

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Trademark Application:)	Trademark Law Office: 121
)	Attorney: Valeriya Sherman
Serial No.: 87/558,228)	
)	
Applicant: Nanotemper Technologies GmbH)	
)	
Trademark: TYCHO)	
)	
Filing Date: April 7, 2017)	
)	
Class: 9)	
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Mailing Date: November 8, 2017)	
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RESPONSE TO OFFICE ACTION

In response to the Office Action issued on November 8, 2017 in connection with the above-captioned application (the “Application”) for the TYCHO mark (the “TYCHO Mark” or “Applicant’s Mark”), Applicant, by and through its counsel, hereby responds to each of the issues raised by the Examining Attorney.

I. Amendment of Goods and Services

In response to the Examiner’s concerns, Applicant submits the following amended description (additions bolded and italicized) which further clarifies Applicant’s goods and conforms to the Examiner’s suggested identification amendment:

Class 9:

Laboratory instruments for use in the study of proteins *namely, devices for evaluating, measuring, and reviewing protein samples; all of the foregoing not including gloves, syringes, or pipettes for laboratory or medical use*

As indicated above, Applicant has narrowed its description to further clarify the scope of its laboratory instrument offerings, adding the following language in Class 9: “*namely, devices for evaluating, identifying, measuring, and reviewing protein samples; all of the foregoing not including gloves, syringes, or pipettes for laboratory or medical use.*” Applicant respectfully submits that this narrowed description of goods is now clearly distinct from and does not overlap with the goods covered in U.S. Registration Nos. 0968723 or 4540562, discussed in greater detail below.

II. Response to Section 2(d) Refusal

A. Introduction.

The Examining Attorney has provisionally refused registration of TYCHO Mark on the ground that Applicant’s Mark is likely to be confused with the TYCOS mark cited in U.S. Registration No. 0968723 and the TIKO mark cited in U.S. Registration No. 4540562 (the “Cited Marks”). Specifically, the Examining Attorney asserts that Applicant’s Mark is “phonetically equivalent” to the Cited Marks and that “[s]imilarity in sound alone may be sufficient to support a finding that the marks are confusingly similar.” The Examining Attorney has also suggested that the description of Applicant’s Mark “encompasses any instruments used in a lab that may involve the study of protein, including microscopes, centrifuge, funnels, disposable reusable dispenser syringes for laboratory use, or gloves for laboratory purposes.” For the TYCOS mark, the Examining Attorney has stated that the “medical instruments” covered by the registration “*could* include goods that overlap with those of the applicant, such as syringes and pipettes” (emphasis added). For the TIKO mark, the Examining Attorney has stated that “[i]f applicant provides gloves for laboratory use, the sole difference between the parties’ goods is the designated use.”

As discussed below, Applicant respectfully disagrees that its TYCHO Mark, when viewed as a whole and in connection with Applicant's amended goods, is likely to be confused with the Cited Marks identified in U.S. Registration Nos. 0968723 or 4540562.

B. Applicant's Market-Leading Protein Research Solutions.

Founded in 2008, Applicant is an industry leader in the characterization and analysis of proteins, providing instruments that enable scientists to easily, efficiently, and accurately evaluate protein stability and quality, and thereby develop better drugs faster.

NanoTemper's clients include major biopharmaceutical companies such as Sanofi, DuPont, Boehringer Ingelheim, Janssen, Sandoz, and Novo Nordisk as well as a wide range of sophisticated research institutions and bodies, including the Max Planck Institute for Biochemistry, the Polish, Chinese, and Czech Academies of Sciences, respectively, the Brazilian Biosciences National Laboratory, Nankai University, and the Indian Institute of Science. *See* <https://nanotempertech.com/customers/> and <https://labiotech.eu/nanotemper-microscale-thermophoresis/>.

Applicant's offerings under its TYCHO Mark include a device that verifies protein quality and characteristics by looking at the structural integrity of a protein, screens various buffers, compares multiple preparations or test conditions, and can help determine the quality of protein samples in only minutes to assist with assay development and purification workflows. *See* <https://nanotempertech.com/tycho/>. Applicant's TYCHO device is useful for researchers working with proteins that experience irreproducible results, and the device is intended to help researchers identify the quality of their starting material to prevent unnecessary experiments and questionable data. *See* <https://www.prnewswire.com/news-releases/nanotemper-technologies-takes-on-the-reproducibility-crisis-launches-tycho-300579424.html> and https://www.youtube.com/watch?time_continue=1&v=zaR2i6Zf8wQ.



