

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Medical Diagnostic Laboratories, LLC

SERIAL Nos: 88668951 **Dermaveda**

FILED: 10/25/2019

ATTY DOC. No.: T - 186

The Examining Attorney issued an Office Action that is a nonfinal refusal of registration under Section 2(D) of the Trademark Act alleging that Applicant's trademark causes a likelihood of confusion with the following mark : "Dermveda" Registration No.: 5186773 "Cited Mark".

- Dermveda: Providing a website and online database both featuring information on health, wellness, diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care in International Class 44. "Cited Mark"
- Applicant's Mark: Medical analysis services for diagnostic and treatment purposes provided by medical laboratories, namely, diagnostic laboratory tests physicians in the dermatology or dermatopathology specialty, molecular diagnostic tests for skin and soft tissue infections by Real-Time PCR, traditional pathology testing of biopsy specimens, nail analysis for fungal pathogens by both molecular analysis Real-Time PCR), pathology, immunohistochemistry testing for skin biopsies, genetic testing for hereditary genetics and tumor analysis, and pharmacogenomic testing. "Applicant's Mark" and collectively with Cited Mark, the "Marks."

The Examining Attorney found (1) the Marks similar in sound, appearance and commercial impression and (2) the Parties (defined as both Applicant and Registrant) services are related.

Applicant respectfully traverses Examining Attorney's refusal because (i) Applicant's Mark is dissimilar from Cited Mark in appearance, (ii) the Marks have different identification of services, (iii) the Cited Mark is descriptive, and must not receive strong protection (the Office has affirmed this position in at least one prior registration using the term "derm,") and (iv) the

Parties' employee different channels of commerce with different types of consumers. Applicant respectfully requests the Examining Attorney to permit publication.

As a preliminary matter Applicant thanks the Examining Attorney for pointing out and suggesting amendments to the identification of services and states the following amendment.

Medical analysis services for diagnostic and treatment purposes ~~provided by medical laboratories,~~ namely, diagnostic laboratory tests for physicians and hospitals in the dermatology or dermatopathology specialty, molecular diagnostic tests for skin and soft tissue infections by Real-Time PCR, traditional pathology testing of biopsy specimens, nail analysis for fungal pathogens by both molecular analysis Real-Time PCR), and pathology, immunohistochemistry testing for skin biopsies, genetic testing for hereditary genetics and tumor analysis, and pharmacogenomic testing [strikethroughs delete; underline added].

Applicant states the amendments clarify and do not broaden the prior description of services.

I. The Marks are Distinguishable.

Consumers can distinguish the marks based on their differences. Applicant's Mark incorporates the letter "a" subdividing its mark into two equal components. The Examining Attorney deemed this insignificant but the case law holds otherwise. The strategic placement of the letter "a" in Applicant's Mark creates a four syllable term pronounced as "Der-ma-ve-da." Cited mark is "Derm-ve-da" only three syllables. Because, the Marks differ in their pronunciation and visual appearance, consumers can distinguish the two marks as a source of goods. As explained below, Applicant submits that Cited Mark is weak and deserving of only narrow protection, rendering this sound and visual difference the more significant vis-à-vis a weak mark like Cited Mark.

It is well known that a conflicting mark is taken as a whole rather than broken up into component parts for comparison, as it is the overall impression that the marks creates on the buyer that is important. McCarthy on Trademarks and Unfair Competition, Section 23.15(1)(a)

(3d. Ed.). “Phonetic similarity alone is insufficient in this case to establish as a matter of law that the uses of the respective marks are likely to cause confusion.” See, *Old Tyme Foods, Inc. v. Pounding’s, Inc.*, 961 F.2d 200, 202-03; 22 U.S.P.Q.2d 1542, 1544-45 (Fed. Cir.1992). The Examining Attorney referred to these as “[s]light differences in the sound of similar marks will not avoid a likelihood of confusion.” OA 1/28/2020 TSDR p. 1. Applicant disagrees with this position and the case law supports Applicant’s position.

Even small distinctions between mark can negate any likelihood of confusion. Additional words, and even mere letters, render marks distinguishable. See *Vision, Inc. v. Parks*, 226 U.S.P.Q. 924, 927 (S.D.N.Y. 1985) (additional letters “U.S.A.,” although small, did distinguish VISION U.S.A. from VISION in overall appearance); *Lever Bros. Co. v. The Barcolene Co.*, 174 U.S.P.Q. 392, 393 (C.C.P.A. 1972) (no likelihood of confusion between ALL and ALL CLEAR for household cleaners because the commercial impression of “ALL CLEAR” is derived by mark as a whole and not merely by the word “ALL” or “CLEAR”). *Textron, Inc. v. Arctic Enterprises, Inc.*, 178 U.S.P.Q. 315, 318 (T.T.A.B. 1973) (EXT “readily distinguishable” from TX due to arrangement of letters and use of an additional letter). The same is true for Applicant’s mark. As these cases hold, even small differences like the placement of the letter “a” can distinguish the source of goods and services. Small as it is, it still provides a basis to distinguish the source of goods, particularly because Cited Mark is weak and descriptive only. The Marks’ pronunciation and sound are sufficient to distinguish the Marks even by a single letter.

Also, aural differences distinguish the Marks. The Marks are not the phonetic equivalent of each other. Applicant’s mark has a balanced sound to it, absent in Cited Mark. The letter “a” combined with the three (3) syllable structure allows purchasers would be commonly known to

the consuming public. See *Lebow Bros. Inc. v. Lebole Euroconf. S.P.A.* 212 USPQ 693, 695 (E.D. Pa. 1980) (finding that the usual or likely pronunciation by the public impacts whether there is a likelihood of confusion exists.). Linguistically, the Marks are dissimilar because they have different stress patterns and definitely sound different because of the letter “a” present in Applicant’s Mark. For example, the “a” is stressed in Applicant’s Mark versus “veda” for Cited Mark.

