

ESTTA Tracking number: **ESTTA258306**

Filing date: **12/31/2008**

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

Proceeding	76678969
Applicant	Mighty Leaf Tea
Correspondence Address	Charles C. Valauskas Valauskas & Pine LLC 150 North Wacker Drive, Suite 1825 Chicago, IL 60612 UNITED STATES lpistorio@vp-law.com
Submission	Reply Brief
Attachments	Applicant's Reply Brief (00057243).PDF ( 7 pages )(29010 bytes )
Filer's Name	Charles C. Valauskas
Filer's e-mail	corder@vp-law.com, lcipra@vp-law.com, ccv@vp-law.com
Signature	/ccv/
Date	12/31/2008

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

**APPLICANT'S REPLY BRIEF**

SERIAL NO:	76/678,969
MARK:	ML
APPLICANT:	Mighty Leaf Tea
FILING DATE:	July 2, 2007
EXAMINING ATTORNEY:	Priscilla Milton
ATTORNEYS:	Charles C. Valauskas Allison M. Corder Valauskas & Pine LLC 150 South Wacker Drive Suite 620 Chicago, Illinois 60606 (312) 673-0360 phone (312) 673-0361 fax

## ARGUMENT

Applicant replies to the Examining Attorney's Appeal Brief. In the Appeal Brief, the Examining Attorney largely relies on the same incomplete analysis performed by her earlier to reach the same unsupportable conclusion. A complete analysis establishes that the mark "ML" when used on or in connection with the identified goods is not likely to be confused with the cited mark "ML MARK LEES" or any other mark under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

To review, the Examining Attorney's analysis was flawed at the onset, particularly with respect to the duPont analysis she conducted. The court in duPont stated that there are a number of principal factors to consider when determining there is a likelihood of confusion under Section 2(d).<sup>1</sup> The duPont court and other courts have recognized that not all of the duPont factors may be relevant or be given equal weight in a given case, and any one of the factors may control a particular case.<sup>2</sup> Regarding which of the duPont factors are relevant or not, the TMEP instructs that while "the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or

---

<sup>1</sup> In testing for likelihood of confusion under Sec. 2(d), the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use, (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing, (5) The fame of the prior mark (sales, advertising, length of use), (6) The number and nature of similar marks in use on similar goods, (7) The nature and extent of any actual confusion, (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion, (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark), (10) The market interface between applicant and the owner of a prior mark, (11) The extent to which applicant has a right to exclude others from use of its mark on its goods, (12) The extent of potential confusion, i. e., whether *de minimis* or substantial, (13) Any other established fact probative of the effect of use. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 1361 177 USPQ 563 (C.C.P.A. 1973); TMEP 1207.01.

<sup>2</sup> duPont quoting In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In re National Novice Hockey League, Inc., 222 USPQ 638, 640 (TTAB 1984).

services,” another one of the duPont factors that is also usually “most relevant” is “[t]he number and nature of similar marks in use on similar goods.” TMEP §1207.01

For whatever reason, the Examining Attorney focused on only two of the duPont factors in her analysis and not also on the particularly relevant sixth factor. In its response to the First Office Action, and again in the Motion for Reconsideration, the Applicant called attention to the incomplete duPont analysis that the Examining Attorney had conducted. The Examining Attorney in her replies to those filings and again in her Appeal Brief does not state why her analysis should not follow the instructions of the duPont court and the TMEP.

If the Examining Attorney had conducted the complete analysis of all of the relevant duPont factors, the evidence would clearly show that there is not just one mark but many marks in the marketplace that include the component “ML” for the same or related goods. These additional marks that include the “ML” component, identified and made of record by the Applicant, are: the registered marks include “MLE”, “MLUXE”, “M’LIS”, “JML & Design”, and “AMLAVI” and the marks that are the subject of pending applications “TMLA”, “MLAB”, “FEMLOGIC & design”, and “SIMLINE”, all used on what Examining Attorney opines are the “respective goods” of “related personal care and skin care products” in the “relevant marketplace” of “the personal care and skincare industry”. (See Office Action dated 10/03/2007 and Office Action dated 01/02/2008).

