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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/678969

MARK: ML

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GENERAL TRADEMARK INFORMATION:
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the mark "ML" based upon Section 2(d) of the Trademark Act.

FACTS

On 07/02/2007, applicant, Mighty Leaf Tea, a corporation of California, filed an application to register the mark "ML," for "personal care products and skin care preparations, namely, skin soap, body wash, foam bath, body lotion, body scrub, bath salts and massage oil; potpourri; and incense."

In Office Action No. 1, the examining attorney refused registration pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark when applied to the goods, so resembles the registrant's mark "ML MARK LEES," for "skin care products, namely, skin cleanser, skin toner, skin cream, skin lotion, skin mask gel, make-up foundation, powder and blush," and required a standard character claim.

In response to Office action No. 1, the applicant submitted a standard character claim and made arguments in support of registration.

Registration was finally refused pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark, when applied to the identified goods, so resembles the registrant's mark, as to be likely to cause confusion, or to cause mistake or deceive.

On 7/2/08 applicant filed a request for reconsideration and a notice of appeal. On 7/24/08 the examining attorney denied the request for reconsideration.

The sole issue on appeal is whether the applicant's mark "ML" is confusingly similar to U.S. Registration No. 2132830 for ML MARK LEES (stylized), thus creating a likelihood of confusion.

ARGUMENTS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken

or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the goods, similarity of trade

channels of the goods and similarity of the marks. *See In re Opus One, Inc.*, 60 USPQ2d 1812

(TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 TTAB 1999); *In re Azteca Rest.*

Enters., Inc., 50 (USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

1. <u>THE GOODS OF THE RESPECTVE PARTIES ARE IDENTICAL AND/OR RELATED</u>

As to the goods, there is no issue as to whether or not the respective goods are closely related. The examining attorney has made copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods listed therein, skin soap, body wash, foam bath, body lotion, body scrub, bath salts, massage oil, potpourri; incense, skin lotions and other skincare products are of a kind that may emanate from a

single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc*., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). [1] The applicant has not made any arguments to the contrary.

Since the goods 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. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.,* 207 USPQ 443 (TTAB 1980).

The only question to be determined is whether the marks are sufficiently similar so that their use on closely related goods would be likely to cause confusion as to source.

2. THE RESPECTIVE MARKS ARE SUBSTANTIALLY SIMILAR IN CONNOTATION,

SOUND AND OVERALL COMMERCIAL IMPRESSION.

The examining attorney's finding that the marks create similar commercial impressions is based on the application of a few widely accepted principals. Firstly, similarity in appearance is one factor in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words. [*In re Pierre Fabre S.A.* 188 USPQ 691

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[1] See the attachments to the Office action dated 12/31/07 in the Office electronic records.

(TTAB 1975) (PEDI-RELAX and RELAX); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS")]. Secondly, when the applicant's mark is compared to a 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). TMEP §1207.01(b).

Thirdly, the examining attorney must look at the marks in their entireties under Section 2(d).

Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether

there is a likelihood of confusion. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693

(C.C.P.A. 1976). *In re J.M. J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). TMEP §1207.01(b)(viii).

In the present case, the applicant contends that applicant's mark is distinct from registrant's marks in appearance, sound, and commercial impression. The applicant points out that the registrant's mark is a highly stylized mark with the letters ML presented in a cursive abstract fashion with entire words not found in applicant's mark, MARK LEES. [2] However, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201,

[2] See applicant's brief, page 7.

175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The examining attorney maintains that the marks create a substantially similar overall commercial impression. The dominant feature of the registered mark is the stylized letters ML which is prominent and in darker letters. The only feature in applicant's mark is ML (standard character mark). The applicant's mark does not have any features that would distinguish it from the registered mark. When an applicant has a standard character drawing, he is not stopped from presenting it anyway he wants. Applicant could, in reality, present it to appear exactly as the registrant's "ML." If you look at the specimens of record, the applicant already presents it in a similar fashion to the registrant's mark. Moreover, the Mark Lees portion of the registered mark can be viewed as an explanation of what the actual portion of the mark "ML," signifies.