Consumers interested in obtaining more information about Applicant’s TYCHO product must contact a support specialist, and are required to provide information regarding their targets of interest, research focus, and organization and work affiliation. Likewise, consumers must request quotes directly from Applicant and may also download a detailed product brochure only after providing NanoTemper with detailed information regarding their research interests and needs. See <https://nanotempertech.com/contact-specialist/>.

The highly-specialized nature of Applicant’s offerings in the marketplace, together with the information-rich process by which consumers interact with Applicant regarding these offerings, render consumer confusion between Applicant’s TYCHO Mark and Cited Marks highly unlikely.

C. Consumer Confusion is Not Likely Between Applicant’s Mark and the Cited Marks.

1. Applicable Principles of Law.

In a likelihood of confusion analysis, the U.S. Patent and Trademark Office (“PTO”) considers all evidence of record for the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) (hereinafter, “*du Pont*”). The Examining

Attorney must then balance the findings for each of the relevant factors in order to assess fully “whether the purchasing public would mistakenly assume that the applicant’s goods originate from the same source as, or are associated with, the goods in the cited registration.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *see Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011). To make such an individualized assessment, the Examining Attorney must consider the effect of the entire mark as it is used in the marketplace in connection with the applicant’s identified goods. *du Pont*, 476 F.2d at 1360-61 (stating that “[t]he only *relevant* application is made in the marketplace” considering “... all of the known circumstances surrounding use of the mark” (emphasis in original)); *See Majestic Distilling*, 315 F.3d at 1315, 65 USPQ2d at 1204.

However, “[n]ot all the *du Pont* factors... are necessarily relevant or of equal weight, and any of the factors may control in a given case, depending upon the evidence of record.” *See Citigroup Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *see also Kellogg Co. v. Pack-Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive. . . . ‘each [of the thirteen elements] may from case to case play a dominant role.’”).

Here, an analysis of the following relevant *du Pont* factors demonstrates that consumer confusion is highly unlikely due to (a) the dissimilarity of the overall commercial impressions created by Applicant’s Mark and the Cited Marks; (b) the dissimilarity between the goods offered by Applicant under the TYCHO Mark and those offered under the Cited Marks; and (c) the sophistication of the parties’ respective consumers and the protracted purchasing process for each parties’ respective offerings.

2. Applicant's Mark Creates a Unique Commercial Impression in Connection with Applicant's Protein Research Tools.

Courts routinely hold that the commercial context in which consumers encounter the marks at issue conditions their similarity or dissimilarity. "...[I]n analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features." *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442 (8th Cir. 1987) (citations omitted).

As described above, Applicant is an industry leader in the characterization and analysis of proteins, providing instruments that enable scientists to easily, efficiently, and accurately evaluate protein stability and quality, and thereby develop better drugs faster. Applicant's offerings appeal to specialized consumers and organizations who seek to obtain Applicant's highly specialized technical expertise with respect to such instruments. Applicant currently offers three primary products: MONOLITH, PROMETHEUS, and TYCHO. Applicant's marks all relate in some way to aspects of Arthur C. Clarke's *Space Odyssey*, a series of science fiction novels published from the 1960s through 1990s. Additionally, Applicant's TYCHO offering was named after Tycho Brahe, the Danish astronomer known for his accurate and comprehensive astronomical and planetary observations, which would eventually prove useful to his successors. Applicant's TYCHO product parallels this theme with its ability to measure the quality of a protein sample to a high degree of accuracy. A sample can then be shipped to a subsequent location where it can be measured again to make sure it is still the same; and hence useful to successors.

The Board has stated that one manner for determining whether two marks share the same connotation or meaning is to ask whether the marks are interchangeable. *In re Finlay Fine Jewelry Corp.*, 41 U. S. P. Q.2d 1152 (T.T.A.B. 1996). In this case, the TYCHO Mark is not interchangeable with the Cited Marks, because the Cited Marks have no such connotations.

Also distinguishing Applicant's Mark from the Cited Marks are differences in spelling which, in addition to resulting in a different connotation for the Applicant's Mark, results in the marks' different visual impressions between the marks. We additionally note that although the application for the TIKO Mark was filed in late 2013, well after the TYCOS Mark registered. Despite both Cited Marks covering goods in Class 10, the Examining Attorney for the TIKO Mark apparently believed the marks were sufficiently distinct and did not cite the TYCOS Mark as an obstacle to registration.

For the foregoing reasons, Applicant respectfully submits that consumers are unlikely to perceive the Cited Marks and Applicant's TYCHO Mark as similar in light of their different connotations and commercial impressions when encountered in the marketplace.

