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** of Response to Office Action ONLY. **

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Serial Number: 78/103740



UNITED STATES PATENT AND TRADEMARK OFFICE

Serial no. 78-103740

Mark: MLAN

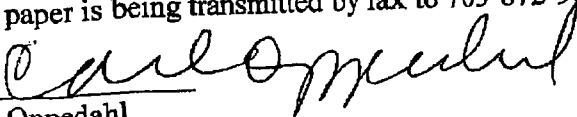
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RESPONSE TO OFFICE ACTION

This paper responds to the Office Action dated December 20, 2002.

The Examiner refuses to register citing Supplemental Register registrations 2566317 and 2554267 for MILAN TECHNOLOGY.

The Examiner is respectfully requested to reconsider the rejection.

Dominant part? The Examiner expresses the view that "the dominant part of each party's mark is the phonetic equivalent of the word 'milan'." The Examiner does not, however, provide any support for the view that "MILAN TECHNOLOGY" has a "dominant part". Indeed it appears to applicant that no part of the mark is more or less dominant than any other part. Absent such support from the Examiner, it is requested that the refusal be withdrawn.

Phonetic equivalent? The Examiner expresses the view that MLAN "is the phonetic equivalent of "MILAN". The Examiner does not, however, provide any support for this view. In fact the pronunciation of "MLAN" is "em-lan", and the Examiner has provided no evidence to the contrary. The only way an English speaker can pronounce "MLAN" is to sound the letter "M" and then to sound the remainder of the mark, in this case "LAN." The result is a word which, when spoken, starts with a vowel sound (the "em" of the letter M). In contrast, the mark "MILAN TECHNOLOGY" starts with a consonant.

Indeed the only way to force a pronunciation of "MLAN" to sound like "MILAN" is to perform the alteration of adding another vowel. To do so would be to admit yet another phonetic difference between "MILAN TECHNOLOGY" and "MLAN."

Any two services mentioning computers are automatically confusingly similar? The Examiner seems to be of the view that if computers are involved in both sets of services, then confusion follows automatically. It is respectfully suggested that precedent puts this view into question. It has been well established that "computer software covers a vast array of very different products that are employed in everything from toys to nuclear reactors."¹ This fact was noted by the TTAB in making the observation that:

As a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized uses in this industry, we think that a *per se* rule relating to source confusion vis-a-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace.

In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985). See also *Information Resources v. X-Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) ("Moreover, there is no 'per se' rule mandating that likelihood of confusion is to be found in all cases where the goods or

¹ *In re Team Financial Management Systems Inc.* (Serial Number 75/584,594), TTAB decision of July 23, 2001.

services in question involve computer software and/or hardware.”).

The Examiner expresses the view that the MILAN TECHNOLOGIES services and the MLAN services “could be encountered by the same consumers” and that such consumers could arrive at “the mistaken belief that the goods/services come from a common source.” The Examiner, however, provides no evidence at all in support of this view, and common sense suggests otherwise.

Sophistication. The consumers who would purchase “maintenance and repair of computer network connectivity hardware” services or “consulting and design services in connection with computer network connectivity hardware and software; maintenance, repair and technical support in the field of network connectivity hardware and software, namely, telephone support provided to purchasers and users of computer hardware and software” would necessarily be sophisticated consumers who would make careful decisions about expensive services. Likewise the consumers who would purchase “electronic transmission of data, documents and messages; providing connectivity services for data transfer; providing telecommunications connections to a global computer network and to a public switched telephone network” services would likewise necessarily be sophisticated consumers who would likewise make careful decisions about expensive services. Such sophisticated consumers would not confuse six syllables for two syllables. They would not confuse four letters with seventeen letters. They would not confuse a mark that starts with a vowel sound with a mark that starts with a consonant.

The Examiner is reminded of the First Circuit's ruling in *Astra Pharmaceutical Prods.*, where “the parties marketed and sold goods marked with the name ‘ASTRA’ to the same purchasing institutions - large hospitals.”² Although both parties manufactured goods “in the same broad health care field,”³ Astra sold pharmaceutical products to hospital pharmacies and Beckman sold

² 718 F.2d at 1206.

³ Id. at 1210.

laboratory instrumentation to hospital laboratories.⁴ In affirming a grant of summary judgment of no infringement, the court held that use in the same broad field "is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." The First Circuit's holding recognized that "[t]he 'hospital community' is not a homogenous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties' respective products."⁵

Furthermore, the sophistication of the purchasing parties is so important in the likelihood of confusion analysis that it is often dispositive even in the cases when the purchasers of goods are the same, because "[s]ophisticated consumers may be expected to exercise greater care."⁶ In a case when both parties used identical marks, the CAFC affirmed the TTAB ruling of no likelihood of confusion, since "because the marks are used on goods that are 'quite different' and sold to different, discriminating customers, there is no likelihood of confusion."⁷ It has also been established in *Astra* that "[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration."⁸

Bridging-the-gap third-party registrations? The Examiner admits that the cited supplemental-register marks are for services in quite different international classes than those of the applicant's mark. The cited marks are in classes 37 and 42, while the applicant's mark is in class 38. The Examiner also admits that the services for the cited marks have no specific overlap with the services for the applicant's mark. There is thus a gap between the cited services and the applicant's services.

⁴ Id. at 1206.

⁵ Id. at 1207.

⁶ *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F. 2d 482, 489 (1st Cir. 1981).

⁷ *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575 (Fed. Cir. 1983).

⁸ 718 F. 2d at 1206.

In an attempt to bridge this gap, the Examiner has resorted to the step of trying to find particular third-party marks which supposedly include both the "MILAN TECHNOLOGY" services and the "MLAN" services.

Even if particular marks could be found which actually recite both the MILAN TECHNOLOGY services and the MLAN services (and no such marks have been cited by the Examiner) this would not be probative of likelihood of confusion in the present case, for at least two reasons. First, such particular marks would have the *same mark* as to the two sets of recited services, while the present refusal is with respect to marks that are *not the same*. No matter how hard the Examiner tries to deny it, "MILAN TECHNOLOGY" is not the same as "MLAN". The number of syllables is different, the number of words is different, the first sound (consonant versus vowel sound) is different. Thus a third-party mark reciting both sets of services would not be probative, since it would have *the same mark* for both sets of services.

But also relevant is that so far as applicant's attorney can discern, the Examiner has found no single mark that recites applicant's class-38 services (electronic transmission of data, documents and messages; providing connectivity services for data transfer; providing telecommunications connections to a global computer network and to a public switched telephone network) and that also recites the services of MILAN TECHNOLOGY (class-37 maintenance and repair of computer network connectivity hardware and class-42 consulting and design services in connection with computer network connectivity hardware and software; maintenance, repair and technical support in the field of network connectivity hardware and software, namely, telephone support provided to purchasers and users of computer hardware and software).

Finally, this bridging-the-gap approach is fundamentally flawed, in that it is commonplace to see "house brands" from particular conglomerates such as Disney and Exxon and Sony that cover any and all possible goods and services. Indeed applicant's attorney challenges the Examiner to put forth any two goods or services and it is submitted that at least one registration could be found that would somehow encompass both of the goods or services that the Examiner might put

forth, simply by reviewing registrations held by such conglomerates. If the Examiner's approach were to be accepted in an across-the-board fashion, it would mean that *any* application could be refused registration due to *any* previous registration, and that cannot possibly be correct.

For all these reasons the Examiner is respectfully requested to reconsider the refusal to register.

Respectfully submitted,



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