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

Proceeding	85924742
Applicant	Myriad Genetics, Inc.
Applied for Mark	MYRIAD MYRISK
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of:	Myriad Genetics, Inc.)	
)	
Serial No.:	85/924,742)	
)	Law Office
Filing Date:	May 6, 2013)	110
)	
Mark:	MYRIAD MYRISK)	
)	
International Class:	010 and 044)	
)	
Examining Attorney:	Dezmona J. Mizelle-Howard)	

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BRIEF FOR APPLICANT-APPELLANT ON APPEAL

This is an appeal from the Examining Attorney's final refusal to register Myriad Genetics, Inc.'s ("Applicant") application to register the mark MYRIAD MYRISK ("Applicant's Mark") based on a likelihood of confusion with the mark MIRISK, Reg. No. 4,276,884, and MIRISK VP, Reg. No. 4,379,753 (together, the "Cited Marks"), owned by Aviiir, Inc. ("Aviiir"). Applicant disagrees and respectfully requests that the Trademark Trial and Appeal Board (the "Board") reverse the Examining Attorney's decision for the reasons stated herein.

1. Statement of Facts

Applicant seeks registration on the Principle Register of its mark MYRIAD MYRISK, for the following goods:

"Non-surgical medical test kits consisting of test forms, mailing materials, user information inserts, and specimen collection tubes and containers for collecting patient specimens for detection of gene mutations, gene expression profiles or other molecular indicators or markers associated with disease or risk of developing disease, excluding cardiovascular disease" in International Class 010; and

"Testing for medical purposes, namely, providing reference and clinical laboratory tests which detect gene mutations, gene expression profiles or other molecular indicators or markers associated with disease or risk of developing disease, excluding cardiovascular disease; medical testing services for predicting disease and identifying risk factors of disease, excluding cardiovascular disease" in International Class 044.

Applicant filed its application on May 6, 2013, which was assigned Serial Number 85/924,742. The Examining Attorney refused registration in a non-final action dated August 23, 2013 based on an alleged likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) with the Cited Marks which are registered for use in connection with "Medical laboratory services" in Class 042 and, in the case of MIRISK VP, "Medical diagnostic testing and assessment services to determine patient's risk of cardiovascular disease" in Class 044. The Examining Attorney also alleged a likelihood of confusion with another registered mark, but withdrew the allegation after Applicant obtained consent from the owner of the registered mark.

With respect to the Cited Marks, Applicant filed a response on February 24, 2014 in which it amended the description of goods and submitted arguments against likelihood of confusion with the Cited Marks. In arguing against a likelihood of confusion, Applicant put forth arguments as to why consumers are unlikely to confuse products and services offered under Applicant's Mark and the Cited Mark as emanating from the same source. Applicant argued, with ample support from case law, that registration of Applicant's Mark is unlikely to cause confusion with the Cited Marks primarily for the following reasons: (1) there are differences between the appearance, sound, meaning, and commercial impression of the marks; (2) the relevant consumers are sophisticated and not likely to confuse the marks; and (3) Applicant's goods and services, as amended, are neither competitive nor closely related to the goods and services associated with the Cited Marks.

To show a difference in appearance, Applicant pointed out that Applicant's Mark begins with the term "MYRIAD," that Applicant's Mark uses the term "MYRISK" rather than "MIRISK" used in the Cited Marks, and that one of the Cited Marks includes the term "VP." The marks share no identical elements in terms of appearance. Applicant further argued that the dominant element of each mark, which is the first term of each, is entirely distinct.

To show the difference in meaning, Applicant argued that, because of the first word MYRIAD in its mark, consumers will recognize Applicant's Mark as belonging or related to Applicant, as MYRIAD is Applicant's primary trademark that has been used extensively in connection with Applicant's goods and services since at least as early as 1993.

Applicant also provided evidence that the marks, when spoken, sound different due to the different first words in each mark and the word "MYRIAD" is unique to Applicant's Mark and "VP" is unique to the MIRISK VP mark.

Applicant next reasoned that the intended consumers are sophisticated, have an increased duty of care and are unlikely to confuse the marks. The goods and services offered under both Applicant's Mark and the Cited Marks are prescribed and dispensed by professionals who are not prone to carelessness, are experienced in distinguishing between the names of products, perform under an increased duty of care and are less likely to confuse similar marks used on related or identical goods.

Finally, Applicant argued that its services and the services used in connection with the Cited Marks are neither competitive nor closely related.

