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

Proceeding	78462025
Applicant	Mid-America Group, Ltd.
Applied for Mark	MID-AMERICA GROUP
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TRADEMARK

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

IN RE: Mid-America Group, Ltd.	)	
SERIAL NO: 78/462,025	)	Appeal No. _____
MARK: MID-AMERICA GROUP (Logo)	)	
FILED: August 4, 2004	)	
LAW OFFICE: 106	)	

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

APPEAL BRIEF

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Dear Sir:

Please enter the following Appeal Brief into the record. It urges reversal of the Examining Attorney's final refusal to register the above-stated mark under Section 2(d) of the Trademark Act.

I. INTRODUCTION

The Examining Attorney has rejected Appellant's mark on the basis that the proposed mark when used with the identified services is likely to be confused with U.S. Reg. No. 2,444,425 ("the '425 mark") for "MA" logo plus "MID-AMERICA" under Trademark Act Section 2(d).

For the reasons set forth below, Appellant's mark "MID-AMERICA GROUP" plus different logo is not likely to be confused with the '425 mark under Trademark Act Section 2(d).

II. LEGAL ARGUMENT

A. The Legal Standard Under Trademark Act Section 2(d)

Section 2(d) of the Trademark Act precludes registration of a mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods [services] of the applicant, to cause confusion . . . " Trademark Act Section 2(d), 15 U.S.C. § 1052(d). The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (CCPA 1977) sets forth the factors that are considered in determining likelihood of confusion. See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2004). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks, and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Ft. Howard Paper Co., 544 F.2d, 1098, 192 U.S.P.Q.

24 (CCPA 1976); see also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997). These two key considerations and other du Pont factors are pertinent in finding no likelihood of confusion between Appellant's mark and the '425 mark. As explained below, here there is no likelihood of confusion because: (1) the commercial impression of the marks are different; (2) the marks are verbalized differently; (3) the marks are in fact different groupings of words; and (4) the services offered are different.

1. Comparison of the Marks

To determine whether two marks are confusingly similar, the appearance, sound, connotation and commercial impression of each mark must be considered. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005). Because likelihood of confusion depends on the overall impression of the marks, similarities and dissimilarities of the two marks must be scrutinized. In re Electrolyte Labs, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990). Similarity of the marks in one respect – sight, sound or commercial impression – will not automatically result in a finding of likelihood of confusion even if the goods are closely related. In re Lamson Oil Co, 6 U.S.P.Q.2d 1041, n.4 (TTAB 1987). As a separate element or as the sum of the three, one must also compare the commercial impressions created by the marks. Miss World (UK) Ltd. v. Mrs. America Pageants, Inc., 856 F.2d 1445, 1450, 8 U.S.P.Q.2d 1237, 1242 (9th Cir. 1988); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 U.S.P.Q. 390, 394 (Fed. Cir. 1983).

The Examining Attorney asserts that the common usage of "MID AMERICA" in the respective marks renders the marks nearly identical in appearance, sound and

meaning, and the addition of the design element did not obviate the similarity of the marks. (Office Action dated 3/9/05, pg. 2). As a basis for this rejection, the Examining Attorney cites In re Shell Oil Company, 26 U.S.P.Q.2d, 1687 (Fed. Cir. 1993). This case does not provide a legal basis on which to base a likelihood of confusion rejection of the mark MID-AMERICA GROUP. Unlike the marks MID-AMERICA GROUP and MA MID-AMERICA, the marks in In re Shell Oil Company, 26 U.S.P.Q.2d, 1687, 1688 (Fed. Cir. 1993) contained identical words in both marks – RIGHT-A-WAY – and included the same design element - an arrow - in both marks.

In the instant matter, the words of the respective marks are not identical and do not include the same design element in each of the marks. Appellant's mark, MID-AMERICA GROUP, includes three words – "Mid," "America," and "Group, and a design element of a stylized "M" appearing over the words.

MID·AMERICA
GROUP

The '425 mark consists of white stylized letters - "MA" – in a black square with the two words "Mid-America" to the right of the stylized letters.

MID-AMERICA

A close look at the two marks visually reveals the distinct differences between the marks. Appellant's mark consists of three words - "Mid" – "America" – "Group" - with a unique stylized "M" over the word portion of the mark which can also be interpreted as a series of building blocks, one laid on the other (connoting Appellant's business of real estate development services). In contrast, the '425 mark consists of the run together stylized letters "M" and "A" in a black square located before the two words "Mid" and "America" all contained on one line (not on top, as Appellant's). As the old saying goes, a picture is worth a thousand words. Here, the picture is different.

