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

Proceeding	87026036
Applicant	John M Fickewirth Associates Insurance Services, Inc. dba Fickewirth Benefits Advisors
Applied for Mark	OPTIMUM BENEFITS PACKAGE
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Applicant: John M Fickewirth  
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Services, Inc.

Law Office 102

Examiner: Howard Smiga

Appl. No.: 87/026,036

Att’y Dkt. No.: 315-47-075

Mark: OPTIMUM BENEFITS  
PACKAGE

Filed: May 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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## **INTRODUCTION**

Applicant respectfully appeals the Examining Attorney's refusal to register Applicant's standard character OPTIMUM BENEFITS PACKAGE mark in Application Serial No. 87/026,036 (the Application"). The Examining Attorney's refused Applicant's mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d), for likelihood of confusion with the mark OPTIMUM in U.S. Registration No. 2010333 and the mark THE OPTIMUM in U.S. Registration No.1473487.

## **PROSECUTION HISTORY**

Applicant filed the Application on May 5, 2016, seeking registration on the Principal Register for the mark OPTIMUM BENEFITS PACKAGE ("Applicant's Mark") in standard characters for use in connection with insurance administrative services, insurance brokerage services, insurance underwriting services in the field of life, health, accident, disability and longterm care insurance (International Class 36).

On August 16, 2016, the Examining Attorney issued a Non-Final Office Action refusing registration under Trademark Act § 2(d) on the grounds that Applicant's mark would cause a likelihood of confusion with U.S. Registration Nos. 2010333 and 1473487 ("Cited Marks", collectively).

On February 16, 2017, Applicant submitted an office action response, in which Applicant presented arguments against the refusal to register the mark under Trademark Act § 2(d).

On March 23, 2017, the Examiner Attorney issued a Final Office Action regarding the refusal under Trademark Act § 2(d).

On September 25, 2017, Applicant submitted a response to the Final Office Action and a Request for Reconsideration. Applicant filed a Notice of Appeal with the Board. With this

response Applicant also disclaimed the exclusive right to use “BENEFITS PACKAGE” apart from the mark as shown.

On October 18, 2017, the Examining attorney denied Applicant’s Request for Reconsideration and again refused registration.

### **ARGUMENT**

The Examining Attorney continues to refuse Applicant’s registration of “OPTIMUM BENEFITS PACKAGE” based on the conclusion that there is a likelihood of confusion with U.S. Registration Nos. 2010333 (for OPTIMUM) and 1473487 (for THE OPTIMUM). Applicant respectfully disagrees with this conclusion and maintains that the goods and services are not similar and are marketed to different members of the public.

The Examining Attorney has refused Applicant’s registration under the Trademark Act § 2(d), 15 U.S.C. § 1052(d), stating that the Applicant's mark, when used on or in connection with the identified goods, so resembles the mark in the above listed registered mark as to be likely to cause confusion, to cause mistake, or to deceive. Applicant disagrees and believes that there is no likelihood that purchasers of the Applicant's goods and the Registrants’ goods would believe that the goods emanate from a common source.

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., Information Resources Inc. v. X\*Press Information Services*, 6 U.S.P.Q.2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 U.S.P.Q. 863, 865 (TTAB 1985) (regarding computer hardware and software);

In re British Bulldog, Ltd., 224 U.S.P.Q. 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

The question of likelihood of confusion between marks is “related not to the nature of the mark but to its effect ‘when applied to the goods of the applicant.’ The only relevant application is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.” In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis). In determining whether there is a likelihood of confusion, courts look to many factors, including as particularly relevant here:

1. The similarity or dissimilarity of the marks in their entirety;
2. The similarity or dissimilarity and nature of the goods or services such that one party’s goods will be mistaken for those of the other party;
3. The channels of distribution of the goods or services;
4. The conditions under which the goods or services are purchased (i.e. impulse buying versus purchases made after careful consideration);
5. The sophistication of the purchasers of the goods or services;
6. The number and nature of similar marks in use on similar goods or services; and
7. The nature and extent of any actual confusion.

Id. at 1361.

Applicant respectively submits that an analysis of these factors here leads inevitably to the conclusion that no confusion will result between Applicant’s Mark and the Cited Mark.

#### **A. Confusion Must Be Probable, Not Possible**

For confusion to be likely the confusion must be probable; it is irrelevant that confusion is merely possible. Electronic Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1465

(TTAB 1992) (standard is likelihood of confusion, “not some theoretical possibility built on a series of imagined horrors”); Rodeo Collection, Ltd. v. West Seventh, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) (“probable, not simply a possibility”). Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1388 (Fed Cir. 1992), quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (CCPA 1969), *aff’g*, 153 U.S.P.Q. 412 (TTAB 1967). Likelihood of confusion “is synonymous with ‘probable confusion’ it is not sufficient if confusion is merely possible.” J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:3 (4th ed. 2007). Here, Applicant respectfully submits that there is no probability of confusion with the registered marks.

