This response is respectfully submitted in connection with the office action issued by the Examining Attorney on April 26, 2019 (the "Office Action") which refused Applicant's application for the mark MYBLUEPRINT in Class 042 (Serial No. 88/294,168) (the "Applicant Mark") citing likelihood of confusion with Blueprint Genetics OY LLC's prior registration for BLUEPRINT GENETICS in Classes 009, 042, and 044 (Registration No. 5,772,042) (the "Cited Mark"). Applicant respectfully disagrees with the Examining Attorney's position and requests reconsideration thereof in view of the herein presented case authority and relevant facts.

As an initial matter, per the Examining Attorney's suggestion, Applicant requests that the Examining Attorney amend the Identification of Services of the Applicant Mark in part, by amending "providing online computer databases that contain aggregated results of DNA testing" to "providing online computer databases that contain aggregated results of DNA testing **for scientific purposes**" (emphasis added).

It is well established that the task of assessing the similarity or dissimilarity of the marks must focus on the consideration of the marks in their entirety. See *Packard Press Inc. v. Hewlett Packard Comp.,* 227 F. 3d 1352 (2000). When viewed in their entireties, the appearance of the Applicant Mark is vastly different from the Cited Mark and accordingly, such distinguishing elements prevent the occurrence of consumer confusion. While there are often terms in marks that are more dominant and thus, more significant to the assessment of similarity, the law precludes the dissection of marks. *Star Industries v. Bacardi & Company, Limited, Bacardi USA and Anheuser-Busch, Inc.* 412 F.3d 373 (2d Cir. 2005). In reviewing the situation at bar, the Examining Attorney's citation of a potential likelihood of confusion refusal is clearly predicated on the fact that both marks share the term "BLUEPRINT" however, when viewed as a whole, the Applicant Mark is vastly different from the Cited Mark.

Moreover, Applicant's Mark is a unitary mark without meaning and it is improper to separate a unitary mark. The two marks, when viewed side by side (MYBLUEPRINT vs. BLUEPRINT GENETICS), clearly do not look or sound alike. While the Applicant Mark contains the term "BLUEPRINT", such term is only a portion of the Applicant Mark, and is the second half of a one-word mark. The Cited Mark, on the other hand, contains the term "BLUEPRINT", but such term is the first word contained in a two-word mark. The first half of the Applicant Mark, "MY", and second word of the Cited Mark, "GENETICS", are two entirely different words that do not look or sound alike, and also have completely unrelated meanings. "MY" consists of one syllable, and is a pronoun defined as "belonging to or associated with the speaker". "GENETICS", on the other hand, consists of three syllables and when following the word "BLUEPRINT" has a completely different connotation. No consumer could reasonably confuse the two terms given their distinct and unrelated meanings. Moreover, not only do "MY" and "GENETICS" have different meanings, but viewing the marks MYBLUEPRINT and BLUEPRINT GENETICS as a whole, it is clear that they evoke different commercial impressions.

Although as stated above, Applicant believes that the marks are to be compared in their entireties, it has been held that "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re Nat'l Data Corp.* 753 F.2d 1056 (Fed Cir. 1985). In issuing the Office Action, the Examining Attorney is clearly focused on the shared term of the marks, "BLUEPRINT", however, Applicant respectfully believes this focus is misplaced. It has been held that "where the mark is a composite of a weak common part and