3. The Offerings of Applicant and Registrants are Entirely Different.

Even if the goods offered under the Cited Marks were related to Applicant's goods, merely falling within a common category or industry has been held insufficient to find a likelihood of confusion. *See W.W.W. Pharm. Co. Inc. v. The Gillette Co.*, 25 U.S.P.Q.2d 1593, 1598 (2d Cir. 1993) (even though they may both be generally defined as personal care products, SPORTSTICK for lip balm and SPORT STICK for deodorants/antiperspirants do not compete nor serve the same purposes so they are not related or confusingly similar); *Checkpoint Sys. Inc. v. Check Point Software Tech. Inc.*, 60 U.S.P.Q.2d 1609, 1620 (3d Cir. 2001) (CHECKPOINT for physical security services and CHECK POINT for data security services fall into distinct sectors of a broad product category and are sufficiently unrelated such that confusion is unlikely); *M2 Software, Inc. v. Madacy Entm't*, 76 U.S.P.Q.2d 1161, 1167 (9th Cir. 2005) (identical M2 marks both used for CDs and downloadable music are not confusingly similar where, *inter alia*, music genres are different); *Therma-Scan Inc. v. Thermoscan Inc.*, 63 U.S.P.Q.2d 1659, 1663 (6th Cir. 2002) (THERMA-SCAN for infrared medical imaging services and THERMOSCAN

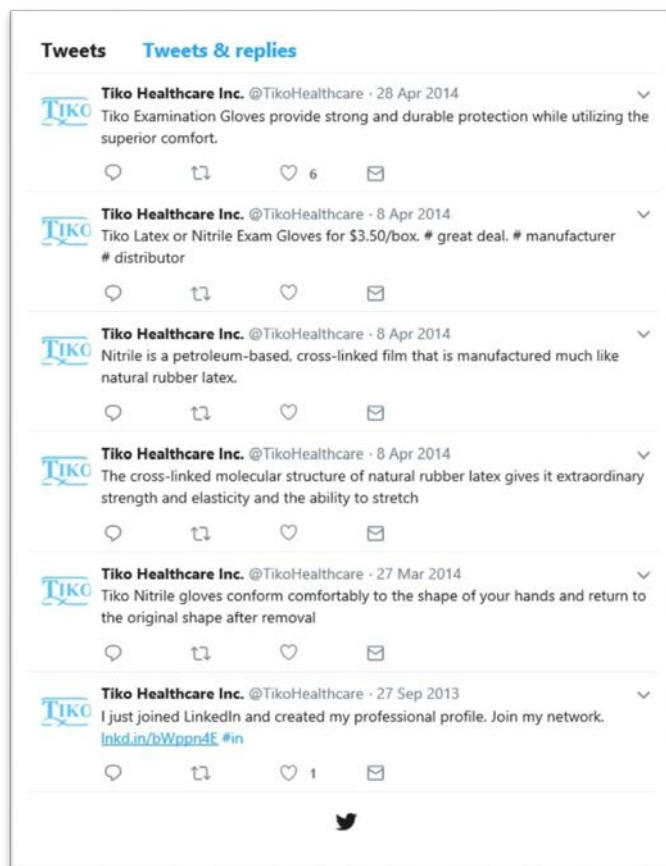
for electronic ear thermometers are not sufficiently related to cause confusion even though marks coexist in same broad industry).

The Board has repeatedly held, including in a precedential decision, that differences in the function or purpose of goods can prevent a likelihood of confusion. *See Aries Sys.Corp. v. World Book, Inc.*, 26 U.S.P.Q. 2d 1926, 1932(T.T.A.B. 1993) (finding KNOWLEDGE FINDER and INFORMATION FINDER not confusingly similar because, inter alia, “[s]uch products, rather than being...simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.”); *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 U.S.P.Q. 2d 1825, 1840 (T.T.A.B. 2013) (precedential) (finding no confusion between RSTUDIO and ER/STUDIO where “the respective software products possess very different functions and purposes”); *PerkinElmer Health Science., Inc. v. Atlas Database Software Corp.*, 2011 TTAB LEXIS 405, at *39 (T.T.A.B. Dec. 22, 2011) (“The mere fact that the parties’ goods fall under the broad category of software for use in laboratories is not a sufficient basis upon which to find that they are related for purposes of likelihood of confusion...The goods perform different functions and are used for different purposes.”).

