

This is in response to the Office Action issued November 5, 2018 related to U.S. App. No. 88153003 for the mark **IMPACT** (“Applicant’s Mark”) for the following amended services in Class 41 (“Applicant’s Services”):

Arranging, conducting and organisation of educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops relating to pharmaceutical and veterinary preparations and substances; arranging, conducting and organisation of educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops relating to pharmaceutical and veterinary preparations and substances for training purposes; training services relating to pharmaceutical and veterinary preparations and substances; provision of interactive online training services in the field of pharmaceutical and veterinary preparations and substances; provision of educational services, namely, classes, seminars, workshops in the fields of pharmaceutical and veterinary preparations and substances; distribution of course materials relating to pharmaceutical and veterinary preparations and substances in connection with educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops in the fields of pharmaceutical and veterinary preparations and substances; provision of online information relating to educational services in the fields of pharmaceutical and veterinary preparations and substances via an online web site; information, advisory and consultancy services in relation to all of the aforesaid services

The Examining Attorney has issued a Section 2(d) Likelihood of Confusion refusal, and a potential likelihood of confusion refusal, related to the following marks (collectively, the “Cited Marks”).

- U.S. Reg. No. 4121537 for the mark **PROJECT IMPACT** owned by American Pharmacists Association Foundation for “medical research and testing in the field of pharmacy sciences, namely, conducting medical research and testing for developing community-based patient care models for various diseases; providing health information in the field of pharmacy science, namely, providing information for community-based patient care models for various diseases” in Class 42;
- U.S. Reg. No. 4862168 for the mark **MSK-IMPACT** owned by Memorial Sloan-Kettering Cancer Center for “Educational services, namely, conducting seminars, workshops and conferences in the field of molecular pathology, tumor biology and cancer care” in Class 41, “Compiling medical data for research purposes in the field of gene mutations in rare and common cancers for evaluating and assessing tumor biology, prognosis and treatment and patient drug responses” in Class 42, and “Cancer health care management utilizing targeted tumor sequencing tests to detect gene mutations and aberrations in rare and common cancers to foster development of individualized treatment options for patients” in Class 44;
- U.S. Reg. No. 4430771 for the mark **MPACT & Design** (shown below) owned by Celgene Corporation for “medical and scientific research, namely, conducting clinical trials for others; providing medical and scientific research information in the field of pharmaceuticals and clinical trials” in Class 42; and



- U.S. App. No. 87687905 for the mark **IMPACT EDUCATION LLC & Design** (shown below) owned by Impact Education, LLC for “education services, namely, continuing medical education (CME) courses, continuing education units (CEU) courses, continuing education (CE) courses, continuing nursing education (CNE) courses, and continuing pharmacy education (CPE) courses, for physicians, nurses, nurse practitioners, pharmacists, professional performance medical directors, pharmacy directors, quality directors, clinical pharmacists, health-system pharmacists, specialty pharmacists, case managers, home infusion providers, policy administrators, utilization managers, Health Information Technology

professionals, C-suite executives, health plan personnel, Health Maintenance Organization personnel, health systems personnel, Integrated Delivery Network personnel, Accountable Care Organization personnel, managed care organizations personnel, employers, employer brokers personnel, employer coalitions personnel, Pharmacy Benefit Managers, specialty pharmacy providers personnel, employers, employer brokers personnel, employer coalitions personnel, Pharmacy Benefit Managers, specialty pharmacy providers personnel, patient advocacy organization personnel, and payer organization personnel, in the field of educational courses for improving knowledge- and skill-based medical education courses for managed care and payer professionals” in Class 41.



Applicant respectfully disagrees with the refusal for the reasons set forth below, and requests that the refusal be withdrawn.

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARKS

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.*, 476 F.2d 1357, 1361, 177 U.S.P.Q.563, 567 (C.C.P.A. 1973). Trademark Act Section 2(d) requires that confusion, mistake, or deception be “likely, not merely possible.” *Sears, Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161 (5th Cir. 1957), *cert. denied*, 355 U.S. 894 (1957). Whether confusion, mistake, or deception are likely is determined by the standard set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q.563 (C.C.P.A. 1973).

