

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Trademark Application:)	
)	
Serial No.: 88/010,868)	
)	
Applicant: White Rabbit e-Healthcare)	
Solutions, LLC)	Trademark Law Office: 106
)	Attorney: Cameron McBride
Trademark: BIO)	
)	
Filing Date: June 22, 2018)	
)	
Classes: 09, 35, 42)	
)	
Mailing Date: October 18, 2018)	

RESPONSE TO OFFICE ACTION

By Office Action dated October 18, 2018, the Examiner has provisionally refused registration of the Applicant’s mark, BIO (“Applicant’s Mark”), in Classes 9, 35, and 42, based on a purported likelihood of confusion with the marks BIO FIRE (U.S. Reg. No. 4973389) and BIO FIRE & Design (U.S. Reg. No. 4867360) (the “Cited Registrations”). The Examiner has also requested certain modifications to the description of goods and services for Applicant’s Mark. In response, the Applicant respectfully submits the following arguments.

I. Amendment of Goods and Services

In response to the Examiner’s concerns, Applicant submits the following amended description (additions bolded and italicized; deletions in strikethrough) which further clarifies Applicant’s goods and conforms to the Examiner’s suggested identification amendment:

Class 9:

Downloadable *software* application to access, query, and receive data ~~relevant to~~ *of* business activities and decisions in the fields of healthcare, life sciences, health diagnostics, pharmaceutical, medical technology, medical devices, and financial services

Class 35:


Business consulting, namely, providing research, case studies, information, data analytical tools, strategic evaluation, and recommendations to enterprises and professionals to support decision-making in the fields of healthcare, life sciences, health diagnostics, pharmaceutical, medical technology, medical devices, and financial services; conducting primary research through expert opinion polls

Class 42:

Providing temporary use of non-downloadable *computer* software for users to access, query, and receive data ~~relevant to~~ *of* business activities and decisions in the fields of healthcare, life sciences, health diagnostics, pharmaceutical, medical technology, medical devices, and financial services

II. Potential Conflict Under Section 2(d) of the Lanham Act

The Examiner has expressed concern regarding a potential conflict under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Applicant’s Mark and the following Cited Registrations:

Mark	Status and Date	Goods and Services	Owner
<p>BIO FIRE</p>	<p>USPTO Status: Registered Filing Date: August 9, 2012 App 85699230 Reg Date: June 7, 2016 Reg 4973389 First Used: September 2015 In Commerce: September 2016</p>	<p>INT. CL. 9 Laboratory devices, apparatus and instruments, namely, imaging devices comprising fluorimeters used to record fluorescence signals and produce data, thermal control elements for heating and cooling, light emitters such as lasers and</p>	<p>BIOFIRE DIAGNOSTICS, LLC 515 Colorow Drive, Salt Lake City, Utah 84108</p>
<p>BIO  FIRE</p>	<p>USPTO Status: Registered Filing Date: August 9, 2012 App 85699261 Reg Date: December 8, 2015 Reg 4867360 First Used: September 2015 In Commerce: September 2016</p>	<p>light bulbs, lenses, mirrors, stations for placement of microtiter plates, microtiter plate readers; Laboratory materials, articles and disposable, namely, optical filters, computer chips, thermal control elements for heating and cooling, sample containers, transformer connectors, batteries, battery chargers, testing sample pouches, testing sample pouch holders, syringes and plungers, carrying packs specially adapted for carrying all of the above-named goods, plastic or other sampling vials, plastic or other preparation vials; Computer software, computer programs and associated instruction manuals all for use in detecting, identifying, classifying, tagging, labeling, amplifying, testing, analyzing, determining sequence, evaluating,</p>	

		<p>monitoring, purifying, counting, mapping, engineering, expressing, measuring, preparing, testing, mixing, heating and cooling chemical, biochemical, biological, genetic, pathological and toxic agents, pathogens, bacteria, germs, viruses, diseases, contagions, materials and samples; Computer software, computer programs and computer firmware all for use in controlling processes, inputting, analyzing, modifying, transferring, displaying, reporting and storing data and results; Laptop computers, hard drives for computers and computer hardware; Probes for environmental purpose; Analytical instruments, namely, a laboratory instrument combining a rapid thermocycling apparatus and a fluorimeter; laboratory equipment, namely, units for the purification and amplification of nucleic acids and devices used to heat and cool biological samples; Bio-defense and bio-surveillance systems and instruments, and food and water security testing systems and instruments, namely, imaging devices comprising fluorimeters used to record fluorescence signals and produce data, thermal control elements for heating and cooling; Scientific apparatus and instruments for measuring DNA, RNA and protein and parts and fittings therefor.</p>
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As discussed below, Applicant respectfully submits that Applicant’s Mark is unlikely to be confused with the Cited Registrations.

