

RESPONSE

This responds to the Office Action issued January 26, 2019, refusing registration of the mark **XSENS** for the services in Class 42 based upon the earlier registered mark **XSENSE**, Reg. No. 3635926, owned by Quest Diagnostics Investments LLC (“Quest”). In addition, the Examining Attorney has enclosed information relating to a prior filed application, Serial No. 79228395 for the mark **XENS**, owned by XSENS AS.

With regard to the refusal under Section 2(d), the Applicant respectfully submits that there is no likelihood of confusion between its mark **XSENS** and the **XSENSE** mark of the cited registration. The factors relevant for determining whether there is a likelihood of confusion between two marks are set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), and likelihood of confusion must be determined on a case by case basis. Of the factors set forth by the Du Pont court, the following are most relevant to the instant application are: (I) the visual and phonetic differences between the marks (II) the significant differences in the services offered under the marks; (III) the differences in the channels of trade through which the marks are sold; and (IV) the sophistication of the purchasers.

I. The Differences in the Respective Marks

Even though the differences are slight, the marks **XSENS** and **XSENSE** are visually and phonetically distinguishable and create a different commercial impression. When spoken aloud, the marks are likely to be pronounced differently. The marks also differ visually, as the registered mark includes the full word “SENSE” preceded by the letter “X”, where applicant’s mark includes the letter string “SENS” after the “X”. The letter string “SENS” can be understood to suggest words other than SENSE, such as “sensory”.

II & III. The Dissimilarities in the Goods and Services Sold Under the Marks and the Dissimilarities in the Channels of Trade Through Which the Goods and Services Are Sold.

The cited mark XSENSE, owned by Quest, covers services that are clearly distinguishable from the Applicant's services in Class 42, namely:

C 042. Medical and scientific research, namely, conducting clinical trials regarding diagnostic tests, diagnostic testing results, testing procedures, disease conditions, genetic conditions, monitoring of disease and disease prevention.

IC 044. Providing medical testing services and information regarding diagnostic tests, diagnostic testing results, testing procedures, disease conditions, genetic conditions, monitoring of disease and disease prevention; Genetic testing for medical purposes.

As shown by the specimens of use filed with the Registrant's recent Declaration Under Sections 8 & 9 on June 17, 2019, copies of which are attached hereto as Exhibit A, and as shown by the printouts from the Registrant's website, attached hereto at Exhibit B, the Registrant Quest Diagnostics is a medical diagnostic company that conducts research and medical testing on behalf of doctors, hospitals, insurance companies, employers and others for the purpose of diagnosing disease. As shown by the Registrant's specimens of use filed in support of its registration, the XSENSE mark is used by the Registrant as the name of a specific diagnostic test used to detect a condition called Fragile X syndrome.

The Applicant's services in Class 42, on the other hand, cover "Conducting scientific, technological and medical studies, research, design, development and consultancy, all in the field of motion capture, measurement of motion, orientation and position, computation of body posture, editing of body posture, analysis of body posture and visualization of body posture; research and development in the field of computer software used to track movement.

The Applicant's research, design and development services are directed at the development and manufacture of its goods in Classes 9 and 10, respectively:

Computer hardware and computer software used for motion analysis, 3-Dimensional motion tracking and character animation, and industrial control and stabilization ; Motion capture systems, consisting of inertial measurement units comprised of gyroscopes, accelerometers and/or magnetometers, and software for use therewith; and system for measurement of joint angles, consisting of inertial measurement units comprised of gyroscopes, accelerometers and/or magnetometers, and software for use therewith; and system for measurement of motion, orientation and position, consisting of inertial measurement units comprised of gyroscopes, accelerometers and/or magnetometers, and software for use therewith; software for computation of body posture; software for editing of body posture; software for analysis of body posture; software for visualization of body posture, in class 9.