The record does not support the applicant's conclusion that the respective marks do not create a substantially similar overall commercial impression. The applicant has deleted a portion of registrant's mark, a person's name, "MARK LEES," and adopted the

remaining portion, the initials, "ML" to form applicant's mark "ML." [3] Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most *Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

The applicant argues that the examining attorney failed to conduct a complete analysis of all the relevant factors necessary to determine a likelihood of confusion because the examining attorney failed to determine whether and to what extent other similar marks are in use on similar goods. To support this conclusion, the applicant makes reference to printouts of third party registrations and applications from the TESS database that purportedly shows that there is a crowded field of ML marks in the personal care and skincare industry.[4] Applicant's brief points out that applicant's third party evidence of record bear the letters "ML" in the same prefatory position as the cited mark; five involve registrations: "MLE," "MLUXE," "M'LIS," "JML," and "AMLAVI." The remainder involve three pending applications: "MLAB," "FEMLOGIC," and "SIMLINE." [5]

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[3] See the cited registration attached to the first Office action wherein it states as follows. The name shown in the mark identifies a living individual whose consent is of record.
[4] See applicant's brief pages, 6 and 7.
[5] The pending applications should not be considered. Pending applications are "competent to prove only the filing thereof." *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981)

In the present case, the examining attorney conducted a complete analysis of all relevant factors when making the refusal based on Section 2(d) of the Trademark Act. The examining attorney did not ignore the proffered evidence of third party marks, but instead concluded that the evidence did not establish that use of "ML" is sufficiently widespread and used in such a manner to compel the conclusion that the "ML" portion of the respective marks is weak and entitled to only a narrow scope of protection. While applicant's third party registrations made of record contain the letters "ML," the "ML" portion is used merely as a prefix or portion of a unitary mark. The only uses of the letters "ML" standing alone is applicant's mark "ML" and the letters "ML" in the cited mark "ML MARK LEES." Further, the marks, "MLE," "MLUXE," "M'LIS," "JML & Design," and "AMLAVI" have different commercial impressions from the applicant's mark and the mark in the cited registration. Thus, there is no competent evidence of record to show that there is a crowed field of "ML" marks in the personal care and skincare industry or that "ML" is weak, descriptive, or suggestive in this field.[6] Therefore, the examining attorney concluded that "ML" has no apparent suggestive or descriptive significance as applied to products in the personal care and skincare industry and, thus is arbitrary as used on the goods set forth in the cited registration.

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[6] See, for examples, the relevant facts in the cases relied on by applicant that was pivotal in determining that the marks in question were weak. *See: General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) wherein it indicates that the record includes evidence of numerous registrations and applications for marks comprising in part, the term "fiber" in food products and dietary food supplements industries, along with affidavit testimony attesting to wide spread use of the tem "fiber" for food products; *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559,1561, 1562 (TTAB) wherein it indicates that the record includes evidence of numerous registrations, business directories, telephone directories, information from telephone directories, affidavits, *Dunn & Bradstreet* database of company names all referencing use of the term "BROADWAY" contained in trade names for restaurant, bars and/or related services; *American Hospital Supply Corp. v. Air Products and Chemicals, Inc*., 194 USPQ 340, 343 (TTAB 1977) wherein it indicates that third party registrations were competent to establish that a portion common to the marks involved in the proceeding has a normally understood and well known meaning for the same or closely related goods where the remaining portion is sufficient to distinguish the marks as a whole.

Because of the similarity of the marks and because the goods are closely related, the likelihood of confusion exists.

CONCLUSION

Applicant's mark "ML" is confusingly similar to registrant's mark "ML MARK LEES (stylized)." The marks are substantially similar in connotation, sound and overall commercial impression. Further, the respective goods are closely related. The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d1261, 1265, 62 USPQ2d 1001, 1003

(Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025 (Fed Cir. 1988).

Respectfully submitted,

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