III. Argument

A. Likelihood of Confusion Factors.

It is well-established that 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); *see also Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q. 2d 1460, 1464 (T.T.A.B. 1992) (“Section 2(d) of the Trademark Act is concerned about the likelihood of confusion, not some theoretical possibility built on a series of imagined horrors.”).

In determining whether there is a likelihood of confusion, courts assess many factors, including, as particularly relevant here:

1. The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. The dissimilarity between the goods and services offered by Applicant under the BIO Mark and those offered under the marked embodied in the Cited Registrations;
3. The dissimilarity of established, likely-to-continue trade channels;
4. The number and nature of similar marks in use on similar goods and services; and
5. The sophistication of Applicant and Registrant’s respective consumers.

E.I. du Pont de Nemours, 476 F.2d at 1361.

Applying these factors to the Cited Registrations, as set forth below, leads inevitably to the conclusion that confusion is not likely between Applicant’s Mark and the Cited Registrations.

B. Confusion is Unlikely Because the Marks Embodied in the Cited Registrations Are Dissimilar in Appearance, Connotation, and Commercial Impression from Applicant’s Mark.

Applicant’s Mark is not likely to be confused with the marks embodied in the Cited Registration, because, when viewed in their entireties, the marks are visually very distinct and convey entirely different commercial impressions. *See E.I. du Pont de Nemours*, 476 F.2d at 1361. “The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction.” TMEP §1207.01(c)(ii). One must review the respective marks

in their entireties and consider each mark's "cumulative effect." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (CCPA 1976). "It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981).

The Trademark Trial and Appeal Board (the "Board" or "TTAB") has stated unequivocally, that there is no rule confusion is automatically likely, simply because marks share common elements. See e.g., *Colgate-Palmolive Company v. Carter Wallace Inc.*, 167 USPQ 529, 530 (CCPA 1970) (PEAK PERIOD for personal deodorants not confusingly similar to PEAK for dentifrice); and *Lever Brothers Company v. The Barcolene Company*, 174 USPQ 392 (CCPA 1972) (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods). Similarity or even identity between two marks, without more, is not dispositive of the issue of likelihood of confusion. See e.g., *McGregor-Doniger, Inc. v. Drizzle Inc.*, 202 USPQ 81, 89 (2d Cir. 1979) (DRIZZLE for women's overcoats not likely to be confused with DRIZZLE for golf jackets despite the marks being identical in appearance); *Jacobs v. International Multifoods Corp.*, 212 USPQ 641 (CCPA 1982) (BOSTON SEA PARTY for restaurant services would not be confused with BOSTON TEA PARTY for food products despite apparent similarities in appearance.)

Even if marks are identical, the goods and/or services must also be sufficiently related and/or the circumstances surrounding their marketing are such that purchasers encountering them would mistakenly believe that they emanate from the same source for the likelihood of confusion to occur. See, e.g., *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ 2d 1917, 1930 (TTAB 2006); see also, *J. Thomas McCarthy, McCarthy on Trademarks & Unfair*