The following analysis of the most relevant *DuPont* factors establishes why there is no likelihood of confusion, mistake, or deception between Applicant’s Mark and the Cited Marks.

1. Strength Of The Mark/The Number And Nature Of Similar Marks For Similar Services

When determining the strength of a particular mark, one looks at the extent of use of the components of the mark. “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.” *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442 (8th Cir. 1987). In fact, in some cases confusion can be prevented by merely using a junior user’s mark in a different type style and format. If a word mark is relatively weak, a significantly different display of the same word can avoid a likelihood of confusion. *First Sav. Bank, F.S.B. v. First Bank System, Inc.*, 101 F.3d 645, 40 U.S.P.Q.2d 1865 (10th Cir. 1996). When determining the strength of a particular mark, one looks at how widely used are the components of the mark.

The Cited Marks should be afforded a sufficiently narrow scope of protection that Applicant’s Mark can coexist, because other marks comprised of or featuring the word IMPACT (or similar) coexist in the relevant fields. TMEP § 1207.01(d)(iii) states in part:

. . . Evidence of third-party use falls under the sixth du Pont factor - the “number and nature of similar marks in use on similar goods.” In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

In addition, TMEP § 1207.01(d)(iii) states in part:

. . . Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983) ...

As an initial matter, Applicant notes that the Cited Marks PROJECT IMPACT, MPACT & Design, and MSK-IMPACT coexist in Class 42 (notably, PROJECT IMPACT and MPACT & Design do not cover Class 41 services). Similarly, MSK-IMPACT and IMPACT EDUCATION LLC & Design coexist in Class 41.

There are over 200 registered marks in Class 41 (where Applicant’s educational services are classified) that cover some form of healthcare-, medical-, and/or pharmaceutical-related educational service, or similar service. A representative sampling is shown in Table 1 below. Further, in Class 42 (where three of the four Cited Marks coexist) over 20 registered marks coexist that cover medical or scientific research. A representative sampling is shown in Table 2 below.

If the Cited Marks and the marks listed in the tables below and in the attached TESS records can co-exist this means that the Cited Marks are not entitled to a broad scope of protection in the relevant space. As a result, Applicant’s Mark should be able to coexist with the Cited Marks as well.

Table 1: Examples of IMPACT (and similar) marks in Class 41 for medical, healthcare, pharmaceutical, etc. related services

Reg. No./App. No.	Mark	Relevant Goods/Services
4862168	MSK-IMPACT (Cited Mark)	Class 41: educational services, namely, conducting seminars, workshops and conferences in the field of molecular pathology, tumor biology and cancer care Class 42: Compiling medical data for research purposes in the field of gene mutations in rare and common cancers for evaluating and assessing tumor biology, prognosis and treatment and patient drug responses