modifying phrase, the court holds that the common portion of the composite mark is to be given less weight on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar" *Continental Grain Company v. Central Soya Company Inc.* 69 F.3d 555 (Fed. Cir. 1995). In *Continental Grain* the court held that "where the common element of conflicting marks is 'weak' in the sense that such portion is descriptive, highly suggestive, or is in common use by many sellers in the market, then this reduces the likelihood of confusion" and accordingly ruled that there was no likelihood of confusion between HI PEAK and PEAK DARI. The case at bar is analogous to that of *Continental Grain*, as the shared term "BLUEPRINT" is commonly used in relation to science and technology-related goods and/or services. The following goods and/or services which are also shown in Exhibit A all contain "BLUEPRINT" for genetics and other science-related goods and services, and upon belief are not from the same source as the Cited Mark: https://www.nutrisystem.com/shop/dna-body-blueprint/index.jsp?gclid=EAIaIQobChMI8Nef0Jbl4QIVlshkCh1AogyaEAAYASAAEgJy-vD_BwE; https://geneblueprint.com/; https://www.bcm.edu/research/medical-genetics-labs/test_detail.cfm?testcode=1390. Due to the widespread use of "BLUEPRINT" in connection with science and technology-related goods and services, the likelihood of confusion is reduced. Accordingly, consistent with *Continental Grain* precedent, the term "BLUEPRINT" should be given less weight, as consumers will focus on other portions of the marks, "MY" and "GENETICS". As detailed herein, Applicant asserts that such remaining portions are sufficiently distinct to avoid a likelihood of confusion amongst consumers.

Applicant additionally notes that the term "BLUEPRINT" is not a highly distinctive element. More than thirty (30) different marks are registered in Class 042 which include the

term “BLUEPRINT”, plus additional words and/or symbols, and peacefully co-exist, including the following:

Reg. Number	Mark
3779909	BLUEPRINT
4988503	BLUEPRINT
5592005	BLUEPRYNT
5871569	INVESTOR BLUEPRINT
5851431	ACHIEVEMENT BLUEPRINT
5819688	BLUEPRINT REGISTRY
5509051	INNOVATION BLUEPRINT
5538700	COBALT BLUEPRINT
5472485	(IOSH) BLUEPRINT
5406630	ABA BLUEPRINT
5191222	ECOGREEN BLUEPRINT
5160176	BLUEPRINT RF NETWORK SERVICES · MANAGED SOLUTIONS
5160172	BLUEPRINT RF
4935508	YOUR BLUEPRINT FOR MARKET ACCESS
5715669	BLUEPRINT VIRTUAL SHOWROOM
4972023	VALLEY BLUEPRINT
5018706	ESM BLUEPRINT
5435769	BLUEPRINT STUDIOS
4830428	INTELLIGENT OUTPUT BLUEPRINT
5032833	XAD BLUEPRINTS
4987510	FOUNDERS BLUEPRINT
4840802	BLUEPRINT NETWORX
4840801	BLUEPRINT NETWORX
4802407	BLUEPRINT YOUR DREAMS
4800910	BLUEPRINT CMS
4800909	BLUEPRINT PLATFORM
4402641	BLUEPRINTS FOR HEALTH
4209441	APPLICATION BLUEPRINT
3992626	TRANSFORMATION BLUEPRINT
4487058	GIFTS ALTA BLUEPRINT
4496890	GIFTS ONLINE BLUEPRINT
4574587	MOBILE MONOPOLY BLUEPRINT
4538772	B BLUEPRINT CLINICAL
5772042	BLUEPRINT GENETICS
3845874	YOUR IMAGINATION IS OUR BLUEPRINT
4067371	DECISION BLUEPRINTS
2856271	PERSONAL BLUEPRINT

The term “BLUEPRINT” is commonly used in connection with science and technology-related goods and/or services, including software, mobile applications and other digital goods, and

therefore as *Continental Grain* pointed out, consumers will automatically look to other portions of the mark, in the case at bar, "GENETICS" and "MY" to distinguish between the marks. Any argument that the Cited Mark has the exclusive rights to the term "BLUEPRINT" in connection with genetic testing and diagnosis and related goods and/or services is precluded by a search of the registry which, as shown above, is littered with other marks containing "BLUEPRINT" and/or variations thereof in Class 042, as well as the numerous common law uses containing "BLUEPRINT" and/or variations thereof.