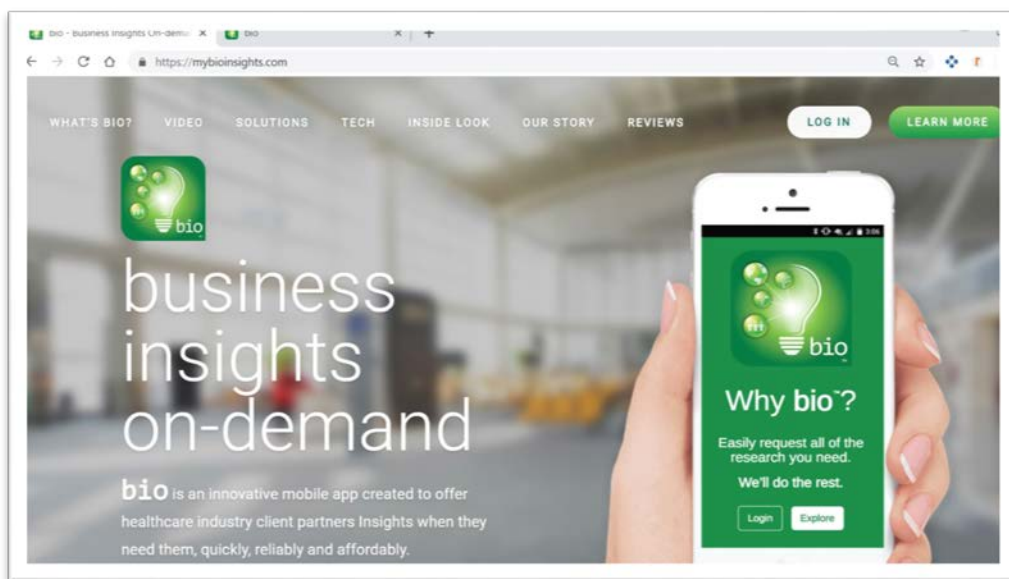
Competition § 24:24 (4th ed. 2010) (“[g]oods are ‘related’, not because they have any inherent common quality of the respective goods, but ‘related’ in the sense that buyers are likely to believe that such goods, similarly marked, come from the same source or are somehow connected with or sponsored by a common company.”) (*Emphasis in original.*)

Thus, when the goods/services covered by allegedly conflicting marks are sufficiently different and sold to different classes of consumers through different channels of trade, no source confusion is likely, even in case where the marks are identical. See, *Triumph Machinery Co. v. Kenimaster Mfg. Co., Inc.*, 1 USPQ 2d 1826, 1829 (TTAB 1987) (no likelihood of confusion between HYDRO-CLIPPER for power-operated de-horning shear and HYDRO-CLIPPER for a power mower attachment); *In re Albert Trostel & Sons Co.*, 29 USPQ 2d 1783 (TTAB 1993) (finding no likelihood of confusion between PHOENIX for bulk leather sold to manufacturers of finished leather goods and PHOENIX for leather luggage sold to consumers due to differences in trade channels and purchasers); and *In re Shipp*, 4 USPQ 2d 1174 (TTAB 1987) (holding that confusion is not likely to occur between PURITAN for dry cleaning machine filters sold to professionals and PURITAN for dry cleaning services sold to the public).

The Examining Attorney has noted that “[h]ere, the first part of both registration’s wording is ‘BIO.’ This dominant portion is identical to the entirety of applicant’s mark. In essence, applicant has merely deleted the term ‘FIRE’ from both registered marks.”

Although Applicant’s Mark and the Cited Registrations both contain the term “bio,” the use of this term by Applicant (which uses it as an acronym) and owner of the Cited Registrations (which uses it as an abbreviation) have meaningfully different connotations in the context of the parties’ respective offerings, resulting in dissimilar commercial impressions.

Under its BIO mark, Applicant provides an array of business insight solutions leveraging state of the art technology to highly sophisticated enterprise clients across a range of industries. See <https://mybioinsights.com/>. Specifically, Applicant leverages “state-of-the-art information technology to deliver an affordable, true on-demand service for healthcare executives who require frequent updates on market conditions, competitive dynamics, and relevant Insights.” *Id.* Applicant’s product offerings include a mobile application as well as an online portal for tracking business insight requests and responses. See <https://app.mybioinsights.com/#/?k=m1mh4p>. As noted prominently on Applicant’s website, reproduced below, and as noted by Applicant via a statement in its initial application, the letters “B,” “I,” and “O” stand for “business insights on demand.”



Applicant’s Mark therefore clearly suggests Applicant’s exclusive focus on providing its clients with fast, reliable, actionable, high quality, and affordable insights to support their business needs and decision-making.

