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ESTTA Tracking number: **ESTTA381942**

Filing date: **12/03/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77416487
Applicant	Intuity Medical, Inc.
Applied for Mark	ONE-STEP
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Submission	Applicant's Appeal Brief
Attachments	77416487 - Applicant's Appeal Brief.pdf (19 pages)(240051 bytes)
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Date	12/03/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:	)
	)
Intuity Medical, Inc.	)
	)
	)
Serial No.: 77/416487	)
	)
Filed: March 7, 2008	)
	)
Mark: ONE-STEP	)
	)

APPLICANT'S APPEAL BRIEF

Applicant, Intuity Medical, Inc. ("Applicant") submits this memorandum in support of its appeal from the Trademark Examining Attorney's final refusal to register the mark **ONE-STEP**. Applicant's Notice of Appeal was submitted on May 26, 2009. Proceedings were suspended, and resumed again on October 6, 2010.

INTRODUCTION

The Examining Attorney has refused registration of Applicant's **ONE-STEP** mark, based on a perceived likelihood of confusion with Medipurpose Pte. Ltd.'s ("MediPurpose") U.S. Registration Nos. 2969890, 2719496 and 2922552, for the marks **ONE-STEP SAFETY LANCET, ONE-STEP** (Design), and **ONE-STEP** (Plain Block) respectively (hereinfafter, "Registrant's Marks"). Applicant filed a consolidated petition to cancel these registrations under Proceeding Number 92051016 (the "Cancellation Action"), after which time the parties entered into a Settlement and Coexistence Agreement, and related Letters of Consent. Among other things, MediPurpose granted its consent to Applicant's registration of the subject Application. The parties then filed a stipulated withdrawal of the Cancellation Action, which the TTAB

granted on December 10, 2009. The Applicant submitted the Letters of Consent to the Examiner in its Office Action Response and Request for Reconsideration. However, the Examiner issued a Final Office Action with respect to the subject application, alleging that the Letters of Consent was nothing more than a naked consent. The Examiner maintained the 2(d) likelihood of confusion refusal.

This appeal brief focuses on the fact that the parties have negotiated in good faith a Settlement and Coexistence agreement and related Letters of Consent, with certain definite terms, which is more than a "naked consent" and sufficient to overcome the likelihood of confusion refusal. Moreover, the marks, when considered in their entireties, are not confusingly similar. Accordingly, Applicant's application should be approved for registration and the Examining Attorney's refusal of the Application should be reversed.

FACTUAL BACKGROUND

On March 3, 2008, Applicant filed an application for its **ONE-STEP** trademark in connection with "*blood glucose monitoring systems including the devices, and parts and accessories thereof*" in Class 10.

On May 21, 2008, the Examining Attorney issued an Office Action refusing to register Applicant's **ONE-STEP** mark, claiming that Applicant's mark resembles the Registrant's Marks covering "*blood sampling prickers and parts therefore.*" The Examining Attorney alleges that Applicant's use of its mark for the proposed goods would cause confusion, mistake, or deceive the consuming public as to the source of the goods of the Applicant and Registrant under 15 U.S.C. Section 1052(d).

Applicant filed a response to the initial Office Action on November 21, 2008 wherein Applicant asserted that confusion was not likely given that Applicant's mark and Registrant's Marks cover different goods and move through different channels of trade. Specifically,

Applicant's blood glucose monitoring systems are used to evaluate the levels of glucose in the blood, and are intended for over-the-counter sale in pharmacies for purchase by diabetics. In contrast, Registrant's blood sampling prickers are needles used to obtain blood samples, primarily in the clinical or laboratory setting. Moreover, the Registrant has adopted and registered distinct stylizations for two of its marks shown below:

ONE-STEP safety lancet and One-Step.