Reg. No./App. No.	Mark	Relevant Goods/Services
		Class 44: Cancer health care management utilizing targeted tumor sequencing tests to detect gene mutations and aberrations in rare and common cancers to foster development of individualized treatment options for patients
87687905 (approved)	IMPACT EDUCATION LLC & Design (Cited Mark)	Class 41: education services, namely, continuing medical education (CME) courses, continuing education units (CEU) courses, continuing education (CE) courses, continuing nursing education (CNE) courses, and continuing pharmacy education (CPE) courses, for physicians, nurses, nurse practitioners, pharmacists , professional performance medical directors, pharmacy directors, quality directors, clinical pharmacists , health-system pharmacists , specialty pharmacists , case managers, home infusion providers, policy administrators, utilization managers, Health Information Technology professionals, C-suite executives, health plan personnel, Health Maintenance Organization personnel, health systems personnel, Integrated Delivery Network personnel, Accountable Care Organization personnel, managed care organizations personnel, employers, employer brokers personnel, employer coalitions personnel, Pharmacy Benefit Managers, specialty pharmacy providers personnel, employers, employer brokers personnel, employer coalitions personnel, Pharmacy Benefit Managers, specialty pharmacy providers personnel, patient advocacy organization personnel, and payer organization personnel, in the field of educational courses for improving knowledge- and skill-based medical education courses for managed care and payer professionals
5668987	IMPACT MELANOMA	Class 41: Educational services, namely, conducting classes, workshops, seminars, conferences, and symposiums, and providing motivational and educational speakers in the fields of cancer , skin cancer , and skin cancer education, prevention, early detection, diagnosis, and treatment; providing a website featuring a blog in the field of cancer and skin cancer Class 44: Providing a web site featuring information in the field of cancer and skin cancer
5200962	IMPACT	Class 41: Charitable services, namely, mentoring of cancer patients in the field of clinical trials.; Charitable services, namely, providing educational materials in the nature of clinical trials availability and admission criteria to cancer patients.; Educational services, namely, conducting community outreach in the field of cancer treatment clinical trials and early detection of cancer .; Educational services, namely, providing data management, biostatistical and epidemiologic analysis in the fields of cancer treatment clinical trials.; Development and dissemination of printed educational materials of others in the field of cancer treatment clinical trials and early detection of cancer .; Providing educational assessment services; Providing science educational mentoring services and programs
5021074	IMPACTU	Class 41: raining and coaching in the field of children's health and well-being, provided by community health and education partners for continuous improvement
4797962	IMPACT	Class 41: Training in patient-centered, evidence-based community health worker-centered healthcare
4587627	IMPACT PRACTICE	Class 41: Training services in the field of interprofessional health care skills, ethics and leadership, for health care professionals; Educational services, namely, providing training for health care professionals in the field of interprofessional collaboration and communication
2788744	IMPACT MALARIA	Class 41: Organization of seminars, working groups, study groups and congresses, in the medical field Class 42: Providing medical research assistance to medical researchers
1948460	IMPACT HEALTH	Class 41: educational services, namely conducting classes, workshops and seminars on the subject of personal health and wellness and the distribution of materials in connection therewith
5481908	IMPACT THEORY	Class 41: Entertainment and education services, namely, the provision of continuing programs in the field of wellness, personal empowerment, career advice, health issues, nutritional issues delivered by television, cable, satellite and the internet; providing seminars, lectures, and workshops all in the fields of self-awareness, personal empowerment issues, and career advice; providing online non-downloadable articles featuring personal empowerment, career advice, health issues, and nutritional issues
5219362	IMPACT IMPROVING PATIENT ACCESS TO CLINICAL TRIALS	Class 41: Charitable services, namely, mentoring of cancer patients in the field of clinical trials; Charitable services, namely, providing educational materials in the nature of websites, brochures, handouts, and advertising regarding clinical trials availability and admission criteria to cancer patients; Development and dissemination of printed educational materials of others in the field of cancer treatment, clinical trials, and early detection of cancer ; Educational services, namely, conducting community outreach in the form of one-on-one counseling, workshops, and events for cancer patients in the fields of cancer treatment, clinical trials, and early detection of cancer ; Educational services, namely, seminars and online programs providing data

Reg. No./App. No.	Mark	Relevant Goods/Services
		about cancer treatment and clinical trials and distribution of educational materials in connection therewith; Providing educational assessment services; Providing science educational mentoring services and programs
4658466	IMPACT JOURNALS	Class 41: Publication of journals in the fields of medicine, cancer research and aging research; Publication of texts, books, journals in the fields of medicine, cancer research and aging research; Publishing of journals, books and handbooks in the fields of medicine, cancer research and aging research
3686972	NCBIOIMPACT	Class 41: Education services, namely, providing degree programs, continuing education, short courses, and customized training for companies, all in the fields of biotechnology, bioprocessing, pharmaceutical , chemical, and life science industries, and in the supporting fields of science, engineering, and technology
3686977	NCBIOIMPACT INDUSTRY-DRIVEN TRAINING AND EDUCATION	Class 41: education services, namely, providing degree programs, continuing education, short courses, and customized training for companies, all in the fields of biotechnology, bioprocessing, pharmaceutical , chemical, and life science industries, and in the supporting fields of science, engineering, and technology
88034983 (allowed)	MPACT ONE & Design	Class 41: Non-downloadable electronic publications in the nature of magazines in the field of culture, social matters, health and wellness, current events relating to local communities, finance and politics

TESS records of the aforementioned registrations are attached as **Ex. A**.