The Examining Attorney responded with a Final Action dated March 18, 2014, arguing that the marks are similar in sight, sound and meaning because “they all contain the MIRISK/MYRISK which are phonetic equivalents.” In doing so, the Examining Attorney ignored Applicant’s arguments regarding the importance of the additional distinct element “MYRIAD” in Applicant’s Mark, despite the Examining Attorney previously admitting that “MYRIAD is a strong mark in the relevant field.” The Examining Attorney also maintained the argument that the goods and services are related.

On September 18, 2014, Applicant filed a Notice of Appeal and a Request for Reconsideration wherein Applicant presented arguments to refute the Examining Attorney’s grounds for refusal. First, Applicant argued that the Cited Marks have been abandoned. Applicant further argued and provided additional evidence showing that the commercial impression of the marks are distinct. Next, Applicant argued and provided additional evidence showing that the intended consumers are sophisticated, have an increased duty of care and are therefore unlikely to confuse the marks. Fourth, Applicant argued and provided additional evidence showing that the parties’ goods and services are neither competitive nor closely related. In addition, Applicant argued and provided additional evidence showing that the channels of trade are distinct. Finally, Applicant provided evidence to show that the Cited Marks are weak.

The Examining Attorney rejected the Request for Reconsideration on December 8, 2014 by maintaining the same position, resulting in Applicant pursuing this Appeal.

2. Arguments

a. Legal Standard for 2(d) Determinations

The determination of likelihood of confusion requires a two-part analysis. First, the similarity or dissimilarity of the marks is analyzed in terms of their “appearance, sound, connotation and commercial impression.” *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973). Second, the relatedness of the goods or services is analyzed for similarities or differences. *Id.*

In assessing the likelihood of confusion, all of the evidence must be considered, “whether or not confusion appears likely.” *Id.* at 1362. The weight given to any one factor varies in light of the circumstances, but the crucial issue is always whether an appreciable number of ordinarily prudent purchasers of the associated goods are likely to be misled or confused as to the source of the goods in question. *Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1003, 222 USPQ 373

(2d Cir. 1983); *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 253, 216 USPQ 177 (2d Cir. 1982) (AUTUMN for margarine not likely to be confused with AUTUMN GRAIN for bread).

A mere possibility of confusion is not enough. *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993) (mark PARENTS not confusingly similar to mark PARENT'S DIGEST for child-rearing magazines). Likelihood means probability. When only a possibility, rather than a probability, of confusion exists, registration of Applicant's Mark should be allowed. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2014).

When all the elements of Applicant's Mark and the Cited Marks are considered, it is clear that there are significant differences between Applicant's Mark and the Cited Marks. Accordingly, confusion is unlikely.

b. The Appearance, Meaning, Sound and Commercial Impression of the Marks Are Distinct

The Examining Attorney admits that "MYRIAD is a strong mark in the relevant field." Office Action, Mar. 18, 2014. Nevertheless, throughout prosecution, the Examining Attorney has focused primarily on the words "MYRISK" and "MIRISK," excluding the overall impression of the marks. The marks in question, however, must be compared in their entireties. *See Ross Bicycles, Inc. v. Cycles USA, Inc.*, 765 F.2d 1502, 1507, 226 USPQ 879 (11th Cir. 1985) ("the marks ultimately must be considered as a whole"); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689 (Fed. Cir. 2005). To decide likelihood of confusion solely on the basis of one feature violates the antidissection rule. *See Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423, 49 USPQ2d 1355 (6th Cir. 1999). Two marks that share "identical, even dominant, words in common does not automatically mean that" such marks are similar. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987). When all of the elements of Applicant's Mark and the Cited Marks are considered it is clear that each mark produces a distinct commercial impression so as to eliminate the potential for consumer confusion.

i. The Appearance of the Marks Are Distinct

The appearance of Applicant's Mark is substantially different than the appearance of the Cited Marks. The Cited Marks consist of MIRISK and MIRISK VP whereas Applicant's Mark

consists of MYRIAD MYRISK. The marks do not share a single identical term, with the only similarity being the terms “MIRISK” and “MYRISK,” which are each spelled differently.

