

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

**In re Application of:**

Spark Therapeutics, Inc.

**Trademark:** KEYSTONE

**Application No.:** 88/338,264

**Filing Date:** March 13, 2019

Law Office 109  
Tracy Cross  
Examining Attorney

**AMENDMENT AND RESPONSE TO OFFICE ACTION**

Spark Therapeutics, Inc. ("Spark" or "Applicant") is a commercial company committed to discovering, developing and delivering gene therapies to challenge the inevitability of genetic diseases such as hemophilia. Hemophilia is a rare genetic bleeding disorder that causes a delay in clot formation as a result of a deficiency in one of several blood-clotting factors. Exhibit A.

On March 13, 2019, Applicant applied to register the mark KEYSTONE ("Applicant's Mark") for "*clinical trials in the field of hemophilia, medical research, education, and patient advocacy services all related to hemophilia*" in class 42. The Examining Attorney initially refused registration of Applicant's Mark on the grounds of an alleged likelihood of confusion with the following prior registrations:

Registration Number 2,621,384 for the mark KEYSTONE SYMPOSIA ("Cited Symposia Mark") for "*arranging and conducting professional business conferences,*" in class 35 and "*arranging and conducting educational conferences, namely, scientific and academic conferences in the field of clinical and life sciences, namely cell biology, cancer, plant biology, molecular biology, immunology, infectious diseases, pharmacology, cardiovascular system, gene therapy, neurobiology and clinical research,*" in class 41 ("Symposia Services")

Registration Number 4,254,863 for the mark KEYSTONE HEART ("Cited Heart Mark" collectively with Cited Symposia Mark as "Cited Registrations") for "*research and development in the field of medical devices, namely, medical devices for use in the treatment of cardiovascular disorders,*" in class 42 ("Heart Services")

The Examining Attorney also perceives a potential conflict with the pending application for the mark KEYSTONE (Ser. No. 88/233,662) for “*providing an interactive web site featuring technology that enables users to access, track, monitor, and generate reports relating to antibiotics and bacterial susceptibility and resistance patterns; providing an internet-based database of cumulative medical and scientific research data on bacterial susceptibility surveillance to monitor changes in resistance patterns and provide doctors and the healthcare community information on the activity of an antibacterial drug to an organism over time,*” in class 42 and “*medical information services, namely, reporting of drug-resistance patterns over time; providing an internet-based database of cumulative data on bacterial susceptibility surveillance to monitor changes in resistance patterns and provide doctors and the healthcare community information on the activity of an antibacterial drug to an organism over time for medical treatment purposes,*” in class 44 (“Cited Application”, collectively, with the Cited Registrations, the “Cited Marks”).

Applicant establishes in this Response that there is no likelihood of confusion between Applicant's Mark and either the Cited Symposia Mark or Cited Heart Mark. The marks in the Cited Registrations have different overall commercial impressions from that of the Applicant's Mark as they suggest to consumers the type of services rendered under the marks. Additionally, the services provided under each mark are narrowly tailored to target different consumers and markets.

Applicant does not fully respond to the pending advisory notice regarding the Cited Application because the Examiner has not presented arguments or evidence as to why she believes there is a reasonable probability of consumer confusion. However, in this Response, Applicant discusses the fact that Applicant's Services relating to hemophilia are not related to or

competitive or overlapping with the provision of information about antibiotics and bacterial susceptibility and resistance patterns in the Cited Application. Because Applicant establishes that these services are not related, it thus establishes that the services of the Cited Application do not conflict with Applicant's services under the KEYSTONE mark.

Applicant therefore requests that the Examining Attorney withdraw the refusals based on the Cited Symposia Mark and Cited Heart Mark and the Cited Application. In the event the Examiner is not willing to withdraw the refusal as to the Cited Application, Applicant requests that the Examiner place Applicant's application in suspension pending the outcome of the Cited Application.

