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**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** )

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**REPLY BRIEF OF APPELLANT**

Applicant hereby submits this Reply Brief in opposition to the Brief filed by the examining attorney.

**A. The Common "CHROME" Portion of the Marks Cannot Constitute a Basis For A Finding of Likelihood of Confusion**

The examining attorney argues that, when compared in their entireties, the subject marks are highly similar in appearance, sound, and overall commercial impression. Specifically, the examining attorney states that both marks begin with the letter "D", that both marks contain three syllables, with the same accent on the end of the second syllable, and that both marks end identically with the term "CHROME". The examining attorney also contends that the marks are substantially similar in sound.

The mere fact that both marks begin with the letter "D" is clearly not a sufficient basis to find a likelihood of confusion. Likewise, the fact that both marks consist of three syllables is also insufficient to support such a finding. It is obvious, therefore, that the primary basis for the examining attorney's conclusion is that both marks end with the term "CHROME".

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However, as discussed in Applicant's initial brief, the primary dictionary definition of the term "chrome" is "chromium". Merriam-Webster's Collegiate Dictionary, Tenth Edition, 2001.<sup>1</sup> Accordingly, this highly suggestive, if not descriptive common component cannot constitute a basis for a finding that there is a likelihood of confusion. Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 U.S.P.Q.2d 1404, 1406 (T.T.A.B. 1988) ("The mere presence of a common, suggestive element in two marks is usually not enough support upon which to base a finding that confusion is likely"), citing Tektronix, Inc. v. Daktronics, Inc., 189 U.S.P.Q. 693, 694 (C.C.P.A. 1976) ("Because marks, including any suggestive portions thereof, must be considered in their entireties, the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion.").

The examining attorney once again attempts to sidestep this fundamental principle by asserting that Applicant 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 that it is therefore weak as applied to such goods. The examining attorney further argues that a dictionary definition alone is not sufficient evidence to support such proposition, "nor is it sufficient," she states "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."

These contentions are without merit, for several reasons, and it is significant that the examining attorney has failed to cite any authority in support thereof. To begin with,

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<sup>1</sup> As this dictionary definition was inadvertently excluded from Applicant's initial brief, it is attached hereto as Exhibit 1.

contrary to the examining attorney's assertion, a dictionary definition is sufficient evidence to demonstrate the suggestive (or descriptive) nature of a mark, or a portion thereof.

It is well settled that 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); The B.V.D. Licensing Corp. v. Body Action Design Inc., 6 U.S.P.Q.2d 1719, 1721 (Fed. Cir. 1988). The taking of judicial notice means that the fact which is the subject of such notice need not be proved. The B.V.D. Licensing Corp., 6 U.S.P.Q.2d at 1721. As such, evidence beyond a dictionary definition is not required to support a finding that "chrome" means chromium. Moreover, it is well settled that dictionaries may be used to show the meaning of a mark, or a portion thereof. Tektronix, 189 U.S.P.Q. at 694-695; United Foods Inc. v. J.R. Simplot Co., 4 U.S.P.Q.2d 1172, 1174 (T.T.A.B. 1987).

Furthermore, a mark, or a portion thereof, can be found to be highly suggestive, and therefore weak, without any evidence at all. Tektronix, 189 U.S.P.Q. at 694 ("Even without the third-party registrations, however, it is obvious that the suffixes of the parties' marks are highly suggestive") (emphasis added); United Foods, 4 U.S.P.Q.2d at 1174 ("even without the third-party registrations, it is obvious that the term . . . is highly suggestive. . .") (emphasis added).

Likewise, in this case, it is obvious that the term "CHROME" as applied to the chromium ingredients sold by the parties is at least highly suggestive of such products, and of the dietary supplements in which they are ingredients. The examining attorney's

failure to take this into account was therefore erroneous, and her present arguments regarding a lack of evidence are devoid of merit.

In addition, it is submitted that there is no additional requirement that evidence of the meaning of the term "CHROME", as defined by the dictionary, must be presented to show that "the public is familiar" with the use of such term as applied to chromium products (Examining Attorney's Brief). The term means what it means, and only the opposite circumstances would require evidence. (For example, evidence would be required to show that purchasers of a particular class of products ascribe a particular meaning to a term which is different from its dictionary definition).

Further, the examining attorney's assertion with respect to the Registrant not having disclaimed the term "CHROME" is irrelevant. The filing of a disclaimer would not remove the disclaimed matter from consideration in the likelihood of confusion analysis. In re Shell Oil, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993). Thus, regardless of whether the Registrant in this case disclaimed the term "CHROME", the Registrant does not have the exclusive right to use the term CHOME in connection with chromium products, apart from the mark as a whole. Likewise, Applicant has every right to use that term in connection with its own product, provided the marks are otherwise distinguishable, as they are in this case. 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).

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 in connection with 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.

Finally, the examining attorney has simply ignored Applicant's contention that, 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. Since further evidence should not have been required to show that the term "chrome" is inherently weak when used in connection with chromium related goods, Applicant should have been given further opportunity to argue this (or even to submit evidence) before the examining attorney made the office action "Final". The examining attorney's decision should therefore be reversed for this reason as well.

**B. The Prefixes of the Subject Marks Are Distinct**

Contrary to the examining attorney's contention, the prefixes of the marks do not look or sound alike, and the examining attorney has erred in failing to acknowledge the differences in connotation.

First, the prefix "DIA" is plainly visually distinct from the prefix "DYNA". To support her position, the examining attorney compares a four-letter prefix to a three-letter prefix, by improperly removing one of the four letters, and then arguing that, but for such difference, the prefixes look the same. Not only is the examining attorney improperly dissecting the marks, but she obviously finds it necessary to alter them, in order to support her conclusion. In short, contrary to the examining attorney's assertion, the presence of the "YN", instead of "I", creates an entirely different visual appearance as between these prefixes.