The Examining Attorney has indicated that the Applicant’s un-amended goods may “encompass[] any instruments used in a lab that may involve the study of protein, including microscopes, centrifuge, funnels, disposable reusable dispenser syringes for laboratory use, or gloves for laboratory purposes,” and that these instruments “could include goods that overlap” with the Registrant’s offerings under the Cited Mark. As courts have determined, however, goods falling into distinct sectors of a broad category, such as laboratory equipment and instruments, can nevertheless be sufficiently unrelated such that confusion is unlikely. This is particularly true where the goods do not compete or serve the same purpose.

Although the Examining Attorney contends that “gloves for laboratory use and for medical use are essentially the same and therefore sold by the same parties under the same marks through the same channels of trade and to similar types of consumers” and that “syringes for medical use and lab use are commonly one and the same,” it is clear that Applicant offers neither gloves nor syringes under its TYCHO Mark, as its narrowed goods description now makes explicit.

The registrant for the TIKO Mark sold disposable medical supplies. See <https://twitter.com/tikohealthcare>. In particular, Tiko Healthcare sold a variety of gloves designed for strength, elasticity, and comfort. See <https://datafox.com/tiko-healthcare-inc>. The company’s Twitter page has only six tweets, nearly all of them relating to its gloves:



The records of the California Secretary of State currently list the status of Tiko Healthcare Inc. (business record no C3586920) as “dissolved.”

Welch Allyn, the registrant of the TYCOS Mark, manufactures medical diagnosis devices, patient monitoring systems, and miniature precision lamps. *See* https://en.wikipedia.org/wiki/Welch_Allyn. The company has a product line that includes the following goods:

- Ophthalmoscope (i.e., a scope for use during eye examinations)
- Stethoscope
- Otoscope (i.e., a device used to look into the ears)
- Medical thermometer
- Sphygmomanometer (i.e., a blood pressure meter)

Welch Allyn lists several “TYCOS” products under its “discontinued products” list, including a “Tycos Hand Aneroid Sphygmomanometer.” *See* <https://www.welchallyn.com/en/products/categories/discontinued-products/blood-pressure-management/sphygmomanometers/tr-1-hand-aneroid/documents.html>. It also appears the company produced hand and pocket aneroids (i.e., a barometer that measures air pressure) under the TYCOS mark, but currently lists all of these products as unavailable for sale. *See* <https://www.welchallyn.com/en/products/categories/blood-pressure-measurement/sphygmomanometers/tycos-aneroids.html>. Welch Allyn’s registration, though broad, covers such goods, which may be classified as “medical instruments” due to their use in diagnosing patients during medical check-ups and visits.

Applicant’s goods serve a radically different function and purpose. As noted above, Applicant develops instruments that enable scientists and researchers to easily, efficiently, and accurately evaluate protein stability and quality, and thereby develop better drugs faster. These laboratory instruments, and in particular the device that verifies protein quality and characteristics which Applicant offers under its TYCHO Mark, are dramatically different from the more basic medical instruments formerly sold by Welch Allyn under the TYCOS Mark or the

gloves formerly sold by Tiko Healthcare under the TIKO Mark, notwithstanding that Applicant's original description "*could include goods that overlap*" with those of either party (emphasis added).

The TTAB at the end of July overturned a similar refusal by an examining attorney, finding that "[t]he terminology of the identification of goods, standing alone ... is an insufficient basis upon which to conclude that the goods are related." *In re Critelli*, Serial No. 86445003, 10 TTABVUE 8 (T.T.A.B. July 24, 2017).

In *Critelli*, Applicant sought to register the mark LAVA GEAR (with "gear" disclaimed) in connection with "outdoor survival wear, namely, jackets and pants for extended periods of use outdoors in extreme cold weather" in Class 25. The examining attorney refused registration on the ground that the mark was confusingly similar to LAVA ACCESSORIES (with "accessories" disclaimed), which was registered in connection with "scarfs; travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf" in Class 25. 10 TTABVUE 7. The examining attorney argued that the application's broad wording could be presumed to encompass all goods of the type described, including those in Registrant's "more narrow identification." *Id.* Applicant argued that the goods do not compete, are not sold to the same customers nor purchased for the same or related purposes. The Board held that despite the examining attorney's contention that outdoor survival wear could include travel clothing, "there [was] no evidence to support these contentions ... nor [was] there evidence that Applicant's goods and Registrant's goods are of a type which may emanate from a single source." *Id.* at 8. Furthermore, where "there is insufficient evidence that Applicant's goods are related to the goods identified in the cited registration, there is no presumption that these goods travel in common trade channels and are marketed to the same consumers." *Id.* While extreme cold weather gear on the one hand and travel clothing on the other "may possibly be purchased by the same

consumers at some point,” the examining attorney failed to produce evidence “to support a finding that the goods typically emanate from the same source.” *Id.*

Here, as in *Critelli*, the Examining Attorney has not produced evidence to suggest that Welch Allyn’s doctor’s office tools, Tiko Healthcare’s gloves, and Applicant’s protein analysis devices are the types of goods that typically emanate from a single source. The mere fact that Applicant’s un-amended description of “laboratory instruments for use in the study of proteins” *could* overlap with those of the Cited Marks is an insufficient basis upon which to conclude that the Applicant and registrants’ goods are related.

