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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Intuity Medical, Inc.

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Serial No. 77416484
Serial No. 77416487

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Deborah A. Gubernick of Latham & Watkins LLP for Intuity Medical, Inc.

Khanh M. Le, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Walters, Zervas, and Bergsman, Administrative Trademark Judges.

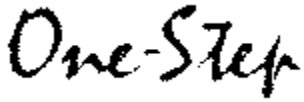
Opinion by Bergsman, Administrative Trademark Judge:

Intuity Medical, Inc. ("applicant") filed intent-to-use applications for the marks ONE STEP and ONE-STEP, both in standard character form, and both for "blood glucose monitoring systems including the devices, and parts and accessories thereof" in Class 10.

Registration has been refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used in connection with "blood glucose monitoring systems including the devices, and parts and accessories thereof" so resemble the three

previously registered ONE STEP marks set forth below all for "blood sampling prickers and parts therefore," in Class 10, as to be likely to cause confusion. The three registrations are owned by the same entity.

1. Registration No. 2719496 for the mark ONE-STEP and design, shown below;[1]



2. Registration No. 2922552 for the mark ONE-STEP, in typed drawing form;[2] and

3. Registration No. 2969890 for the mark ONE-STEP SAFETY LANCET and design, shown below.[3] Registrant disclaimed the exclusive right to use the term "Safety Lancet."

Because the applications are owned by the same applicant and involve common issues of fact and law, we have consolidated the appeals.

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[1] Issued May 27, 2003; Sections 8 and 15 affidavits accepted and acknowledged.
[2] Issued February 1, 2005; Sections 8 and 15 affidavits accepted and acknowledged.
[3] Issued July 19, 2005. Registrant filed affidavits of use and incontestability under Sections 8 and 15 on June 16, 2011.

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also, In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. <u>The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression</u>.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.,* 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.,* 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.,* 6 USPQ2d 1041, 1042 (TTAB 1988). In analyzing the similarity or dissimilarity of the marks, we are mindful that the test is not whether

the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.,* 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.,* 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992).

Applicant's marks ONE STEP and ONE-STEP are virtually identical to the registered marks ONE-STEP, One-Step, and ONE-STEP safety lancet. Nevertheless, applicant contends that the marks are not similar.

> 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."[4]

[4] Applicant's Brief, p. 11.

Suffice it to say that we disagree. Applicant has not offered any credible arguments in support of its contention that the marks create separate and distinct visual impressions.

B. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers.

It is well-settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

To prove that applicant's blood glucose monitoring systems including the devices, and parts and accessories

thereof and the registrant's and blood sampling prickers and parts therefore are related, the Examining Attorney has submitted use-based, third-party registrations for the goods listed in both the applications and registrations at issue.[5] Third-party registrations which individually cover a number of different services that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.,* 29 USPQ2d at 1785-1786; *In re Mucky Duck Mustard Co. Inc.,* 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The third-party registrations are listed below with the relevant goods.

Mark	**Reg. No.**	**Goods**
SPECIALTY MEDICAL SUPPLIES	342485	Devices for drawing blood, lancets,[6] lancing devices; blood glucose meters; devices for measuring blood sugar
LIBERTY	3040046	Blood glucose meters; lancets and lancing devices

[5] This would have been a good case for the examining attorney to have required applicant to identify the "devices, parts and accessories thereof" comprising the blood glucose monitoring system in the event applicant's devices included lancets or the like.

[6] A "lancet" is a "surgical knife with a short, wide, sharp-pointed, two-edge blade." Stedman's Medical Dictionary (28th ed. 2005). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,* 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Mark	**Reg. No.**	**Goods**
TEST RIGHT THE FIRST TIME	3220634	Blood glucose monitor; blood glucose monitoring kit consisting of a blood glucose monitor, diagnostic test strips, lancets and control solutions for medical diagnostic use
FREESTYLE FREEDOM	3169832	Instruments and sensors for measuring blood glucose levels; apparatus for drawing or sampling blood, namely, lances, lancets, and lancing devices
GLUCOGUARD	3320219	Blood glucose monitoring apparatus; puncturers for medical use, namely, lancets.
ACCU-CHEK GO	3206211	Blood glucose measuring devices; lancets

In the November 25, 2008 Office Action, the examining attorney submitted excerpts from websites showing that blood drawing devices are a component of blood glucose monitoring systems.

1. *GlueText* website (gluetext.com) advertises an ACCU-CHEK brand "Multiclix Finger Pricker," lancets, blood glucose testing strips, and a blood glucose meter system.