#### **AMENDMENT**

As set forth in the Office Action response form, Applicant hereby amends the service identification from *Clinical trials in the field of hemophilia, medical research, education, and patient advocacy services all related to hemophilia*, in class 42 to the following and pays the prescribed fees associated therewith:

*Class 42: Conducting clinical trials for others in the field of hemophilia; providing medical research information in the field of clinical trials relating to hemophilia; medical research in the field of hemophilia*

("Applicant's Amended Services").

#### **ARGUMENT**

There is no likelihood of confusion between the Applicant's Mark and the Cited Marks. First, Applicant's Mark is different from the Cited Symposia Mark and Cited Heart Mark. Second, Applicant's amendment to its services eliminates any perceived overlap with the Symposia Services because of the deletion of any reference to education, which was the only similarity between Applicant's Services and the Symposia Services. Additionally, the Applicant's Amended Services and the services of the Cited Marks are all narrowly tailored and

targeted at consumers who are sophisticated audience who are also unrelated. Accordingly, the difference in the marks and services dispels any likelihood of consumer confusion.

**1. There is no likelihood of confusion between Applicant's Mark and the Cited Symposia Mark because the marks are different and the Applicant's Amended Services and the Symposia Services are narrowly tailored and targeted to sophisticated consumers.**

The Examining Attorney argues that the mark KEYSTONE and KEYSTONE SYMPOSIA are confusingly similar because Applicant's Mark "contains some of the wording" in the Cited Symposia Mark. However, marks having a common element does not by itself lead to a finding of likelihood of confusion. General Mills, Inc. v. Kellogg Co., 3 USPQ2d 1442, 1445 (8<sup>th</sup> Cir. 1987) (stating that "the use of identical, even dominant, words in common does not automatically mean that two marks are similar"). It is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). When properly viewed in their entirety, the marks are not confusingly similar because the Cited Symposia Mark includes the term SYMPOSIA which is strongly suggestive of the services offered under this mark-arranging and conducting educational conferences or symposiums. The meaning or connotation of a mark must be determined in relation to the named goods or services. TMEP § 1207.01(b)(v). Even marks that are identical in sound and/or appearance (and here the marks are not), may create sufficiently different commercial impression when applied to the respective parties' goods or services so that there is no likelihood of confusion. See e.g., In re Sears, Roebuck & Co., 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras,

whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"). Consumers, especially well educated doctors and medical researchers, are not going to see the mark KEYSTONE SYMPOSIA and think it is somehow related to Applicant's hemophilia medical trials. They will understand that the mark directs them to a medical symposium.

Also, contrary to the Examining Attorneys implication that omitting wording is not enough to overcome a likelihood of confusion, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is diluted. TMEP 1207.01(b)(iii). Likelihood of confusion is obviated in this case because KEYSTONE is relatively weak as demonstrated by the coexistence of a number of third-party "KEYSTONE" for medical-related services. Where the consuming public is exposed to numerous third-party uses of similar marks for related goods and services, the reality is that consumers will look to differences in the marks and the goods or services themselves to distinguish their source and are not likely to be confused. See General Mills, Inc. v. Health Valley Foods, 24 USPQ 1270, 1278 (TTAB 1992). Evidence of third-party use or registration of similar marks for similar goods and services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection such that the public will look to other elements to distinguish the source of the goods and services. TMEP § 1207.01(d)(iii); Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). The Examining Attorney cited three marks containing the term KEYSTONE that are used generally for varying medical related services. If an examining

attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP 1207.01(d)(x). Because there are several registrations containing the term KEYSTONE for various medical services, any differences in the marks are significant.

Additionally, the Examining Attorney states “both parties provide educational services in the medical field” and that the Applicant’s Services use broad wording to describe education services, which presumably includes all of the narrowly worded Symposia Services. Applicant has herein amended the service identification to delete the claim to educational services thereby eliminating any perceived relatedness of the services. Further, the Examining Attorney supports the assertion that “both parties provide education services in the medical field” based on a review of the parties’ respective websites. However, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. TMEP 1207.01(a)(iii). Not only does the Application no longer include a claim to education services, Applicant’s Mark is not in use on Applicant’s website. Any education-related services noted on Applicant’s website are under the house mark SPARK THERAPEUTICS or other trademarks, which makes the website irrelevant to the analysis of whether Applicant’s Services and Symposia Services for KEYSTONE and KEYSTONE SYMPOSIA are related. The Examining Attorney provides no other evidence to support the assertion that Applicant’s Services and Symposia Services are related.