In direct contrast to the connotation and commercial impression created by Applicant’s Mark, the BIO FIRE mark in the Cited Registrations is used by Biofire Diagnostics, LLC, which

is located in Salt Lake City, Utah, and is focused on “syndromic infectious disease diagnostics.” See <https://www.biofire.com/>. In this context, it is clear that the “bio” component of Registrant’s mark is intended to index and suggest to consumers both: (a) the nature of Registrant’s core business activities – *i.e.*, molecular diagnostics through syndromic infectious disease testing and tests for viruses, bacteria, parasites, yeast, and antimicrobial resistance genes; and (b) the relationship between Registrant and its parent company, BioMérieux, a multinational biotechnology company. See <https://www.biomerieux.com/>. When appropriately viewed in the context of Registrant’s overall business offerings (molecular diagnostics), it is clear that “bio” has a literal meaning of biology or biotechnology.

Setting aside the marked differences in connotation and commercial impression between Applicant’s Mark and the marks embodied in the Cited Registrations, the marks are also visually and aurally distinguishable by virtue of Registrant’s addition of the distinctive term FIRE as well as a prominent central helix design element, respectively.

C. The Offerings of Applicant and the Registrant are Entirely Different.

Even if the goods offered under the marks embodied in the Cited Registration were related to Applicant’s goods and services, merely falling within a common category or industry has been held insufficient to find a likelihood of confusion. See *W.W.W. Pharm. Co. Inc. v. The Gillette Co.*, 25 U.S.P.Q.2d 1593, 1598 (2d Cir. 1993) (even though they may both be generally defined as personal care products, SPORTSTICK for lip balm and SPORT STICK for deodorants/antiperspirants do not compete nor serve the same purposes so they are not related or confusingly similar); *Checkpoint Sys. Inc. v. Check Point Software Tech. Inc.*, 60 U.S.P.Q.2d 1609, 1620 (3d Cir. 2001) (CHECKPOINT for physical security services and CHECK POINT for data security services fall into distinct sectors of a broad product category and are sufficiently unrelated such that confusion is unlikely); *M2 Software, Inc. v. Madacy Entm’t*, 76 U.S.P.Q.2d 1161, 1167

(9th Cir. 2005) (identical M2 marks both used for CDs and downloadable music are not confusingly similar where, *inter alia*, music genres are different); *Therma-Scan Inc. v. Thermoscan Inc.*, 63 U.S.P.Q.2d 1659, 1663 (6th Cir. 2002) (THERMA-SCAN for infrared medical imaging services and THERMOSCAN for electronic ear thermometers are not sufficiently related to cause confusion even though marks coexist in same broad industry).

The Board has repeatedly held, including in a precedential decision, that differences in the function or purpose of goods can prevent a likelihood of confusion. *See Aries Sys. Corp. v. World Book, Inc.*, 26 U.S.P.Q. 2d 1926, 1932 (T.T.A.B. 1993) (finding KNOWLEDGE FINDER and INFORMATION FINDER not confusingly similar because, *inter alia*, “[s]uch products, rather than being... simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.”); *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 U.S.P.Q. 2d 1825, 1840 (T.T.A.B. 2013) (precedential) (finding no confusion between RSTUDIO and ER/STUDIO where “the respective software products possess very different functions and purposes”); *PerkinElmer Health Science., Inc. v. Atlas Database Software Corp.*, 2011 TTAB LEXIS 405, at *39 (T.T.A.B. Dec. 22, 2011) (“The mere fact that the parties’ goods fall under the broad category of software for use in laboratories is not a sufficient basis upon which to find that they are related for purposes of likelihood of confusion... The goods perform different functions and are used for different purposes.”).

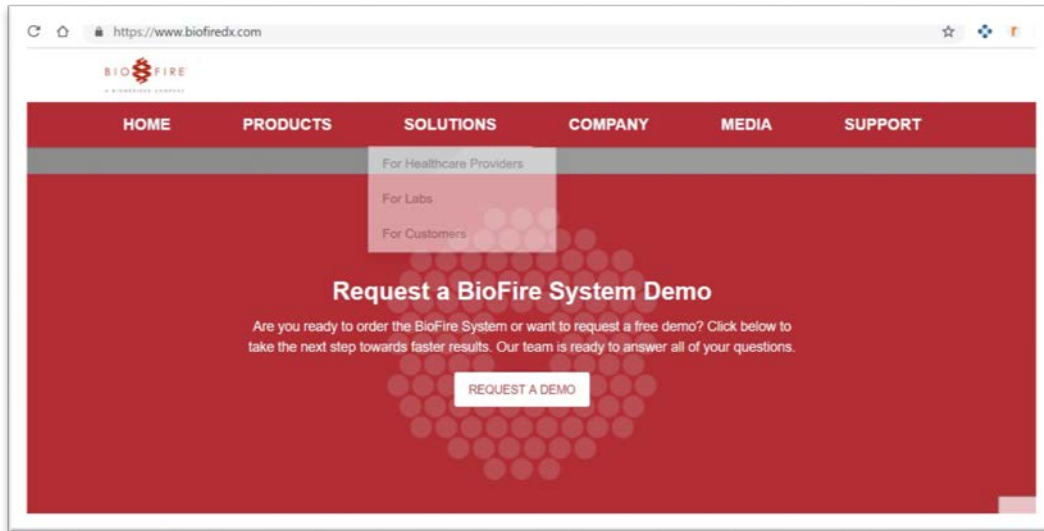
The Examining Attorney has indicated that “the registrations use broad wording to describe ‘Computer software, computer programs and computer firmware all for use in controlling processes, inputting, analyzing, modifying, transferring, displaying, reporting and storing data and results’, which presumably encompasses all goods and services of the type described, including

