

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:)
Nutrition 21, Inc.)
Serial No. 76/170416)
Filed: November 22, 2000)
Trademark: DIACHROME)

Law Office: 115
Examining Attorney:
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by J. VALENCIA WARD - ACUSFRONG

APPEAL BRIEF FOR APPELLANT

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the examining attorney, dated April 10, 2002, finally refusing registration of the above-identified trademark. Applicant respectfully requests that the refusal be reversed, on the grounds that there is no likelihood of confusion between Applicant's mark and the mark cited by the examining attorney.

I. BACKGROUND

The subject application was filed by Nutrition 21, Inc. on November 22, 2000, for the mark DIACHROME, for "dietary and nutritional supplements," in class 5. In the first office action, dated April 23, 2001, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), stating that Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in the Registration Nos. 2,003,843 and 2,030,812, as to be likely to cause confusion, to cause mistake, or to deceive.

In a second office action, dated April 10, 2002, the examining attorney withdrew the Section 2(d) refusal with respect to the Registration No. 2,003,843. The examining

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attorney maintained the Section 2(d) refusal with respect to Registration No. 2,030,812, for the mark DYNA CHROME, for "chromium sold as a component of dietary supplements."

II. ARGUMENT

A. The Examining Attorney's Basis For Finding A Likelihood of Confusion

In the first office action, the examining attorney concluded that Applicant's mark is substantially similar to the cited mark in sound, appearance and overall commercial impression. The examining attorney also stated that the fact that Applicant's mark is a single term while the cited mark is composed of two terms does not alter the commercial impression of the marks so as to obviate a determination of a likelihood of confusion.

In the second office action, the examining attorney rejected Applicant's argument that the marks are not confusingly similar because the prefix to each mark (DIA- and DYNA-) has a different connotation and because the common portion of the marks (CHROME) is a weak term, and maintained her position that the two marks are sufficiently similar in sound to support a finding of a likelihood of confusion. In a footnote, the examining attorney stated Applicant that there was no evidence of record concerning the apparent weakness of the term CHROME, with respect to the goods in question.

The examining attorney clearly erred in relying only on an asserted similarity in sound and appearance, without regard to other circumstances, in finding a likelihood of confusion in this case. Specialty Brands v. Coffee Bean Distributors, Inc., 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984) (Similarity between the words in the respective marks is only part of the inquiry into a likelihood of confusion). After properly taking into account all

appropriate considerations, therefore, it is clear that the finding of a likelihood of confusion in this case should be reversed.

B. The Examining Attorney Erred in Disregarding the Weakness of the Common "Chrome" Portion of the Subject Marks

The first error committed by the examining attorney was in focusing solely on the prefix of the subject marks, and in disregarding, entirely, the highly suggestive nature, and therefore the inherent weakness, of the common "chrome" portion of the marks. Regardless of whether there was any "evidence" of record, as to the weakness of the registered mark, the examining attorney clearly erred in refusing to consider the issue. Moreover, the examining attorney was plainly incorrect in determining that there was no evidence of the mark's weakness.

A portion of a mark may be weak, not only because it is commonly used, but also, in the sense that such portion is highly suggestive. It is well settled that highly suggestive terms, because of their connotation (and possible frequent registration) per se, and as components of marks, for the same or similar goods, have been considered to fall within the category of weak marks. Plus Products v. Redken Laboratories, Inc., 199 U.S.P.Q. 111, 116 (TTAB 1978). Thus, the addition of other matter, to a highly suggestive or laudatory term, whether such matter be equally suggestive or even descriptive, may be sufficient to distinguish between them and to avoid confusion. Id. At 116-117.

The examining attorney therefore clearly erred in dismissing this fundamental principle from consideration, by merely stating, in a footnote, that there was no evidence of record that the "chrome" portion of the registered mark is weak. Indeed, it should have been obvious to the examining attorney that, as applied to "chromium sold as a component of dietary supplements," the "chrome" portion is, at the very least, highly

suggestive, if not outright descriptive. In fact, the primary dictionary definition of the term "chrome" is "chromium". Merriam-Webster's Collegiate Dictionary, Tenth Edition, 2001 (See Exhibit A attached hereto).¹

Likewise, as applied to Applicant's goods, the term "chrome" is also highly suggestive. Indeed, the examining attorney went so far as to make of record an excerpt from Applicant's website which identifies chromium picolinate as an ingredient of the dietary supplement in connection with which Applicant's mark is used.

Thus, the examining attorney clearly erred in disregarding Applicant's contention that the common "chrome" portion of the subject marks is weak because it is highly suggestive of the goods on which the marks are used. As such, the examining attorney has also thereby erred in failing to account for this fact in determining whether registration of Applicant's mark would result in a likelihood of confusion.² Moreover, because the "chrome" portion of registrant's mark is highly suggestive, it cannot be relied upon to preclude the registration by others of similarly suggestive, but otherwise distinguishable trademarks for chromium products. See, e.g., Sunbeam Corporation v. Green Bay Tissue Mills, Inc., 199 U.S.P.Q. 695 (TTAB 1978); Plus Products v. Medical Modalities Associates, Inc., 211 U.S.P.Q. 1199, 204 (TTAB 1981).