Even as originally filed, though, Applicant’s Services and the Symposia Services are both narrowly tailored so that there is in reality no overlap or relatedness. The Applicant’s Services are limited to one specific and rare illness, hemophilia. Exhibit A. And the Symposia Services are limited to “cell biology, cancer, plant biology, molecular biology, immunology, infectious

diseases, pharmacology, cardiovascular system, gene therapy, neurobiology and clinical research,” none of which include hemophilia. Further, Applicant’s Amended Services do not include any educational component. Applicant’s services are conducting clinical trials and research relating to one specific and rare disease, hemophilia. Clinical trials are highly regulated experiments and observations designed to answer specific questions about interventions or treatments for biomedical or behavioral issues and to gather data on the safety and efficacy of the same. Exhibit B. This regimented and exacting service is a stark contrast to the “dynamic,” “open scientific dialogue,” “cross-disciplinary collaborations” educational conferences with “recreational experiences in beautiful settings [that] refresh the mind and inspire creative, new thinking and direction” offered under the Cited Symposia Mark. Exhibit C.

Similarly, the respective consumers for Applicant’s Amended Services and Symposia Services are different and sophisticated. A patient seeking information about the rare disease hemophilia or possible inclusion in a clinical trial relating to hemophilia is not going to find, no less confuse such with, a general scientific and academic conference in the field of clinical and life sciences for those in the medical profession. They or their doctors are looking for help for a rare disease. An online search for “clinical trial hemophilia” did not produce and any medical conferences. Exhibit D. The Symposia Services are targeted to “a geneticist, an immunologist or virtually any other type of life science investigator...from academia, industry or the government/nonprofit sector.” Exhibit C. These consumers are going to know the difference between a clinical trial and a general medical conference.

Accordingly, there is no likelihood of consumer confusion between Applicant’s Mark and the Cited Symposia Mark so Applicant respectfully requests that the Examining Attorney withdraw the refusal.

**2. There is no likelihood of confusion between Applicant's Mark and Cited Heart Mark because the marks are different and the Amended Services and the Heart Services are unrelated.**

The Examining Attorney argues that the mark KEYSTONE and KEYSTONE HEART are confusingly similar because the Applicant's Mark "contains some of the wording" in the Cited Heart Mark. However, as previously noted, marks having a common element does not by itself lead to a finding of likelihood of confusion. General Mills, Inc. v. Kellogg Co., 3 USPQ2d 1442, 1445 (8<sup>th</sup> Cir. 1987) (stating that "the use of identical, even dominant, words in common does not automatically mean that two marks are similar"). To the contrary, marks must be considered in their entireties, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

When properly viewed in their entireties, Applicant's Mark is not confusingly similar to the Cited Heart Mark because the Cited Heart Mark includes the strongly suggestive term HEART. Moreover, the meaning or connotation of a mark must be determined in relation to the named goods or services. TMEP § 1207.01(b)(v). Even marks that are identical in sound and/or appearance (and here the marks are not), may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. See e.g., In re Sears, Roebuck & Co., 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line

between two seasons"). The additional term HEART and its use in relation to the cardiovascular-related services is striking and clear. It signals to consumers that the services relate to the heart. Consumers are not going to see the mark KEYSTONE HEART and think it is somehow related to hemophilia, which has nothing to do with the heart. The mark KEYSTONE HEART is strongly associated with cardiovascular- or other heart- related services as indicated in the Heart Services.

