

U.S. Application No.: 87/045185  
Mark: **HYPERION**  
Class: 1  
Our Reference No.: 2132.1850000

The Examining Attorney has raised the following two issues that must be addressed before the application can be approved for publication: (1) potential likelihood of confusion with a prior-filed application; and (2) amendment to the identification and classification of goods. Applicant addresses the Examining Attorney's concerns, in turn, below.

### **There is no Likelihood of Confusion with the Cited Application**

The Examining Attorney has preliminarily cited the following pending application as a possible bar to registration:

Mark: **HYPERION**  
Serial No.: 86/367800  
Owner: Oxford Nanopore Technologies Limited

Goods in Classes 1, 5, 9, and 10, **including**, (generally), reagents for industrial use and for non-medical purposes in Class 1; reagents for veterinary or medical use, blood substitutes, and aqueous and non-aqueous solvents for medical or veterinary use in Class 5; automated instruments for detecting the presence, properties and identity of analytes, comprising cartridges, microarrays, silicon chip based arrays, ASICs (application specific integrated circuits), and networked computer hardware and software for performing and controlling the analysis, and for processing, displaying and storing the information obtained from the analysis for scientific or research purposes and prerecorded software for performing and controlling analysis for scientific and research purposes, laboratory equipment, batteries, and nanopore sensing devices for scientific or research purposes in Class 9; blood testing apparatus, diagnostic apparatus for medical or veterinary purposes, and portable diagnostic apparatus for medical or veterinary purposes in Class 10;

and

Services in Class 42, **including**, consultation, research and design services relating to automated systems and instruments for direct electrical detection and analysis of molecules for use in the field of genomics, protein analysis, molecular analysis, life sciences, food science, agriculture, environmental monitoring, healthcare, security and defense.

- A. **The term HYPERION is weak for medical/biotech goods and services and should not be entitled a scope of protection sufficient to preclude registration of the cited mark.**

A predominant factor in a likelihood of confusion analysis is whether the "senior" mark[s] falls within a category of weak marks. *Basic Vegetable Prod., Inc. v. General Foods Corp.*, 165 USPQ 781 (TTAB 1970). Where a mark is weak, the scope of protection is limited to

"substantially identical designations" used for "substantially similar goods" or services. *Id.* In this case, the goods and services in the prior cited mark are sufficiently dissimilar from those in the applied-for mark as to avoid a likelihood of confusion.

Both Applicant's mark and the cited mark consist entirely of the term HYPERION. The term HYPERION has the following context-dependent definitions: (1) in Greek Mythology: a Titan, the son of Gaea and Uranus and the father of Helios; (2) in science: a satellite of Saturn. See attached definition from: <http://www.thefreedictionary.com/Hyperion>. Therefore, the term HYPERION is a laudatory term, highly suggestive of something beyond Earth, something powerful and/or majestic, and has often been used in the scientific, chemical, medical, and/or electronic fields. A broad search for HYPERION-formatted marks, which included identical or arguably closely related goods/services to the medical/biotech-related goods and services of the cited mark, resulted in approximately 100 records of registered, published for opposition, and/or pending marks, indicating the term HYPERION is weak as it relates to the medical/biotech fields. Weak marks, such as the cited prior-filed mark, are not entitled to a broad a scope of protection.

Applicant notes the following marks, as a representative sample of the numerous registered HYPERION and/or HYPERION-formative marks, registered for identical and/or closely related goods/services as those in the cited mark:

- Registration No. 5092247 for the mark **HYPERION**, owned by Avatar Corporation, for "active chemical ingredients used in the manufacture of pharmaceutical drug products for human and animal health" in Class 1; registered November 29, 2016;
- Registration No. 4153063 for the mark **HYPER+ION**, owned by Chemtrade Chemicals US, LLC, for "chemical coagulant and flocculant for water treatment in a wide variety of industries" in Class 1; registered June 5, 2012;
- Registration No. 4397520 for the mark **HYPERION**, owned by McLaughlin Gormley King Company, for "pesticides and insecticides" in Class 5; registered September 3, 2013; also owns Registration Nos. 4445095 and 4441438 for the marks HYPERION and Design and HYPERION ADVANCED MIST CONCENTRATE and Design, respectively;
- Registration No. 4257685 for the mark **HYPERION**, owned by Psychology Software Tools, Inc., for "projectors for presenting visual images in the MRI environment" in Class 9; registered December 11, 2012;