Table 2: Examples of IMPACT (and similar) marks used in Class 42:

Reg. No./App. No.	Mark	Relevant Goods/Services
4121537	PROJECT IMPACT (Cited Mark)	Class 42: medical research and testing in the field of pharmacy sciences, namely, conducting medical research and testing for developing community-based patient care models for various diseases; providing health information in the field of pharmacy science, namely, providing information for community-based patient care models for various diseases
4430771	MPACT & Design (Cited Mark)	Class 42: medical and scientific research, namely, conducting clinical trials for others; providing medical and scientific research information in the field of pharmaceuticals and clinical trials
87469594 (pending, no 2d refusals)	IMPACT ISOLATION TECHNOLOGY	Class 42: Medical and scientific research in the field of cancer treatment and diagnosis
4791316	APPIMPACT	Class 42: Testing, analysis, and evaluation of healthcare technologies for the purpose of certification and re-certification
3618098	IMPACT BIODYNAMICS RESEARCH AND CONSULTING GROUP OF LOUISIANA & Design	Class 42: Compiling data for research purposes in the field of medical science and medical consultancy.
3738378	IMPACTINDEX	Class 42: Application service provider (ASP) featuring software for measuring the impact of certain medical practices and solutions on cost and patient satisfaction for use in scientific research and comparative evaluation in the field of health care.
3741328	IMPACTCALCULATOR	Class 42: Application service provider (ASP) featuring software which provides theoretical scenarios of the impact of certain medical practices and solutions on cost and on patient satisfaction and safety for use in scientific research and comparative evaluation in the field of health care
2975739	IMPACT OF CHANGE	Class 42: Research services for others in the field of health care in the nature of identifying and analyzing the changing technology and business of health care; development of databases and computer services via the internet for health care systems, providers, payers, suppliers, consultants and medical equipment manufacturers
4118234	IMPACT ANALYTICAL	Class 42: Design, engineering, research , development and testing services in the field of polymeric materials, polymer synthesis, and materials customization for medical , scientific, and technological applications
4660049	INNOVATIONS WITH IMPACT	Class 42: Scientific research ; product development; scientific research , product development, and process development services for others in the fields of chemistry, pharmaceuticals , advanced composites, high-performance resins, wind power, automotive, and oil and gas; research in the field of chemical catalysts; technology consultation and research in the

Reg. No./App. No.	Mark	Relevant Goods/Services
		field of chemical manufacturing and resin and plastics processing

TESS records of the aforementioned registrations are attached as **Ex. B**.

Based on these co-existing marks in Tables 1 and 2 alone it would appear that the Cited Marks are sufficiently weak in Classes 41 and 42 that there is room on the register for Applicant’s Mark. In particular, this demonstrates that consumers are accustomed to seeing marks featuring the term IMPACT (or similar) used with healthcare-, medical-, and/or pharmaceutical-related educational services, as well as medical or scientific research services, and that the USPTO acknowledges, accepts, and allows these marks to coexist on the Principal Register.

The ultimate test of relative strength is the distinctiveness of a mark in the mind and perception of the relevant customer group. But a mark that is hemmed in on all sides by similar marks on similar goods **cannot be very “distinctive.”** It is merely one of a crowd of marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. *McCarthy on Trademarks and Unfair Competition*, 4th ed. §11:85.

Clearly, with the other marks that are comprised of or feature the term IMPACT (or similar) that coexist in the same fields as one another on the register, including the Cited Marks, Applicant’s Mark should be able to coexist, especially considering the overall differences between Applicant’s Services and those covered by the Cited Marks. Because Applicant’s Mark and the Cited Marks are distinguishable, confusion is unlikely.

2. Dissimilarity Of The Marks In Their Entireties As To Appearance, Sound, Connotation And Commercial Impression

Further, the fact that marks share common elements *does not* automatically lead to a finding of a likelihood of confusion. *Source Services Corp. v. Chicagoland JobSource, Inc.*, 1 U.S.P.Q.2d 1048 (N.D. Ill. 1986). “When considering the similarities of the marks ‘[a]ll relevant factors pertaining to the appearance and connotation must be considered.’” TMEP § 1207.01(b). *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000). The mere similarity or even identity between the two marks can never alone be decisive of likelihood of confusion. *McGregor-Donniger, Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81, 89 (2nd Cir. 1979). Thus, in holding the mark “DRIZZLE” for women’s overcoats was not likely to cause confusion with “DRIZZLER” for golf jackets, the Court of Appeals for the Second Circuit stated:

First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. “Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.” Callman § 82.1(a), at 601-02 (footnote omitted). For this reason cases involving the alteration, addition or elimination of only a single letter from the old mark to the new reach divergent results.