2. The *Epinions.com* website presented reviews of the TheraSense FreeStyle Flash Blood Glucose Meter. The reviews provided the following statements:

> When dealing with a medical device designed to poke a hole in your skin, you want two things: accuracy and ease of use.
>
> Pros: Small blood drop, smaller meter, smaller lancer.
>
> Cons: Lancer doesn't keep setting, mine was defective.
>
> The included lancet supports testing from different locations.
>
> Lance is not as good as some.
>
> Lancing device will not maintain settings.
>
> Supplied lancing device is weak and may require you to re-stick to get blood drop.

3. The OneTouch UltraMini Blood Glucose Monitoring system advertised at *activeforever.com* includes, *inter alia,* a blood glucose meter and a lancing device.

The language used in a description of goods in an application or registration should be understandable to the average person and should not require an in-depth knowledge of the relevant field. "An identification may include terms of art in a particular field or industry, but, if these terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology." TMEP § 1402.01 (7th ed. 2010). Accordingly, the term "blood

sampling pricker" in the registrant's description of goods means a device that pricks the skin to obtain a blood sample. A lancet falls within the definition of a blood sampling pricker. In this regard, we note in the mark ONE-STEP SAFETY LANCET and design, the registrant refers to its blood sampling pricker as a lancet. The evidence demonstrates that blood sampling prickers, or lancets, are a component of blood glucose monitoring systems, or that they are used in conjunction with blood glucose monitoring systems, because that is how the user obtains the blood sample. Thus, blood sampling prickers move in the same channels of trade and are sold to the same classes of consumers as blood glucose monitoring systems.

Applicant argues that "[b]lood glucose monitoring systems are distinct from 'blood sampling prickers' since the monitoring system is to evaluate the levels of glucose in the blood. Blood sampling prickers, by contrast, are typically specialized needles for the purpose of puncturing the skin to obtain blood, usually in the clinical or laboratory setting."[7] This argument is not supported by the description of goods in the application or registrations nor is it supported by the evidence.

[7] Applicant's November 21, 2008 Response.

First, applicant's description of goods includes the devices, parts and accessories for a blood glucose monitoring system. As discussed above, the evidence shows that a blood sampling pricker or lancet is a component of a blood glucose monitoring system, and that blood sampling prickers are used in conjunction with blood glucose monitoring systems, because that is how the system user gets the blood to sample. Second, there is nothing in the record to explain that the term "blood sampling pricker" is a term of art in the medical field meaning a specialized needle. Thus, the term "blood sampling pricker" has its ordinary meaning for purposes of the likelihood of confusion analysis.

Applicant also argues that its blood glucose monitoring systems are marketed to diabetics while registrant's products "are for *needles* or as medically described by Registrant, 'blood sampling prickers' for various medical uses in a clinical setting."[8] (Emphasis in the original). As discussed above, the term "blood sampling prickers" is broad enough to encompass blood drawing devices used in connection with monitoring blood glucose levels. There is no restriction in the description

[8] Applicant's Brief, p. 13.

of goods for the registrations limiting the blood sampling prickers to any specific use. Moreover, as pointed out above, applicant failed to introduce any evidence to show that the term "blood sampling prickers" is a term of art with a generally understood meaning in the medical field. Accordingly, there is no basis for us to distinguish the use of registrant's blood sampling prickers as argued by applicant.

In view of the foregoing, we find that the goods at issue are related, move in the same channels of trade and are sold to the same classes of consumers.

C. The degree of consumer care.

Applicant argues that its blood glucose monitoring systems are sold to diabetics who exercise a high degree of consumer care because their lives depend upon accurate measurements of blood glucose levels.[9] Applicant also contends that registrant's blood prickers are sold to clinicians in hospital settings and that these consumers exercise a high degree of care because they are using the "needles" to render medical services.[10]

As indicated above, there is no evidentiary basis supporting the distinction in trade channels and classes of

[9] Applicant's Brief, p. 15.
[10] *Id.*

consumers for the products at issue. Even assuming that a high degree of care, that does not outweigh the similarity of the marks and the relatedness of the goods, and the similarity in the channels of trade and classes of consumers. *See Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.,* 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible.").

D. The strength of the registered marks.

Applicant argues that ONE-STEP is a weak mark and that, therefore, it is entitled to only a narrow scope of protection. Applicant asserts that "there are at least one hundred seventy eight (178) active marks containing the term '**ONE STEP**.'"[11] To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted during prosecution of the application. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Applicant did not submit copies of the "active marks" in support of this

[11] Applicant's Brief, p. 16.

argument.[12] Moreover, applicant did not limit its argument to the use and/or registration of the mark ONE STEP to the medical field. *See Hunt Foods & Industries, Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 151 USPQ 350, 353 (CCPA 1966) ("the nature of the products covered by the third-party registrations is a factor to be considered in determining the distinctiveness of the mark in relation to the issue of likelihood of confusion"); *In re Imperial Jade Mining, Inc.*, 193 USPQ 725, 726-727 (TTAB 1977) ("the indiscriminate citation of third-party registrations without regard to the goods involved cannot be indicative of weak marks or suggestive or descriptive connotations").