The only question is whether there is any likelihood of confusion between the Applicant’s mark and any of these other many marks containing the letters “ML” that appear in the marketplace for the same or related goods. The answer is no. Consumers in the relevant marketplace would see various “ML” marks applied to the same or related goods and therefore be required to look to other components of these many marks to determine the source of the goods.

To support her positions that somehow the other "ML" marks that appear in the same marketplace need not be considered equally with the cited mark, and confusion is likely the Examining Attorney makes various assertions that do not stand up to further scrutiny.

For example, the Examining Attorney argues that the stylized ML component of the registered mark is the dominant feature of the mark and therefore should be assigned greater weight. (Examining Attorney's Appeal Brief ("EA. App. Br."), p. 4). However, contrary to the Examining Attorney's assertion, the ML component cannot be the dominant feature of the mark in the relevant marketplace since it is common to many registered and pending marks.<sup>3</sup> Accordingly, consumers would be more likely to perceive the other, non-ML features of the many relevant marks as the source-indicating feature of the many marks.

The Examining Attorney also argues that "the points of similarity are of greater importance than the points of difference". (EA. App. Br., p. 4). However, she fails to recognize that this argument is equally applicable to the third party registrations and applications made of record that include the "ML" component. Again, the only points of similarity between the cited mark and the Applicant's mark are the letters "ML", which is also a point of similarity to third party registrations and applications made of record such as "MLE", "MLUXE", "M'LIS", and "MLAB".<sup>4</sup>

---

<sup>3</sup> Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); Plus Products v. Star-Kist Foods, Inc., 220 USPQ 541, 544 (TTAB 1983)

<sup>4</sup> If, in fact, the Examiner did conduct a complete analysis by considering third party registrations and applications, and did reach the conclusion that the "ML MARK LEES" registration was for the same reason sufficiently different from "MLE", "MLUXE", "M'LIS", and "MLAB", that conclusion – that "ML MARK LEES" was sufficiently different from these other marks – and the evidence supporting that conclusion had to be made of record. TEMP 710.01 ("All evidence that the examining attorney relies on in making any requirement or refusal to register must be placed in the record and copies must be sent to the applicant.").

The Examining Attorney argues also that “[t]he focus is on the recollection of the average purchaser”. (EA. App. Br., p. 5). However, this clearly means that the average purchaser would also recall all the other “ML” marks for “related personal care and skin care products” in the “the personal care and skincare industry”. Therefore, based on this recollection, the average purchaser would look to the design elements or additional word element – MARK LEES – of the cited mark to distinguish it from the Applicant’s mark just as the average purchaser would look to other elements of the other “ML” marks made of record. More specifically, the average purchaser would look to the “E” component of “MLE”, the “UXE” component of “MLUXE”, and the “IS” component of “M’LIS to distinguish these marks from the Applicant’s mark as well as from the cited mark.

In an inherently inconsistent argument, the Examining Attorney assigns little weight to the third party registrations and applications that the Applicant made of record on the basis that they only illustrate that “the “ML” portion is used merely as a prefix or portion of a unitary mark”. (EA. App. Br., p. 7).<sup>5</sup> Therefore, according the Examining Attorney’s own argument, consumers would look to other non-prefatory elements to distinguish the source of the goods or services. See TMEP §1207.01(d)(iii). This is the Applicant’s position. In this case, consumers would somehow look to the design elements or easy to read and easy to pronounce word element found in the cited mark, “MARK LEES”<sup>6</sup>, to distinguish the source of the goods, particularly when, as clearly demonstrated in the record, the “ML” component is common to many marks used on the related goods and therefore, not indicative of one source.

---

<sup>5</sup> However, this dismissal flies in the face of the point that the Examining Attorney made earlier – that “[c]onsumers are more inclined to focus on the first word, prefix or syllable in any trademark” (EA. App. Br., p. 6).

<sup>6</sup> Supporting this contention, the Examining Attorney states that “the Mark Lees portion of the registered mark can be viewed as an explanation of what the actual portion of the mark “ML”, signifies.” (EA. App. Br., p. 6).