As explained below, the Office considers the term “Derm” descriptive indeed a “weak” mark incapable of sourcing goods. Accordingly, Applicant’s Mark can come closer to Cited Mark without any likelihood of confusion as stated below. Applicant respectfully disagrees with Examining Attorney’s position and believes the Marks are dissimilar enough in appearance to minimize any likelihood of confusion because Cited Mark is weak in strength.

II. The Purchaser’s Identity and the Conditions of Sales Eliminate a likelihood of confusion.

The Parties’ purchasers are different and the conditions of sales makes any likelihood of confusion merely speculative. Confusion is less likely where the goods or services are “relatively expensive items purchased with a certain amount of care and thought, rather than inexpensive items purchased on impulse.” *McCarthy* § 23:27; *Information Res., Inc. v. X*Press Information*, 6 U.S.P.Q.2d 1034, 1039 (T.T.A.B. 1988); *Holding Co. of the Villages Inc. v. Power Corp.*, 101 USPQ2d 1528 (M.D. Fla. 2012) (no likelihood of confusion between THE VILLAGES and VILLAGE(S) OF LAKESIDE LANDING because buyers of real estate are considered sophisticated, not average, consumers); *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 1957 (T.T.A.B. 2006) (no likelihood of confusion despite overlap in goods—communication servers and computers—because goods are not purchased on impulse and

purchasers of such goods “must be considered sophisticated”); Astra Pharm. Prods., Inc., 220 U.S.P.Q. 786, 790-791 (1st Cir. 1983) (holding the "most critical factor" in finding no likelihood of confusion was the sophistication of the purchasers).

Physicians and hospitals purchase Applicant’s services to diagnose cancers. Cited Mark provides a “wellness database,” a far cry from Applicant’s services. Far from being impulse buyers, Applicant’s purchasers are very discerning consumers. Registrant’s consumers are ordinary non-medical purchasers. Applicant uses medical agreements in its transactions and does no online selling like Registrant. Applicant has no online database of “wellness” like Registrant. Applicant’s purchasers use care in investigating its providers like Applicant for reliable service.

To suggest they would consider the Parties’ services under one mark is remote and unreasonable. It would defy logic to conclude that Applicant’s highly sophisticated and discriminating consumers would likely be confused as to the source of the Parties’ services, especially with Registrant. Applicant provides life or death services; Registrant a “website and online database.” The two services are inapposite to each other.

Further, Applicant objects to Examining Attorney’s description of Registrant’s medical information for Registrant’s website and states Registrant does not provide medical information. Registrant provides information relating to and pertaining to the sale of cosmetics. With all due respect, Examining Attorney conflates Applicant’s services, cancer diagnosis with Registrant’s database? No comparison exists and this should be obvious. Thus, consideration of the relevant sophisticated consumers decidedly weighs against a finding of likelihood of confusion.

Nor is Registrant's services –a “website and online database both featuring information” even within Applicant's identification even with a plain reading of the description of services. To suggest the two Parties are related is a non sequitur. No physician or hospital would consult Registrant's “website and online database both featuring information” for a diagnostic test for skin cancer. Further, Applicant objects to any assertion Registrant provides medical information.

a. The Parties Trade Channels are Different

Where the channels of distribution and/or advertising of goods and services are different, the likelihood of confusion between similar marks decreases. See *Electronic Data Systems*, 23 U.S.P.Q.2d at 1462-63 (finding the plaintiff advertised its computer services through brochures, direct mail and presentations targeted at the general public. *Id.* at 1462. Applicant marketed mark “only in trade journals directed to the electrical engineering profession.” *Id.* at 1463. No confusion as marks not encountered by the same customers).

The Parties' market and services are different. Applicant does no online sales. It maintains no website like Registrant which is a “website/database.” Registrant states it is a provider of a website and an online marketer of cosmetics. See Exhibit 1 Dermveda Find my skin type page (1) “We take the guess work out of skin care, skin – body-mind, your gut and sleep health matter, it's all about mind over skin” - a cosmetic pitch. Dermveda's sales focus on holistic approaches to its online sales.

We believe in a holistic approach to health. Your skin, body, and mind are intimately connected so that's why we want to help you as a whole person -- not just your skin. *id.*

Registrant is an online database and no person can find relatedness to Applicant. See Exhibit 2 Dermveda P. (1) for Mediterranean skin qualities. Registrant offers exciting

opportunities “that allow you [consumers] to better educate yourself on the products you put in your body and apply to your skin.” See Exhibit 3 Mobile Application Android/iOS p. 1. Note Registrant’s connection between selling “products” and the “website and online database both featuring information” Registrant’s mission statement summarizes its services:

Our Mission

At Dermveda, we believe that skin health reflects your overall well-being. Our experts are committed to empowering you on your personal journey to harmonise your mind, body and skin. We bridge thousands of years of traditional knowledge with latest science to give you personalised solutions for Better Skin, Better Health, Better YOU. See Exhibit 4 Our Mission Statement

Exhibit 3 shows Registrant’s marketing through mobile phone services. The services and trade channels of the Parties do not intersect and no reasonable person would believe they do. That Dermveda, is a “website and online database both featuring information” means just that – a website which does not in any manner relate to Applicant’s services. That information is outside of Applicant’s description of services as a medically licensed laboratory.

The Office Action states that though, “purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks.” OA TSDR p. 1 5/22/2020. “When the relevant buyer class is composed of such professional purchaser, the likelihood of confusion is lower.” Homeowners Group, Inc. v. Home Marketing Specialists, Inc., 931 F. 2d 1100 (6th Cir. 1991). Because that is true here - that Applicant’s purchasers are sophisticated, knowledgeable and investigative of their purchases confusion is unlikely and this fact is relevant, probative and dispositive. The reasons that purchasers would even seek out Applicant’s services is totally different from Registrant’s purchaser’s motivation. The services are not encountered together to create incorrect assumptions as to their source.

