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Subject: U.S. TRADEMARK APPLICATION NO. 77416487 - ONE-STEP - 036891-7-  
US0 - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**APPLICATION SERIAL NO.** 77416487

**MARK:** ONE-STEP



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Intuity Medical, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

036891-7-US0

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## EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant appeals the examining attorney's final refusal to register the mark "ONE-STEP" in standard characters for "blood glucose monitoring systems including the devices, and parts and accessories thereof." The examining attorney refused registration on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052 (d), because applicant's mark is likely to cause confusion with three registered marks owned by a single registrant for "ONE-STEP in stylized characters (Reg. No. 2719496)," "ONE-STEP in typed characters (Reg. No. 2922552)" and "ONE-STEP SAFETY LANCET in stylized character and with two horizontal lines design (Reg. No. 2969890)." It is respectfully requested that the refusal be affirmed.

### STATEMENT OF THE CASE

On March 7, 2008, applicant filed the application at issue. Registration was refused under Trademark Act Section 2(d) with respect to Registration Nos.

2719496, 2922552 and 2969890 in an Office action issued on May 21, 2008. The applicant filed a response on November 21, 2008, containing arguments in support of registration. The refusal pursuant to Trademark Act Section 2(d) was made final on November 25, 2008. On May 26, 2009, applicant filed a request for reconsideration requesting suspension pending the outcome of a petition to cancel the registrations at issue. A Notice of Appeal was filed concurrently with the request for reconsideration. On June 16, 2009, prosecution of the application was suspended pending disposition of Cancellation Proceeding No. 92051016. On January 13, 2010, applicant requested removal of the application from suspension and submitted a letter of consent for consideration. The application was removed from suspension and a subsequent final refusal under Trademark Act Section 2(d) with respect to Registration Nos. 2719496, 2922552 and 2969890 was re-issued on February 4, 2010, on the basis that the letter of consent was a “naked consent.” A third request for reconsideration was filed on June 30, 2010, containing arguments regarding the sufficiency of the consent letter. The request for reconsideration was denied on October 1, 2010, because no new evidence had been submitted. On December 7, 2010, jurisdiction was restored to the undersigned for a brief. The undersigned mistakenly issued a denial of a “Request for Reconsideration” Office action on December 23, 2010, which returned the application to the Board for resumption of the appeal.

#### ISSUE

The issue on appeal is whether the mark “ONE-STEP” in standard characters for “blood glucose monitoring systems including the devices, and parts and accessories thereof” is likely to be confused with three registered marks for “ONE-STEP

in stylized characters (Reg. No. 2719496),” “ONE-STEP in typed characters (Reg. No. 2922552)” and “ONE-STEP SAFETY LANCET in stylized characters with two horizontal lines design (Reg. No. 2969890)” all for “blood sampling prickers and parts therefore.”

## ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. In re Majestic Distilling Co., 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see In re E. I. du Pont, 476 F.2d at 1361-62, 177 USPQ at 567. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See In re Opus One, Inc., 60 USPQ2d 1812 (TTAB 2001); In re Dakin’s Miniatures Inc., 59 USPQ2d 1593 (TTAB 1999); In re Azteca Rest. Enters., Inc., 50 USPQ2d 1209 (TTAB 1999).

***I. Applicant’s mark “ONE-STEP” is highly similar in appearance, sound, connotation and commercial impression to the registered marks for “ONE-STEP (Reg. No.***

*2719496),” “ONE-STEP (Reg. No. 2922552)” and “ONE STEP SAFETY LANCET in stylized characters with two horizontal lines design (Reg. No. 2969890)”*

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. In re Dakin’s Miniatures, Inc., 59 USPQ2d 1593, 1596 (TTAB 1999); In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987); Amoco Oil Co. v. Amerco, Inc., 192 USPQ 729, 735 (TTAB 1976).

Applicant has applied for the mark “ONE-STEP” in standard character format. The registered marks are “ONE-STEP” in stylized characters (Reg. No. 2719496), “ONE-STEP” in typed characters (Reg. No. 2922552), and “ONE-STEP SAFETY LANCET” in stylized characters with two horizontal lines design. In the present instance, the words “one-step” which are shared by all marks, create the most significant commercial impression and should be accorded the greatest weight in determining likelihood of confusion. The words “one-step” when used in relation to blood glucose monitoring systems and blood sampling prickers, convey the same meaning and commercial impression, namely, that the goods may be used by performing one step. Furthermore, the design elements are minimal and should be accorded very little weight.

