

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RESPONSE TO OFFICE ACTION**

This responds to the Office Action dated June 17, 2019 for U.S. Serial No. 88372683 for the mark UNITY.

**IDENTIFICATION OF SERVICES**

Pursuant to the Examining Attorney's suggestion, Applicant respectfully requests amendment of its description of services as follows:

Class 44: prenatal testing **for medical purposes**

**RESPONSE TO 2(d) REFUSAL: NO LIKELIHOOD OF CONFUSION**

The United States Patent and Trademark Office (the "Office") has cited U.S. Application Serial Nos. 88137760 and 88226437 as potential preliminary bars to the registration of Applicant's mark.

***U.S. Serial No. 88226437***

As a preliminary matter, Applicant submits that, according to the Office's online TSDR records, it appears that U.S. Application Serial No. 88226437 should now be abandoned in due course and no longer pose a bar to the registration of Applicant's mark.<sup>1</sup> An Office Action was issued for App. Serial No. 88226437 on March 15, 2019, meaning that that applicant's response to the Office Action was due on September 15, 2019. According to TSDR records, it does not appear that the applicant for App. Serial No. 88226437 filed a response to the Office Action within the statutorily prescribed timeframe and a Notice of Abandonment was issued on October 15, 2019. As such, App. Serial No. 88226437 should no longer pose a bar to the registration of Applicant's mark.

***U.S. Serial No. 88137760***

As discussed in greater detail below, Applicant respectfully disagrees that a likelihood of confusion exists between Applicant's mark and U.S. Application Serial No. 88137760 (the "Cited Mark") because: (1) the respective services are different; (2) the respective purchasers and the channels of marketing and

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<sup>1</sup> See Exhibit A: printout of TSDR status page for U.S. App. Serial. No. 88226437.

trade are distinct; (3) the commercial impressions presented are different; (4) a significant number of the *du Pont* factors weigh in Applicant's favor; and (5) the burden of proof to find a likelihood of confusion has not been met. As such, Applicant requests that the subject trademark application be approved for publication.

**I. The Respective Services are Different**

The cumulative effect of differences in the essential characteristics of the goods and services involved is a fundamental inquiry mandated by Section 2(d) of the Trademark Act. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 USPQ 151, 153 (CCPA 1978). Applicant submits that its services in the subject application are so different from the services of the Cited Mark that no confusion is likely.

Applicant's identification of services for the subject trademark application claims prenatal testing services. Applicant's services involve a non-invasive prenatal blood test that uses a single tube of blood from a mother's arm to identify high risk pregnancies early, easily and accurately, testing specifically for cystic fibrosis, spinal muscular atrophy, sickle cell disease, and thalassemias.<sup>2</sup> The Cited Mark, in stark contrast, is used in connection with a web-based platform<sup>3</sup>, and the identification of services claims medical research and analysis services in the field of cancer and medical imaging. Applicant's prenatal test is not medical research or analysis, it is not designed to screen for cancer, and it does not use medical imaging. Conversely, the Cited Mark is not used in connection with a prenatal blood test, nor does the identification of services claim as much. Given these stark differences in the nature of the respective parties' services, no confusion is likely.

Although both Applicant's services and the services in the Cited Mark are in the extremely broad field of medical-related services, it is not sufficient that a particular term (such as "medical" in the present case) may be found which may broadly describe the goods and/or services in order to demonstrate that the involved goods and/or services are related for purposes of likelihood of confusion.. *See In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (TTAB 2007). Further, courts have held that the mere fact that "two

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<sup>2</sup> See Exhibit B: screenshot of Applicant's website.

<sup>3</sup> See Exhibit C: screenshot of website for the Cited Mark.

products or services fall within the same general field . . . does not mean that the two products or services are sufficiently similar to create a likelihood of confusion.” *Matrix Motor Co. v. Toyota Jidosha Kabushiki Kaisha*, 290 F. Supp.2d 1083, 1092 (2003), *aff’d* 120 Fed. Appx. 30 (9th Cir. Cal. 2005) (citing *Harlem Wizards Entm’t Basketball, Inc. v. NBA Props.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997)); *see also UMC Indus., Inc. v. UMC Elecs. Co.*, 207 U.S.P.Q. 861, 879 (T.T.A.B. 1980) (“[T]he fact that one term, such as ‘electronic’, may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”); *Harvey Hubbell, Inc. v. Tokyo Seimitsu Co.*, 188 U.S.P.Q. 517, 520 (TTAB 1975) (“In determining whether products [or services] are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods [or services] of the parties.”); *Machine Head v. Dewey Global Holdings, Inc.*, 61 U.S.P.Q.2d 1313, 1318 (N.D. Cal. 2001) (“The fact that both products could broadly be described as relating to music is not sufficient to find that the products have a similar use or function.”) (internal citation omitted).

Because Applicant’s services are vastly different in nature and purpose than those of the Cited Mark, and do not appeal to the same market, no confusion is likely.

## **II. The Respective Purchasers and the Channels of Marketing and Trade are Distinct**

A likelihood of confusion is precluded when there is no reasonable probability that the same customers will encounter opposing marks. *See In re Fesco, Inc.*, 219 U.S.P.Q. 437, 439 (T.T.A.B. 1983). Even identical marks can coexist without confusion when the consumers and relevant markets are sufficiently distinct. *Electronic Design & Sales, Inc. v. Electronic Data Systems*, 954 F.2d 713, 716 (Fed. Cir. 1992) (reversing TTAB finding of likelihood of confusion between EDS for computer hardware components and E.D.S. for data processing services); *see also NEC Electronics, Inc. v. New England Circuit Sales*, 13 USPQ2d 1059 (D. Mass. 1989) (no likelihood of confusion between the marks NEC and NECS, where both companies sold computer chips to sophisticated purchasers with specific technical needs). In the present case, Applicant’s services and the services of the Cited Mark travel through different and distinct channels of marketing and trade and the respective purchasers are distinct.