These stylized marks are indeed distinct from Applicant's **ONE-STEP** mark (and Applicant's mark does not include the descriptive terms "**SAFETY LANCET**"). In addition to its arguments refuting a likelihood of confusion, Applicant also alleged in its response to the Examiner that Registrant had, by its own admission, abandoned its marks – further eliminating any possibility for confusion. On November 25, 2008, the Examining Attorney issued a Final Office, maintaining the likelihood of confusion refusal. On May 26, 2009, Applicant filed a Request for Reconsideration with the United States Patent and Trademark Office and a Notice of Appeal with the Trademark Trial and Appeal Board. Applicant simultaneously filed the consolidated Cancellation Action against the cited registrations under Proceeding Number 92051016. Due to the Cancellation Action, the Examining Attorney suspended all action with respect to the Subject Application.

After negotiating with MediPurpose, Applicant and MediPurpose entered into a formal Consent Agreement and related Letters of Consent. Medipurpose agreed to Applicant's registration of the subject Application. Therefore, the parties terminated the Cancellation Action. Applicant then filed a Request to Lift the Suspension of the subject Application on January 13, 2010, and submitted therewith copies of the Letters of Consent entered into by

Applicant and MediPurpose. Meanwhile, Applicant also filed (and was granted) Requests for Extension of Time to File Brief on Appeal while awaiting the Examining Attorney's review of its January 13, 2010 response.

The Examining Attorney then issued a Final Office Action, removing the Application from suspension, but alleged that the Letters of Consent were a "naked consent" and insufficient to overcome the likelihood of confusion refusal. Applicant again responded to this office action on June 30, 2010, indicating that Applicant and MediPurpose entered into a Settlement Agreement with terms much more specific than those listed in the Letters of Consent, however the complete terms of Settlement Agreement were intended to be confidential. Applicant, without disclosing the entire Settlement Agreement, explained to the Examining Attorney that the parties did appropriately limit use of one another's marks and that MediPurpose uses its mark primarily with blood sampling lancets while Applicant's mark is for blood glucose monitoring systems for the daily tracking of blood glucose levels for diabetics. Moreover, as explained to the Examiner, the parties agreed to mutual cooperation – if either party becomes aware of action confusion, the parties will notify each other and will take prompt action to correct and remedy any such confusion.

ARGUMENT

I. LETTERS OF CONSENT MUST BE GIVEN GREAT WEIGHT

Letters of Consent and consent agreements in general must be given great weight by the TTAB. This tenet has long been established by case law. Bongrain International v. Delice de France, 811 F.2d 1479 (Fed. Cir. 1987). Even when the Letters of Consent do not contain information regarding the underlying facts which led the parties to conclude that confusion is not likely, the letters of consent are entitled to probative value. See, i.e. In re Buhler Technologies GMBH, Serial No. 79034792 (February 12, 2009) [not precedential]. In such cases, "we may

infer from the fact that consent was given by both registrants that the owners of the cited registrations do not believe confusion is likely." Id., citing In re Donnay International Society Anonyme, 31 U.S.P.Q. 2d 1953, 1956 (TTAB 1994).

Thus, because the parties themselves entered into the agreement contending that confusion is not likely, the TTAB and USPTO must honor the parties' position. Moreover, if in the off chance any confusion arises, the parties agreed to cooperate and immediately take remedial action to eliminate such confusion. Accordingly, the Letters of Consent should be given great weight, and Applicant's mark should be granted registration.

II. NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S ONE STEP MARK AND REGISTRANTS MARKS

In addition to accepting the Letters of Consent, the TTAB should not hesitate to reverse the Examiner's refusal because there is no likelihood of confusion between Applicant's **ONE-STEP** mark and registrant's **ONE-STEP SAFETY LANCET, ONE-STEP (Design)** and **ONE STEP** (Plain Block) marks. Accordingly, Applicant hereby submits that the Examining Attorney erred in maintaining and making final the Trademark Act Section 2(d) rejection. Applicant respectfully requests reconsideration of its application through its appeal to the Trademark Trial and Appeal Board.

