

M.F.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/170416

**APPLICANT:** NUTRITION 21, INC.

**CORRESPONDENT ADDRESS:**  
MICHAEL F. SARNEY  
KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK, NY 10022

FEB 24 2003

**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
**ecom115@uspto.gov**

**MARK:** DIACHROME

**CORRESPONDENT'S REFERENCE/DOCKET NO:** SPOR 18.050

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Nutrition 21, Inc.	:	BEFORE THE
Trademark:	DIACHROME	:	TRADEMARK TRIAL
Serial No:	76/170416	:	AND
Attorney:	Michael F. Sarney	:	APPEAL BOARD
Address:	Katten Muchin Zavis Rosenman 575 Madison Avenue New York, New York 10022-2585	:	ON APPEAL

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant has appealed the Trademark Examining Attorney's Final Refusal to register the mark DIACHROME for use on "dietary and nutritional supplements" on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. 1052(d).

## I. FACTS

The Applicant applied for registration on the Principal Register of the trademark DIACHROME in typed form for use on "dietary and nutritional supplements." Registration was initially refused under Section 2(d) of the Trademark Act based on a likelihood of confusion with U.S. Registration No. 2,003,843 for the mark DICROM in typed form for use on "pharmaceutical preparations for the treatment of eye conditions" and U.S. Registration No. 2,030,812 for the mark DYNA CHROME in typed form for use on "chromium sold as a component of dietary supplements." This appeal follows the Examining Attorney's Final Refusal on the issue of likelihood of confusion with U.S. Registration No. 2,030,812 for the mark DYNA CHROME.<sup>1</sup>

## II. ARGUMENT

- A. THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, AND OVERALL COMMERCIAL IMPRESSION AND THE GOODS OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT AS TO THE SOURCE OF THE GOODS.

The Court in *In re E. I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principle factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the listed *DuPont* factors may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. The other *DuPont* factors cannot be considered because no relevant evidence concerning those factors is contained in the record. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

---

<sup>1</sup> Prior to issuing the Final Refusal to register, the Examining Attorney withdrew the refusal based on a likelihood of confusion with U.S. Registration No. 2,003,843.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of registrant and against applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

i. The Marks Are Highly Similar.

The applicant is seeking to register the mark DIACHROME in typed form. The registered mark is DYNA CHROME in typed form. The examining attorney must compare the marks for similarities in sound, appearance, meaning and connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

When compared in their entireties, the marks are highly similar in appearance, sound, and overall commercial impression. Both marks begin with the letter "D", both marks contain three syllables, when spoken the second syllable in each mark appears to most naturally end with a short *ă* sound, and both marks end identically with the term "CHROME." Although not exact phonetic equivalents, the marks are substantially similar in sound. Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys*, 188 USPQ 469 (TTAB 1975).

The only differences between the marks are a single vowel, "I" and "Y", each of which can be pronounced the same, the consonant "N" in the registered mark, and the fact that the Applicant's mark consists of one term while the registered mark consists of two terms. However, these slight differences do not alter the appearance, sound, or overall commercial impression of the marks in such a way that eliminates a likelihood of confusion.

Further, when the Applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun*

*Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956).

The applicant argues that the marks of the parties are not confusingly similar because the term "CHROME" is highly suggestive and therefore inherently weak. The Applicant contends 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." Applicant's Appeal Brief at. p. 3.

The Applicant, however, has not presented sufficient evidence to suggest that the term "CHROME" is commonly used and/or frequently registered for dietary and nutritional supplements or similar goods and therefore weak as applied to the goods. It is the Applicant's burden to present evidence to support its arguments in favor of registration. A dictionary definition, alone, is not sufficient evidence to support this proposition nor is it sufficient to indicate what happens in the marketplace or that the public is familiar with the use of the term "CHROME" in relation to the goods in question.<sup>2</sup>

Nevertheless, even if held to be weak, "weak" marks, e.g., laudatory or descriptive marks, are entitled to protection from registration of a confusingly similar mark for closely related goods or services. *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). Section 7(b) of the Trademark Act, 15 U.S.C. Section 1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of that registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. TMEP section

---

<sup>2</sup> Although the Applicant indicates that a dictionary definition is attached to its Appeal Brief (Applicant's Appeal Brief at p. 4), no attachment was in the file when it was forwarded to the Examining Attorney for her brief.

1207.01(c)(v). The cited mark DYNA CHROME is registered on the Principal Register, and the Registrant has not disclaimed exclusive rights to use "CHROME" apart from the mark as shown.

The Applicant also argues that the marks are not confusingly similar because the prefixes "DIA-" and "DYNA-" have different connotations. Based on dictionary definitions attached to the Applicant's communication filed on October 23, 2001, the applicant contends that the prefix "DYNA-" is used to refer to "power," and the prefix "DIA-" means "through, across, from point to point." Applicant's Appeal Brief at p. 5.

As stated above, the burden rests on the Applicant to present evidence to support its arguments in favor of registration. In this case, the dictionary excerpts submitted by the Applicant are insufficient evidence to suggest that the prefix "DYNA-" is commonly used and recognized as suggesting "power" in the dietary and nutritional supplement and/or related industries or that the prefix "DIA-" is commonly used and recognized as meaning "through, across, from point to point" in the dietary and nutritional supplement and/or related industries.