The Parties' services are available on different platforms and are targeted toward very different consumers. Accordingly, any likelihood of confusion is unlikely given no intersection of trade channels. This fact makes any likelihood of confusion virtually non-existent and highly speculative.

b. The Descriptions are not legally identical nor related.

Applicant sells a narrow subset of services, medical diagnostic testing for cancers and other serious ailments. Registrant uses terms like medical and dermatology but solely in the context of its "website and online database featuring information."¹ Registrant does not provide medical information just information. No consumer would mistake the two even in light of the Examining Attorney's extrinsic evidence. Physicians purchase Applicant's services only after performing a careful investigation. The services are not legally the same or are readily understood to be the same.

Just because the services may have something to do with "health" does not make them per se related by their descriptions. See *In re Iris Data Services, Inc.* Serial No. 86455558 (TTAB Apr. 24, 2017) (Board rejects evidence that the term "legal services" and "legal discovery and legal document review" – the latter is within the former). Applicant services are not related to Registrant's services simply due to an informational website. Registrant's website does not proffer medical information. The Examining Attorney categorized the services as "health industry" one of the largest and broadest possible measures. This is insufficient to establish a relationship between the two services. See *In Re White Rock Distilleries Inc.*, 93 USPQ2d 1282 (TTAB 2009), (categorizing wine and vodka as "alcoholic beverages" -

¹ Noticeably, Registrant provides "information" but not "medical information" and this fact is dispositive because "information" and "medical information" are entirely different in scope, method and use.

insufficient to establish relationship). A shared industry or field does not automatically mean a sufficient relationship or identical target market. Here, Applicant's industry is medical diagnostic services for cancers and this fact alone is relevant and dispositive. Registrant's industry is not medical information remotely comparable to Applicant's services.

Applicant has licenses in all fifty jurisdictions (50) to perform its services. Examining Attorney minimizes this point and Applicant respectfully disagrees. This fact is critical because in any likelihood of confusion analysis the Registrant's cannot legally perform nor inform of information of a medical nature. This means the services are distinct and not related. Noticeably, the Examining Attorney third party evidence from Quest and LabCorp are all licensed medical laboratories – which Registrant is not. Registrant doesn't comport with this evidence as a “website and online database both featuring information.”

The Parties descriptions are not the same and Examining Attorney has conflated them and misapplied the Registrant's description concluding the services are related. They are not and a plain reading of the Parties' descriptions proves they are not.

III. Dermveda should not receive strong trademark protection.

The Examining Attorney must not give Dermveda strong protection as the mark is weak and descriptive. Moreover, on at least one occasion the Office has affirmed this position. The 1/28/2020 Office Action p. 1 states, “that both “DERM” and “DERMA” are prefixes/suffixes used to refer to the skin.” Therefore, “derma” and “derm” terms render “Dermveda” a weak mark at the least descriptive.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of an ingredient, quality, characteristic, function, feature, purpose, or use of

the goods or services with which it is used. See, e.g., *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). This true for Cited Mark as it too functions as a feature, “skin.”

Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1818, 1831 (Fed. Cir. 2007); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1473 (TTAB 2014); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

The issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016). A mark is “merely descriptive” within the meaning of § 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709.

Dermveda refers to skin, and consumers well know this. A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. See, e.g., *Fat Boys*, 118 USPQ2d at 1515. Dermveda requires neither suggestion or imagination making it descriptive.

The Office must not give Dermveda strong protection. “In order to determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive, arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). Does Dermveda “convey[s] any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *Fat Boys*, 118 USPQ2d at 1515-16 (quoting *Oppedahl & Larson*, 71 USPQ2d at 1372). If each word instead “retains its merely descriptive significance in relation to the goods [and services], the combination results in a composite that is itself merely descriptive.” *Id.* at 1516 (citing *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); see also *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1953-55 (TTAB 2018).

In the context of a likelihood of confusion analysis, the commercial strength of a mark is not a binary factor, “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). The Cited Mark is not inherently strong and must be afforded weak protection.

Further, descriptive terms received little weight. See, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 751). Descriptiveness is considered in relation to the relevant services and obviously consumers will recognize “Derm” as descriptive.

a. Extrinsic third party evidence shows Dermveda is inherently weak.

Applicant offers third party registration showing the Office regularly registers marks with the term “derm” and that this term is commonly used in IC 044 same as Applicant.

Registrations

- Exhibit 5 – forty -seven (47) records with the term “Derm” within them and all in IC 044 and all inclusive of the word “skin.”
- Exhibit 6 – 16 of the 47 records are live records with registrations.
- Exhibit 7- Good Derm - Notice of Allowance for Good Derm;
<https://tsdr.uspto.gov/documentviewer?caseId=sn88438234&docId=ALW20200407074504#docIndex=0&page=1>; Date Accessed 10/6/2020
- Exhibit 8- InDERM – Registration certificate
<https://tsdr.uspto.gov/documentviewer?caseId=sn79154314&docId=ORC20150908001225#docIndex=6&page=1>; date accessed 10/6/2020.
- Exhibit 9 Futurederm – Registration certificate
<https://tsdr.uspto.gov/documentviewer?caseId=sn85675230&docId=ORC20130226005310#docIndex=4&page=1>; dated accessed 10/6/2020.
- Exhibit 10 FirstDerm – Registration Certificate
<https://tsdr.uspto.gov/documentviewer?caseId=sn87196946&docId=ORC20171015155234#docIndex=0&page=1>; Date Accessed 10/6/2020
<https://tsdr.uspto.gov/documentviewer?caseId=sn87160852&docId=ORC20180708024330#docIndex=1&page=1>; Date Accessed 10/6/2020
- Exhibit 11 DP Derm
https://tsdr.uspto.gov/#caseNumber=87160852&caseType=SERIAL_NO&searchType=statusSearch; Date Accessed 10/6/2020
- Exhibit 12 Derm skin care support Registration Certificate
https://tsdr.uspto.gov/#caseNumber=88164399&caseSearchType=US_APPLICATION&caseType=SERIAL_NO&searchType=documentSearch; Date Accessed 10/6/2020
- Exhibit 13 Vero Derm
<https://tsdr.uspto.gov/documentviewer?caseId=sn88288022&docId=ORC20190728032104#docIndex=0&page=1>; Date Accessed 10/6/2020
- Exhibit 14 OTC Derm
<https://tsdr.uspto.gov/documentviewer?caseId=sn88759829&docId=ORC20200615105535#docIndex=0&page=1>; Date Accessed 10/6/2020.