The Trademark Office recognizes that registration of a mark should not be refused merely because other similar or identical marks exist. Rather, such a refusal should issue only where similar or identical marks create a likelihood of confusion or mistake on the part of the purchasing public. T.M.E.P. § 1207.01. In determining whether a likelihood of confusion exists, the Examining Attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression, as well as the goods and/or services with which the

marks will be used. In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

The purpose of the likelihood of confusion standard is to protect consumers from mistakenly believing that an applicant's goods or services emanate from the cited registrant, or are related to the registrant's business. Applicant submits that the Examining Attorney erred by focusing solely on the marks' similarities rather than giving appropriate weight to the dissimilarities in appearance and overall commercial impression, as well as the divergent channels of trade.

Although the Examining Attorney is not required to consider all *thirteen* DuPont factors, an evaluation of the following factors provide evidence that no likelihood of confusion exists between the two marks:

1. The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The differences of the goods as described in the application or registration or the difference of the goods for which the marks are used.
3. The dissimilarity of established trade channels.
4. The sophistication of consumers.
5. No instances of confusion among consumers.
6. The number and nature of similar marks in use on similar goods.
7. The extent to which applicant has a right to exclude others from use of its mark on its goods.
8. The market interface between applicant and owner of a prior mark (i.e. consent to register agreement). Id. at 1367.

There is no likelihood of confusion if one considers and gives appropriate weight to the marks' distinguishable visual appearances and their differing overall commercial use. In addition, the differences in the goods, the vastly different trade channels, and the fact that there are no instances of actual confusion of consumers lead to the inevitable conclusion that no likelihood of confusion exists.

III. DISTINGUISHABLE DIFFERENCES BETWEEN THE MARKS

In any comparison, the trademarks must be viewed in their entirety. Applicant's **ONE STEP** mark and Registrant's **ONE-STEP SAFETY LANCET** (Reg. No. 2969890), **ONE-STEP** (Design) (Reg. No. 2719496) and **ONE STEP** (plain block) (Reg. No. 2922552) marks are visually (and aurally – in the case of **ONE-STEP SAFETY LANCET**) distinct. Registrant's mark contains terms (and a hyphen) not present in Applicant's mark.

When analyzing a likelihood of confusion, the important consideration is the effect the compared marks will have upon a prospective customer. Del Laboratories, Inc. v. Alleghany Pharmacal Corp., 215 USPQ 421, 425 (S.D.N.Y. 1981). Even a close similarity between marks is not dispositive on the likelihood of confusion issue. Id. In Del Laboratories, the District Court compared the marks **REJUVIA** with **REJUVA-NAIL** and determined that although the marks have some aural resemblance, there is total visual dissimilarity between the marks on the products as they appear to consumers. Id. at 426. The Del Laboratories court concluded that the **REJUVA-NAIL** product, as presented to the consumer, differs considerably from the **REJUVIA** mark. Id. Accordingly, in comparing the **ONE-STEP** mark with Registrant's Marks, the Examining Attorney should not have ignored the overall effects that distinct visual and aural differences have on consumers.

In the Heartsprings case, the court stated that a final determination regarding a likelihood of confusion must be based on a consideration of *all* relevant factors. Heartsprings Inc. v.

Heartspring Inc., 46 U.S.P.Q. 2d 1481, 1483 (10th Cir. 1998). The key inquiry is "whether consumers are likely to be deceived or confused by the similarity of the marks." Id., citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769, 23 U.S.P.Q. 2d 1081 (1992). The court in Heartsprings applied a likelihood of confusion test to determine if the defendant's "Heartspring, Inc." trade name was confusingly similar to plaintiff's "Heartsprings, Inc." trade name. There, the court finds that when viewing the marks as experienced by consumers, the marks are distinct. Likewise, Applicant's mark is distinct from Registrant's Marks. As in Heartsprings, the respective marks' use and presentation bear no similarity beyond the obvious sameness of spelling and "clearly support the … conclusion that the marks at issue in this case are somewhat visually distinct." Id. at 1484.

In fact, when considering Applicant's **ONE-STEP** mark and Registrant's **ONE-STEP SAFETY LANCET** mark as a whole, the sole point of similarity is the term "ONE-STEP." There are numerous and significant differences which distinguish one mark from the other. It is quite common for two registered marks to have terms in common because the remaining portion of the marks sufficiently distinguish the marks from each other. In this case, Registrant's mark includes the additional words "**SAFETY LANCET**" which clearly leaves a distinct impression in the minds of consumers.