While a dictionary may provide a definition for a particular prefix, that prefix may be used in a completely different or even arbitrary sense in relation to the particular goods or services in question. In fact, in this case, the Applicant indicates that the prefix "DIA-" is used in the Applicant's mark to suggest "diabetes" and not to mean "through, across, from point to point," as the definition suggests. Applicant's Appeal Brief at p. 5.

Finally, the Applicant argues that "when the 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 CRHOME are different in sound and appearance." Applicant's Appeal Brief at p. 6.

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. *Visual Information Institute, Inc. v. Viacom Industries,*

*Inc.* 209 USPQ 179 (TTAB 1980). The issue is whether the marks create the same overall impression in the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. This point was reiterated in *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975) and *Chemtron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (CCPA 1978). In *Chemtron*, the Court, referring to the fallible recollection of consumers, stated that: “[t]he law of trademarks is not so unsophisticated as to permit a registration to a subsequent user of a mark which comprises an appropriation of a letter or word mark of another with the addition of a subtle variation of form or display or design.” *Id.* at 541.

As stated above, the marks, in fact, produce only a slight difference in sound due only to the letter “N” in the registered mark, as the letter “I” and the letter “Y” can be (and in this case appear to be) pronounced the same. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983). In addition, the fact that the registered mark consists of two terms, while the Applicant’s mark consists of only one term, does not affect the pronunciation, connotation, or overall commercial impression of the mark, and is therefore not a basis on which to distinguish the marks.

Further, if, as will be demonstrated below, the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

As shown above, when considered in their entireties, the similarities in appearance and sound and the creation of the same overall commercial impression in the fallible recollection of

consumers are enough to establish that the marks are sufficiently similar such that a likelihood of confusion exists under Section 2(d) of the Trademark Act.

ii. The Goods And Trade Channels Are Closely Related.

In accordance with the practice established in *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), after examining the similarities of the marks to determine likelihood of confusion, the next issue to be considered is the similarities between the goods or services associated with the marks.

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. It is well established that "relatedness" may exist even though the goods of the parties are not directly competitive and have significant differences. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common origin or source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Further, the fact that the goods or services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods or services, but the likelihood of confusion as to the source of those goods or services. See *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), and cases cited therein.

In this case, while the goods of the respective parties are not identical, as identified in the application and the registration, they are very closely related. Also, as will be demonstrated below, as actually marketed to consumers, the goods of the parties appear to be virtually identical.

The Applicant intends to use its mark on "dietary and nutritional supplements." The registered mark is used on "chromium sold as a component of dietary supplements." Thus, the

registered mark is a component mark, which in commerce is displayed on the finished product – the dietary supplements.

Based on the evidence contained in the application record and the Applicant's own admissions (Applicant's Appeal Brief at p. 9), it is clear that the Applicant, like the registrant, uses its mark on a chromium-based ingredient sold as a component of dietary and nutritional supplements. Attached to the Final Action mailed on April 10, 2002, is an excerpt retrieved from the Applicant's website, which indicates that, "Nutrition 21's ingredients business specializes in marketing and sales of proprietary, science based mineral ingredients for the nutritional products industry. Ingredients are sold in bulk to nutritional supplement manufacturers who incorporate these minerals into dietary supplements."

Other evidence contained in the application record indicates that the goods of both parties may be used to aid in weight loss, while the Applicant's goods are also purported to provide other health benefits. Specifically, an excerpt retrieved from the Applicant's website indicates that the goods to be marketed under the DIACHROME mark are a "patented combination of Chromax® chromium picolinate and biotin [which] promotes healthy blood sugar levels, increases energy production and maintains healthy cholesterol profiles" and "may also be beneficial for the weight loss and sports nutrition markets." Similarly, an excerpt retrieved from another website indicates that the goods marketed under the DYNA CHROME mark are "a uniquely effective form of Chromium [which] helps insure more efficient regulation of blood glucose levels to reduce your urge for between meal snacks."

In summary, the goods of the Applicant and the goods of Registrant are virtually identical, as actually marketed to consumers. Both are chromium-based ingredients sold to manufacturers of

dietary and nutritional supplements and both are marketed to consumers as a component of dietary and nutritional supplements.

The Applicant concedes that the goods of both parties involve chromium-based ingredients sold to manufacturers of dietary and nutritional supplements and marketed to consumers as components of dietary and nutritional supplements. However, the Applicant argues that manufacturers of dietary and nutritional supplements 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” and “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.” Applicant’s Appeal Brief at p. 10.

The fact that purchasers may be sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Therefore, absent any evidence to the contrary, the Applicant’s argument as to the sophistication of purchasers is without merit.

### III. CONCLUSION

In view of the highly similar nature of the marks, the similarity and close relatedness of the goods, and the common channels of trade, purchasers are likely to confuse the sources of these goods. Therefore, the Examining Attorney respectfully requests that the Board affirm the refusal to register the mark on the Principal Register under Section 2(d) of the Trademark Act.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Alicia Collins".

Alicia Collins  
Trademark Examining Attorney  
Law Office 115

Tomas Vlcek, Managing Attorney  
Law Office 115  
(703) 308-9115