All these registrations use the term “Derm” in IC 044 yet the Office saw fit to issue registrations. Obviously, no likelihood of confusion existed to bar these marks. If these marks

issued without a likelihood of confusion then so too must Registrant's Mark issue. This table underscores this point further (underline shows common description with Registrant's description). Applicant's comments appear within each column in italics.

<u>Registrant's Description IC 44</u>	<u>In Derm R. 4806023</u>	<u>Futurederm R. 4295645</u>	<u>First Derm R. 5320860</u>
Providing a website and online database both featuring information on health, wellness, diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care	<p><u>Medical services; consultancy services relating to the <u>medical and cosmetic care of the skin</u>; hygienic and <u>beauty care</u> for human beings.</u></p> <p><i>Cosmetic care of the skin and beauty care.</i></p>	<p><u>Providing a web site featuring information about health and wellness, namely, <u>skin care and dermatology, beauty, nutrition, and personal development, and featuring links to health- and wellness-related</u> merchandise for retail purposes.</u></p> <p><i>Registrant and '645 both provide a website for information purposes for skin conditions.</i></p>	<p><u>Providing a website featuring information regarding <u>skin-related medical conditions affecting humans.</u></u></p> <p><i>Registrant and '860 both provide a website for information purposes for skin conditions.</i></p>

<u>Registrant's Description IC 44</u>	<u>DP Derm R. 5522016</u>	<u>Derm Skincare Support R. 5774456</u>	<u>Vero Derm R. 5834313</u>
Providing a website and online database both featuring information on health, wellness, diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care	<p><u>Cosmetic <u>skin care services</u>, namely, microdermabrasion.</u></p> <p><i>Cosmetic skin care services</i></p>	<p>Pharmacy advice and compounding services in connection with pharmaceuticals used for <u>dermatologic and cosmeceutical <u>skin care therapy</u></u>.</p> <p><i>Cosmetic skin care therapy</i></p>	<p><u>Cosmetic face care services; Cosmetic <u>skin care services</u>; Laser hair removal services; Laser <u>skin</u> rejuvenation services; Laser <u>skin</u> tightening services; Laser tattoo removal service; <u>Medical services</u>; Medical clinic providing weight loss solutions, services and programs, nutrition counseling, hormone therapy, including, bioidentical hormone replacement, anti-aging therapy, and natural hormone therapy, medical aesthetic procedures, including, laser hair removal, laser peels, botulinum toxin treatments, microdermabrasion,</u></p>

		liposuction, vein treatments, vein therapy, cellulite treatments, body contouring treatments, injectable filler treatments, <u>facials, and skin care; Medical diagnostic testing, monitoring and reporting services; Medical skin care services; Medical spa services, namely, minimally and non-invasive cosmetic and body fitness therapies; Skin care salon services; Wellness and health-related consulting services; Clinical medical practice consultation services; Plastic surgery services that integrate traditional western medical practices with holistic therapies; Providing medical information, consultancy and advisory services; Providing wellness services, namely, weight loss programs offered at a wellness center; Providing medical aesthetic procedures, namely, treating the skin with dermal fillers and botulinum toxin.</u>
--	--	-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

Two of the above extrinsic Registrations also provide a “website “ featuring the same health information as Registrant – no likelihood of confusion between these two and Registrant and the marks registered. All the registrations recited “skin care” – no likelihood of confusion and the marks registered. Obviously the term, “Derm” in IC 044 is commonplace with respect to skin care. If these registrations issued so too must Applicant’s Mark issue. The public expects to see this term. Its commonality renders “derm” a weak mark.

Third party use of a similar marks is evidence of its strength or weakness of that mark. Old Tyme Foods, Inc. v. Roundy’s Inc. 22 USPQ2d 154, 1545 (Fed. Cir. 1992)) evidence of actual use of similar marks for similar goods can reasonably support an inference that the assert mark is weak); see also Shoe Corp. of America v. Juvenile Shoe Corp, 121 USPQ 510 (CCPA

1959) finding it proper to take notice of extent to which LAZY was used in trademarks by others on similar merchandise.

That the Office found no likelihood of confusion for all these marks despite the shared term and common descriptions means consumers are conditioned to this term, “derm.” See *In re Broadway Chicken Inc.*, (third party use of marks with a shared term can suggest that purchase have been conditioned to look at other elements to distinguish the source of goods or services).

Moreover, that the cited registrations exist in a crowded field “health” and all in IC 044 with the term “Derm” means the Office found no relatedness in the parties’ services and a narrow scope of protection. See *Miss World Ltd. v. Mrs. American Pageants, Inc.*, 859 F. 2d 1445, 1449 (9th Cir. 1988) (finding crowded field portends relatively weak mark in ability to stop others from using in that crowded field and less likely to be confused because consumers have learned to discern each mark.).

Considering this commonplace term “derm” for skin service enterprises, consumers are not likely to view this word as a single source of origin in their minds. “The greater the number of identical or more or less similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark.” *First Saving Bank, F.S.B. v. First Bank Sys.* 101 F.3d 645, 653-654 (10 Cir. 1996).

Applicant submits the shared term is weak, underserving of strong protection by the Office. It is unlikely to invoke a source of services. Further, given the number of marks issued by the Office, evidently the Office views this shared term “derm” as unlikely to give rise to confusion in the marketplace.

b. In at least one instance the Office held “Derm” to be Descriptive.