Further, the dominant portions of each mark are entirely distinct. The first term of the Cited Marks is “MIRISK.” In contrast, the first term of Applicant’s Mark is “MYRIAD,” which the Examining Attorney admits “is a strong mark in the relevant field.” Office Action, March 18, 2014. “MIRISK” and “MYRIAD” are strikingly different and create two distinctly different visual impressions, a factor the Examining Attorney has completely ignored. As tribunals have repeatedly found, the first word, prefix, syllable or letter in a mark is generally the dominant part of the mark, in part, because it is often the first part of a mark that is impressed upon the mind of a purchaser. *See, e.g., Palm Bay Imps., Inc.*, 396 F.3d at 1372-73 (VEUVE was a prominent element of the mark VEUVE CLICQUOT because it was “the first word in the mark and the first word to appear on the label”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (T.T.A.B. 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”); *Pathfinder Commc ’ns Corp. v. Midwest Commc ’ns Co.*, 593 F. Supp. 281, 284, 224 USPQ 203 (N.D. Ind. 1984) (finding that it is an “accepted fact that people perceive differences which occur at the end of words less clearly than when differences occur at the beginning of words”); *Bunte Bros. v. Standard Chocolates, Inc.*, 45 F. Supp. 478, 481, 53 USPQ 668 (D. Mass. 1942) (“First names in trade-marks catch the eye and ear. They are very likely to be the dominant words. Where an only word or first word of a trade-mark is adopted by a competitor, as the first word in its trade-mark, there is more likelihood of confusion than when second or later words are used.”). As the Examining Attorney has agreed, “[g]reater weight is often given to th[e] dominant feature when determining whether marks are confusingly similar.” Office Action, Dec. 8, 2014. In this case, the dominant elements of the marks are significantly different, which precludes the likelihood of consumer confusion between use of Applicant’s Mark and the Cited Marks.

In at least two recent decisions, the Board has found no likelihood of confusion in cases very similar to this one. First, in a precedential decision from 2011, the Board found that the mark ZU ELEMENTS was unlikely to cause confusion with ELEMENT for similar goods because the addition of the word “zu” created a mark with a different appearance, sound, connotation and commercial impression, where both marks were used on virtually identical goods. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1074-75 (T.T.A.B. 2011). The Board reasoned that “[a]lthough applicant’s mark practically incorporates opposer’s

ELEMENT mark, the term ZU dominates applicant's mark and is very different from opposer's marks." *Id.* at 1076. Here, the different spelling of the terms "MYRISK" and "MIRISK," the presence of the "strong mark" MYRIAD in Applicant's Mark and the additional term "VP" in one of the Cited Marks creates marks with a different appearance, pronunciation, and meaning to an even greater degree than "ZU" in *Rocket Trademarks*, which makes the marks even more dissimilar.

Second, the Board recently found no likelihood of confusion between the mark CAPITAL CITY BANK and CITIBANK. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645 (T.T.A.B. 2010). The marks in *Citigroup* shared two common words and were used on identical services. *Id.* at 1658-59. The Board found that the use of a different word "CAPITAL" in one mark was sufficient to create a different commercial impression from the other mark. *Id.* at 1664. The differences between Applicant's Mark and the Cited Marks are even more pronounced than the differences between the marks in *Citigroup*.

The Board and other tribunals have consistently found that differences in the first words of marks are sufficient to prevent a likelihood of confusion, even when the goods or services are identical or closely related. *See, e.g., Jet, Inc.*, 165 F.3d 419 (finding no likelihood of confusion between JET and AEROB-A-JET, both for waste water treatment devices); *Spex, Inc. v. Joy of Spex, Inc.*, 847 F. Supp. 567, 31 USPQ2d 1019 (N.D. Ill. 1994) (finding no likelihood of confusion between SPEX, INC. and THE JOY OF SPEX, INC., both for the sale of eyewear); *Bell Labs., Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 231 USPQ 569 (S.D. Fla. 1986) (no likelihood of confusion between FLIP and FINAL FLIP when used in connection with pesticides and rodenticides); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (T.T.A.B. 2009) (finding no likelihood of confusion between VOLTA for caffeine-infused vodka and TERZA VOLTA for wines); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844 (T.T.A.B. 2008) (finding no likelihood of confusion between BASS PRO SHOPS SPORTSMAN'S WAREHOUSE (with SPORTSMAN'S WAREHOUSE disclaimed) and SPORTSMAN'S WAREHOUSE (with all wording disclaimed) for the same services); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715 (T.T.A.B. 2007) (finding no confusion between GULPY for animal water containers and BIG GULP and related ___ GULP marks for fountain drinks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (T.T.A.B. 1986) (finding no likelihood of confusion between CATFISH BOBBERS for fish and BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (T.T.A.B. 1985) (finding no likelihood of confusion between

GOLDEN CRUST for flour and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (T.T.A.B. 1984) (finding no likelihood of confusion between DESIGNERS/FABRIC (stylized) for retail fabric store services and DAN RIVER DESIGNER FABRICS and design for textile fabrics); *Miller Brewing Co. v. Premier Beverages, Inc.*, 210 USPQ 43, 48-49 (T.T.A.B. 1981) (finding no likelihood of confusion between MILLER and OL' BOB MILLER, both for beverages); *Standard Brands Inc. v. Peters*, 191 USPQ 168 (T.T.A.B. 1975) (no likelihood of confusion between CORN-ROYAL for butter and margarine and ROYAL for a variety of food products, including shortening); *United Drug Co. v. Mercirex Co.*, 182 F.2d 222, 86 USPQ 112 (C.C.P.A. 1950) (finding no likelihood of confusion between REX and MERCIREX, both for medications).