Given these notable differences, it is highly unlikely that any reasonable consumer, and particularly the sophisticated enterprise and research consumers to which Applicant markets and sells its offerings, would perceive a relationship between the Applicant and the owners of the Cited Marks. To conclude otherwise would run counter to commercial realities and unreasonably expand the potential for trademark conflict.

D. The Sophistication of Applicant’s and Registrants’ Respective Consumers, the Cost of the Goods and Protracted Purchasing Processes Render Confusion Highly Unlikely.

1. Applicable Law.

Likelihood of confusion is determined from the perspective of the consumer. The level of sophistication of purchasers and the care in exercising a purchasing decision are therefore relevant when determining whether confusion is likely. TMEP §1207.01(d)(vii). Circumstances suggesting care in purchasing tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (T.T.A.B. 2006).

Purchasers of expensive goods are elevated to the standard of a “discriminating” or sophisticated purchaser, i.e., one who does not buy casually, but only after careful consideration. *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *see, e.g., McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 USPQ 81, 92 (2d Cir. 1979) (holding purchasers of women’s coats priced from \$100-\$900 “to be sophisticated and knowledgeable about women’s apparel).

Courts have held that purchaser sophistication and a protracted purchasing process may be readily inferred even where the listed goods contain no limitation as to trade channels or certain types of purchaser:

Just from the record description of goods and services here one would expect that nearly all of opposer’s and applicant’s purchasers would be highly sophisticated. Nothing in the record is to the contrary. Indeed, the record confirms that opposer’s services are expensive and purchased *only* by experienced corporate officials after significant study and contractual negotiation.

Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp., 954 F.2d 713, 718 (Fed. Cir. 1992); *see also In re Digirad Corp.*, 45 USPQ2d 1841, 1843-44 (T.T.A.B. 1998).

2. Applicant’s Consumers are Sophisticated and Make Purchasing Decisions Through a Methodical, Information-Rich Process.

Analytical instruments for protein analysis are the very type of goods that would only be sought by a knowledgeable and careful clientele. Brief searching of the Applicant’s website, customer lists, and consumer testimonials confirms a high level of customer expertise and deliberation, in addition to close, one-on-one relationships between the Applicant and its respective clients. In particular, Applicant’s clientele includes highly sophisticated and knowledgeable companies and organizations, including drug development companies and research universities. For Applicant, the circumstances of sale are often directly personal and time consuming, with Applicant employing a team of dedicated sales specialists. Indeed, Applicant’s customers are required to provide detailed information regarding their needs and affiliations prior to initiating one-on-one conversations with Applicant about its TYCHO product.

The circumstances of sale for Applicant's goods, therefore, are so information-rich that confusion *as to the source of Applicant's goods* is all but impossible.

Given the nature of Welch Allyn and Tiko Healthcares' respective offerings, it is also highly likely that consumer purchasing decisions for both parties' products are also made after extended and information-rich interaction with those registrants. For Welch Allyn, in particular, consumers are often required to contact the registrant directly to request a demonstration of the product in question by a company sales representative. *See, e.g.,* <https://www.welchallyn.com/en/products/categories/physical-exam/scales/diaper-organ/diaper-organ-scale.html>.

Applicant has built its reputation by working with sophisticated consumers making individualized and highly informed judgments within the context of close, one-on-one relationships. The statutory standard of Section 2(d) is *likelihood* of confusion, not the mere possibility of confusion. *Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1482 (Fed. Cir. 1987). Under *du Pont*, the sophistication and circumstances of purchase are an independent factor separate from the services and trade channels of the respective parties. In any given case, a single *du Pont* factor may be dispositive of the likelihood of confusion analysis. *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991). Here, the commercial reality and specific conditions for sale of the parties respective offerings weighs heavily against a finding of *likely* confusion between the Applicant's Mark and the Cited Marks.

III. Conclusion

Applicant has responded to all of the issues raised by the Examining Attorney in her Office Action of November 8, 2017. Accordingly, Applicant respectfully submits that the instant application is now in condition for a prompt publication.

Date: May 8, 2018

Respectfully submitted,

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