Moreover, despite the examining attorney's assertion to the contrary, 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 (T.T.A.B. 1985). Having failed to cite any authority to support her contrary position, the examining attorney's rejection of this distinction is without merit.

The examining attorney further errs in disregarding the different connotations of the marks, resorting once again to her failsafe argument that there is no evidence to support this asserted distinction. Despite the examining attorney's contentions, however, the terms DIACHROME and DYNA CHROME plainly have different connotations, and evidence other than the dictionary definitions of record is not required to confirm this obvious fact.

Moreover, the examining attorney simply ignores the point that these prefixes are themselves suggestive, and that this is further evidence that the marks, as a whole, are highly suggestive, and therefore weak. The addition of a suggestive prefix "DIA", to the highly suggestive common component "CHROME", is sufficient to create a different appearance and connotation for Applicant's mark than that evoked by the suggestive prefix "DYNA", and the highly suggestive common portion "CHROME", of the registered mark. This is sufficient to distinguish between the marks and to avoid confusion, Plus Products, 199 U.S.P.Q. at 116-117, particularly given that in one case, the mark consists of a single term, while in the other the mark consists of two terms.

Accordingly, when the visual distinctions of the prefixes are combined with their difference in connotation, and when both of these differences are considered in

combination with the highly suggestive nature of the "CHROME" portion of the marks, there is no basis to support the finding that there exists 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).

It becomes clear, then, that the only remaining argument made by the examining attorney, in support of her finding that the overall impression created by the marks is confusingly similar, is her argument that the marks sound alike. Yet, 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". The difference in sound is therefore not slight, as argued by the examining attorney, since the presence of the letter "N" in the registered mark creates an accent that is entirely absent from Applicant's mark.

Further, like the similarity in appearance, the similarity in sound is also based primarily on the weak common "CHROME" portions of the marks. Thus, like the alleged similarity in appearance, this common portion cannot be relied upon to support a finding that the marks are confusingly similar on the basis that they sound similar. Like the Registrant, Applicant is entitled to use the term "CHROME" as a component of its trademark for a chromium product.

Nevertheless, 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).

**C. The Examining Attorney Erroneously Ignores the Sophistication of the Relevant Customers**

In direct contravention of her criticism of Applicant’s position, the examining attorney fails to cite any evidence in support of her finding that the Registrant’s mark is displayed in commerce on the finished products – dietary supplements. While it is possible that this may occur, there is simply no evidence that it does. Accordingly, this finding must be rejected as clearly erroneous. On the other hand, the evidence of record does show that the dietary supplements themselves would be sold under the mark of another. (See excerpt from Applicant’s website).

Thus, the examining attorney has failed to rebut Applicant’s point that 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. Therefore, the examining attorney’s conclusion that consumers of the dietary supplements containing the chromium ingredients are likely to be confused is sheer speculation. Further, the examining attorney presents no evidence that consumers of dietary supplements give any consideration as to the source of the ingredients set forth on the labels of dietary supplements.

Additionally, regarding the sophistication of the dietary supplement manufacturers which purchase chromium ingredients, the examining attorney’s only response is to repeat the oft-quoted, but meaningless dicta, that 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. Certainly no one is immune from source confusion, but that is not the standard. If controlling legal precedent permitted the application of this meaningless and illusory distinction, which it plainly does not, the sophistication of customers would never be an appropriate factor to consider in a likelihood of confusion analysis. Yet, it is fundamental that such factor is to be properly considered. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). As such, the sophistication of the relevant consumers is a factor which cannot be summarily dismissed by resort to such meaningless dicta.

Moreover, confusion as to source is the appropriate consideration, not confusion of the marks, and to say that the relevant class of purchasers at issue here may be unsophisticated in trademarks, whatever that may mean, certainly does not demonstrate that they are likely to be confused as to the source of the ingredients which they purchase. Indeed, such statement raises the question of who, in fact, is sophisticated in trademarks. Attorneys and examining attorneys, and this Board, to be sure. But, it is the potential confusion of the relevant class of purchasers which is the requisite consideration, and the issue of whether purchasers are "sophisticated in trademarks" is entirely irrelevant.

As Applicant has pointed out, manufactures of dietary supplements are not likely to be confused as to the source of the ingredients which they are purchasing. These manufactures know who their suppliers are. Indeed, they are carefully selected. Thus, a trademark which - for the sake of argument - is similar to another trademark, will not result in these manufacturers being confused as to the source of the ingredients they are

purchasing. They are purchasing their ingredients based on manufacturing, quality and cost considerations. Unlike consumers, they are not charmed by brand names, and trademarks do not factor into their purchasing decisions.

Accordingly, 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 DYNA CHROME. 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).

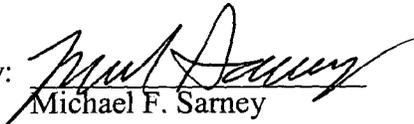
**D. Conclusion**

In support of her conclusion that registration of Applicant's mark would result in a likelihood of confusion, the examining attorney relies on nothing more than her own subjective opinion that there are only slight differences in the appearance, pronunciation and overall impression of the subject marks. Moreover, in reaching her conclusion, the examining attorney ignores the fact that the common portions of the mark are highly suggestive, if not outright descriptive, and further ignores the sophistication of the relevant purchasers, as well as the marks' differences in connotation. Accordingly, for the foregoing reasons, the examining attorney's refusal to register Applicant's mark should be reversed.

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