

RESPONSE TO OFFICE ACTION

Applicant, Pioneer Life Sciences LLC (“Applicant”) responds as follows to the Office Action, issued in connection with Serial No. 88838968 for the logo GENCARE GENERIC HEALTHCARE.

I. Likelihood of Confusion

The Examining Attorney has issued a refusal to register Applicant’s Mark pursuant to Trademark Act Section 2(d), 15. U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the mark in Reg. No. 5404240 (the “Registrant’s Mark”).

Likelihood of confusion between two marks at the PTO is determined by a review of the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1356, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, “there is no mechanical test for determining likelihood of confusion and ‘each case must be decided on its facts.’” TMEP § 1207.01 (citing *du Pont*, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen du Pont factors may be considered in weighing likelihood of confusion, if raised, and any one may be dispositive, especially where that single factor is the dissimilarity of the marks. See TMEP § 1207.1. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entirety convey significantly different commercial impressions, are used in connection with different goods and services, or are used in connection with goods/services purchased by a sophisticated consumer. See TMEP § 1207.01(b)(iii).

Comparison of the Marks

Determining whether there is a likelihood of confusion requires careful consideration of the overall commercial impression created by each mark. Specifically, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entirety convey significantly different commercial impressions. *See e.g. Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH’S GOLD’N CRUST and design (with "GOLD’N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD’N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH’S" is sufficient to distinguish the marks).

With regards to a composite mark, the anti-dissection rule dictates that “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). In fact the Board has discouraged the dissection of a mark for comparison. “It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.” See *Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981).

Here the Examining Attorney finds that the term GENOCARE of Registrant’s Mark is “virtually identical” to GENCARE of Applicant’s Mark. However, the Examining Attorney disregards how the letter O alters the commercial impression of each term. GENO is a common prefix that means “race, family, tribe”. See Exhibit A. Accordingly, the term GENOCARE suggests “care suitable for the entire family and based on genetics. In contrast, GENCARE suggests “general” care, implying general care of the consumer.

Furthermore, the Examining Attorney gives little weight to the presence of the terms GENERIC HEALTHCARE, stating that disclaimed matter is “less significant”. However, the Examining Attorney ignores the contribution of the second and third terms of the Applicant’s Mark. The second term GENERIC following GENOCARE creates an alliterative effect. The repetition of a similar sounds in GENOCARE GENERIC creates rhythm and carries the consumer’s eyes forward from GENCARE TO GENERIC. Upon reaching GENERIC, the consumer is conveyed information that the underlying goods are for the general well-being of the consumer. To re-emphasize this point, GENERIC is followed by the term HEALTHCARE. Accordingly, Applicant’s Mark as whole strongly conveys the impression that the underlying goods are for general care and wellbeing. This impression contrasts with the “care of family” impression conveyed by the Registrant’s Mark.

Therefore, Applicant’s Mark has a different sound, look, and commercial impression than Registrant’s Mark. Accordingly, confusion is unlikely.

Based on the significant differences in the commercial impression, Applicant contends that the dissimilarity of the marks is dispositive of the issue of likelihood of confusion. See *Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346-47 (Fed. Cir. 2010).

II. Doubts to Be Resolved in Favor of the Applicant

Where it is unclear, the Board takes the position that doubt is to be resolved in favor of the applicant. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141 (Fed. Cir. 1987). The Examining Attorney is respectfully asked to allow Applicant’s application to proceed to registration if there is any doubt.

III. Conclusion

Applicant respectfully submits that the above evidence fully supports Applicant’s claim that Applicant’s Mark is Registerable on the Principal Register. Applicant respectfully requests that

the Examiner withdraw the refusals of the present office action and allow the Applicant's Mark to proceed to publication.

Applicant's representative would welcome the chance to discuss the above response in greater detail with the Examining Attorney, at the Examining Attorney's convenience, if the Examining Attorney believes such a discussion could expedite the allowance of the Applicant's Mark.

EXHIBIT A
WIKTIONARY ENTRY FOR GENO-



Wiktionary
The free dictionary

- Main Page
- Community portal
- Preferences
- Requested entries
- Recent changes
- Random entry
- Help
- Glossary
- Donations
- Contact us

- Tools
- What links here
- Related changes
- Upload file
- Special pages
- Permanent link
- Page information
- Cite this page

- Print/export
- Create a book
- Download as PDF
- Printable version

In other languages

- Español
- Euskara
- Italiano
- Portugués

If you have time, leave us a note.

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geno-

See also: [geno](#), [gēno](#) and [-geno](#)

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4.1	Prefix
4.1.1	Derived terms

English [\[edit\]](#)

Etymology [\[edit\]](#)

From the stem of Ancient Greek γένος (*génos*, "race, kind"), also Ancient Greek γεννάω (*gennáō*, "to produce") and Latin *gēns* ("tribe, clan")

Prefix [\[edit\]](#)

geno-

- genetics - e.g. genome
- family, tribe or race - e.g. genocide

Derived terms [\[edit\]](#)

► English words prefixed with geno-

Related terms [\[edit\]](#)

- genome
- genomic
- genomics

Anagrams [\[edit\]](#)

- ENGO, Goen, NGE0, Onge, geon, gone, oneg

Finnish [\[edit\]](#)

Prefix [\[edit\]](#)

geno-

- geno-

Derived terms [\[edit\]](#)

► Finnish words prefixed with geno-

Anagrams [\[edit\]](#)

- egon

German [\[edit\]](#)

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geno-

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