### **B. The Marks Differ In Sight, Sound and Commercial Impression**

The Examining Attorney argues that Applicant’s Mark so resembles the registered marks that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of Applicant and Registrant. In determining whether there is a likelihood of confusion between marks, however, the overall impression in commercial context made by each mark is determinative, not whether the marks share a component. *See* Pacific Sunwear of California, Inc. v. AIT, Inc., 2004 TTAB LEXIS 76 (T.T.A.B. Feb. 18, 2004) (PAC SUN and PAC AIT are different in overall commercial impression and not confusing). In the present case, there is no likelihood of confusion because, the addition of the words “benefit” and “package” in Applicant’s Mark sufficiently distinguishes it from the Cited Mark. These two parts of Applicant’s mark calls attention to the components as equally prominent portions of the mark and, for this reason also, Applicant’s Mark makes a commercial impression distinct from the Cited Marks. One of the primary

considerations in testing for likelihood of confusion is the similarity or dissimilarity of the marks in their entireties as to appearance, sound and meaning or connotation. TMEP § 1207.01(b) (i).

Applicant's mark is "OPTIMUM BENEFITS PACKAGE" and the cited marks are for "Optimum" and "The Optimum". While the marks all use "optimum", Applicant's mark includes the additional words BENEFITS PACKAGE. As a result, the marks are dissimilar in appearance and they are very different words in sight and sound. Applicant respectfully submits that because the marks are dissimilar in appearance, sound and meaning or connotation that there is no likelihood of confusion between the marks. Such differences in connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used. Revlon, Inc. v. Jerrell, Inc., 713 F. Supp. 93, 11 U.S.P.Q. 2d 1612, 1616 (S.D.N.Y. 1989) (No likelihood of confusion because the meaning and connotation of the marks THE NINES and INTO THE NINETIES are not related. Plaintiff's motion for preliminary injunction is denied.); citing Clarks of England, Inc. v. Glen Shoe Company, 465 F. Supp. 375, 379, 209 U.S.P.Q. 852, 854-55, (S.D.N.Y. 1960) (TREK and STAR TREK for shoes; TREK connotes hiking across the Himalayas; STAR TREK connotes space travel.) It is unlikely that consumers would view Applicant's mark as a variation of Registrant's mark.

The marks are dissimilar in appearance and sound. Applicant's mark "OPTIMUM BENEFITS PACKAGE" does not look or sound like "Optimum" or "The Optimum". With all due respect to the Examining Attorney, the Office did not meet its burden of proof in this case. Because the marks have very different connotations, sound differently and create substantially different commercial impressions, it is very unlikely that relevant consumers of the respective goods will believe there is any connection between the two companies. At the outset, Applicant notes that the Examining Attorney has not introduced any evidence as to the likely commercial impression of the two marks. Applicant respectfully submits that its mark and the Cited Marks are not identical, nor

are they confusingly similar. Moreover, the marks sound differently and do not impart the same or similar commercial impression. *See Kellogg Co. v. Pack'em Enterprises, Inc.*, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (FROOTE ICE and FROOT LOOPS "sound different and create different commercial impressions."). Here, the addition of "BENEFITS" and "PACKAGE", looks and sounds very different and provides a completely different commercial impression. In *Knudsen & Sons, Inc. v. Vita-Pakt Citrus Products Co.*, 11 U.S.P.Q.2d 1654 (Fed. Cir. 1989), the dissimilarity of the terms "PAKT" and "JUICE" in VITA-PAKT and VITA JUICE, both marks for fruit juice, was cited as grounds for finding no likelihood of confusion. The difference in this matter are more than sufficient to avoid likelihood of confusion. Based on the dissimilarity of appearance, and connotation of the marks, Applicant submits that there is no likelihood of confusion between the marks.

Based on the dissimilarity of appearance, services, and connotation of the marks, Applicant submits that there is no likelihood of confusion between the marks.

## CONCLUSION

In view of the requirement that likelihood of confusion must be probable, and not only possible, for a refusal under Trademark Act § 2(d), that the goods listed for the Application and the registered mark are distinct, and that the goods of the Application and the registered mark are directed to different target markets, there is not a likelihood of confusion between the mark of the Applications and the registered mark.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act § 2(d) and allow the Application to proceed to publication.

Respectfully submitted,

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