Applicant submits Office Action Serial No. 87196946 Registration No. 5320860;
1/18/2017 TSDR p. 1 stating in pertinent part and requiring a disclaimer of the term “Derm”

“Disclaimer Required

Applicant must disclaim the wording “DERM” because it merely describes a characteristic, function, feature, purpose, or use of applicant’s goods and services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

Please see the attached dictionary definition of “DERM,” which is “another term for dermis,” or the skin. See Exhibit 1 attached. Applicant’s goods and services pertain to skin-related medical conditions. As such, the term “DERM” in the mark merely describes a characteristic, function, feature, purpose, or use of applicant’s goods and services, and must be disclaimed.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and services in the marketplace. *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “DERM” apart from the mark as shown.”

See Exhibit 15

<https://tsdr.uspto.gov/documentviewer?caseId=sn87196946&docId=OOA20170118134427#docIndex=10&page=1> accessed 10/8/2020.

Applicant disclaimed “Derm” term. See Exhibit 16

This underscores the point that the shared term “Derm” remains weak and undeserved of strong protection. Accordingly, Applicant can come closer to Cited Mark without any likelihood of confusion. Applicant does not attempt to “collaterally attack” Cited Mark but Applicant is permitted to proffer evidence of a third party registration to demonstrate that (1) the shared term is weak and only entitled to narrow protection; See TMEP 1207.01 (d)(iii); (2) that Applicant’s denial of publication is not consistent with the Office’s past position and (3) other extrinsic third party registrations using the term “derm” in the same IC code and the same word descriptions issued without a likelihood of confusion.

Moreover, Applicant submits that its description of services is even further removed from Registrant’s description of a “website and online database both featuring information” vis a vis the above third party registrations shown because its description truly pertains to medical analysis services whereas Registrant’s does not at all. See below wherein only the term “dermatology” and “medical” are actually in common. The following chart compares the services of each mark.

<u>Applicant’s Mark</u>	<u>Registrant’s Marks</u>
<p>Medical analysis services for <u>diagnostic and treatment purposes provided by medical laboratories, namely, diagnostic laboratory tests physicians in the dermatology or dermatopathology specialty, molecular diagnostic tests for skin and soft tissue infections by Real-Time PCR, traditional pathology testing of biopsy specimens, nail analysis for fungal pathogens by both molecular analysis Real-Time PCR), pathology, immunohistochemistry testing for skin biopsies, genetic testing for hereditary genetics and tumor analysis, and</u></p>	<p>Providing a website and online database both featuring information on health, wellness, diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care in International Class 44.</p>

<u>pharmacogenomic testing in International Class 44.</u>	
-----------------------------------------------------------	--

The underlined portions indicate where Applicant’s description of services is dissimilar to Cited Mark. Examining Attorney’s position is unreasonable because (1) a clear reading of the description of the parties which is the only basis for similarity of services by law proves that Applicant and Registrant do not occupy the same space as Registrant nor do they compete for the same purchasers. If Applicant is further removed from Registrant’s description of services, then Applicant is even further distant for the above cited registrant’s description. Applicant respectfully asks Examining Attorney to reconsider his position and permits publication of Applicant’s Mark.

IV. **Contrary to the Examining Attorney the Services are not related.**

a. **The Examiner’s internet evidence does not establish relatedness of the services.**

The extrinsic screenshots of Quest Diagnostics®, University of Michigan® Labs, and UHMC Health, stating “that the same entity commonly provides the relevant services and markets the services under the same mark” is not correct. For example, “Quest Diagnostics® provides an array of diagnostic medical tests, as well as a website featuring in-depth information on those tests and health conditions in general.” Examiner concludes that, “because it is common in applicant’s and registrant’s industry to provide both applicant’s diagnostic testing services and registrant’s health information services, the services are considered related for purposes of likelihood of confusion. OA 1/28/2020 p.1. Applicant disagrees and traverses this position because (1) Registrant does not provide health information comparable to Applicant and

(2) The Parties are not related because they each occupy different segments of the health industry.

First, the screenshots are not representative of the facts. Registrant performs no diagnostic medical tests. See Registrant's description. It merely provides a "website and online database both featuring information" of a type call health information but this by no means is the comparable to Applicant's services – i.e. diagnostic medical tests for cancer etc. A website is not the same as Applicant's description of services and this point is critical.

The extrinsic evidence improperly imputes or suggests what Quest or LabCorp does to the Registrant. This is not correct because the relevant fact is Registrant performs no medical diagnostic testing, provides no medical information (health information is not the same) and by its own description is just a website. Therefore, the extrinsic evidence does not show it is commonplace to offer both services under one mark because Quest and Registrant are completely different types of entities. Quest does perform medical diagnostic testing for cancer.

For example, that Quest Diagnostic, "provides an array of diagnostic medical tests" may be true but Registrant performs no diagnostic medical tests. Hence Quest Diagnostics cannot serve as an appropriate reference. In other words, providing a "website and online database both featuring information" is not the same as performing medical diagnostic testing. For this reason, Applicant objects to this extrinsic evidence as inappropriate references.

While Applicant and Registrant may provide services to humanity, lumping Registrant's "website and online database both featuring information" into the same category as Applicant's i.e. – "health" fails to recognize significant differences between the two Parties. It ignores the differences Applicant plays versus Registrant's services. Applicant traverses this comparison by

Examining Attorney. Applicant objects to the Examiners extrinsic evidence with these comments for the OA 5/22/2020 TSDR cited page number: based on the parties description of services.