¹ The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 213 U.S.P.Q. 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983).

² In addition, by making the second office action "final", the examining attorney never gave Applicant the opportunity to respond to her short-shrift, and clearly improper rejection of this significant point.

C. The Prefixes of the Subject Marks Distinguish Them

The examining attorney also erred in rejecting Applicant's argument that that the marks are not confusingly similar because the prefix of each mark (DIA- and DYNA-) have different connotations, and in finding that the fact that Applicant's mark is a single term, while the cited mark is composed of two terms, does not alter the commercial impression of the marks so as to obviate a determination of a likelihood of confusion. The examining attorney therefore erred in concluding that Applicant's mark is substantially similar to the cited mark in sound, appearance and overall commercial impression, especially when the highly suggestive nature of the common portion of the marks is properly taken into account.

1. The Marks Have Different Connotations

As Applicant argued in response to the first office action, Applicant's mark, as a whole, has a difference connotation than that of the cited mark, since the connotation of the prefix of each mark is different. Specifically, the term "DYNA" is a used to refer to power. (See dictionary definition, filed of record with Applicant's response to first office action). This is a common meaning for this term as used as a prefix in words such as "dynamite," "dynamo," and "dynamic."

On the other hand, the prefix "DIA" in Applicant's mark does not have any such meaning. "DIA" is defined as being a prefix meaning "through, across, from point to point" (See dictionary definition, filed of record with Applicant's response to first office action). Furthermore, the "DIA" of Applicant's mark is suggestive of "diabetes", as evidenced by the fact that Applicant's DIACHROME product is recommended for use in dietary supplements for the diabetic market (See excerpt from Applicant's website, made

of record by examining attorney in response to second office action). Thus, the marks DIACHROME and DYNA CHROME clearly have different connotations.

In addition, it must be considered that these prefixes are themselves suggestive, and that this is further evidence that the marks, as a whole, are highly suggestive. As discussed above, the addition of a suggestive prefix (“dia”), to the highly suggestive common component (“chrome”), is sufficient to create a different connotation for Applicant’s mark than that evoked by the suggestive prefix and the highly suggestive common portion of the registered mark. This, in turn, is sufficient to distinguish between the marks and to avoid confusion. Plus Products, 199 U.S.P.Q. at 116-117.

2. The Marks Are Visually Distinct

The examining attorney’s conclusion that the overall impression of the marks is similar is also erroneous because she has erred in finding that the letters “YN” in the registered mark “does not alter the commercial impressions of the marks so as to render them dissimilar.” To the contrary, when the subject marks are perceived in their entireties, as they must be, it is clear that they are visually and audibly distinct, since the terms DIACHROME and DYNA CHROME are different in sound and appearance.

First, the prefix “DIA” is visually distinct from the prefix “DYNA”. Contrary to the examining attorney’s assertion, the presence of the “YN”, instead of “T”, creates an entirely different visual appearance. In short, the term “DIA” does not look like the term “DYNA”. Furthermore, and again contrary to the examining attorney’s conclusion, the overall commercial impression of a mark having two terms is different from the overall commercial impression of a mark having one term. See, e.g., Northwestern Golf Company v. Acushnet Company, 226 U.S.P.Q. 240, 243 (TTAB 1985) (finding that

when considering the marks in their entirety, POWER-STEP and POWER KICK when used on golf clubs “are distinctly different in sound and appearance”); Brewski Beer Co. v. Brewski Brothers Inc., 47 U.S.P.Q.2d 1281, 1286 (TTAB 1998) (As between the marks BREWSKY’S and BREWSKI BROTHERS, the presence of the word BROTHERS is a distinguishing element).

Thus, when these visual distinctions are combined with the difference in connotation of the two prefixes, and when all of these differences are considered in combination with the highly suggestive nature of the “CHROME” portion of the marks, the proper conclusion is that there does not exist a likelihood of confusion. See, e.g., Land-O-Nod Co. v. Paulison, 220 U.S.P.Q. 61 (T.T.A.B. 1983) (no likelihood of confusion found in CHIROPRACTIC vs. CHIRO-MATIC for mattresses on grounds that “chiro” is weak as suggestive of healthful support).

3. The Marks Are Audibly Distinct

It is clear, then, that the only arguable basis supporting the examining attorney’s finding that the overall impression of the marks is similar, is the argument that the marks sound alike. Yet even this asserted basis is questionable. Clearly, in pronouncing the marks, the accent on the letter “N” in the registered mark distinguishes it audibly from Applicant’s mark, which does not include the letter “N”, and therefore cannot have an accent on that letter.