Further, the sound of the marks is distinctly different. Appellant's mark is "Mid-America Group" which when vocalized consists of three distinct words – "Mid" – "America" – "Group." The '425 mark consists of two letters and two words and would be vocalized as "M" - "A" - "Mid" – "America." Thus, the vocalization of the two marks is distinctly different.

The distinct differences in both appearance and sound between the two marks weigh in favor of Appellant's composite mark MID-AMERICA GROUP and against a likelihood of confusion.

2. Comparison of Services

Any likelihood of confusion between Appellant's mark MID-AMERICA GROUP and the '425 mark MA MID-AMERICA is further diminished by the differences in the nature of the services offered under the respective marks. "The issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category." Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992). In fact, the courts have avoided identifying goods so broadly. See e.g.,

Zazu Designs v. L'Oreal S.A., 979 F.2d 499, 24 U.S.P.Q.2d 1828 (7th Cir. 1992) (finding no confusion for ZAZU for hair salon and ZAZU for hair care products); Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982) (finding no confusion between BENEFICIAL for consumer loans and BENEFICIAL CAPITAL for business loans).

In this case, the services offered by the Appellant under its mark are placed into the broad category of "real estate services" by the Examining Attorney. (Office Action dated 3/9/05, pg. 2). This broad categorization runs contrary to the case law cited above. The Examining Attorney bases the refusal to register, in part, on Coca-Cola Bottling Co. v. Seagram & Sons, Inc., 188 U.S.P.Q. 105 (C.C.P.A. 1975); however, this case is not on point. In Coca-Cola Bottling the respective marks had a common term, BENGAL, however, the appellant admitted that the goods sold under its mark and those sold under the appellee's mark "are sold to the same class of purchasers, are used together, and are sold over the same counters." Id. at 106. These facts are contrary to the facts in this matter. The services offered under the MID-AMERICA GROUP mark and the MA MID-AMERICA mark are not sold or offered to the same class of customer; are not used together; and are not sold over the same counters (i.e. same channels of trade).

It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence actually shows regarding the goods or services. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 U.S.P.Q.2d 1783 (Fed. Cir. 1992); The Chicago Corp. v. North Am. Chicago Corp., 20 U.S.P.Q.2d 1715 (TTAB 1991). The services marketed under Appellant's MID-AMERICA GROUP mark are distinct and specifically limited to "real

estate development services" (International Class 037). Consumers encountering the MID-AMERICA GROUP mark are seeking "development" services which include services related to the growth, expansion, building, etc. of real estate, as well as ancillary services such as architectural and engineering services, and construction management and financing. This distinction is furthered by the use of the word "Group" as part of Appellant's mark which connotes the assembly or collection in the development of real estate services. The services offered under the '425 mark are limited to "real estate brokerage and management services" (International Class 036). Brokerage and management services include financial analysis, budgeting; market analysis; and other aspects of managing a real estate portfolio. Although it may be true that the respective services offered under the Appellant's mark and under the '425 mark may both be broadly described as "real estate activities" as noted by the Examining Attorney, to demonstrate that goods or services are related, it is not sufficient that a particular term may be found which may generally describe them. See Gen. Electric Co. v. Graham Magnetics Corp., 197 U.S.P.Q. 690 (TTAB 1977); Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd., 188 U.S.P.Q. 517 (TTAB 1975); In re Cotter, 179 U.S.P.Q. 828 (TTAB 1973). The services offered under the respective marks are distinctly different and would be sought for different purposes. Appellant's services are real estate "development" and the services offered under the '425 mark are real estate "brokerage and management services." Because of the nature of the services, they would be offered to different classes of consumers through different channels of trade. As such, it is unlikely that there would be any opportunity for confusion to occur and, therefore, this factor weighs in favor of the Appellant for its mark MID-AMERICA GROUP and against a likelihood of confusion.