Applicant’s mark for “ONE-STEP” is in standard character format and the mark shown in registration number 2922552 for “ONE-STEP” is in typed format. These marks are identical in sound, appearance, meaning and commercial impression. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. See

37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., In re Melville Corp., 18 USPQ2d 1386, 1387-88 (TTAB 1991); In re Pollio Dairy Prods. Corp., 8 USPQ2d 2012, 2015 (TTAB 1988). Because the rights reside in the words rather than the stylization of the words, applicant mark for “ONE-STEP” in standard character format is confusingly similar to registration numbers 2719496 and 2969890, which also contain the words “one-step” in stylized characters. Other than the stylized characters, the only other design elements in the registered marks consist of hyphens and two horizontal lines under the word “one” in registration number 2699890. The hyphen between the words “one” and “step” is a common element in all of the marks. Lastly, the two horizontal lines in registration number 2699890 serve to emphasize the literal portion of the mark because it underlines it. Contrary to applicant’s argument that the design elements should be given considerable weight, the literal portions of the marks are more significant in the present instance.

The mark shown in registration number 2969890 is “ONE-STEP SAFETY LANCET” in stylized characters with double lines under the word “one” and with the words “safety lancet” disclaimed. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. See In re Dixie Rests., Inc., 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); In re Nat’l Data Corp., 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985).

As discussed above, the literal portions of marks are normally accorded more weight in a likelihood of confusion analysis. *In re Dakin's Miniatures, Inc, supra*. The words “one-step” in applicant’s mark and the mark in registration number 2969890 create the dominant commercial impression because the words “safety lancet” are disclaimed because they are descriptive. Contrary to applicant’s argument that “safety lancet” create a distinct impression, the words are less significant because they are descriptive of the goods.

The applicant relies on *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854(TTAB 1984) as well as several other cases from district courts and some circuit courts in support of the very general argument that “[c]ourts have consistently held that even identical marks may not be confusingly similar although they are used in connection with related goods and services.” (Applicant’s brief at p.10). The Board in *In re British Bulldog, Ltd.* held that the mark “players” evoked different meanings and connotations when used with “shoes” and “men’s underwear.” In contrast to the facts of the present case, the primary commercial impression and significance of the marks at issue is the same. Contrary to applicant’s very general argument, the facts and the case law support a finding of confusion under Section 2(d) in the present instance.

Applicant argues that the words “one step” are weak and states that there are at least one hundred seventy eight active marks containing these words. (Applicant’s brief at p. 16). However, applicant has not supported this statement with any evidence. Even assuming “one step” is a weak mark, the registered marks are still entitled to protection against applicant’s highly similar mark used on closely related goods. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have

recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. In re Colonial Stores, Inc., 216 USPQ 793, 795 (TTAB 1982); *see* King Candy Co. v. Eunice King’s Kitchen, Inc., 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974).

***II. The applicant and registrant’s goods are closely related, travel in the same channels of trade and are marketed to the same class of purchasers.***

The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See* Herbko Int’l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); Han Beauty, Inc. v. Alberto-Culver Co., 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001).

Applicant’s goods are “blood glucose monitoring systems including devices, and parts and accessories thereof.” The goods listed in all three registrations are “blood sampling prickers and parts therefore.” In a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); In re Dakin’s Miniatures, Inc., 59 USPQ2d 1593, 1595 (TTAB 1999). In this case, applicant’s goods and/or services are identified broadly. Therefore, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant’s more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See* In re La Peregrina Ltd., 86

USPQ2d 1645, 1646 (TTAB 2008); In re Jump Designs LLC, 80 USPQ2d 1370, 1374 (TTAB 2006). In particular, the words “including devices, and parts and accessories thereof” are broad enough to include prickers or lancets for the purpose of sampling blood.

As specified in the identifications, applicant’s goods are for the purpose of monitoring blood glucose and registrant’s goods are for “sampling blood.” Applicant and registrant’s goods are marketed to the same class of purchasers, namely, people with diabetes who need to check their blood glucose levels daily. People with diabetes would be the class of purchasers for both applicant’s and registrant’s goods because they would need to take blood samples by using prickers, as well as monitor their blood glucose levels by using a monitoring device.

Furthermore, the websites attached to the Office action of November 25, 2008, are evidence of companies that manufacture the types of goods at issue as well as market them under the same marks. The following are representative examples of these websites which show blood glucose monitoring devices sold under the same marks as prickers or lancets:

***Excerpt from pages 8-9 of Office action of 11/25/08:*** “ACCU-CHEK®/Accucheck Products/ Blood Glucose Meters; Accu-Chek Aviva/ Test Strip and Lancet “Test Strip and Lancet Accu-Chek Multiclix Finger Pricker” and “ACCU-CHEK® Aviva Blood Glucose Meter System.”