Applicant additionally notes that there are three (3) registrations containing the term "BLUEPRINT" in Class 042 which identify scientific and technology-related goods and/or services which, despite the fact that the Cited Mark makes no claim to the exclusive right to use "GENETICS", peacefully co-exist with the Cited Mark. Surely, if BLUEPRINT GENETICS for science and technology services in the nature of "science and technology services, namely, research and development of genetic testing and diagnosis, testing of DNA for inherited disorders, and providing information to others relating to genetic testing and diagnosis" and (IOSH) BLUEPRINT and Design for scientific and/or technical services in the nature of "scientific and/or technical research in the field of occupational health and safety in business" can co-exist, there is no likelihood of confusion between BLUEPRINT GENETICS for "science and technology services, namely, research and development of genetic testing and diagnosis, testing of DNA for inherited disorders, and providing information to others relating to genetic testing and diagnosis" and MYBLUEPRINT for "Application Service Provider featuring software for use in data management, data storage, data analysis, report generation, user identification, and membership identification, all in the fields of genetics and genetic testing….", such that the two cannot co-exist.

Based on the foregoing, Applicant respectfully submits that Applicant Mark is vastly different from the Cited Mark in appearance, sound, connotation, meaning, and commercial impression and that registration of MYBLUEPRINT will not result in a likelihood of confusion with the Cited Mark. Accordingly, Applicant kindly requests that the Examining Attorney reconsiders its position on the potential likelihood of confusion and that the Applicant Mark proceed towards registration.

EXHIBIT A

/dna-body-blueprint/index.jsp?gclid=EAIaIQobChMI8Nef0Jbl4QIVIshkCh1AogyaEAAYASAAEgJy-vD_BwE

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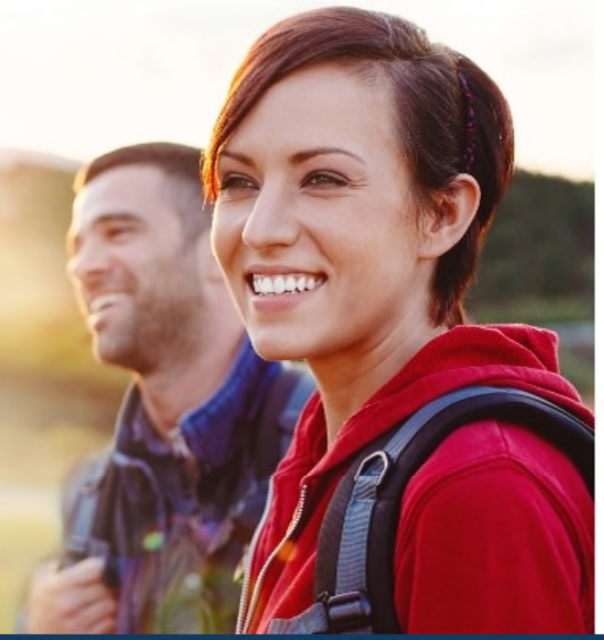

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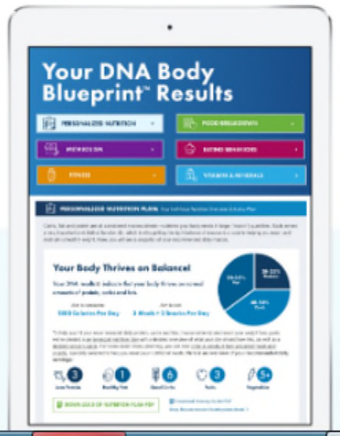