Applicant's services, by their very nature, are directed to pregnant women seeking a non-invasive blood test to identify high-risk pregnancies due to cystic fibrosis, spinal muscular atrophy, sickle cell disease, and thalassemias. In stark contrast, the services of the Cited Mark are directed to individuals seeking a web-based platform to integrate the collection of radiographic/imaging data. Applicant's services and the services of the Cited Mark are not closely related given the disparate channels of marketing and trade between individuals looking for a prenatal blood test to identify high-risk pregnancies, and individuals looking for a web-based platform to manage imaging data. Accordingly, because the respective services differ significantly in their nature and purpose, it would be erroneous to presume that the services would move in the same channels of trade. *See Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987). Therefore, taking into account all of the relevant facts, confusion is not likely.

Even if it were possible for the same purchaser to encounter both Applicant's mark and the Cited Mark, here the intended consumers are sophisticated. "[S]ophisticated consumers may be expected to exercise greater care." *In re N.A.D. Inc.*, 754 F.2d 996 (Fed. Cir. 1985) (quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489 (1st Cir. 1981)). *See also NEC Electronics, Inc. v. New England Circuit Sales*, 13 U.S.P.Q.2d 1059 (D. Mass. 1989) (no likelihood of confusion between the marks NEC and NECS, where both companies sold computer chips to sophisticated purchasers with specific technical needs). Both expectant mothers seeking Applicant's services and the individuals and clinicians seeking the web-based platform of the Cited Mark will want to ensure the well-being of the individuals involved and will therefore likely do research of the market and make careful, thoughtful purchasing decisions. Accordingly, confusion is not likely to occur.

In sum, the nature of the services ensures that the likely purchasers and channels of marketing and trade are distinct. This helps to ensure confusion is not likely.

### **III. The Commercial Impressions Presented are Different**

Determining whether there is a likelihood of confusion requires careful consideration of the overall commercial impression created by each mark. *See* TMEP § 1207.01(b)(iii). If the marks create different

commercial impressions, confusion is not likely. *See, e.g., In re TicketAmerica, Inc.*, 2002 TTAB LEXIS 263, Ser. No. 75/526,870 (March 29, 2001); *In re Best Products Co., Inc.*, 231 U.S.P.Q. (BNA) 988 (TTAB 1986). It is well established that even identical marks may be sufficiently different in commercial impression that no likelihood of confusion exists. *See, e.g., In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing); *See also Revlon Inc. v. Jerrell Inc.*, 713 F.Supp. 93 (SDNY 1989) ("differing connotations themselves can be determinative even where identical words with identical meanings are used.").

In the present case, the differences in the nature of the services claimed makes the commercial impression presented by Applicant's mark different than the commercial impression presented by the Cited Mark. Applicant's mark, when used in connection with a prenatal blood test, creates a different commercial impression than the Cited Mark in connection with a web-based platform in the field of medical imaging and cancer. For instance, Applicant's mark connotes the idea of a pregnant woman being joined with her baby, while the Cited Mark connotes the idea of having a united web platform for integrating the collection of radiographic/imaging data.

In sum, when viewed as a whole, consumers perceive Applicant's mark in a very different way than they perceive the Cited Mark. As such, confusion is not likely to occur.

**IV. A Significant Number of the *du Pont* Factors Weigh in Applicant's Favor**

In *du Pont*, the Court of Customs and Patent Appeals analyzed a likelihood of confusion by considering several factors. The most pertinent factors are addressed below, in relation to the present case:

<b><u>FACTOR</u></b>	<b><u>ANALYSIS</u></b>	<b><u>WHOSE FAVOR</u></b>
Similarity of the goods and services.	Applicant's services and very different from the services of the Cited Mark.	Applicant

Similarity of trade channels	Applicant's trade channels are very different from those of the Cited Mark.	Applicant
"Impulse" vs. careful, sophisticated purchasing.	Purchasers of Applicant's services and the services of the Cited Mark are sophisticated, discriminating purchasers.	Applicant
Market interface between Applicant and owner of Cited Mark.	No evidence of record.	Applicant
Extent to which owner of Cited Mark has the right to exclude others from use of its mark on its goods/services.	Unclear.	Applicant
Extent of potential confusion, i.e., whether de minimis or substantial.	De minimis.	Applicant
Fame of the prior mark.	No evidence of record.	Neither

Not only do the majority of the *du Pont* factors weigh in Applicant's favor, but those in its favor weigh heavily in Applicant's favor. When compared in their entirety the marks are sufficiently dissimilar such that confusion as to the source of the services offered under the respective marks is not likely to occur. Therefore, the evidence now of record, taken as a whole, establishes that confusion is not likely.

**V. The Burden of Proof**

The burden of proof is on the Examining Attorney to establish the likelihood of confusion. A refusal should be based on an understanding of the relevant industries, an analysis of the marketplace, and the likely reaction of prospective purchasers. Substantial evidence is now before the Examining Attorney to show that no likelihood of confusion is possible. To maintain this refusal in view of these submissions, significant contrary evidence would be necessary.

**CONCLUSION**

Applicant has responded to all matters in the Office Action and should the Examining Attorney have any questions with regard to this Response or to any matter relating to this Application, in general, a

telephone call to Applicant's undersigned representative at the telephone number listed below would be greatly appreciated.

Respectfully submitted,

/s/ /bssmith/

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