Further, tribunals have found no likelihood of confusion in cases similar to this even when similar marks are used in connection with closely related goods and services. *See, e.g.*, *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 USPQ 1161 (Fed. Cir. 1999) (no likelihood of confusion between MAGNIVISION and MAGNA•DOT, both for eyeglasses); *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (B A D not likely to be confused with B.V.D., both for clothing); *Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 185 USPQ 321 (2d Cir. 1975) (KICK'ER not likely to be confused with KIK-IT, both for tabletop soccer games); *Church of the Larger Fellowship of Unitarian Universalist v. Conservation Law Found.*, 221 USPQ 869 (D. Mass. 1983) (no likelihood of confusion between the identical marks CLF); *Carefirst of Md., Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492 (T.T.A.B. 2005) (no likelihood of confusion between CAREFIRST and FIRSTCAROLINACARE when used in connection with healthcare services); *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (T.T.A.B. 1986) (no likelihood of confusion between POLY PRO and POLY FLO, both for paintbrushes); *Glamorene Prods. Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (T.T.A.B. 1979) (finding no likelihood of confusion between SPRAY 'N VAC and RINSENVAC, both for vacuum rug cleaners); *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457 (T.T.A.B. 1978) (AQUASEAL and AQUA STREAM, both for plumbing products, not likely to be confused); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384, 1385, 179 USPQ 45 (C.C.P.A. 1973) (finding no likelihood of confusion between SILK for face cream and SILK 'N SATIN for lotion and bath oil for hands and skin); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 USPQ 392

(C.C.P.A. 1972) (no likelihood of confusion between ALL and ALL CLEAR! when used in connection with household cleaning products). The differences between Applicant's Mark and the Cited Marks are as conspicuous as the differences between the marks found distinctive in these cases.

ii. The Meaning of the Marks Are Distinct

The meanings of the marks are also entirely different, another factor weighing in favor of registration. Courts and the Board frequently find that the inclusion of additional terms in similar marks is sufficient to distinguish such marks where the marks in their entireties convey substantially different meanings. *See, e.g., Castle & Cooke, Inc. v. Oulevay, S.A.*, 370 F.2d 359, 152 USPQ 115 (C.C.P.A. 1967) (FARENDOLE not confusingly similar to DOLE for related food products because DOLE is so merged into FARANDOLE that it loses its individual identity therein); *Lever Bros.*, 463 F.2d 1107 (mark ALL CLEAR! not confusingly similar to ALL); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (C.C.P.A. 1970) (no likelihood of confusion found between marks PEAK for dentifrice and PEAK PERIOD for personal deodorant); *Outback Steakhouse of Fla., Inc. v. Waterworldwide Pty Ltd.*, Opp. No. 91161384, 2009 WL 129559 (T.T.A.B. Jan. 7, 2009) (finding that OUTBACK RAIN and Design for water is not confusingly similar to OUTBACK STEAKHOUSE and Design for beer).

In this case, Applicant's Mark includes the additional term "MYRIAD" while one of the Cited Marks also includes the additional term "VP," creating dissimilar meanings. In addition, the term "MYRIAD" is Applicant's primary trademark that has been used extensively in connection with Applicant's goods and services since at least as early as 1993 and, as a result, "is a strong mark in the relevant field" that is recognized by consumers as referring to Applicant. Such connotations are entirely absent in the Cited Marks. Further, Applicant's Mark uses the combination of "MYRIAD" and "MYRISK," which produces a meaning indicating a personalized assessment of risk of disease developed by or with assistance from Myriad Genetics, Inc. The Cited Marks do not bring to mind a personalized plan developed by a particular person or entity. Thus, the construction of each mark combined with the context in which they are used yields different meanings, making confusion unlikely.

Further, when the marks involve common words with well-known meanings, slight differences can be sufficient to prevent confusion. *See Al-Site Corp.*, 174 F.3d at 1330 (finding that the prefix "magni/magna" is commonly used in the eyeglass field and that MAGNIVISION

was not confusingly similar to MAGNA•DOT, both for eyeglasses); *Chesebrough-Pond's, Inc. v. Faberge, Inc.*, 666 F.2d 393, 214 USPQ 44 (9th Cir. 1982) (finding no confusion between MATCH and MACHO, both for men's toiletries); *Wooster Brush Co.*, 231 USPQ 316 (no likelihood of confusion between POLY PRO and POLY FLO, both for paintbrushes, where "poly" found to be commonly used term in the industry); *Am. Standard Inc.*, 200 USPQ 457 (AQUASEAL and AQUA STREAM, both for plumbing products); *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 392, 128 USPQ 114 (C.C.P.A. 1960) (finding no likelihood of confusion where marks shared the phonetically descriptive prefix "asma" but the suffixes were dissimilar).