Additional evidence that although marks have a term in common, the remaining portion of the mark renders that mark distinctive from the other mark includes, the mark **SUBURBANS** (Reg. 1,703,429) on the Principal Register for "women's clothing, including shirts," peacefully co-existing with the mark **SUBURBAN CLASSICS** (Reg. No. 1,088,214) for "men's, boys', girls', and women's shirts," and the mark **SUBURBAN MISS** (Reg. No. 640,377) for "suits with blouses." Although all three marks are now expired or cancelled under Section 8, all were

considered distinguishable and co-existed on the Trademark Register despite the nearly identical goods and dominant "suburban" term.

Another case supporting Applicant's position that no likelihood of confusion exists is CIT Group, Inc. v. Citicorp., 20 F. Supp 2d 775 (D.N.J. 1998). In this case, the Court decided that there was no likelihood of confusion between the marks **CITIGROUP** and **CIT GROUP**, both covering financial services. In its decision, the Board concluded that the two names did not create the same overall impression. Thus, Applicant's mark for **ONE-STEP** should be deemed distinguishable from Registrant's Marks.

Moreover, the design elements in Registrant's **ONE-STEP SAFETY LANCET** and **ONE-STEP** Design marks must be given considerable weight in the analysis. The design elements themselves are enough to distinguish the marks since the design is a dominant portion of the marks that would stay in the mind of consumers. The TTAB has issued decisions stating that the presence of a design element and additional terms in the mark, result in a finding that the marks are visually and aurally different such that no likelihood of confusion exists. When Applicant's **ONE-STEP** and Registrant's **ONE-STEP SAFETY LANCET** and **ONE-STEP (Design)** marks are viewed in their entirety, they are different, each creating a distinct overall commercial impression. These differences eliminate any likelihood of confusion between Applicant's mark and the cited Registrations **ONE-STEP SAFETY LANCET** (Reg. No. 2969890), **ONE-STEP** (Design) (Reg. No. 2719496).

Further, even Applicant's **ONE-STEP** mark and Registrant's **ONE-STEP** (Plain Block) (Reg. No. 2922552) mark are distinguishable. Although the marks may contain a term that is similar or identical, consumers are unlikely to conclude that the services emanate from a single source based solely on this term. "Use of identical, even dominant, words in common does not automatically mean that two trademarks are similar." See, e.g., General Mills, Inc. v. Kellogg

Co., 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). The registered marks and the Applicant's mark must be considered in their entireties. See, e.g., Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (CCPA 1974).

Courts have consistently held that even identical marks may not be confusingly similar although they are used in connection with related goods and services, such as in the case at hand. See, e.g., Azau Designs v. L'Oreal S.A., 970 F.2d 499 (7th Cir. 1992) (the mark **ZAZU** for hair salons was not be confusingly similar to the mark **ZAZU** for hair care products); Allstate Ins. Co. v. Allstate Inv. Corp., 210 F.Supp 25 (W.D. La. 1962), affd., 328 F.2d 608 (5th Cir. 1964) (the mark **ALLSTATE** for insurance services was not confusingly similar to mark **ALLSTATE** for mortgage brokerage); American Optical Corp. v. American Olean Tile Co., 185 U.S.P.Q. 405 (S.D.N.Y. 1974) (the mark AO for floor coating was not confusingly similar to mark AO for ceramic able); Pabst Brewing Co. v. Decatur Brewing Co., 284 F. 110 (7th Cir. 1922) (the mark **BLUE RIBBON** for beer was not confusingly similar to mark **BLUE RIBBON** for malt extract); Vitarroz Corp. v. Borden, Inc., 664 F.2d 960 (2d Cir. 1981) (the mark **BRAVO'S** for crackers was not confusingly similar to the mark **BRAVOS** for tortilla chips); In re Mars, Inc., 741 F.2d 395 (Fed. Cir. 1984) (the mark **CANYON** for fresh citrus fruits was not confusingly similar to the mark **CANYON** for candy bars); Exquisite Form Industries, Inc. v. Exquisite Fabrics of London, 378 F. Supp. 403 (S.D.N.Y. 1974) (the mark **EXQUISITE** for ladies' undergarments was not confusingly similar to the mark **EXQUISITE** for fabric); Edison Bros. Stores, Inc. v. Cosmair, Inc., 651 F. Supp. 1547 (S.D.N.Y. 1972) (the mark **NOTORIOUS** for women's clothing and shoes was not confusingly similar to the mark **NOTORIOUS** for skin care products, cosmetics and perfume); In re British Bulldog, Ltd., 224 U.S.P.Q. 854 (TTAB. 1984) (the mark **PLAYERS** for shoes was not confusingly similar to the mark **PLAYERS** for men's underwear).

