RESPONSE TO OFFICE ACTION

I. INTRODUCTION

On April 29, 2019, Applicant received a Section 2(d) Refusal – Likelihood of Confusion initial office action refusing registration of the applied-for mark "ECL COMMAND CENTER" (Serial No. 88291857) (also referred to as "Applicant's Mark") because of a perceived likelihood of confusion with the stylized mark ECL Empire City Laboratories (U.S. Registration No. 4320534) (also referred to as "Cited Mark").

II. NO LIKELIHOOD OF CONFUSION

In a likelihood of confusion analysis, two main considerations are the similarities between the marks and the similarities between the goods and/or services. In determining whether there is a likelihood of confusion between two marks, one must consider all evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Applicant sets forth below the reasons why it is entitled to registration.

A. Dissimilarity of the Marks

The first *du Pont* factor focuses on the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.,* 177 USPQ at 567. The ultimate conclusion rests on consideration of the marks in their entireties. *In re National Data Corp*., 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

Applicant disagrees with Examiner's assertion that there may be a likelihood of confusion between Applicant's Mark and the Cited Mark. As a general matter, Applicant respectfully notes that Applicant has a validly issued registration for "ECL" (Serial No. 88004917), and its use here in Applicant's Mark to qualify COMMAND CENTER in a manner consistent with that registered mark is dispositive, particularly in combination with the other observations recited below. Applicant's mark is a standard character word mark ECL COMMAND CENTER while the Cited Mark is stylized design mark with the literal element ECL EMPIRE CITY LABORATORIES. Applicant argues that the two Marks give off entirely different commercial expressions. First, the mere fact that a mark shares a similar word is not enough to constitute a likelihood of confusion. For example, in *In re 1776, Inc.*, 223 U.S.P.T.Q. 186 (T.T.A.B. 1984) the applicant attempted

to register the mark "Mamma's" for restaurant services, however, the examining attorney cited three registered marks for restaurant services, each containing some form of the word "mamma." The applicant's registration was denied based on likelihood of confusion. However, the Board found that there was no likelihood of confusion determining that, "the mere presence in each of two marks of the same term is usually not sufficient to support a holding of likelihood of confusion." *Id*. The Board stated that although the marks all contained the term "mamma", the other words and designs in the marks "play a significant role in creating the commercial impression of each mark." *See also, Sunbeam Corporation v. American Safety Razor Company*, 207 U.S.P.Q. 799, 1980 WL 30154 (Trademark Tr. & App. Bd. 1980) (holding that THE LADY and LADY SUNBEAM in connection with razors not likely to cause confusion); *ENNIS, INC. v. JOEL L. BELING D1B1A SUPA CHARACTERS PTY LTD,* 2017 WL 412412 (January 12, 2017) (holding no likelihood of confusion between COLOR WARS and COLORWORX despite the similarity of "COLOR" in both marks); *The H.D. Lee Company, Inc. v. Maidenform, Inc.*, 87 U.S.P.Q.2d 1715 (Trademark Tr. & App. Bd.), 2008 WL 1976596, 14 (holding no likelihood of confusion between ONE FAB FIT and ONE TRUE FIT because of commercial impression on consumers).

Likewise, while the two Marks at issue share the similar word ECL, the marks as a whole are completely different. Applicant's Mark has 3 words, ECL COMMAND CENTER, and Applicant argues that the main commercial expression of Applicant's Mark, and the words that consumers will most likely focus on, are COMMAND CENTER, as ENGINE is a longer text that makes up most of the commercial expression of Applicant's Mark. On the other hand, the Cited Mark has 4 words and it is apparent that the ECL stands for "EMPIRE CITY LABORATORIES," which is arguably the main commercial expression of the Cited Mark. The Cited Mark also contains other distiquishing factors, as it is a stylized design and contains a prominent jacks-like design at the top of the words. The Examiner must compare these marks in their entireties and it is clear that there are substantial differences between the Marks, and each of the Marks give off entirely different commercial expressions.