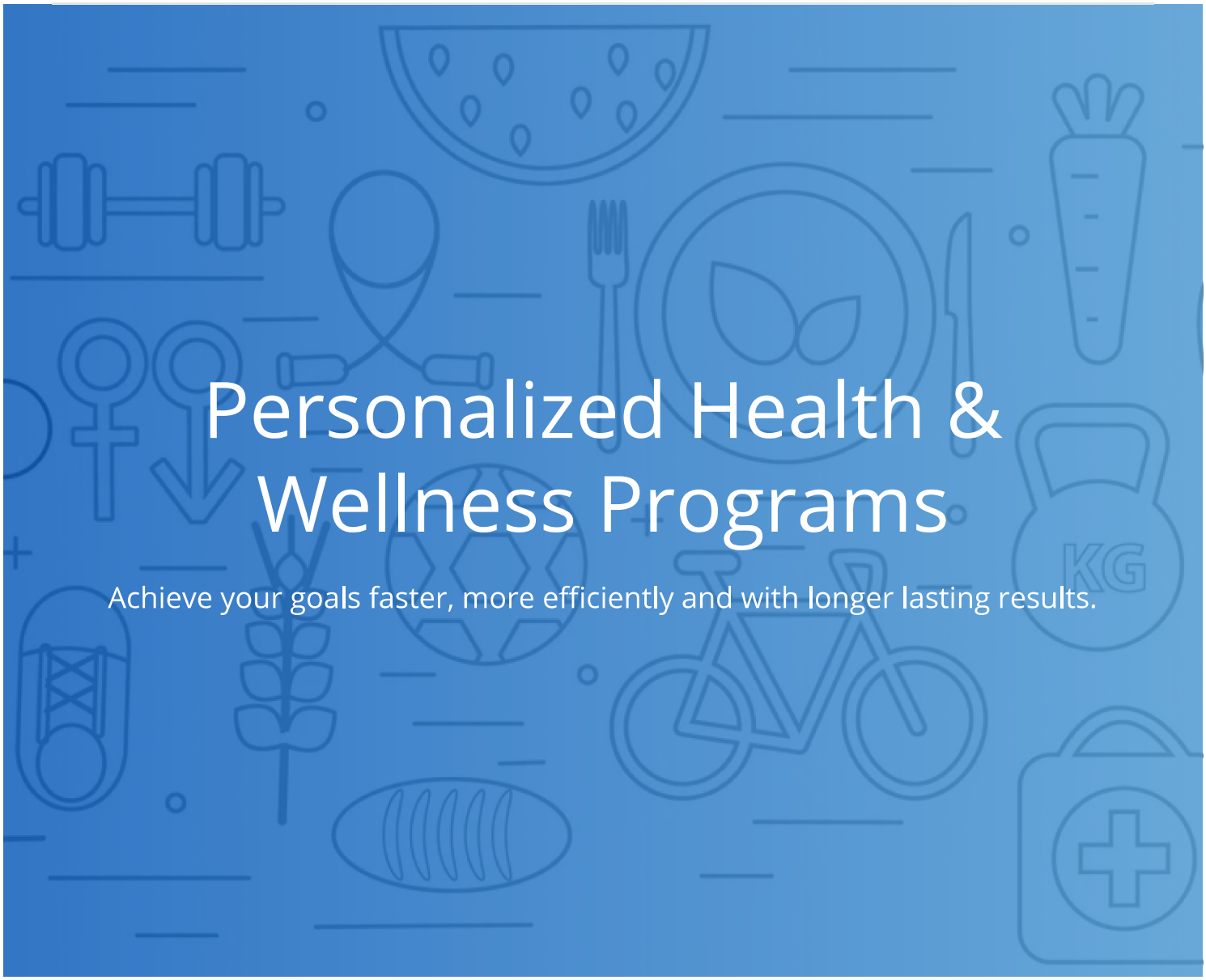
Find the right nutritional approach for you—straight from your DNA!

Our easy and secure DNA test reveals what type of foods your body thrives on, and your FREE Personalized Nutrition Plan maps out your optimal nutrition. You'll discover...

How Your Metabolism Affects Your Weight Loss—And What To Do About It

The Right Balance Of Nutrients For You—No More Guesswork Needed!

Your Fat Loss Fitness Plan, And How To Optimize Your Workouts



Personalized Health & Wellness Programs

Achieve your goals faster, more efficiently and with longer lasting results.

How It Works

It's simple. Order your DNA test, provide sample, mail it back. That's it. We'll take care of the rest. We provide a life time subscription to the

GeneBlueprint web portal where you have access to 20+ genetic prediction scores, fitness and nutrition blueprint.

Step 1: Order test from an authorized GeneBlueprint partner

We will ship a saliva DNA collection kit to you. It will take less than 10 minutes to complete the online registration and sample collection. Ship back your sample using the pre-paid shipping package.

Step 2: DNA analysis

Once we receive your sample we will detect 10 million genetic variants using state-of-the-art technology.

