Applicant's goods and the goods in the Cited Marks, there is no likelihood for confusion.

#### **The Parties' marks are dissimilar**

There is no mechanical test for determining likelihood of confusion, and "each case must be decided on its own facts." *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). In determining whether similarity exists between marks, the marks must be viewed in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224

U.S.P.Q. 749 (Fed. Cir. 1984). *See also Packard Press Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1354 (Fed Cir. 2000). “A mark should not be dissected but rather must be considered as a whole in determining the likelihood of confusion.” *MarCon, Ltd. v. Avon Products, Inc.*, 4 U.S.P.Q.2d 1474 (TTAB 1987). Under this well-established concept of trademark law (also known as the “anti-dissection rule,” 3 J. Thomas McCarthy, *McCarthy on TradeMark and Unfair Competition*, 4<sup>th</sup> ed. 2005 (“McCarthy”), §23:41), conflicting marks are not to be compared by breaking them up into their component parts. When the marks are viewed properly, in their entireties, it is clear that there is no likelihood of confusion between the Cited Mark and Applicant’s Mark, because the marks differ in appearance and sound and can be sufficiently differentiated by consumers.

It is often held that there is no likelihood of confusion when additional or substitute matter is present in one of the marks. *See e.g. Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (no likelihood of confusion between PEAK and PEAK PERIOD); *In re Merchandising Motivation Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (no likelihood of confusion between MENSWEAR and MEN’S WEAR); *Dunfey Hotels Corp. v. Meridien Hotels Investments Grp., Inc.*, 504 F. Supp. 371 (S.D.N.Y. 1980) (no likelihood of confusion between PARKER HOUSE and PARKER MERIDIEN for hotels); *Beech-Nut, Inc. v. Warner-Lambert Co.*, 480 F.2d 801 (2d Cir. 1973) (BREATH PLEASERS and BREATH SAVERS not confusingly similar for breath mints). For example, the U.S. Court of Appeals for the Federal Circuit in *M2 Software, Inc. v. M2 Communications, Inc.* 450 F.3d 1378, 1384 (Fed. Cir. 2006) upheld the TTAB’s decision that the mark M2 as used on CD-ROMs in the pharmaceutical industry was not likely to be confused with the mark M2 COMMUNICATIONS as used on CD-ROMs in the music industry. “[W]hile the board found the ‘M2’ portion of the

marks to be identical and that the disclaimed term [communications] did not create any significant difference in meaning or commercial impression, it did not err in finding that the marks, when considered as a whole, were not identical,” and were not likely to be confused. *Id.* (emphasis added). As such, when comparing Applicant’s Mark and the Cited Mark, it is not appropriate to focus solely on the common words “MILLENNIUM”, while ignoring the clear differences from the cited marks THE MILLENNIUM STORE and MILLENNIUM WORLDWIDE.

The Court of Customs and Patent Appeals applied similar reasoning in holding that the mark TIC TAC for candy was not confusingly similar to the mark TIC TAC TOE for ice cream and sherbet. *See In re Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (holding that “the board has made too much of the indisputable fact that TIC TAC is two-thirds of TIC TAC TOE and that TIC TAC would ‘bring to mind’ TIC TAC TOE. Neither fact determines the issue of likelihood of confusion.”). In fact, in *Ferrero*, the Court of Customs and Patent Appeals noted that the “very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, two marks.” *Id.* at 1397.

Courts have held that very small distinctions can distinguish marks from each other. *See NEC Electronics v. New England Circuit Sales, Inc.*, 722 F.Supp. 861, 863 (D. Mass. 1989) (holding that the mark NEC for manufacture and sales of integrated circuits and computer chips was not confusingly similar with the mark NECS for a computer chip sales business even though “[b]oth companies have advertised in the same trade publications” and “[b]oth companies use direct mail solicitation and conduct extensive business by phone.”). Likewise, the U.S. Court of Appeals for the Second Circuit found that there was no likelihood of confusion between the marks KIK-IT and KICK’ER when both were used on “similar tabletop games in which wooden

figures, manipulated by the players, play a soccer game.” *Affiliated Hospital Products, Inc. v. Merdel Game Manufacturing Company*, 513 F.2d 1183, 1188 (2<sup>nd</sup> Cir. 1975). If the marks KIK-IT and KICK’ER could co-exist without confusion even when both marks are used on the same type of tabletop soccer games and the owners “compete for the same market,” then surely Applicant’s Mark can co-exist with the cited THE MILLENNIUM STORE and MILLENNIUM WORLDWIDE marks, particularly where the goods are so different.

Finally, in a closely analogous matter, in *In re Nobody’s Perfect, Inc.*, the TTAB held that the marks NOBODY’S PERFECT, used in relation to apparel retail store services, and NOBODY’S PERFECT used in relation to feminine underwear, were unlikely to create confusion because they had sufficiently different commercial impressions – even though the services and goods in question were “closely related.” *In re Nobody’s Perfect, Inc.*, 44 U.S.P.Q.2d 1054, 1057 (TTAB 1997) (not reported). The “NOBODY’S PERFECT” marks are essentially phonetic and spelling equivalents, and are both used in regard to apparel, but the TTAB still found they created sufficiently distinct commercial impressions. Applicant respectfully submits that case at hand presents even more of a distinction. The marks at issue are not phonetic equivalents and the goods are even more distinguishable than in the *Nobody’s Perfect* matter.

As the above-cited cases and decisions demonstrate, even slight differences in the marks can be sufficient to avoid a likelihood of confusion. This is particularly the case when the goods are not similar or even related. Applicant respectfully submits that, if marks that differ by only one letter, exist in the same industry, are advertised in the same channels, and are advertised with the same methods can exist without confusion, then the differences between Applicant’s Mark and the Cited Marks are sufficient to prevent any confusion.

**Consumers are well able to distinguish between the Marks**

Applicant's Mark and Registrant's mark have been used concurrently for more than three (7) years in the absence of confusion. Registrant claims a date of first use as of February 2007. Applicant's Mark has been in use since at least as early as February 2009. Applicant is not aware of any confusion in the marketplace. The lack of any actual confusion in spite of seven years of continuous usage weighs heavily in favor of a finding of no likelihood of confusion.

### **Conclusion**

Applicant respectfully submits that the Examiner should weigh the dissimilarities in the goods, the differences between the parties' marks, and the length of time during which peaceful, confusion free coexistence has occurred. These factors weigh heavily in favor of the registerability of the Applicant's Mark. For these reasons, the applicant respectfully requests that the Examining Attorney withdraw this objection and move the application along to publication.