3. "Possible" Confusion is Insufficient

Likelihood of confusion has been said to be synonymous with "probable" confusion, that is, it is not sufficient if confusion is merely "possible." See e.g. Estee Lauder, Inc. v. The Gap, Inc., 108 F.3d 1503, 1510, 42 U.S.P.Q.2d 1228, 1232-33 (2nd Cir. 1997) ("Likelihood of confusion means a probability of confusion; 'it is not sufficient if confusion is merely possible,'"); Elvis Presley Enterprises Inc. v. Capece, 141 F.3d 188, 193, 46 U.S.P.Q.2d 1737, 1740 (5th Cir. 1998) ("Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion."). A mere theoretical possibility of confusion, deception or mistake is insufficient to show "probability," See Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F.3d 713, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (citation omitted). The Examining Attorney offered nothing to suggest that a likelihood of confusion would be more than a possibility. Once again, this weighs in favor of Appellant in registration of its mark.

4. Concurrent Use with No Evidence as to Any Confusion

Appellant submits there is no likelihood of confusion because the MID-AMERICA GROUP mark and the '425 mark have co-existed for over two years with no evidence as to any confusion. Specifically, the MID-AMERICA GROUP mark was first used in interstate commerce in June 2004. Appellant applied for registration August 4, 2004, in International Class 037, "real estate development services." The '425 mark was first used in interstate commerce in December 1984, and was issued registration in April 2001, in International Class 036, "real estate brokerage and management services."

5. Consumer Sophistication Will Prevent Confusion

Where the consumer is a professional or an expert in the field, even while two marks might be sufficiently similar to confuse an ordinary consumer, a reasonable degree of discrimination is exercised and the consumer is not likely to be confused. See Id., 21 U.S.P.Q.2d at 1392; see also Astra Pharm. Products v. Beckman Instruments, Inc., 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790-91 (1st Cir. 1983). Consumers who are builders and realtors, and corporate executives and real estate professionals have been held to be "professional buyers" who exercise a higher degree of care in purchasing goods and services. See Allstate Ins. Co. v. Allstate Inv. Corp., 210 F. Supp. 25, 136 U.S.P.Q. 156 (W.D. La. 1962), aff'd, 328 F.2d 608, 141 U.S.P.Q. 280 (5th Cir. 1964) (holding builders and realtors take a higher degree of care in purchasing); The Deal, LLC v. Korangy Pub., Inc., 309 F. Supp. 2d 512, 69 U.S.P.Q.2d 1775 (S.D.N.Y. 2004) (holding corporate executives and real estate professionals are sophisticated consumers). Here, Appellant and the cited registrant target different market segments in which the consumer regularly deals in real estate development services offered under Appellant's mark in contrast to real estate brokerage and management services offered under the '425 mark. Like consumers in Allstate Insurance and The Deal, consumers contemplating the purchase of services from Appellant or the cited registrant would involve an informed and discriminating decision undertaken by one who is trained in the field and, thus, less likely to be misled or confused by the similarity of different marks. See Virgin Esters, Ltd. v. Nawab, 335 F.3d 141, 145, 67 U.S.P.Q.2d 1420, 1428 (2d Cir. 2003) (holding sophistication of consumers usually weighs against a finding of likelihood of confusion). As such, the level of sophistication of the consumer in contemplating the purchase of

services offered by the Appellant and the cited registrant weighs in favor of the Appellant for its mark MID-AMERICA GROUP and against a likelihood of confusion.

6. Other Similar Marks

Relevant to the argument against likelihood of confusion is the prior registered mark "MID AMERICA" (Registration No. 1,383,686) in International Class 036 for "brokerage and administration of real estate title insurance." It is well established that where marks, similar wholly or in part, are used by third parties in the same field, the owner's mark tends to be weak as a indicator of a single source and is therefore entitled to a narrower scope of protection. Freedom Savings & Loan Assn. v. Way, 226 U.S.P.Q. 123, 127 (11th Cir. 1985) citing Sun Banks of Florida, Inc. v. Sun Fed. Savings and Loan Assn., 211 U.S.P.Q. 844, 848-49 (5th Cir. 1981) and Amstar Corp. v. Domino's Pizza, Inc., 205 U.S.P.Q. 969, 975 (5th Cir. 1980) quoting Restatement of Torts § 729 (1938) ("The greater the number of identical or more or less similar trademarks already in use on different kinds of goods, the less is the likelihood of confusion."). The question relates to consumer perception, "Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related." Gen. Mills, Inc. v. Kellogg Co., 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987).