When Applicant's mark and Registrant's Marks are viewed in their entirety, the differences create separate and distinct visual impressions upon the viewer and are therefore sufficient to distinguish the marks from one another. Consumers are unlikely to conclude that goods offered under the Applicant's mark and those offered by the Registrant emanate from a single source based solely on the fact that both marks use the term "ONE STEP."

IV. THE MARKS ARE SIGNIFICANTLY DIFFERENT IN COMMERCIAL IMPRESSION

The overall commercial impression of Applicant's **ONE-STEP** mark is completely different from the commercial impression created by the cited registrations. Accordingly, there is no likelihood of confusion between the marks.

The ultimate question is whether consumers are likely to be confused as to the source of origin of Applicant's services in light of Registrant's services, or whether Applicant is affiliated with Registrant. Nabisco v. Warner-Lambert Co., 55 U.S.P.Q. 2d 1051, 1054 (2d Cir. 2000). Commercial impression is sometimes viewed as a separate factor, but overall is more appropriately viewed as a summation of the sound, appearance, and meaning factors. Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law, §4:3.1 (Rel. 12, Practising Law Institute 2004); TMEP § 1207.01(b). In determining whether two marks are confusingly similar, the Examining Attorney must appraise the overall impression created by the marks, in their respective context, by considering all factors that would likely cause confusion among consumers. Nabisco, 55 U.S.P.Q. 2d at 1054. The Nabisco court determined that there was no likelihood of confusion between **DENTYNE ICE** and **ICE BREAKERS**, both for chewing gum. Although the trade name "**DENTYNE**" played an important part in the analysis, the court was also persuaded by differences in the overall look of how the marks were marketed, including color, shading, patterns, and stylization. Id. at 1055. The court concluded that the "cumulative effect of the differences between the parties' products and in the commercial presentation of their

marks creates distinct marketplace impressions." Id. Accordingly, mere similarities in one factor do not create a likelihood of confusion.

In reviewing these marks and services for the "cumulative effect" mentioned in Nabisco, the marks convey distinct commercial impressions in the minds of consumers. Applicant's mark invokes an overall impression of simplicity with or pertaining to measuring and continually monitoring one's blood glucose levels. In contrast, Registrant's Marks create their immediate impression based the descriptive term "**SAFETY LANCET**" – suggesting the needles sold under the mark are safe for use. The Registrant's **ONE-STEP** mark used with the needles suggest use or pricking in one simple step. As such, the Registrant's mark creates an impression significantly different from that of Applicant's mark – which is used for blood glucose monitoring systems.

The great dissimilarities between Applicant's **ONE-STEP** mark and Registrant's Marks and their respective commercial impressions cannot be discounted. Courts and this Board should not confine its scrutiny merely to similarities. Petro Stopping Centers L.P. v. James River Petroleum Inc., 44 U.S.P.Q. 2d 1921, 1926 (4th Cir. 1997). Discounting the notably differences in the overall commercial impressions would result in an incomplete analysis of the likelihood of confusion test. Here, considering the distinct commercial impression created by the marks, there is no likelihood of confusion.

Comparing the respective overall commercial impressions created by the mark **ONE-STEP** and Registrant's Marks, the Board may conclude that there is no likelihood of confusion between the marks.