Overall, the Cited Mark and Applicant's Mark are distinct enough so as not to create any likelihood of confusion.

B. Dissimilarity of the Services

Examiner has requested clarification of Applicant's description of services. Applicant hereby updates its description of services as requested by Examiner as follows:

Medical laboratory services; scientific laboratory services; conducting laboratory experiments remotely; software as a service featuring software for designing laboratory

experiments, for running laboratory experiments, for analyzing laboratory experiment controls, equipment, and environment data, and for analyzing laboratory experiment results; remote scientific testing services of chemicals, pharmaceuticals, biologics, vaccines, and medical devices; biopharmaceutical research design and scientific testing services; product safety and quality assurance testing services for pharmaceuticals, biopharmaceuticals, chemicals, medical devices, vaccines, and biologics; toxicological safety and quality assurance testing services for pharmaceuticals, chemicals, and consumer products; software as a service for developing, executing, monitoring, and managing enterprise resource planning, experimental logistics, manufacturing execution systems, and connected factories; software as a service featuring software for running computer simulations of laboratory experiments, for running computer simulations of biological and chemical phenomena and systems, for optimizing laboratory experiment parameters with computational methods, and for comparison of computer simulations against empirically observed laboratory experiment results; software as a service for providing regulatory compliance documentation following experiments, for performing regulatory agencies audits following experiments, and for performing internal audits following experiments; software as a service for processing of un-structured, semi-structured, and structured information relating to laboratory experiments and computer simulations of laboratory experiments and biological and chemical phenomena and systems.

(referred to as "Applicant's Services").

The Cited Mark description of goods and services read as follows:

IC 042: *Medical laboratories; Medical laboratory services.*

(collectively referred to as "Cited Mark's Services")

Applicant's Services and the Cited Mark's Services are clearly different. First, Applicant is not applying for medical laboratories or medical laboratory services. As the updated description of services make clear, Applicant's services are cloud computational services and software as a service services that may be used by customers who wish to perform remote laboratory experiments, including basic research experiments with potential future medical applications. However Applicant does not offer normal medical laboratory services as understood by customers and the FDA.

The Board has held that the mark "Cross-Over" for women's bras was not likely to be confused with the mark "Crossover" for women's' sportswear, even though the goods were complimentary in that they were both for women's clothing. *In re Sears Roebuck and Co.*, 2 U.S.P.Q. 2d 1312 (T.T.A.B. 1987). The Board found that "although applicant's brassieres and registrant's ladies' sportswear, namely, tops, shorts, and pants, are undeniably related goods, nevertheless there is a competitive distance between them.

That is, they are different types of clothing, having different uses, and are normally sold in different sections of department stores."

Here the distinction is dramatically stronger than in *In re Sears Roebuck and Co.* Cited Mark's Services and Applicant's Services are different types of services as a matter of law as memorialized in the FDA's regulatory scheme, with dramatically different uses, and are normally sold through completely different sales channels.

Specifically, Applicant's Mark is part of the Emerald Cloud Lab platform, which is a basic research service governed by a completely different FDA regulatory scheme. Thus, not only do the respective services use different types of tools, it would be *illegal* to use Applicant's Services to offer clinical laboratory services like Cited Marks Services. Unsurprisingly, Applicant Services's Terms of Service expressly warns against such usage, which is common knowledge among those in basic R&D like Applicant's customers:

> 1.4. Research Only. The ECL is for scientific and technical research purposes only. **It is not for use in clinical research or in the diagnosis and/or treatment of medical and physical conditions in humans ("Unauthorized Uses")**. The ECL is not intended to be used for any diagnostic purpose and is not to be used as a substitute for professional medical advice. **The ECL is not a CLIA registered laboratory** and we make no representation or warranty as to compliance with 21 C.F.R. § 58. By submitting specimens to the ECL, you acknowledge that the results of the testing requested are only for the uses set forth above and further acknowledge that WE DISCLAIM ANY AND ALL LIABILITY AND/OR RESPONSIBILITY FOR USE OF RESULTS FOR UNAUTHORIZED USES.