applicant's more narrow software goods and related services for 'access, query, and receive data relevant to business activities and decisions in the fields of healthcare, life sciences, health diagnostics, pharmaceutical, medical technology, medical devices, and financial services' in International Classes 9 and 42."

As courts have determined, however, goods falling into distinct sectors of a broad category, particularly such as computer software, can nevertheless be sufficiently unrelated such that confusion is unlikely. This is particularly true where the goods do not compete or serve the same purpose.

Although the Examining Attorney contends that because "business consulting companies also offer[] software for data" that "establishes that the same entity commonly manufactures and provides the relevant goods and services and markets the goods and services under the same mark," it is clear that Applicant offers nothing in the way of medical diagnostic software, as its Class 9 and Class 42 descriptions make clear.

The Registrant offers sophisticated devices that integrate sample preparation, amplification, detection, and analysis (<https://www.biofiredx.com/products/filmarray/>), pathogen test panels (<https://www.biofiredx.com/products/the-filmarray-panels/>), and scientific research on its core focus areas (<https://www.biofiredx.com/research/>). Further, in order to take advantage of Registrant's various offerings, consumers are required to contact Registrant directly to receive a quote or demo, adding an additional hurdle that makes likelihood of confusion between the parties' offerings virtually *de minimis*.



Applicant’s goods and services serve a radically different function and purpose. As noted above, Applicant works one-on-one with its customers to deliver tailored insights on-demand, from industry experts, to meet pressing business needs. Such offerings are unmistakably different from the diagnostic goods provided by Registrant under its BIO FIRE Mark, notwithstanding that the “software goods and related services” in Applicant’s description are “more narrow” than those of Registrant (emphasis added). Additionally, in order to obtain access to Applicant’s mobile application, customers must already have a relationship with Applicant and have executed a negotiated subscription.

The TTAB last July overturned a similar refusal by an examining attorney, finding that “[t]he terminology of the identification of goods, standing alone ... is an insufficient basis upon which to conclude that the goods are related.” *In re Critelli*, Serial No. 86445003, 10 TTABVUE 8 (T.T.A.B. July 24, 2017).

In *Critelli*, Applicant sought to register the mark LAVA GEAR (with “gear” disclaimed) in connection with “outdoor survival wear, namely, jackets and pants for extended periods of use outdoors in extreme cold weather” in Class 25. The examining attorney refused registration on

the ground that the mark was confusingly similar to LAVA ACCESSORIES (with “accessories” disclaimed), which was registered in connection with “scarfs; travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf” in Class 25. 10 TTABVUE 7. The examining attorney argued that the application’s broad wording could be presumed to encompass all goods of the type described, including those in Registrant’s “more narrow identification.” *Id.* Applicant argued that the goods do not compete, are not sold to the same customers nor purchased for the same or related purposes. The Board held that despite the examining attorney’s contention that outdoor survival wear could include travel clothing, “there [was] no evidence to support these contentions ... nor [was] there evidence that Applicant’s goods and Registrant’s goods are of a type which may emanate from a single source.” *Id.* at 8. Furthermore, where “there is insufficient evidence that Applicant’s goods are related to the goods identified in the cited registration, there is no presumption that these goods travel in common trade channels and are marketed to the same consumers.” *Id.* While extreme cold weather gear on the one hand and travel clothing on the other “may possibly be purchased by the same consumers at some point,” the examining attorney failed to produce evidence “to support a finding that the goods typically emanate from the same source.” *Id.*