In this case, each mark uses the common word "risk," which means exposure to the chance of injury or loss, and, to a lesser extent, Applicant's Mark includes the term "my," which is a form of the possessive case of the word "I"—the nominative singular pronoun—used as an attributive adjective, and the Cited Marks include the term "mi" in, which is an abbreviation for "myocardial infarction," the medical term for a heart attack. *See* Exhibit B to Applicant's Request for Reconsideration, Sept. 18 2014. These terms are commonly used and understood by the relevant consumers and, as a result, slight differences are sufficient to prevent confusion between Applicant's Mark and the Cited Marks.

In addition, the terms "MIRISK" and "MYRISK" are suggestive terms that refer to the nature of the parties' respective goods and services. Where the only similar portions of marks are suggestive, the inclusion of other terms has been found sufficient to alleviate likelihood of confusion concerns. *See Pacquin-Lester Co.*, 484 F.2d at 1385 (finding no likelihood of confusion between SILK for face cream and SILK 'N SATIN for lotion and bath oil for hands and skin) ("The obvious substantial differences between the marks are enough to prevent any reasonable likelihood of confusion, mistake or deception when the marks are applied to the respective goods, especially considering the suggestive nature of the term SILK which appellant admits to exist in this field."); *Standard Brands Inc.*, 191 USPQ 168 (finding that because the word "ROYAL" is suggestive, there is no likelihood of confusion between CORN-ROYAL for butter and margarine and ROYAL for a variety of food products, including shortening); *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313 (T.T.A.B. 2005) (finding that the term ESSENTIALS was highly suggestive of clothing and therefore the inclusion of a house mark was sufficient to distinguish NORTON MCNAUGHTON ESSENTIALS from ESSENTIALS where both were used for clothing); *Indus. Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 951-52

(T.T.A.B. 1983) (finding no confusion between BOND-PLUS and WONDER BOND PLUS, both used for adhesives). In short, while Applicant's Mark and the Cited Marks may include the terms "MYRISK" and "MIRISK," each phrase conveys a unique meaning, and, as a result, consumers are not likely to be confused between Applicant's Mark and the Cited Marks.

As noted above, the use of the term "MI" in the Cited Marks and the additional word "MYRIAD" in Applicant's Mark create distinct meanings for the marks. These differences are reflected in the parties' goods and services as well, as discussed below. The Cited Marks suggest evaluating the likelihood of suffering from cardiovascular disease, whereas Applicant's Mark has no such connotation. Evidence of extensive third-party use shows that the relevant consumers understand the mark MIRISK as meaning "myocardial infarction risk." See Exhibit C to Applicant's Request for Reconsideration, Sept. 18 2014. As shown by Applicant's evidence, medical and bioscience professionals commonly refer to the risk of a heart attack as "MI risk," and such professionals, who are also the intended consumers of Aviiir's goods and services, would immediately understand the Cited Marks as describing or suggesting Aviiir's medical testing services to determine a patient's risk of cardiovascular disease. Applicant's Mark conveys no such meaning. Thus, the construction of each mark combined with the context in which they are used yields different meanings, making confusion unlikely.

iii. The Sound of the Marks Are Distinct

The first word of the Cited Marks is "MIRISK" while "MYRIAD" is the first word in Applicant's Mark. Other than the initial "M" sound, "MIRISK" and "MYRIAD" share no similarities in pronunciation. Applicant's Mark consists of five syllables, whereas the Cited Marks consist of two and four syllables. Thus, as spoken, MYRIAD MYRISK sounds quite different from MIRISK and MIRISK VP.

Further, the use of "MYRIAD" in Applicant's Mark and the use of "MI" and "MY" in the Cited Marks and Applicant's Mark, respectively, also results in a distinct pronunciation in comparison to Applicant's Mark. The Cited Marks do not include any words that sound similar to "MYRIAD." In addition, as discussed above, the term "MI" is commonly understood as an acronym for "myocardial infarction," and is pronounced as the separate letters "M" and "I," or "em eye." See Exhibit D to Applicant's Request for Reconsideration, Sept. 18 2014. As a result, the Cited Marks, which are pronounced "em eye risk" and "em eye risk vee pee," sound very different from Applicant's Mark, which is pronounced "mir ee uhd mai risk."