Step 3: Review genetic data

Utilizing the 10 million variants from step 2, we will compute genetic prediction scores for 20+ unique traits.

Step 4: Create fitness and nutrition blueprint

Based on your genetic prediction scores, we will create personalized fitness and nutrition plans

BCM Baylor College of Medicine

Medical Genetics Test Details

View Custom Req | Tests in Custom Req: 0

Search Tests: (Search by disease, test name, gene name, test code, or keyword. Return to test index.)

Search Browse: #ABCDEFGHIJKLMNOPQRSTUVWXYZ

The American Medical Association (AMA) Current Procedural Terminology (CPT) codes and Healthcare Common Procedure Coding System (HCPCS) codes listed, are provided for informational purposes only. The codes reflect our interpretation of CPT/HCPCS coding requirements based upon AMA guidelines published annually. CPT/HCPCS codes are provided only as guidance to assist clients with billing. Baylor Genetics strongly recommends that clients confirm CPT/HCPCS codes with their Medicare Administrative Contractor (MAC) or other payer being billed, as requirements may differ. CPT coding is the sole responsibility of the billing party. Baylor Genetics assumes no responsibility for billing errors due to reliance on the CPT codes listed. Please direct any questions regarding CPT coding to the payer being billed.

Print Req

Total BluePrint Panel

Test Information:	The Total Blueprint Panel is a test comprised of approximately 4,800 known Mendelian disease causing genes. This test focuses on the regions of the genes that contain important sequences of DNA that serve as the blueprint for essential proteins important for proper body function. These regions of DNA are referred to as exons. It is known that most of the errors that occur in DNA sequences that then lead to genetic disorders are located in the exons. In contrast to other sequencing tests that analyze anywhere from one gene to hundreds of genes, yet could still miss the culprit gene, the Total Blueprint Panel will analyze all the exonic regions of the 4,800 or so genes at one time in order to identify the rare changes in an individual's DNA that are contributing to their medical concerns. For more information on specific coverage, click here: Total BluePrint Panel gene list and coverage information

Test Details

Test Code:	1390
Special Notes:	Parental samples are requested, if available, to interpret proband Total BluePrint Panel results by targeted Sanger sequencing. See requisition for sample requirements and further details.

Technical Information

Methodology:	Next Generation Sequencing

Sample & Shipping Information

Test Requisition:	Total BluePrint
Specimen Type:	**Blood**
Requirements:	Draw blood in an EDTA (purple-top) tube(s). Send at least 5cc (children) or 10cc (adults).
Shipping Conditions:	Ship at room temperature in an insulated container by overnight courier. Do not heat or freeze. Sample must arrive within 72 hrs.
Specimen Type:	**Buccal Swab**
Requirements:	Collected with ORAcollect.Dx (OCD-100) self-collection kit (provided by Baylor Genetics with instructions). It is highly recommended the sample be collected by a healthcare professional.

Shipping Conditions:	Ship at room temperature in an insulated container by overnight courier. Do not heat or freeze. Sample must arrive within 72 hrs.

Specimen Type:	**Cultured Skin Fibroblast**
Requirements:	Send 2 T25 flasks at 80-100% confluence.
Shipping Conditions:	Ship at room temperature in an insulated container by overnight courier. Do not heat or freeze.

Specimen Type:	**Purified DNA**
Requirements:	Send at least 20ug of purified DNA (minimal concentration of 50ng/ul; A260/A280 of ~1.7).
Shipping Conditions:	Ship at room temperature in an insulated container by overnight courier. Do not heat or freeze.

Turn Around Time:	8 weeks

Billing Information

List Price:	*For Insurance or Institutional Prices, please call.
CPT Codes:	81404x4, 81405x1, 81406x7, 81407x1, 81408x2

Return to test index

Baylor Genetics Laboratories

Address: 2450 Holcombe - Grand Blvd Dock, Houston, Texas 77021-2024
Mail: One Baylor Plaza, Mail Stop NAB 2015, Houston, Texas 77030
Phone: 1-800-411-GENE (4363) | **Fax:** 1-800-434-9850
Contact: Baylor Genetics Laboratories