and

- Registration No. 4486842 for the mark **ASAHI HYPERION**, owned by Asahi Intecc Co., Ltd., for "medical guidewires, and structural parts therefor; IVR (interventional radiology) guidewires; PTCA (percutaneous transluminal coronary angioplasty) guidewires; medical spring guidewires; medical plastic clad guidewires" in Class 10; registered February 25, 2014.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re*

*Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984).

Weak marks are entitled to protection against registration of a highly similar mark only where the goods/services are closely related. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A. 1974). Applicant's goods differ from the goods/services in the cited prior-filed application in (at least) nature, use, and targeted consumers.

#### **B. The Goods and Services Differ Sufficiently to Avoid a Likelihood of Confusion**

A likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. See *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985). In this case, given the coexistence of numerous registered marks for identical/nearly identical marks on the PTO register, and presumably in the marketplace, consumers are accustomed to seeing HYPERION and HYPERION-formative marks in connection with chemical, scientific, medical, and electronic goods in the marketplace. Thus, the differences between the goods and/or services are the most relevant factors in determining a likelihood of confusion.

Applicant submits that the differences between the goods and services identified by even visually similar marks can be sufficient to overcome any potential confusion. See, e.g. *Havery Hubbell Inc. v. Tokyo Seimitsu Co.*, 188 USPQ, 517, 520 (TTAB 1975)(holding no likelihood of confusion existed between PULCOM and PULSECOM based on differences between the parties' electronic goods); *In re Jacques Bernier Inc.*, 1 USPQ2d 1924, 1925 (TTAB 1987)(finding no likelihood of confusion between INTERNATIONAL SPORTS CLUB for clothing and SPORTS CLUB for cologne). Applicant submits the nature of the goods, fields of use, channels of trade, and targeted consumers differ from those covered by the cited prior-filed application.

Applicant's goods are quantum dots --very small semiconductor particles that are only several nanometers in size -- that are used in consumer electronics.

In contrast, the cited application covers reagents for scientific sensing of biological molecules, the development of nanopore sequencing products -- including DNA nanosequencers for the direct electronic analysis of single molecules, and highly sophisticated and specialized medical devices purchased for use in scientific and medical labs – not consumer electronics. See attachment from applicant's website at: <https://nanoporetech.com/>.

As Applicant's goods/quantum dots are used in consumer electronics such as televisions and mobile phones, Applicant submits that the fields of use, the channels of trade, and targeted consumers for Applicant's quantum dots and the cited prior-filed goods/services do not overlap. Purchasers of quantum dots for use in manufacture of televisions or mobile phones are not typically seeking to purchase the goods/services covered by the cited prior-filed application.

Given the highly sophisticated and technical nature of the goods/services at issue, the targeted customers for the goods/services are likely to be sophisticated and professional purchasers who exercise a great degree of care when investigating and purchasing goods/services of the type

covered by these marks, reducing the potential for a likelihood of confusion. See *e.g.*, *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). It is well-settled that the sophistication or knowledge of purchasers and their care in purchasing may diminish the likelihood of confusion. TMEP §1207.01(d)(vii). Applicant submits that the differences between the goods/services at issue in their nature, fields of use, channels of trade, and targeted consumers, render confusion between the marks highly unlikely. Applicant further submits that the goods/services covered by the cited prior-filed mark are more similar to the goods/services covered by several of the above listed registered marks than they are to Applicant's.

#### **I. Amendment to Classification and Identification of Goods**

In response to the Examining Attorney's requirement, Applicant amends the classification and identification of goods as follows:

Quantum dots, namely, crystalline semiconductor material for use in consumer electronics in Class 9.

In view of the foregoing, Applicant respectfully requests that the anticipatory refusal based on a likelihood of confusion with the cited prior filed application be withdrawn and that this application be approved for publication.