- LabCorp Services p. 3 Comment – Comment Applicant objects; Recites “employee wellness with body measurement, H pylori breath tests, employee drug testing.” Registrant provides a “wellness” website, it performs no H. pylori breath testing; it perform none of the aforementioned tests, nothing herein related to skins disorders. Nothing in this evidence pertains to Applicant’s services specifically, diagnostic testing of skin disorders and other ailments. All healthcare entities provide a website for wellness but in this case the subject evidence does not show applicant and registrant services under a common mark.
- LabCorp p. 4 Comment – recites to “biopsy” and “skin.” Applicant performs biopsies; registrant’s description states “dermatology and medical and cosmetic skin care,” Applicant states: Registrant description performs no biopsies or diagnostic testing; Screenshot fails to show LabCorp performing both biopsies of skin and providing a website and online database advice on skincare; diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care. Applicant objects to this screenshot as evidence of relatedness.
- LabCorp Services p. 5 Comment Applicant performs “genetic testing for hereditary genetics.” Registrant does not perform “genetic testing for hereditary genetics.” Registrant description states “dermatology and medical and cosmetic skin care,” and no recitation of genetic testing. Evidence fails to show Registrant’s services specifically providing a website and online database both featuring information on health, wellness, diet, medicine, preventative medicine, alternative medicine, natural medicines, homeopathic medicine, medical and cosmetic uses of botanicals, dermatology, and medical and cosmetic skin care. Applicant objects to this screenshot as evidence of relatedness.
- LabCorp p. 6 Comment – Applicant performs immunohistochemistry; no recitation by Registrant of performing immunohistochemistry as per Registrant’s own description of services. No commonality of source of services under one mark. Applicant objects to this screenshot as evidence of relatedness.
- LabCorp p. 7 Comment – neither applicant nor registrant perform diagnostic testing for “Dengue Fever.” Registrant’s description of services does not include this testing. No commonality of source of services under one mark as source of services. Applicant objects to this screenshot as evidence of relatedness.

- Reveal Bioscience p. 8 Comment – applicant performs immunohistochemistry; no recitation by registrant of performing immunohistochemistry. Same comment as above for page 7. No commonality of source of services under one mark.
- Reveal Bioscience p. 9 Comment – Same comment above as for page 8. No commonality of source of services under one mark.
- Reveal Bioscience p. 10 Comment – Evidence is recitation of scientific publication on unrelated science articles; this appears to be advertisements without indicating registrant and applicant’s goods under the ; Not relevant to establish relatedness.
- Reveal Bioscience p. 11 Comment – Evidence of formation of clinical research consortium. Not relevant to show single source of services under one mark for either applicant or registrant’s services together.
- Mdbiosciences p. 12 Comment – Evidence for COVID – 19 response. Not relevant to show single source of services under one mark for recited services of applicant and registrant. Registrant does not perform Covid testing as per its services description. No evidence its “wellness” or “database” provides information on Covid 19. Evidence refers to preclinical services not performed by either Registrant

Applicant further objects to the proffered evidence with these comments OA 1/28/2020

TSDR: based on the parties description of services as follows:

- Dermveda p. 1 Comment for all the reasons set forth herein applicant objects to this evidence.
- Quest Diagnostics p. 7 Comment – Generalized discussion of various types of health related issues; no recitation of applicant and registrant’s services under a single mark as source of services.
- Quest Diagnostics p. 8 Comment – Generalized listing of medical conditions none of which pertain to applicant and registrant’s services; overly broad and generalized in scope, insufficient to establish relatedness; discussion of various types of health related issues; no recitation of applicant and registrant’s services under a single mark as source of services.
- Michigan Medicine University of Michigan p. 9 – refers to cytopathology; neither applicant nor registrant recited cytopathology.
- Michigan Medicine University of Michigan p. 10 – refers to diagnostic services applicant performs molecular diagnostic tests for skin, and performs no other tests

listed in evidence; registrant performs none of the listed tests nor does it perform diagnostic testing.

- Michigan Medicine University of Michigan p. 11 – applicant and registrant neither perform bone density testing nor breast feeding services recited in the evidence.
- P. 12 comment – Neither applicant nor registrant perform radiology testing. Not relevant. Evidence does not show both registrant and applicant services under the same mark.

b. The Evidence does not establish the required Nexus.

None of the Internet evidence demonstrates that necessary nexus between the services offered by Applicant and Registrant and all under the same mark. The Examining Attorney is attempting to link medically licensed laboratories like Labcorp and Quest, equating them to a “website and online database both featuring information” about health. This speculative connection does not portend relatedness and is dubious more like comparing apples to oranges. Applicant performs services; Registrant offers “information” on a “website and online database” the two are totally unrelated. The evidence does not demonstrate that Registrant or Applicant’s business are included within the other. That Registrant is an informational online website cannot be disputed, Examining Attorney has improperly taken this fact and equalized Registrant to Applicant’s services.

The Examining Attorney’s extrinsic evidence is scant with generalized depictions of services from organization that the Registrant is not. Applicant calls into question the probative value of this evidence to establish relatedness because it refers to activities or services of Quest, not performed by Registrant at all. Quest’s health information greatly differs from Registrant’s health information on its website and this is obvious upon sight.

That Registrant cannot legally perform any of Quest or LabCorp's services is damning evidence against relatedness. This point alone should moot any relatedness. Registrant's description of services is not a healthcare description to be compared to Applicant's merely because it contains the word "dermatology." Merely referring to "dermatology" an extremely broad term is not the same as Applicant's services because dermatology is a very broad field. The Applicant and Registrant do not even intersect in their services because they cannot legally intersect. Applicant traverses the evidence and states its objections herein.

Nor can the Examining Attorney rely on this evidence using general statements of relatedness in some common level of generality to conclude the Parties services are related. See *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977); *Harvey Hubell Incorporated v. Tokyo Seimitus Co., Ltd.* 188 USPQ 517 (TTAB 1975) (finding insufficient for relatedness that a particular terms or use may be found to generally describe the goods or services.) Examining Attorney's evidence consists of screenshots with generalized statements of the third party services purporting to render medical services which Registrant does not describe nor perform. Many elements of Applicant's description are lacking in the extrinsic evidence. That Registrant's description of services refers to dermatology or medical skin care or preventive medicine does not portend or even suggest relatedness to Applicant's services.