The different words and order of each mark produce wholly separate sounds, which has been found sufficient to nullify any possibility of confusion. See *Chesebrough-Pond's, Inc.*, 666 F.2d at 397 (finding no likelihood of confusion between MATCH and MACHO) (“[The marks] differ[] both in spelling and in the number of syllables. The marks do not sound the same: the ‘a’ in ‘Match’ is pronounced differently from the ‘a’ in ‘Macho.’ The final vowel in ‘Macho’ also distinguishes their sound.”); *Rocket Trademarks Pty Ltd.*, 98 USPQ2d at 1075 (finding no likelihood of confusion between ZU ELEMENTS and ELEMENT for similar goods) (“[A]pplicant’s mark will clearly be pronounced differently as it begins with the term ZU.”). When the pronunciations of Applicant’s Mark and the Cited Marks are compared in their entirety, it is clear that consumers are unlikely to confuse these marks based on sound.

Regardless, “phonetic similarity is not dispositive in creating a likelihood of confusion,” especially where the marks are different in appearance and meaning, as is the case here. *Katz v. Modiri*, 283 F. Supp. 2d 883, 895 (S.D.N.Y. 2003) (finding that JUVA and JUVENEX were not confusingly similar). Indeed, marks much closer to each other in sound than Applicant’s Mark and the Cited Mark have been found to be distinctive. See *Lebow Bros., Inc. v. Lebole Euroconf S.p.A.*, 503 F. Supp. 209, 213, 212 USPQ 693 (E.D. Pa. 1980) (finding that LEBOLE and LEBOW CLOTHES were not confusingly similar); *Nat’l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 721, 184 USPQ 34 (C.C.P.A. 1974) (finding that DUVET and DUET were not confusingly similar).

c. The Intended Consumers Are Sophisticated, Have an Increased Duty of Care and are Unlikely to Confuse the Marks

The intended consumers of Applicant’s and Aviir’s goods and services are also sophisticated, which factor also supports finding no likelihood of confusion. Tribunals consider the sophistication of consumers as a factor in determining likelihood of confusion. *In re E.I. DuPont DeNemours*, 476 F.2d at 1361. When goods are “purchased with a certain amount of care and thought, rather than...on impulse,” confusion is less likely to be found. *Info. Res., Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1039 (T.T.A.B. 1988). “[T]he more sophisticated the consumer the less likely he will be confused” when encountering different goods or services with similar marks. *Moore Bus. Forms, Inc. v. Rite Aid Corp.*, 21 USPQ2d 2024, 2029 (W.D.N.Y. 1991). When consumers have a focused need or a specific purpose for the goods, they will take greater care when purchasing the service or selecting the service provider. See *Hayden Swith &*

Instrument, Inc. v. Rexnard, Inc., 4 USPQ2d 1510 (D. Conn. 1987); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295, 16 USPQ2d 1635 (Fed. Cir. 1990). Consumers exercise greater care when the purchase of goods or services requires considerable planning. *Munters Corp. v. Matsui Am., Inc.*, 730 F. Supp. 790, 799, 14 USPQ2d 1993 (N.D. Ill. 1989), *aff'd*, 909 F.2d 250, 15 USPQ2d 1666 (7th Cir. 1990). The relevant consumers to be evaluated are “those members of the public who are or may become customers of either party,” rather than the general consuming public. *Omicron Capital, LLC v. Omicron Capital, LLC*, 433 F. Supp. 2d 382, 393 (S.D.N.Y. 2006) (quoting *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 450, 213 USPQ 1091 (S.D.N.Y. 1982)).

Medical devices or services, such as those offered by Applicant and Aviiir, are prescribed and dispensed by professionals, such as oncologists and cardiologists, who are not prone to carelessness and perform under an increased duty of care. See *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301 (T.T.A.B. 2004). In addition to the Board in *Alfacell*, a number of tribunals have found that medical professionals ordering pharmaceuticals and other medical goods and services are experienced in distinguishing between the names of products and are less likely to confuse similar marks used on related or identical goods. See *Pfizer Inc. v. Astra Pharm. Prods. Inc.*, 858 F. Supp. 1305, 1328, 33 USPQ2d 1545 (S.D.N.Y. 1994) (“The consumers here are doctors, as sophisticated a group as one could imagine.”); *Barre-National, Inc. v. Barr Labs., Inc.*, 773 F. Supp. 735, 743, 21 USPQ2d 1755 (D.N.J. 1991); *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1260, 9 USPQ2d 1870 (5th Cir. 1989) (finding that medical professionals exercise a higher degree of care when ordering medical equipment); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983) (finding that the relevant purchasers were unlikely to confuse ASTRA for pharmaceutical preparations and syringes with ASTRA for a medical device). While even sophisticated consumers may confuse marks that are closely related, this is not the case here.