The weight of evidence of a third party mark varies primarily on the similarity of the third party mark and goods [services] to the mark and goods [services] of the parties in dispute. Natl. Motor Bearing Co. v. James-Pond Clark, 121 U.S.P.Q. 515, 517 (CCPA 1975). Third party registrations may be used effectively to show that a mark is inherently weak, by showing that different entities have adopted and registered marks in a particular field, and that the Patent and Trademark Office ("PTO") has allowed the registration of

marks over one another despite the fact that they have some points of similarity. Clinton Detergent Co. v. Proctor & Gamble Co., 133 U.S.P.Q. 520 (CCPA 1962). For instance, when a PTO trademark application is refused because of a prior registration, the applicant can effectively argue that its mark is not more likely to cause confusion with the registered mark than the registered mark is likely to be confused with one or more other registered marks, all of which include the common element. In re Hamilton Bank, 222 U.S.P.Q. 174, 179 (TTAB 1984); SmithKline Beckman Corp. v. Proctor & Gamble, Co., 223 U.S.P.Q. 1230, 1236 (N.D.N.Y. 1984), aff'd without opinion, 755 F.2d 914 (2nd Cir. 1985). Third party registrations may be made of record by filing copies of PTO printouts, which are admissible as "official records." Weyerhaeuser Co. v. Katz, 24 U.S.P.Q.2d 1230, 1231-32 (TTAB 1992).

The prior registered mark "MID AMERICA" for services in International Class 036 for "brokerage and administration of real estate title insurance" arguably weakens the protection of marks containing the words "Mid" and "America." Appellant's mark MID-AMERICA GROUP is no more likely to cause confusion with the '425 mark MA MID-AMERICA than the '425 mark is likely to be confused with the previously registered mark "MID AMERICA." Although not dispositive, the fact that a previously registered mark to the '425 mark existed for the same international class weighs in favor of Appellant's mark in not causing a likelihood of confusion.

B. Anti-Dissection Rule

Under the anti-dissection rule, a composite mark is tested for its validity and distinctiveness by looking at is as a whole, rather than dissecting it into its component parts. 2 McCarthy on Trademarks and Unfair Compeition, § 11:27 (2006). As the United States Supreme Court stated: "The commercial impression of a trademark is

derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." Estate of Beckwith, Inc. v. Comm. of Patents, 252 U.S. 538, 545-46 (1920). While the basic rule is that marks must not be dissected, but compared in their entireties, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re Natl. Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). "The dominant element of a trademark is the element most readily associated with the products or services it identifies." Assoc. of Co-operative Members, Inc. v. Farmland Industries, Inc., 216 U.S.P.Q. 361, 367 (5th Cir. 1982) (citation omitted). When a composite mark includes both words and a design, the design element is likely to be dominant if it is more conspicuous. Id.

In the Examining Attorney's refusal only the word element "Mid-America" of Appellant's mark is considered in noting that the same commercial impression is created as the '425 mark and will cause a likelihood of confusion. (Office Action dated 3/9/05, pg. 2). The design element is completely ignored. The design element of Appellant's mark – (stylized "M") predominates in size and appearance in the mark in that it sits over the word portion of the mark, and appears in close conjunction with the remainder of the mark MID-AMERICA GROUP. It is only by mark dissection of the word portion of Appellant's mark, and ignoring the design element, that the Examining Attorney can make the argument that the marks are similar as to cause a likelihood of confusion since nothing remotely similar to the design element of

Appellant's mark is contained within the '425 mark. Appellant's mark must be considered in its entirety, along with the conspicuous design element of the mark. See id.; see also In re Natl. Data Corp., 224 U.S.P.Q. at 750-51. Viewed in this light, Appellant's mark has a fundamentally different commercial impression. Much like the word "lightning" and the words "lightning bug," both share the word "lightning" but the commercial impression is distinctly different. Put another way, when the composite mark is considered as a whole, and the way the public actually sees it, the two marks are not sufficiently similar to cause a likelihood of confusion. As such, Appellant's mark will not likely be confused with the '425 mark.

III. ORAL ARGUMENT REQUEST

Appellant hereby requests oral argument in this case. It is not believed a fee is due with this request. However, if a fee is due, please consider this a request to debit Deposit Account No. 26-0084 accordingly.

IV. CONCLUSION

For the above-stated reasons, Appellant's mark MID-AMERICA GROUP is not confusingly similar to the '425 mark. Appellant therefore respectfully requests that the Examining Attorney's final refusal to register dated September 29, 2005, be reversed and Appellant's mark be forwarded for publication.

Respectfully submitted,

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