With all due respect, this evidence is mistakenly takes Registrant for a medically licensed laboratory, which it is not. Registrant is not capable of performing medical diagnostic testing nor analysis and this should be apparent from its own description.

c. **The Examining Attorney must show “something more” than overbroad and generalized evidence.**

Examining Attorney is “shoehorning” Applicant into Registrant’s service space by equating a “website and online database” featuring health information with medically licensed diagnostic testing and analysis for skin cancer, for example. “Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012). TMEP 1207.01(a)(i). Registrant, provides “a website and online database” that is informational only. Applicant performs diagnostic testing and analysis. The Parties offer totally different services and the Examining Attorney has conflated to two as equals. They are not equal nor related in services.

“[W]hen the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. In re *St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness).

Because no consumer would seek Registrant’s services for medical diagnosis of skin cancer or immunochemistry services, more support than the above internet evidence is required to find the services related. Examining Attorney offered no evidence to establish that “something more” or “nexus” other than the third party screenshots with general statements and some with websites. Essentially, Examining Attorney’s argument is

If Quest offers health information on their website, and Registrant's also offers health information on its website, then Registrant and Quest services are related services, because they both offer health information on their websites and health is the relevant industry, in which case, Registrant's services must be related to Applicant's services because Applicant also health information on its website same as Quest and Registrant.

The problem with this reasoning is that Registrant is only an informational website. That Quest offers health information is true, but Quest and Registrant do not offer related services merely because they both offer health information on their websites. Thousands of websites offer health information which in no way equates them to Registrant or to Quest. Quest is a medically licensed laboratory, Registrant is not.

Registrant's own description of services is a "website/online" database. Applicant is neither of these two and in fact it offers no health information on its website. Though Registrant and Quest offer healthcare information, this information is completely different information and even the Examining Attorney's evidence established this fact. Because of this difference, Registrant's and Quest's websites cannot be compared as related. Even if, for arguendo sakes, Applicant is related to Quest, which Applicant does not admit, it is not related to Registrant, simply due to health information disclosure on Registrant's website.

Examining Attorney as not shown in sufficient detail to establish nexus under one single mark. ". . . examples of actual use of a mark for both the goods and services at issue and/or evidence of a large number of third-party registrations covering both the goods and services at issue may suffice." TMEP 1207.01(a)(ii). [underline added]. Nothing presented by the Examiner's extrinsic evidence shows that the services "cover both the goods and services at issue," [underline added] together. It only shows that Quest and Registrant use websites to

display health information and this is insufficient to establish relatedness to Applicant's services. Any claim of relatedness is speculative at best.

The Examining attorney must provide evidence to show that the goods and services are related to a likelihood of confusion and not merely suggestive evidence. See *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together).[Emphasis added].

The Examining Attorney's extrinsic evidence, do not show the services can emanate from a single source under a single mark. Much of the evidence doesn't even show Registrant's services other than in generalized statements. There is nothing inherently related to cosmetics and medical laboratories implying relatedness is speculative. The Parties services are unlikely to result in an overlapping of classes of customers.

Nor is the evidence sufficient to demonstrate that both Applicant and Registrant's services travel in similar trade channels with overlapping classes of consumers because it does not show that a single entity provides both Applicant's and Registrant's goods under a single mark. The mere fact that Registrant may possibly move in the same channels with Applicant – i.e. through licensed medical professionals, (highly unlikely as Registrant is neither a medical service nor licensed laboratory) for the same class of purchases does not ipso facto prove there is a definite relationship between the goods. See *Champion International Corp. v. Genova, Inc.*, 199 USPQ at 305. See also *Canada Dry Corp. v. American Home Product Corp.*, 468 F.2d 207, 175 USPQ 557 (CCPA 1972) (despite the fact that applicant's laundry detergent is sold in the same channels of trade to the same consumers as opposer's soft drinks, the two products are so

different in their essential character and purpose that there is no likelihood of confusion); Alliance Mfg. Co., Inc. v. Chicago Musical Instrument Co., 184 USPQ 118, 121 (TTAB 1974). Purchasers cannot conceive of Applicant's services as the same kind as Registrant's services in their mind as to the origin of the goods because the two products "are so different in their essential character and purpose that there is no likelihood of confusion." Id. at 121.

Examining Attorney states that the services "need only be related in some manner," if the circumstances" are such that marketing are likely to give rise to a mistaken believe that the goods emanate from the same source, See OA p. 1. This is not accurate, as "something more" is required than just "some manner." Examining Attorney must establish relatedness beyond "some manner" and the proffered evidence fails this test because is merely shows Registrant's and Quest's website offer health information (as millions of sites do and Applicant disagrees with this position) but implies Registrant and Applicant can market their services under one mark. Registrant cannot legally do so. Nothing proffered by the Examining Attorney shows that the screenshot organizations commonly offer the same services as both the Applicant and Registrant under one mark.

d. The Parties are not related services even if in healthcare.

The services are not related even though they may possibly sold or offered in the same industry. The fact that the products at issue are sold in the same "field" or "industry" does not of itself provide a basis for regarding them as related. [Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law, 5-13 (October 1998) (citing cases). Even if the services are from the same general field of commerce, there should be no presumption of confusion. See In re Quadram Corp. 228, U.S.P.Q. 863, 865 (T.T.A.B. 1985); Astra Pharm. Prods., Inc. v. Beckham Instruments, Inc. 220 U.S.P.Q. 786, 790 (1st Cir. 1983) (holding that the mere fact that both

parties' products were used in medical/healthcare field was insufficient to show likelihood of confusion of the parties' ASTRA marks and about the source of the plaintiff's pharmaceutical preparations/syringes and defendant's blood analyzer device). See also *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841, 1845 (T.T.A.B. 1998) (apparatus for use in medical nuclear imaging and electronic digital x-ray system not sufficiently related even though products both were medical imaging and diagnostic equipment, and the DIGIRAD and DIGIRAY marks differed only by one letter).