Applicant’s goods and services are marketed to and used by oncologists, while Aviiir’s services are marketed to and used by cardiologists. Both oncologists and cardiologists are specialist physicians that have undertaken additional education and training after meeting the basic requirements to be a licensed medical doctor. See *In re Optical Sensors, Inc.*, Ser. No. 78566607, 2007 TTAB LEXIS 391, at *37 (T.T.A.B. Aug. 13, 2007) (finding that cardiologists are “highly knowledgeable, discriminating and sophisticated purchasers [that purchase products only] after thorough deliberation” and were unlikely to confuse ACQTRAC and

ACCUTRACKER, both for cardiovascular monitoring devices); *In re Inspired Techs., Inc.*, Ser. No. 77272899, 2011 TTAB LEXIS 15, at *13 (T.T.A.B. Jan. 19, 2011) (finding that medical specialists, including oncologists, are “highly knowledgeable, discriminating and sophisticated purchasers [that purchase products only] after thorough deliberations” and were unlikely to confuse SMARTDOSE for oxygen delivery devices with SMART DOSE for pharmaceutical delivery pumps). As shown above, Applicant’s Mark and the Cited Marks differ substantially in terms of overall commercial impression. Sophisticated professionals will easily distinguish the two marks, making confusion unlikely.

d. Applicant’s Goods and Services and the Services Used in Connection with the Cited Marks Are Neither Competitive nor Closely Related

Applicant’s goods and services are also distinct from Aviiir’s services, which is another factor showing no likelihood of confusion. Similarity of marks and relatedness of goods or services vary in inverse proportion to one another for likelihood of confusion: the more dissimilar the goods or services, the less likely that even similar marks will be confused. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 633, 63 USPQ2d 1659 (6th Cir. 2002). Thus, when the services are unrelated, there may be no likelihood of confusion even from identical marks, whereas when the services are identical and the parties are direct competitors, the marks must be sufficient by themselves to distinguish the two sources. *Id.*; see also *Astra Pharm. Prods., Inc.*, 718 F.2d 1201 (finding no confusion with ASTRA for pharmaceutical preparations and syringes and ASTRA for a medical device); *Church of the Larger Fellowship of Unitarian Universalist*, 221 USPQ 869 (finding no likelihood of confusion between the identical marks CLF when used for religious services and legal services, respectively). Whether two products are related does not depend on whether a single term can be found that describes them both, or whether both can be classified under the same general category. *Harvey Hubbell Inc. v. Tokyo Seimitsu Co.*, 188 USPQ 517, 520 (T.T.A.B. 1975); *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (T.T.A.B. 1992) (citing *In re Cotter & Co.*, 179 USPQ 828 (T.T.A.B. 1973)). Nor are services necessarily related because they coexist in the same broad industry, or because the same large company may purchase both goods and services. *Elec. Data Sys.*, 23 USPQ2d at 1464; *Therma-Scan*, 295 F.3d at 633; *Bose v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1376, 63 USPQ2d 1303 (Fed. Cir. 2002) (“[A] broad general market category is not a generally reliable test of relatedness of products.”).

Applicant's goods and services, as amended, are distinct from the services identified in the registrations for the Cited Marks. Applicant's Mark is for genetic testing services for predicting the likelihood of developing hereditary cancer, excluding cardiovascular disease, and identifying risk factors associated with hereditary cancer, including analysis of gene mutations, gene variants, gene expression profiles and other molecular indicators or markers, while the Cited Marks are used for medical laboratory services. It is clear from the description of services in the MIRISK VP registration, the specimens filed with the application for the Cited Marks and from Aviiir's available past marketing material that the Cited Marks are used in connection with a specific type of medical laboratory services, namely, medical laboratory services to determine the risk of cardiac disease:

MIRISKTM calculates an objective, standardized 5-year cardiac risk score based on the combination of 5 clinical risk factors, 2 lipid biomarkers and an algorithm. MIRISK evaluates your patient's risk status based on age, gender, diabetic and smoking status, HDL, total cholesterol, and blood pressure, and will identify your patient as low (0-3.49%), intermediate (3.5-7.49%) or high ($\geq 7.5\%$) risk.