Medical and biomechanical apparatus and instruments, namely, measuring devices for tracking body motion, orientation and position for use in medical diagnostics and medical treatment; medical and biomechanical apparatus and instruments, namely, motion angle and posture measurement devices for tracking body motion, orientation, angle and position for use in medical diagnostics and medical treatment; medical and biomechanical apparatus and instruments, namely, displacement measurement devices, and measurement devices and systems for motion tracking, orientation, angle and posture measurement, namely, force and motion testing apparatus for physical training and rehabilitation, in class 10.

As shown by enclosed printouts from Applicant's website, the applicant advertises itself as "the leading innovator in 3D motion tracking technology." The client's research services leads to innovation in products such as 3D animation for movies or sensors used in training for athletes. The purpose and nature of the Registrant's research services are completely different from the diagnostic testing services offered by the Registrant, and the channels of trade through which the services are offered to customers are very different as well. To the extent that both parties offer services within the vast medical industry, that is not sufficient to conclude that there is a likelihood of confusion. The Applicant's services to the medical industry differ significantly from the Registrant's services. The Applicant respectfully submits that the medical industry is a multi-billion dollar industry that includes a vast number of products. "It is error to deny registration simply because an applicant markets and sells its goods in the same general field as those promoted and sold by the registrant." *In Re Itec Mfg., Ltd., Serial No. 78/621,722, 2008 WL 885926 *8 (TTAB Feb. 13, 2008).*

IV. The Parties Goods Are Sold to Sophisticated Purchasers

The same consumer would rarely, if ever, view the parties' marks at the same time, and even if they did, there would be no confusion as to the source of the goods. The services of both

parties are highly specialized and customized, and are purchased after careful consideration and probably some negotiation on contract terms. The purchasers of such services are sophisticated professionals who are not likely to be confused because of surface similarities in the marks. The purchasers of services such as these, which are intended only for a very specialized use, are not likely to be confused as to the source of the services. Such purchases are carefully considered, investigated and negotiated, and there is almost no possibility that this type of purchaser is likely to have any confusion or doubt as to the source of the services.

In a similar case, the Federal Circuit found that the Board had failed to give due weight to the sophistication of the purchasers. The Court held "Even assuming, arguendo, that the Board was correct in finding sufficient relatedness of the goods and services, the relevant persons--potential or actual purchasers--are nevertheless mostly different and in any event are sophisticated enough that the likelihood of confusion remains remote." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (1992), 21 USPQ2d 1388, 1992 WL 1574 (C.A. Fed. 1992). (Finding no likelihood of confusion between the parties concurrent use of the mark "EDS").

Similarly, in the case of *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed.Cir.1983), the Federal Circuit affirmed the Board's conclusion that "because the marks are used on goods that are 'quite different' and sold to different, discriminating customers, there is no likelihood of confusion" even though both parties used the identical mark "DRC". Where the purchasers are the same, their sophistication is important and often dispositive because "[s]ophisticated consumers may be expected to exercise greater care." *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489, 212 USPQ 246,

252 (1st Cir.1981). "[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *Astra*, 718 F.2d at 1206, 220 USPQ at 790.

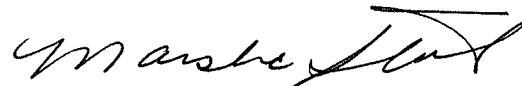
Conclusion

When the Applicant's mark and the Registrant's mark are properly viewed in their entireties, as they will be viewed by consumers, the differences outweigh the similarities. The marks are visually and phonetically distinctive, and are used in connection with very different types of services. Further, the parties' services under the marks are offered through different channels of trade to very sophisticated purchasers who are unlikely to be confused as to the source of the goods and services. Therefore, it is highly unlikely that consumers will be confused or misled by the coexistence of the parties' marks. Accordingly, the Applicant respectfully requests that the Examining Attorney withdraw her refusal of registration and that a Notice of Publication issue in connection with the mark.

Respectfully submitted,

Date:

July 11, 2019



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