Also, contrary to the Examining Attorney's implication that omitting wording is not enough to overcome a likelihood of confusion, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is diluted. TMEP 1207.01(b)(iii). Likelihood of confusion is obviated in this case because KEYSTONE is relatively weak, as demonstrated by the coexistence of a number of third-party "KEYSTONE" for medical related services. Where the consuming public is exposed to numerous third-party uses of similar marks for related goods and services, the reality is that consumers will look to differences in the marks and the goods or services themselves to distinguish their source and are not likely to be confused. See General Mills, Inc. v. Health Valley Foods, 24 USPQ 1270, 1278 (TTAB 1992). Evidence of third-party use or registration of similar marks for similar goods and services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection, because the public will inevitably look to other elements of the branding and overall presentation to distinguish the source of the goods and services. TMEP § 1207.01(d)(iii); Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). The Examining Attorney cited three marks containing the term KEYSTONE which are used generally for medical-related services. If an examining attorney finds registrations that appear to

be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP 1207.01(d)(x). Because there are several registrations containing the term KEYSTONE for medical services, it suggests that the term KEYSTONE is weak and that differences in the marks and the services they are used for are significant.

Additionally, the Examining Attorney states that the Applicant's Services use broad wording to describe medical research which presumably includes all of the narrowly worded Heart Services. However, Applicant's Services and the Heart Services are in fact both narrowly tailored to relate to hemophilia and cardiovascular disease, respectively. Accordingly, there is no overlap or relatedness. Applicant's Amended Services are limited to a specific and rare illness, hemophilia. Exhibit A. And, the Heart Services are limited to cardiovascular disease. There simply is no overlap between the two.

Similarly, the consumers for Applicant's Amended Services and the Heart Services are different populations, each of which is sophisticated. A patient seeking information about the rare disease hemophilia or possible inclusion in a clinical trial relating to hemophilia is not going to confuse such with research for a medical device used for an unrelated and common disorder like cardiovascular disease. They or their doctors are looking for help in connection with for a rare disease. An online search for "clinical trial hemophilia" did not produce results relating to cardiovascular disease. Exhibit D. The Heart Services relate to the development and manufacture of cerebral embolic protection (CEP) devices designed to help interventional cardiologists and electrophysiologists reduce the risk of stroke, neurocognitive decline and dementia caused by brain emboli associated with cardiovascular procedures. Exhibit E. Interventional cardiologists and electrophysiologists are going to know the difference between a

clinical trial for a rare disease they do not treat and a medical device made for cardiovascular procedures they routinely perform.

Accordingly, there is no likelihood of consumer confusion between Applicant's Mark and the Cited Heart Mark. Applicant therefor respectfully requests that the Examining Attorney withdraw the refusal.

**3. There is no likelihood of confusion between Applicant's Mark and Cited Application because the Amended Services and the Application Services are narrowly tailored and unrelated.**

Applicant respectfully reminds the Examining Attorney that when an examining attorney finds registrations containing the same term that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP §1207.01(d)(x). In this case, the Examining Attorney cited three marks containing the term KEYSTONE which are used generally for medical-related services.

Additionally, Applicant submits that Applicant's Amended Services and the services in the Cited Application are both narrowly tailored so that there is no overlap or relatedness. Applicant's Services are limited to a specific and rare genetic illness, hemophilia. Exhibit A. The services in the Cited Application related solely to antibiotics, bacterial susceptibility and resistance patterns and antibacterial drugs. There simply is no overlap between conducting clinical trials for one blood-based genetic disorder and providing information related to antibiotics and bacteria.

Accordingly, there is no likelihood of consumer confusion between Applicant's Mark and the Cited Application. Applicant therefore respectfully requests that the Examining Attorney refrain from issuing a refusal based on the Cited Application and allow the Application to proceed.

**CONCLUSION**

Applicant respectfully requests that the Examining Attorney withdraw the refusals based on the Cited Symposia Mark and Cited Heart Mark and the Cited Application. In the event the Examiner is not willing to withdraw the refusal as to the Cited Application, Applicant requests that the Examiner place Applicant's application in suspension pending the outcome of the Cited Application.

Respectfully submitted,

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