V. THE MARKS ARE FOR SIGNIFICANTLY DIFFERENT GOODS

Applicant respectfully submits that there are sufficient differences between the goods covered under Applicant's mark and Registrant's Marks making confusion unlikely. In the case

In Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q. 2d 1460, 1463 (TTAB. 1992), the TTAB held that the issue of whether two products are related does not revolve around the question of whether a term can be used that describes them both, or whether they can be classified in the same general category. The most that can be said of any similarity of services of the Applicant and those of the Registrant is that all of the goods could be generally characterized as "medical-related." However, it has been held that "such a broad inference [of similarity] is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206 (1st Cir. 1983) (no likelihood of confusion between marks of maker of local anesthetics, cardiovascular medicines and prefilled syringes, and maker of laboratory instruments, though both parties' products used in the medical or health care field).

Case authority supports the proposition that even though the products and services may be in the same *general* category, it does not automatically follow that they are related. The Trademark Office requires Applicants to specify the field of use for broad categories because it would be against public policy to grant trademark protection for an entire category of services without specifying the fields of use. Because Applicant's goods are relating to "blood glucose monitoring systems," it is clear that Applicant specializes in goods for the diabetic niche population. In contrast, Registrant's Marks are for *needles* or as medically described by Registrant, "blood sampling prickers" for various medical uses in a clinical setting. These types of "monitoring systems" and "prickers" are distinct, highly specialized and investigated by consumers so that the same consumers are well educated and know the source of, and type of product they are seeking.

The Examiner must contemplate the reality between Applicant's and the Registrant's respective goods. In fact, the TMEP states: "[t]he facts in each such case vary and the weight to

be given each factor may be different in light of varying circumstances; thus, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion for use of similar marks in relation thereto." T.M.E.P § 1207.01 (a)(iv) (emphasis in original).

VI. THE MARKS ARE MARKETED THROUGH SIGNIFICANTLY DIFFERENT CHANNELS OF TRADE

Further, the respective services associated with Applicant's **ONE-STEP** mark and the Registrant's Marks cater to vastly different consumers. The concern is to prevent buyer confusion as to the source of the goods. In this case, however, Applicant and Registrant market their respective services in different channels of trade, which greatly reduces the likelihood of confusing the marks. See Jeanne-Marc Inc. v. Cluett, Peabody & Co., 221 USPQ 58, 61 (TTAB. 1984). There is far less likelihood of confusion where the trade channels do not lead to the same target purchasers. Leathersmith of London v. Alleyn, 695 F.2d 27, 30, 220 USPQ 204, 206 (1st Cir. 1982) (This absence of convergent marketing channels or of competition serves to decrease the likelihood of confusion). The definitive issue in the channels of trade analysis is whether consumers would have reason to believe that the junior user's services originate from, or are authorized or approved by, the senior user. Saab-Scania Aktiebolag v. Sparkomatic Corp. Opposition, 26 U.S.P.Q. 2d 1709, 1711-1712 (TTAB. 1993).

Here, consumers would not believe that Applicant's goods originate from, or are in any way related to, the Registrant. Applicant's goods are targeted to the diabetic consumer, consumers who would purchase specialized monitors at pharmacies for use on a daily basis as one tracks its glucose levels to monitor diabetes. In contrast, Registrant's pricking needles are marketed to clinicians and hospitals, not for diabetics. Thus, the different trade channels weighs in favor of Applicant's position that there is no likelihood of confusion.

VII. THE CONSUMERS ARE SOPHISTICATED AND KNOWLEDGABLE

A high degree of care is exercised by the relevant consumers, which must also be considered in this analysis. Accuride Int'l., Inv. V. Acuride Corp., 10 U.S.P.Q.2d 1589 (9th Cir. 1989). The sophistication of purchasers is a factor that weighs heavily in favor of finding no likelihood of confusion. See Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) ["sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care"]; and In re Box Solutions Corp., 79 U.S.P.Q.2d 1953 (TTAB 2006).

Here, Applicant's consumers are diabetics or their caretakers. Diabetics are intimately familiar with their disease. Their accurate and constant measuring of blood glucose levels is a life-and-death responsibility handled by the individual diabetic (or his/her caretaker). Accordingly, they are sophisticated with respect to the blood glucose monitoring systems on which their lives depend on a daily basis. They use blood glucose monitoring systems multiple times a day, and usually after each meal.