https://www.emeraldcloudlab.com/ecl-terms-of-service (emphasis added). In contrast, Cited Marks Services is clearly a typical clinical laboratory that deals with patient diagnostics:

> Empire City Laboratories **is a full-service clinical laboratory** that is dedicated to provide highly-efficient results to both **doctors and patients**. We guarantee our services and 100% confidentiality. Empire City Laboratories uses the latest medical technology to ensure the accuracy, reliability, and timeliness **of patient test results**.

https://www.empirecitylabs.com/about-us/ (emphasis added). This is further evidenced by Empire City Laboratories's own filings with the USPTO, *e.g.*, https://tsdrapi.uspto.gov/ts/cd/casedocs/bundle.pdf?sn=85698399&type=SPE&fromdate=2012-08-08&todate=2012-08-08. For example, page 11 notes its Clinical Laboratory

Improvement Amendments (CLIA) registration number, 33D1057336, which is part of the FDA's mandatory regulatory scheme for clinical laboratories. *See* https://www.fda.gov/medical-devices/ivd-regulatory-assistance/overview-ivd-regulation#1 ("IVDs are generally also subject to categorization under the Clinical Laboratory Improvement Amendments (CLIA '88) of 1988.") Violation of CLIA can subject a laboratory to both monetary penalities and criminal sanctions. https://www.acponline.org/system/files/documents/running_practice/mle/clia-and-your-lab.pdf ("One lab owner was sentenced to 60 months in prison and ordered to pay restitution of more than $2.5 million.")

Furthermore, beyond mandatory regulatory distinctions, the Applicant's Services and Cited Mark's Services have dramatically different uses. *Compare* https://www.emeraldcloudlab.com/experimental-capabilities with https://www.empirecitylabs.com/test-directory/?s=. A customer ordering a clinical Hepatitis C test would not find such a test available from Applicant, and, even if it were somehow possible, any prospective customer would have to subscribe to a services plan that starts at 6 figures and also go through at least a week of intensive programming training on how to utilize Applicant's Service, which is eminently sensible for a commercial life sciences research customer but not for a patient or doctor seek a simple clinical test. This is also evident from Applicant's offerings, *e.g.*, industrial caliber experiments for Structural/2D Nuclear Magnetic Resonance (NMR) and Matrix Assisted Laser Desorption Ionization (MALDI) Mass Spectrometry. To be clear: a skilled artisan might utilize Applicant's Services as part of their research relating to developing or improving a clinical test, but it is not a platform for selling FDA-approved clinical tests to patients, a la Cited Mark's Services. In other words, Applicant's Services are addressed to researchers while Cited Mark's Services are addressed to patients and their caretakers; as such, the services address substantially different markets.

Finally, the respective services have distinct sales channels. Cited Mark's Services are typical diangostics tests sold at retail either to customers or ordering physicians on behalf of their patients, whereas Applicant's Services are sold as a B2B offering for commercial research customers conducting basic R&D. There is no overlap between the two areas.

In summary, in this case, there is a competitive distance between software services and cloud based remote monitoring of medical experiment services for use in scientific laboratories versus a medical laboratory or medical laboratory services. Software and cloud based medical experiment services are completely different than offering a medical laboratory or offering medical laboratory services. The Cited Marks Services and Applicant's Services have completely different uses, appeal to different audiences and are normally distributed by different companies. *See also, In re Peebles, Inc.*, 6 USPQ2d 1795, 1796 (TTAB 1992) ("the mere fact that an applicant's goods are of a type sold in a

registrant's outlet is, in itself, insufficient to support a holding of likelihood of confusion if the marks are dissimilar").

III. CONCLUSION

The evidence shows that there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Both the services offered and the Marks themselves are distinct. Accordingly, Applicant respectfully requests that Examiner reconsider the finding that there is a likelihood of confusion and not issue a refusal under the Trademark Act, Section 2(d).