The courts have widely recognized that, when many different sources use the same term for the same or similar goods or services, even small differences - such as those between the Applicant's mark and the cited mark in this case - are sufficient to distinguish the marks as a whole. In re Broadway Chicken, Inc., 38 USPQ2d 1559 (TTAB 1996)<sup>7</sup>; General Mills, Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1277 (TTAB 1992)<sup>8</sup>; In re Hamilton Bank, 222 USPQ 174 (TTAB 1984)<sup>9</sup>; Melaro v. Pfizer, Inc., 214 USPQ 645, 649 (TTAB 1982)<sup>10</sup>; Cutter

---

<sup>7</sup> In In re Broadway Chicken, Inc., 38 USPQ2d 1559 (TTAB 1996), evidence was submitted by the Applicant to show that many third party registrations and uses existed for marks that included the term "Broadway". The TTAB found that "[e]vidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field." Id. at 1565 - 66. Accordingly, the TTAB reversed the Examining Attorney's refusal to register under Section 2(d) the mark "Broadway Chicken" in light of the cited registrations for "Broadway Pizza" and "Broadway Pizza & Bar". Id.

<sup>8</sup> In General Mills, Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1277 (TTAB 1992), General Mills ("GM") opposed the registration of "FIBER 7 FLAKES" by Health Valley Foods in light of GM's registration of "FIBER ONE", also for cereal. The TTAB considered the many third-party registrations and applications directed to marks that comprise, in part, the term "FIBER". Id. The TTAB stated that such registrations and applications "show the sense in which the "Fiber" is employed in the marketplace, similar to a dictionary definition" and held that "we do not believe there is any doubt but that the field of "FIBER" marks for foods (including cereals) is a crowded field." Id. The TTAB found that evidence of the "FIBER" crowded market suggests that consumers are accustomed to distinguish between different "FIBER" marks even on the basis of small differences. Id. at 1278. Accordingly, the TTAB held that the duPont factors favored the Applicant and found that confusion was not likely between the two marks. Id.

<sup>9</sup> In In re Hamilton Bank, 222 USPQ 174 (TTAB 1984), the TTAB held that the refusal to register under Section 2(d) to be improper after finding that the many registrations not cited by the Examining Attorney for marks containing the common term or feature "key" for the same or closely related goods or services were competent evidence to show that the remaining portions of the marks are sufficient to distinguish the marks as a whole from one another. Id. at 179.

<sup>10</sup> In Melaro v. Pfizer Inc., 214 USPQ 645, 649 (TTAB 1982), the TTAB stated that a large number of registrations of marks that include a certain component indicates that the Trademark Office treats that component as weak, and not subject to exclusive appropriation in the given field. The TTAB recognized that the mere fact that each of the two marks that were before the TTAB contained the common term "SILK" is not a sufficient basis in and of itself upon which to predicate a holding of likelihood of confusion. Id. The TTAB held that the marks must be considered in their entirety and when this was done, the marks "POLYSILK" and "SILKSTICK" were sufficiently removed by the addition of the components ("POLY" and "STICK") from the petitioner's mark "SILK", *per se*, to avoid any confusion of purchasers as to the source of the products sold thereunder. Id.

Laboratories, Inc. v. Air Products and Chemicals, Inc., 189 USPQ 108, 110 (TTAB 1975)<sup>11</sup>.

Consumers will not view the “ML” component as identifying a single source of “related personal care and skin care products” in “the personal care and skincare industry”.

There is not a likelihood of confusion between Applicant’s mark and the cited mark. Therefore, contrary to the opinion of the Examining Attorney, from a comparison of the marks, confusion is not likely.

For the foregoing reasons, the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), for the reason that Applicant’s mark when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 2,132,830, should be reversed.

Dated: December 31, 2008

Respectfully submitted,

By: /Charles C. Valauskas/  
Charles C. Valauskas  
Reg. No. 32,009

---

<sup>11</sup> The TTAB in Cutter Labs Inc. v. Air Products and Chem., Inc., 189 USPQ 108, 110 (TTAB 1975) found that the many third party registrations of marks containing the component "FLEX" to be competent evidence to suggest that the Registrant and the Applicant adopted and used the term "FLEX" for the same purpose and that the inclusion of the "FLEX" component in each mark to be an insufficient basis to predicate a holding of a likelihood of confusion. The TTAB found that the difference between the marks to be sufficient to be distinguishable by purchasers so as to preclude a likelihood that the purchasers will mistakenly assume that the products sold thereunder emanate from a common source. Id.