Likewise, clinicians in a hospital setting are intimately familiar with needles or "blood prickers" and their respective clinical uses. They know what type and what size needle to use for a particular patient, vein, injection or extraction. Because of their sophisticated knowledge and dedication to "do no harm" clinicians exercise a great deal of caution and when utilizing a particular medical needle.

A diabetic consumer of Applicant's goods making a purchase in a pharmacy, and a clinician consumer of Registrant's goods in a hospital/clinical setting will not be confused as to the source of the goods. Thus, considering the differences in the target audiences and channels of trade, as well as the sophistication of consumers, it is unlikely that consumers will be confused

or mistaken when reviewing each mark and the respective goods. Accordingly, this factor weighs in favor of finding no likelihood of confusion.

VIII. NO INSTANCES OF CONFUSION AMONG CONSUMERS

Applicant is not aware of any instances of actual consumer confusion between its services and that of the Registrant.

IX. NUMBER OF SIMILAR MARKS, AND EXTENT TO WHICH REGISTRANT CAN PRECLUDE OTHERS FROM USING ITS MARK

Where a mark is strong, Registrant may preclude third parties from using the mark on similar or related goods. However, where a mark is not strong, Registrant may not preclude all third parties from using a similar mark. Here, there are at least one hundred seventy eight (178) active marks containing the term "**ONE STEP**." While this is not determinative information, such information is persuasive in determining that Applicant's mark may also coexist with Registrant's Marks without confusion. Moreover, this information supports the fact that Registrant cannot preclude others from using marks containing "**ONE STEP**." This factor weighs in favor of allowing registration of Applicant's mark.

X. INTERFACE BETWEEN APPLICANT/REGISTRANT–CONSENT AGREEMENT

As discussed at the outset of this brief, the Applicant and Registrant have entered into a Settlement and Consent agreement and related Letters of Consent. Accordingly, the parties have determined that confusion is not likely, and they have undertaken to prevent any such confusion going forward. Accordingly, this factor weighs in favor of reversing the Examiner's refusal of the subject Application.

CONCLUSION

Applicant believes that it has demonstrated that Applicant and the Registrant of the marks cited against the subject application believe confusion is not likely. Applicant and the Registrant

of the cited marks have entered into Letters of Consent and a related Settlement and Consent Agreement such that they believe confusion is not likely to occur, and they have agreed to take measures to remedy any confusion should such confusion arise. Ultimately, the Letters of Consent must be given great weight. Moreover, no likelihood of confusion exists between Applicant's marks and the Registrations cited against it, as explained above. Thus, Applicant respectfully requests that the Examiner's refusal of this Application be reversed.

Respectfully submitted,
LATHAM & WATKINS LLP

Dated: December 3, 2010

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1. *Accuride Int'l., Inv. V. Acuride Corp.*, 10 U.S.P.Q. 2d 1589 (9th Cir. 1989).
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3. *American Optical Corp. v. American Olean Tile Co.*, 185 U.S.P.Q. 405 (S.D.N.Y. 1974).
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9. *Del Laboratories, Inc. v. Alleghany Pharmacal Corp.*, 215 U.S.P.Q. 421 (S.D.N.Y. 1981).
10. *Edison Bros. Stores, Inc. v. Cosmair, Inc.*, 651 F. Supp. 1547 (S.D.N.Y. 1972).
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12. *Exquisite Form Industries, Inc. v. Exquisite Fabrics of London*, 378 F. Supp. 403 (S.D.N.Y. 1974).
13. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q. 2d 1442 (8th Cir. 1987).
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28. *Petro Stopping Centers L.P. v. James River Petroleum Inc.*, 44 U.S.P.Q. 2d 1921 (4th Cir. 1997).

29. *Saab-Scania Aktiebolag v. Sparkomatic Corp. Opposition*, 26 U.S.P.Q. 2d 1709 (TTAB. 1993).

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