***Excerpt from page 29 of Office action of 11/25/08:*** “Ascensia Coutour Blood Glucose Monitoring System” and “Ascensia Microlet Vaculance Lancing Device”

Lastly, the websites attached to the Office action of November 25, 2008, also evidence that the goods at issue travel in the same channels of trade. Because glucose monitoring

systems and blood sampling prickers are tools that are used in checking blood glucose levels, they are often marketed together on the same website, as evidenced on page thirty-five of the Office action of November 25, 2008, consisting of a retail website for “Towers Pharmacy.”

Applicant argues that its goods are targeted to the diabetic consumer whereas, registrant’s goods are marketed to clinicians and hospitals. (Applicant’s brief at p. 14). The record does not contain any evidence to support this argument. Furthermore, in a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); In re Dakin’s Miniatures, Inc., 59 USPQ2d 1593, 1595 (TTAB 1999). In this case, the identifications set forth in the cited registrations use broad wording to describe registrant’s goods and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registrations encompass all goods of the type described and that the goods move in all normal channels of trade, and that they are available to all potential customers, including diabetic consumers. See In re Thor Tech, Inc., 90 USPQ2d 1634, 1638-39 (TTAB 2009); In re Jump Designs LLC, 80 USPQ2d 1370, 1374 (TTAB 2006); In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

***III. Applicant’s Letter of Consent is a “Naked” Consent and Does Not Overcome the Likelihood of Confusion Refusal Under Section 2(d) of the Trademark Act***

In the request for reconsideration filed on January 13, 2010, applicant submitted a letter of consent from registrant, MediPurpose Pte. Ltd. The letter of consent

specifies applicant's name, address and its trademark applications, as well as registrant's name, address and its registrations. The third and final paragraph of the letter of consent is copied in its entirety as follows:

“Pursuant to the Settlement and Co-Existence Agreement dated as of the date hereof by and among Intuity Medical, Inc. and MediPurpose Pte. Ltd, MediPurpose Pte. Ltd hereby grants its consent for Intuity Medical, Inc. to use and obtain registration in the United States and internationally of its ONE STEP and ONE-STEP marks in connection with the following goods: *blood glucose monitoring systems including the devices, and parts and accessories thereof* in Class 10.”

The submitted letter of consent is a “naked consent” and is insufficient to overcome a likelihood of confusion refusal because it neither (1) sets forth reasons why the parties believe there is no likelihood of confusion, nor (2) describes the arrangements undertaken by the parties to avoid confusing the public. See In re Mastic, 829 F.2d 1114, 1117-18, 4 USPQ2d 1292, 1295-96 (Fed. Cir. 1987); In re Permagrain Prods., Inc., 223 USPQ 147, 149 (TTAB 1984). Without additional factors to support the conclusion that confusion is unlikely, naked consents are generally accorded little weight in a likelihood of confusion determination. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A. 1973).

Factors to be considered in weighing a consent agreement include the following:

- (1) Whether the consent shows an agreement between both parties;
- (2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
- (3) Whether the parties agree to restrict their fields of use;

- (4) Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
- (5) Whether the marks have been used for a period of time without evidence of actual confusion.

See In re Four Seasons Hotels Ltd., 987 F.2d 1565, 1569, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993); In re Mastic, 829 F.2d at 1117-18, 4 USPQ2d at 1295-96; cf. Bongrain Int'l (Am.) Corp. v. Delice de Fr., Inc., 811 F.2d 1479, 1485, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987).

The letter of consent filed on January 13, 2010, does not evidence an agreement between the parties because it is signed by only one party, the registrant. Furthermore, the letter of consent is “naked” because it does not contain any indication that the goods travel in separate trade channels, whether the parties agree to restrict their field of use, whether the parties will make efforts to prevent confusion in the future or whether the marks have been used for a period of time without evidence of confusion. In conclusion, the letter of consent is insufficient to overcome the refusal under Section 2(d) of the Trademark Act.

In the request for reconsideration filed on June 30, 2010, applicant states that the terms of its settlement agreement with registrant are confidential and references some of the general terms contained in the alleged settlement agreement, none of which has been submitted as evidence. As stated above, the letter of consent is a “naked” consent and is the only evidence of record which references the content of any agreement between the parties. The statements made by applicant’s attorney in the request for reconsideration regarding the content of the alleged settlement agreement, do not change the nature of the letter of consent that is of record because the statements made in the

request for reconsideration have not been signed and agreed to by both parties. In conclusion, the statements are unsubstantiated by any evidence in the record and should not be given much weight in determining whether the letter of consent is sufficient to overcome the likelihood of confusion refusal.

#### CONCLUSION

The applicant's mark is highly similar in appearance, sound, connotation and commercial impression to the registrant's marks and the goods are closely related. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register, under Trademark Act Section 2(d), because the marks are likely to cause confusion, or to cause mistake, or to deceive.

Respectfully submitted,

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