Even if the Parties' services reside within the same general field of commerce, that is still not a basis to presume relatedness exists between the Parties nor a presumption of confusion arise either. While both Parties may serve humanity (Applicant disputes Registrant's services do as much as cosmetics industry) Registrant's and Applicant's description do not equate to each other in an identical nor related way. If medical nuclear imaging and digital e-ray imaging are not related as in *Digirad*, neither are the Parties in this matter. If two products commonly used in taking blood are not related, as in *Astra*, then neither are the Parties in this present matter. Applicant performs medically licensed services, Registrant does not (it is an information website) and cannot and that should be the end of it. Just being in the same general field of commerce, - i.e. health does not portend relatedness between the Parties.

To find that goods or services are related, there must be "more of a connection than that a single term may be used to generally describe them." *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 U.S.P.Q.2d 1213, 1221 (T.T.A.B. 2011) (finding "financial field" too broad to assume a connection between software for financial institutions and investment management services); see also *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007) (finding "preparations for repairing surfaces" too broad and encompassing distinct classes of consumers);

In re The Paperclip Club, LLC, 2010 WL 985345, at *3 (T.T.A.B. 2010) (finding “office and home office supplies” not related to “office and residential furniture”).

If the financial field was too broad to find relatedness then too is “health” too broad and generalized with respect to these Parties. If office and home office supplies are not related to office and residential furniture, then so too for Applicant – i.e. medical diagnostic tests are not related to Registrant’s services. Examining Attorney concluded that given the same industry within healthcare (Applicant disputes this) the services are related. Yet, none of the evidence proffered in either of the Office Actions sufficiently establishes relatedness.

The Board has further found that confusion is not likely when “the conditions of sale minimize any potential confusion” and the record does not support a finding that the goods or services in question “are marketed in such a way as to be likely to cause confusion.” In re Vision Wheel, Inc., 2010 WL 3164749, at *1 (T.T.A.B. July 28, 2010) (finding no confusion between V-TEC for “custom wheels for vehicles” and VTEC for “vehicles, namely, automobiles, motorcycles, motorized wheelbarrows and motorized land vehicles; engines for automobiles; engines for motorcycles; engines for other motorized land vehicles” both in Class 12) [non precedential]; see also In re Thor Tech, Inc., 113 U.S.P.Q.2d 1546, 1549 (T.T.A.B. 2015) (finding no likelihood of confusion between TERRAIN for “recreational vehicles, namely, towable trailers,” and TERRAIN for “motor land vehicles, namely, trucks,” both in Class 12, when the evidence did not establish that consumers would assume a common source for the goods).

In these facts, it is not common for a single entity to provide both Applicant’s medical analysis services and Registrant’s health information services together under one single mark. Registrant does not perform medical analysis services unless one believes that online testing for

skin cancer is possible. “We must look to the goods and services as identified in the involved application and cited registrations, not to any extrinsic evidence of actual use. *Stone Lion Capital Partners, LP v. Lion Capital LLP* 746 F. 3d 1317 (Fed Cir. 2014). If we apply *Stone Lion* to these facts, then (1) The Parties services are not identical nor related and (2) the extrinsic evidence presented by Examining Attorney does not comport with the case law holdings on relatedness.

The related evidence does not demonstrate a connection between the services of the Registrant and Applicant for two reasons. First, it contains overly broad generalities of some common commercial field and second, it does not show the Parties services are offered under a single common mark. The Board admonished in *Edwards Lifesciences Corp. v. VigLanz Corp.* 94 USPQ 2d 1399, 1410 (TTAB 2010) “a finding that goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both”).

The Examining Attorney used “healthcare” as the “overarching relationship” between the Parties. However, Registrant’s “website” is in no way the same or related to Applicant’s medical diagnostic testing. Any consumer would see this just from reading their descriptions – an informational website does not related to biopsies.

Applicant traverses the Examining Attorney’s opinion on this issue and states no relatedness can exists between the Parties. The Examining Attorney’s evidence does not show that consumer would expect a relationship between “medical diagnostic testing” and an “online informational database” and it is not common to offer both under the same mark. Applicant’s description is narrowed to medical diagnostic testing and Applicant objects to Examining Attorney’s characterization that somehow, Registrant’s “online wellness website” is even capable of equating Applicant’s services to Registrant’s services. Applicant respectfully asks

Examining Attorney to his reconsider position on relatedness, finding this du pont factor in the Applicant's favor for all the aforementioned reasons.

Conclusion

For all the aforementioned reasons, the Applicant respectfully requests the Examining Attorney permit publication of Applicant's Mark. Applicant submits the dissimilarities between the Parties' marks is sufficient for consumers to distinguish between the two marks. The Parties' purchasers and the conditions of sales are dissimilar making the likelihood of confusion at least speculative. Each Party has an entirely different description – Registrant's is online database of "wellness" while Applicant provides medically necessary diagnostic testing for serious diseases. The extrinsic evidence for related services of the Parties is weak and challengeable. Further extrinsic evidence of the term "derm" proves its weakness and the Office must not give strong protection to it as a common mark. In at least one instance, the Office required a disclaimer for the term "derm." Finally, Applicant submits that the evidence does not show both Parties' services under a single mark.

No fee is believed to be required for this Response. However, the Commissioner is hereby authorized to charge any additional required fees, or credit any overpayment, to Medical Diagnostic Laboratories, LLC Deposit Account No. 503644.

Respectfully submitted for Applicants,

/Arnold Braun/

By: Arnold Braun (54,001)

Date: October 19, 2020
Medical Diagnostic Laboratories
2439 Kuser Road
Hamilton, NJ 08690-3303
T: (609) 528-6177
E: abraun@mdlab.com