Here, as in *Critelli*, the Examining Attorney has not produced evidence to suggest that BioFire Diagnostics’ infectious disease and pathogen medical diagnostic goods, including test panels and laboratory devices, and Applicant’s customer-tailored business insight offerings are the types of goods or services that typically emanate from a single source. The mere fact that Applicant’s software-related descriptions may be *presumed* to overlap with those of the Cited Registrations is an insufficient basis upon which to conclude that the Applicant and Registrant’s goods or services are related.

Given these notable differences, it is highly unlikely that any reasonable consumer, and particularly the sophisticated enterprise healthcare consumers to which Applicant markets and sells its offerings, would perceive a relationship between the Applicant and the owner of the Cited Registrations. To conclude otherwise would run counter to commercial realities and unreasonably expand the potential for trademark conflict.

D. Consumers Would Never Encounter the Goods Sold Under Applicant’s Mark in Commercial Proximity to the Cited Registration.

“If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” T.M.E.P. § 1207.01(a)(i).

There is no reason to believe that consumers would ever have the opportunity to confuse Applicant’s Mark with the marks embodied in the Cited Registrations because the marks would never be simultaneously encountered by consumers.

Specifically, BioFire Diagnostics is based in Salt Lake City, Utah, and appears to only sell and offer its products to customers via on-demand, one-on-one consultations. *See* <https://www.biofiredx.com/products/request-a-demo/>. Applicant, in contrast, offers its services directly through its own proprietary software application and platform, or through requests for further information that consumers can submit via its website. *See* <https://mybioinsights.com/>. As noted above, in order to obtain access to Applicant’s mobile application, customers must already have a relationship with Applicant and have executed a negotiated subscription. Applicant is not aware of physical or online retail space where its software would be available alongside those of BioFire Diagnostics.

Accordingly, the same consumers would never be given the opportunity to encounter Applicant's Mark and the BIO FIRE marks of the Cited Registrations and form the incorrect assumption that they originate from the same source.

E. Confusion is Unlikely Because the Cited Registration Is Peacefully Coexisting with Other Similar Marks.

The number and nature of similar marks in use on similar goods and services also militates against a finding of likelihood of confusion. *See In re E I DuPont De Nemours & Co.*, 476 F.2d at 1361; *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565–66 (T.T.A.B. 1996) (evidence showed that third-party use of the term BROADWAY was so common that consumers would look to the other elements of applicant's mark BROADWAY CHICKEN and thereby would distinguish the source of the goods from BROADWAY PIZZA and BROADWAY BAR & PIZZA). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." TMEP §12.07(d)(iii) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005)).

"[I]n a 'crowded' field of similar, look-alike marks, each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd." J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition § 11:85 (4th ed.) "Simply put, 'a mark which is hemmed in on all sides by similar marks on similar goods . . . is merely one of a crowd of marks . . . [and] customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.'" *Miss World (UK) Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (citing MCCARTHY § 11:85).

The Cited Registrations for BIO FIRE are at least as similar to numerous third party filings as it is to Applicant's Mark. A search of the USPTO database indicates that in Class 9 alone,

which is the only Class covered by the Cited Registrations, there are currently 390 live, one or two word trademark filings that *begin* with the term “bio” and which include the term “software” in the description.

If the Cited Registrations can peacefully coexist with these 390 other marks in connection with broadly related software offerings, including where the commercial impression or underlying meaning of “bio” is more likely to reference “biology” or “biotechnology” and therefore be similar to that of Registrant’s marks, it can certainly coexist with Applicant’s Mark.

Given the coexistence of these BIO-formative marks for software, it is apparent that consumers are accustomed to differentiating between multiple unrelated third party marks that bear some visual or aural resemblance to Applicant’s Mark and the Cited Registrations. This factor, too, weighs against consumers confusing Applicant’s Mark with the Cited Registrations.

F. Applicant’s Offerings are Marketed and Sold to Sophisticated Consumers.

Additionally, the channels of trade and sophistication of consumers for Applicant’s offerings mitigate any likelihood of confusion with either Cited Registrations. As described above, Applicant’s goods and services are individually tailored and typically offered to customers in the healthcare field, and access to Applicant’s offerings requires a negotiated contract between Applicant and its customers.