While In re Energy Telecommunications & Electrical Association, 222 U.S.P.Q. 350 (TTAB 1983), cited by the examining attorney, does state that slight differences in sound are insufficient to avoid a finding of likelihood of confusion, clearly the slight difference in sound was the only distinguishing factor in that case. In this case, Applicant

does not contend that a slight difference in sound is sufficient, by itself, to distinguish the marks.

First, as noted, the difference in sound is not slight, since the presence of the letter “N” in the registered mark creates an accent that is entirely absent from Applicant’s mark. Further, even if the marks DIACHROME and DYNA CHROME can be said to sound alike, that alone cannot support a finding of likelihood of confusion between these marks, given the visual differences in the prefixes of the marks, the highly suggestive nature of the common portions, the further suggestiveness of the prefixes themselves, and the differences in connotation. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 192 U.S.P.Q. 24 (CCPA 1976) (“Hynap” and “Hy-Top” have different visual, aural, and suggestive impressions and would not be likely to cause confusion even if applied to identical goods); Sears Mortgage Corp. v. Northeast Savings F.A., 24 U.S.P.Q.2d 1227 (TTAB 1992) (APPROVALFIRST not likely to be confused with APPROVAL PLUS, since marks do not closely resemble each other in appearance or pronunciation, and since meaning is different).

Thus, to the extent that a slight difference in sound is the only basis supporting the examining attorney’s finding of a likelihood of confusion, such finding is clearly erroneous, in view of the requirement, as set forth in Specialty Brands, 223 U.S.P.Q. at 1282, that a similarity between the words in the respective marks is only part of the inquiry into a likelihood of confusion. Accordingly, taking into account all appropriate considerations, any similarity in the pronunciation of Applicant’s mark and the registered mark is insufficient to support a finding of a likelihood of confusion.

D. The Examining Attorney Failed to Give Due Consideration to the Relevant Purchasers of the Subject Goods

In addition to all of the foregoing, yet another reason weighs against the examining attorney's finding of a likelihood of confusion in this case. Under In Re E.I. Dupont Denemours & Co., 177 U.S.P.Q. 563, 567 (CCPA 1973), the buyers to whom the goods are sold (i.e., the relevant class of purchasers) is a factor to be considered in the likelihood of confusion analysis. In this case, the examining attorney determined that purchasers are likely to be confused, but did so without making a proper determination as to the actual class of such purchasers. Indeed, the examining attorney's conclusion is sheer speculation.

Although Applicant has filed for use of the mark on nutritional and dietary supplements, the examining attorney made of record excerpts from Applicant's website, and correctly recognized that Applicant sells the subject product as a bulk ingredient to nutritional supplement manufacturers who incorporate the ingredient into dietary supplements (See excerpts from Applicant's website, quoted by the examining attorney in the Office Action of April 10, 2002, and attached thereto). Indeed, the website excerpt specifically identifies Applicant's DIACHROME product as a "new proprietary chromium based ingredient", and lists it, under the heading "key ingredients", as being a combination of chromium picolinate and biotin.

Similarly, registrant's goods sold under the DYN CHROME mark are "chromium sold as a component of dietary supplements." As such, and as the examining attorney recognized, the purchasers of the registrant's goods are also manufacturers of dietary supplements.

Thus, while both Applicant's mark and the registered mark could appear on the packaging of the dietary supplement product, as an indicator of the source of the chromium ingredient therein, the dietary supplements themselves would be sold under another's mark, i.e., the mark of the source of the dietary supplement itself, i.e., the manufacturer, or a distributor or retailer, such as General Nutrition Centers, TwinLabs etc. (See excerpt from Applicant's website). Thus, the purchasers of the goods at issue, i.e., chromium ingredients, are the manufacturers of the dietary supplements themselves, not the consumers who purchase the dietary supplements.

This is a significant consideration in this case, since such manufactures are sophisticated, in that they must obviously be careful and discriminating in connection with the ingredients which they purchase for use in making their end products. Such manufacturers would clearly be acutely aware of the ingredient suppliers they use, and therefore would not likely be confused as to the source of the chromium ingredients they are purchasing.

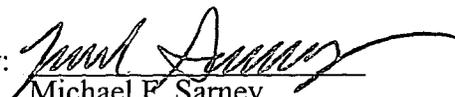
Thus, contrary to the examining attorney's speculation, there is no evidence that the relevant purchasers would likely believe that chromium sold under the mark DIACHROME originates from the same source as chromium sold under the name DYNACHROME. Rather, given the highly suggestive nature of these marks, as applied to chromium, the natural perception of the relevant purchasers is far more likely to be that the chromium sold under these marks emanate from competitive sources, rather than the same source. The examining attorney's unsupported speculation to the contrary should therefore be rejected. See In re Bed & Breakfast Registry, 229 U.S.P.Q. 818 (Fed. Cir. 1986) (Speculative assumption an inadequate basis for legal conclusion).

III. CONCLUSION

When all of the foregoing reasons are considered together, the refusal to register under Section 2(d) was clearly erroneous and should be reversed.

Dated: December 9, 2002

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