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Paper No. 16
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Degussa-Hüls AG¹

Serial No. 75/411,277

William F. Rauchholz of Smith, Gambrell & Russell, LLP
for Degussa-Hüls AG.

Barney L. Charlon, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Wendel, Holtzman and Rogers, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Degussa AG, now merged into Degussa-Hüls AG, has filed
an application to register the mark SYMBIOBOND for
"precious metal alloy for tooth replacements."²

¹ The merger of the original applicant, Degussa AG, with Degussa-Hüls AG has been recorded by the Assignment Branch at Reel 1983, Frame 0290.

² Serial No. 75/411,277, filed December 29, 1997 under Section 44(e), based on German Registration No. 397 32 626, granted August 25, 1997.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the following registered marks, all owned by the same entity:

- | | |
|-------------------------|--|
| BIOBOND ³ | for "dental gold, gold solder and porcelain for use in fabricating intra-oral composite custom dental restorations"; |
| BIOBOND ⁴ | for "ceramic bonding alloy for use in making dental crowns and bridges, and for solder and flux used therewith"; and |
| BIOBOND II ⁵ | for "metal ceramic bonding dental alloy for use in making crowns and bridges." |

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was requested but the request was later withdrawn.

We make our determination of likelihood of confusion on the basis of those of the *du Pont* factors⁶ which are relevant under the circumstances at hand and for which evidence is of record. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Two key

³ Registration No. 917,737, issued August 3, 1971, Section 8 & 15 affidavits accepted and acknowledged, respectively; first renewal.

⁴ Registration No. 1,143,861, issued December 23, 1980, Section 8 & 15 affidavits accepted and acknowledged, respectively.

⁵ Registration No. 1,258,235, issued November 22, 1983, Section 8 & 15 affidavits accepted and acknowledged, respectively.

considerations in any likelihood of confusion analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Looking first to the respective goods, we note that applicant has failed to contest the Examining Attorney's argument that the goods of applicant and registrant are closely related, in part, and identical in part.

Turning, however, to the similarity or dissimilarity of the respective marks, applicant strongly takes issue with the Examining Attorney. The Examining Attorney maintains that applicant has simply added the prefix SYM- to registrant's BIOBOND mark, so that applicant's mark would be viewed as having the connotation "with BIOBOND." According to the Examining Attorney, the mere addition of the term or prefix SYM is insufficient to alter the overall commercial impression created by applicant's mark so as to "negate the confusing similarity between applicant's and registrant's marks." (Brief, p.4).

⁶ See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant, on the other hand, argues that the marks, when viewed in their entireties, are significantly different not only in sound and appearance, but also in meaning. Besides noting the obvious differences in pronunciation and visual appearance of SYMBIOBOND and BIOBOND, applicant argues that the term "symbio" (stemming from "symbiosis") has a meaning independent and distinct from the term "bio." Applicant contends that it has not merely added a term, descriptive or otherwise, to registrant's mark, but rather has created a "completely new fanciful term SYMBIOBOND." (Brief, p.7).

We are in total agreement with applicant. The marks SYMBIOBOND and BIOBOND differ not only in appearance and sound, but also convey distinctly different connotations. While the Examining Attorney argues that there is no definition for the prefix "symbio" in the dictionary, there are definitions for the terms "symbiosis" and "symbiotic."⁷ We believe that the relevant purchasers here, namely those in the dental profession, would recognize the differences in connotation between the scientifically-oriented terms

⁷ We take judicial notice of the definitions of "symbiosis" as "the living together of two dissimilar organisms" or as "any interdependent or mutually beneficial relationship between two persons, groups, etc." The prefix "bio," on the other hand, is defined as "a combining form meaning 'life'." *The Random House Dictionary of the English Language* (2nd ed. 1987).

"bio" and "symbio." Thus, while the marks as a whole may have no precise meanings, because of the recognizable differences in the prefixes they would be evocative of distinctly different commercial impressions. Contrary to the position taken by the Examining Attorney, we do not think potential purchasers would view the mark SYMBIOBOND as consisting of the combination of SYM- with BIOBOND or as having the connotation "with BIOBOND." Instead we believe the reasonable interpretation of applicant's mark would be as the combination of the term SYMBIO- with the descriptive suffix BOND, resulting in a markedly different commercial impression from that resulting from the combination of the prefix BIO- with the same descriptive suffix.

The difference in commercial impression created by the marks becomes even more significant when we consider the relevant purchasers and the conditions under which the dental alloys would be sold. Applicant argues that the goods would be sold to knowledgeable professionals after careful consideration of the products, making confusion less likely. We agree that the degree of sophistication of the potential purchasers and the nature of the present dental goods would result in a more careful perusal of the goods and respective marks than that involved in a typical purchase by an ordinary consumer. Even more significantly,

as stated above, we believe these scientifically-oriented purchasers would be even more apt to recognize the difference in connotation between SYMBIOBOND and BIOBOND and thus to readily distinguish between the two marks. Here, despite the Examining Attorney's arguments to the contrary, the knowledge of the purchasers in their particular field is highly relevant to their ability to distinguish between the two marks and directly aids in obviating confusion.

While applicant has also raised the matter of its ownership of other marks containing the prefix SYMBIO-, we find no need to reach any "family of marks" argument. Applicant contends that consumers are likely to recognize SYMBIO- dental goods as originating from applicant. We would simply note, however, that applicant has failed to support its contention with any evidence of promotion of its various SYMBIO- marks as a family of marks, or of recognition by relevant purchasers of the same. Furthermore, the issue here remains the likelihood of confusion of applicant's mark SYMBIOBOND vis-à-vis registrant's marks. See *In re Lar Mor International, Inc.*, 221 USPQ 180 (TTAB 1983).

All in all, considering the distinct differences in the commercial impressions created by the marks SYMBIOBOND

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and BIOBOND and the degree of sophistication of the relevant purchasers, we find confusion unlikely, despite the use of the respective marks on identical and closely related goods.

Decision: The refusal under Section 2(d) is reversed.