Given the highly specialized nature of Applicant’s goods and services, more care is likely to be taken at the point of purchase and buyers are less likely to be confused as to source or affiliation. In particular, customers for Applicant’s offering will no doubt engage in careful research and discussion before obtaining the offering, since (1) Applicant’s business insights solutions provide a critical and sophisticated purpose that obviously necessitates an exchange of substantial information and development of trust and confidence in Applicant’s ability to deliver high quality goods and services; and (2) Applicant’s products necessitate a significant investment

of time and attention by the customer and engagement by the consumer directly with Applicant. *See, e.g., Deere & Co. v. MTD Holdings, Inc.*, 70 U.S.P.Q.2d 1009, 1023 (S.D.N.Y. 2004) (finding that consumer interaction with sales personnel when purchasing equipment helps dispel confusion and heighten consumer care); *Beneficial Corp. v. Beneficial Capital Corp.*, 529, F. Supp. 445, 450 (S.D.N.Y. 1982) (finding increased consumer sophistication because of complexity of purchasing transaction).

In addition to the factors noted above, the fact that Applicant's offerings are often individually tailored and result in protracted interactions between Applicant, its customers, and its strategic partners also weighs against likely confusion. *See Black & Decker, Inc. v. N. Am. Philips Corp.*, 632 F. Supp. 185, 193 (D. Conn. 1986) (finding that consumers of an infrequently purchased item are sophisticated in that such a "product is not the kind of ... item that one purchases frequently, but rather is an item that the purchaser expects will last for a lengthy duration and therefore would require care in its purchase.").

By contrast, Registrant offers its goods to sophisticated clinicians and laboratories with molecular diagnostic needs. In addition, as discussed above, Registrant's website indicates that consumers must contact it direct to receive demonstrations or quotes. Consumers interacting with this Registrant to obtain its highly specialized medical offerings for a protracted period are highly unlikely to be confused between Applicant's offerings and those under the BIO FIRE marks in the Cited Registrations.

Applicant and Registrant's consumers in the healthcare and medical fields fall squarely within the category of "informed, deliberative buyers" who are unlikely to be confused. *See Oreck Corp. v. U.S. Floor Systems, Inc.*, 803 F.2d 166, 173 (5th Cir. 1986); *Pfizer Inc. v. Astra Pharmaceutical Products Inc.*, 858 F.Supp. 1305, 33 USPQ2d 1545, 1562 (S.D.N.Y. 1994) ("[t]he

consumers here are doctors, as sophisticated a group as one could imagine”); *Warner-Hudnut, Inc. v. Wander Co.*, 280 F.2d 435, 126 USPQ 411, 412 (C.C.P.A. 1960) (stating physicians constitute “a highly intelligent and discriminating public”). *See also* 3 McCarthy On Trademarks And Unfair Competition, § 23:101 (4th ed. 2010) (“Where the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers. Many cases state that where the relevant buyer class is composed of [such] buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar”). The relevant consumer bases here are “extremely sophisticated buyers [and] the likelihood of consumer confusion cannot be presumed on the basis of the similarity in trade name alone.” *Perini Corp. v. Perini Construction, Inc.*, 915 F.2d 121, 128 (4th Cir. 1990). Applicant’s consumers and partners, in particular, include many highly trained professionals, casting “considerable doubt” on the assumption they would be confused “simply on the basis of a similar name.” *Id.* at 127-128; *see also Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 467 (4th Cir. 1996) (holding that the “relative sophistication of the market may trump the presence or absence of any other factor”).

For all of these reasons, confusion is unlikely with either of the Cited Registrations.

G. Summary of the Factors.

Applicant respectfully submits that the factors set forth above, namely the meaningful differences in the marks in terms of visual appearance, aural pronunciation, connotation, and commercial impression, the dissimilarity between the parties’ respective offerings and channels of trade, the coexistence of the Cited Registrations and other similar BIO-formative third party marks, and the sophistication of and care exercised by the parties’ respective consumers, all compel the conclusion that Applicant’s Mark is not likely to be confused with the Cited Registrations.

IV. Conclusion

Applicant submits that the instant application is now in condition for a prompt publication and such favorable action is therefore respectfully requested.

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