McGregor-Donniger, Inc. v. Drizzle, Inc., 202 U.S.P.Q. 81, 89 (2nd Cir. 1979), citing *E.I. DuPont de Nemours & Co. v. Yoshida Internat'l, Inc.*, supra, 393 F.Supp. at 511-12, 185 USPQ at 604-605.

In comparing the relevant factors in the present case, it is evident that when Applicant's Mark and the Cited Marks are viewed in their entireties and in connection with the other relevant likelihood of confusion factors, they are dissimilar in appearance, sensory impression, connotation, and commercial impression and not likely to result in confusion.

Any similarities between Applicant's Mark and the Cited Marks is greatly outweighed by the overall differences in the marks. In particular, Applicant's Mark is comprised of the singular term IMPACT. The cited mark MSK-IMPACT contains the additional, distinctive term MSK (which is an acronym for the owner Memorial Sloan-Kettering, see **Ex. C.**) that it is linked to the term IMPACT with a hyphen. As such, the term IMPACT in the cited mark MSK-IMPACT is not considered separable from the term MSK, and consumers would not refer to the mark as simply IMPACT.

Similarly, the cited mark PROJECT IMPACT contains the additional, distinctive wording PROJECT. Notably, the wording is found at the beginning of the mark. Such wording is often considered the dominant portion of a mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in a trademark. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). In other words, although the marks share the wording IMPACT, consumers are unlikely to focus on this fact, and instead, will first identify the dominant portion of this cited mark – PROJECT – use of which results in the cited mark PROJECT IMPACT conveying a highly different commercial impression when compared to Applicant's Mark.

Although the Examiner argues that the cited mark MPACT & Design and Applicant's Mark are phonetic equivalents and that similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar, the Examiner did not consider the marks as a whole when comparing the marks. In particular, Celgene used MPACT as an acronym for its "Metastatic Pancreatic Adenocarcinoma Clinical Trial" study. See **Ex. D.** Further, when presented with the mark MPACT & Design, it is notable that the mark does not feature the letter I at the beginning of the mark. As a result, consumers would pronounce the mark M-PACT, without inferring that the mark is pronounced as "impact." Additionally, this mark features a distinctive design element, as shown above.

Lastly, the IMPACT EDUCATION LLC & Design mark features the additional wording EDUCATION LLC, as well as a distinctive design element, as shown above.

The additional wording found in the cited marks MSK-IMPACT, PROJECT IMPACT, and IMPACT EDUCATION LLC & Design, as well as the distinctive design element found in the IMPACT EDUCATION LLC & Design mark and the overall appearance, meaning, and design

element found in the cited mark MPACT & Design, when compared to Applicant's Mark, transforms the commercial impression imparted by the marks, especially when considered in the context of the other likelihood of confusion factors. When taken as a whole Applicant's Mark and the Cited Marks are much different in terms of appearance, look, feel, meaning, and commercial impression.

3. Differences in the Services

Applicant's Services are distinguishable from the services offered under the Cited Marks. As indicated above, Applicant has amended its identification of goods as follows:

Class 41: Arranging, conducting and organisation of educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops relating to pharmaceutical and veterinary preparations and substances; arranging, conducting and organisation of educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops relating to pharmaceutical and veterinary preparations and substances for training purposes; training services relating to pharmaceutical and veterinary preparations and substances; provision of interactive online training services in the field of pharmaceutical and veterinary preparations and substances; provision of educational services, namely, classes, seminars, workshops in the fields of pharmaceutical and veterinary preparations and substances; distribution of course materials relating to pharmaceutical and veterinary preparations and substances in connection with educational conferences, congresses, conventions, lectures, seminars, symposiums and workshops in the fields of pharmaceutical and veterinary preparations and substances; provision of online information relating to educational services in the fields of pharmaceutical and veterinary preparations and substances via an online web site; information, advisory and consultancy services in relation to all of the aforesaid services