E. Letter of Consent.

On January 13, 2010, applicant submitted a letter of consent for the registration of its applications signed by the registrant. The terms and conditions upon which the letter of consent is based reads, in its entirety, as follows:

> Pursuant to the Settlement and Co-Existence Agreement dated as of the date hereof by and among [applicant] and [registrant], [registrant] hereby grants its consent for [applicant] to

[12] To the extent that applicant's third-party "active marks" include pending applications, we note that applications are evidence only of the fact that they were filed. *Interpayment Services Ltd. v. Docters & Thiede,* 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

> 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. (Emphasis in the original).

In her February 4, 2010 Office Action, the examining attorney explained that the letter of consent was "insufficient to overcome the 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." The examining attorney further advised applicant that in evaluating a letter of consent or a consent agreement, the Office considers whether the goods move in different channels of trade, whether the parties agree to somehow restrict their fields of use, whether the parties agree to cooperate and take steps to avoid confusion, and the extent to which the marks have been used without any reported instances of confusion.

In response, applicant explained that applicant and registrant executed a detailed settlement agreement that specifically addressed the issues raised by the examining attorney. However, because the terms of the settlement agreement are confidential, applicant would not disclose

them.[13] Although applicant could have submitted a copy of the confidential settlement agreement with the truly confidential terms redacted, it did not.[14] Thus, applicant submitted only a "naked consent."

Despite that fact that in its brief, applicant argued that the marks are different, the goods listed in the cited registration and the goods listed in the application are different, that the goods move in different channels of trade and are sold to different classes of consumers and that the relevant consumers exercise a high degree of care when making their purchasing decision, no facts supporting those arguments appear in the letter of consent. Nevertheless, applicant argued that the letter of consent is entitled to great weight.

> [B]ecause the parties themselves entered into an 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 [sic] of Consent should be

[13] Applicant's June 30, 2010 Response.
[14] As an attachment to its reply brief, applicant submitted a copy the confidential settlement agreement presenting only the introductory paragraph identifying the parties and the signature blocks. Everything else was redacted, including the "Whereas" clauses.

> given great weight, and Applicant's mark should be granted registration.[15]

A "naked consent," as presented by applicant in this case, carries little weight as compared to a more detailed agreement. *In re Four Seasons Hotels Ltd.,* 987 F.2d 1565, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993); *In re Du Pont,* 177 USPQ at 568. A letter of consent must reflect "the considered judgment of experienced businessmen that confusion is not likely in their respective uses of the mark. … One must look at all of the surrounding circumstances, as in *DuPont,* to determine if the consent reflects the reality of no likelihood of confusion in the marketplace, or if the parties struck a bargain that may be beneficial to their own interests, regardless of any confusion to the public." *In re Mastic Inc.,* 829 F.2d 1114, 4 USPQ2d 1292, 1294 (Fed. Cir. 1987).

> If the evidence of record establishes facts supporting an applicant's argument that the two uses can exist without confusion of the public, even a "naked" consent to registration is significant additional evidence in support of the applicant's position. If, in addition, the consent is "clothed" with the parties' agreement to undertake specific arrangements to avoid confusion of the public, as in *DuPont*, the parties' assessment of no likelihood of confusion is entitled to greater weight, not because of the

[15] Applicant's Brief, p. 5.

> consent itself, but because such arrangements are additional factors which enter into the likelihood of confusion determination.

Id. In other words, the consent agreement or letter of consent should reflect the relevant *du Pont* likelihood of confusion factors. *Id.* at 1295. In this case, the letter of consent is conspicuously silent as to the underlying facts which led registrant to the conclusion that there is no likelihood of confusion.

Applicant explained that applicant and registrant entered into a Settlement Agreement "with terms much more specific than those listed in the Letters [sic] of Consent, however, the complete terms of [sic] the Settlement Agreement were intended to be confidential."[16] Because blood glucose monitoring systems, in general, and blood sampling prickers are products that are sold in commerce, it is hard to imagine how the facts supporting the purported differences in the marks, the goods, their channels of trade, and the classes of consumers, as well as the degree of consumer care constitute confidential information. There is simply no credible explanation for why this type of information was not included in the letter of consent.

[16] Applicant's Brief, p. 4.

Accordingly, under the circumstances of this case, the letter of consent has little, if any, probative value.

E. Balancing the factors.

In view of the facts that the marks are virtually identical, the goods are related, and the goods move in the same channels of trade and are available to the same classes of consumers, we find that applicant's registration of the marks ONE STEP and ONE-STEP for "blood glucose monitoring systems including the devices, and parts and accessories thereof" are likely to cause confusion with the ONE-STEP registrations for "blood sampling prickers and parts therefore."

Decision: The refusals to register are affirmed.