Applicant's services are all educational in nature, whereas the focus of the services covered by the Cited Marks is medical and scientific research. Specifically, as mentioned above, Celgene Corporation used its mark MPACT & Design in connection with a "Metastatic Pancreatic Adenocarcinoma Clinical Trial" study. The objective of the study/clinical trial was to "evaluate the efficacy of the combination of ABI-007 and gemcitabine versus gemcitabine alone in improving overall survival in patients with metastatic adenocarcinoma of the pancreas." See Ex. D. According to ClinicalTrials.gov, this study has been completed. See Ex. E. Celgene's mark only covers medical and scientific research in Class 42, and does not cover educational services.

Similarly, the PROJECT IMPACT mark owned by American Pharmacists Association Foundation also covers medical research and testing in Class 42, and does not cover educational services. American Pharmacists Association Foundation uses its PROJECT IMPACT mark in connection with a number of medical studies and research. Its website describes its PROJECT IMPACT mark/services as follows: "The Foundation has implemented its Project ImPACT process of care model to study its effect on chronic diseases such as Osteoporosis, Depression and Hypertension. ImPACT stands for Improving Persistence and Compliance with Therapy and the ImPACT care model encompasses a collaborative effort between the patient, caregiver, prescriber, and pharmacist to improve chronic disease control." Ex. F.

Memorial Sloan-Kettering uses its MSK-IMPACT mark in connection with a test available to its patients. According to its website, MSK-IMPACT "stands for integrated mutation profiling of actionable cancer targets. It is a targeted tumor-sequencing test available to MSK patients." Ex. G. There does not appear to be an educational component. In fact, the specimens filed as part of the application to support the Class 41 services, appear to use the MSK-IMPACT mark to

reference the subject matter of the educational services, as opposed to the source of the educational services. See **Ex. H**.

Lastly, Impact Education, LLC provides health care continuing education services for health care professionals, which is reflected by the listed services covered by the application.

The differences in the specific nature of the parties' respective goods and services are an important factor in the likelihood of confusion analysis, and must be given due consideration. In *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978), the Court held that RED ZINGER for herbal tea was not confusingly similar to ZINGERS for snack cakes, because an analysis of the actual relationship of the goods/services based on their individual characteristics is always required, and **it is not proper to lump different goods/services into a broad category** and then hold the different goods/services to be "related" automatically as a result. Accordingly, in *Astra Pharmaceutical Products Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 790 (1st Cir. 1983), the court affirmed a grant of summary judgment and found that the marks ASTRA, for the plaintiff's pharmaceuticals and syringes and ASTRA for the defendant's computerized blood analyzer machines, were not likely to be confused. In so doing, the court stated:

The most favorable inference that may be drawn from the evidence regarding the similarity of goods is that both parties' products are used in the medical or health care field. However, such a **broad inference is not sufficient** to demonstrate that a genuine issue exists concerning likelihood of confusion as to the source of the products identified in the present suit.

The case at hand is even stronger than the *Astra* case cited above, as the marks in the case at hand are not identical as was the case in *Astra*.

The services offered under Applicant's Mark and the Cited Marks are clearly different as is evidenced by the actual nature of the services. Therefore, consumers would be able to distinguish between Applicant's Mark and the Cited Marks.

Conclusion

Under the Lanham Act, a refusal to register based on an allegation of likelihood of confusion requires that such confusion as to the source of the goods/services must not be merely possible, but likely. A mere possibility of confusion is an insufficient basis for refusal under Section 2(d). See *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368 (TTAB 1983). The TTAB specifically stated in *In re Massey-Ferguson*: "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with practicalities of the commercial world, with which trademark deals." *Id.* at 368, quoting *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969).

In total, the *DuPont* factors weigh against a finding of likelihood of confusion between Applicant's Mark and the Cited Marks. Therefore, the Section 2(d) Likelihood of Confusion

Refusal related to the Cited Marks should be withdrawn, and Applicant's Mark should be allowed to proceed to publication.