See Exhibit E and Exhibit F to Applicant's Request for Reconsideration, Sept. 18 2014. In contrast, Applicant's services consist of genetic testing services for predicting the likelihood of developing hereditary cancer, excluding cardiovascular disease, and identifying risk factors associated with the hereditary cancer, including analysis of gene mutations, gene variants, gene expression profiles and other molecular indicators or markers. For example, over the past 20 years Applicant has conducted over a million tests for hereditary cancer and, based on those tests, it is identifying and classifying genes, which are passed from parents to children and are likely to play a role in the development of cancer. See Exhibit G to Applicant's Request for Reconsideration, Sept. 18 2014. Sophisticated healthcare providers then use this information to counsel patients on their potential risk of developing hereditary cancer, to develop cancer risk management plans prior to development of cancer, and to avoid prescribing unnecessary cancer screenings and surgery. *Id.* In short, Aviiir's laboratory services for assessing the risk of cardiovascular disease are in no way related to Applicant's testing services that are used to predict the likelihood of developing hereditary cancer. When compared, Aviiir's goods and services and Applicant's goods and services are dissimilar, not competitive and not related. See *Therma-Scan*, 295 F.3d at 632-63; *Bose*, 293 F.3d at 1376 (“[A] broad general market category is not a generally reliable test of relatedness of products.”); see also *UMC Indus., Inc. v. UMC*

Elects. Co., 207 USPQ 861, 879 (T.T.A.B. 1980) (“[T]he fact that one term, such as ‘electronic’, may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”).

Tribunals have frequently found no likelihood of confusion in cases with closely similar or identical marks when both were used in connection with distinct goods or services, even when those goods or services were related. *See, e.g., Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350 (Fed. Cir. 2004) (no likelihood of confusion between the identical marks RITZ because cooking classes are unrelated to kitchen textiles); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969 (2d Cir. 1981) (BRAVO’S for crackers not likely to be confused with BRAVOS for tortilla chips); *Omicron Capital, LLC*, 433 F. Supp. 2d at 394 (finding no likelihood of confusion between the identical marks OMICRON CAPITAL for closely related financial services); *NEC Elects. v. New England Circuit Sales, Inc.*, 722 F. Supp. 861, 13 USPQ2d 1058 (D. Mass. 1989) (NEC for electronic components, including computer chips, not likely to be confused with NECS for computer chip broker); *Kingsford Prods. Co. v. Kingsford, Inc.*, 715 F. Supp. 1013, 1017, 11 USPQ2d 1350 (D. Kan. 1989) (KINGSFORD for charcoal briquettes not confusingly similar to KINGSFORD for barbeque sauce); *Basic Am. Med., Inc. v. Am. Med. Int’l, Inc.*, 649 F. Supp. 885, 1 USPQ2d 1217 (S.D. Ind. 1986) (AMI not likely to be confused with BAMI, both for goods and services in the healthcare field); *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213 (T.T.A.B. 2011) (finding no likelihood of confusion between CALYPSO and a number of marks with CALYPSO with additional disclaimed wording describing the services for closely related financial services); *In re HerbalScience Grp., LLC*, 96 USPQ2d 1321 (T.T.A.B. 2010) (MINDPOWER for various ingredients for use in the manufacture of nutritional supplements not likely to be confused with MIND POWER RX for dietary and nutritional supplements). The differences between Applicant’s goods and services and Aviiir’s services are far more conspicuous than the differences between the marks found distinctive in these cases.

Regardless of any similarities of the goods, similarity of the marks is the most important factor in a likelihood of confusion analysis. *See Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 501, 203 USPQ 19 (5th Cir. 1979) (“The evaluation of the marks themselves is of course the most important consideration, for it is in their similarity that the roots of the confusion lie.”). Dissimilar marks can be used on identical goods without creating likelihood of confusion. *See supra* Section 2(b)(i). The differences in the appearance, sound, meaning, and commercial

impression between Applicant's Mark and the Cited Marks prevent a likelihood of confusion, even if used on identical goods.

e. The Channels of Trade are Distinct

Applicant and Aviir also offer their respective goods and services through distinct channels of trade, which further evidences no likelihood of confusion. If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for liquid drain opener was not confusingly similar to LITTLE PLUMBER for advertising services in the plumbing field); *see also In re HerbalScience Grp., LLC*, 96 USPQ2d at 1324 (finding no likelihood of confusion where “[t]here is nothing in this record to show that a normal channel of trade for [registrant’s goods] is that they are sold to the companies that would purchase applicant’s identified goods”). The presence of distinct channels of trade is given substantial weight in a likelihood of confusion analysis, and such differences can trump similarities between the marks and the associated goods or services. *See In re HerbalScience Grp., LLC*, 96 USPQ2d at 1324 (“Because of the differences in the channels of trade and customers for applicant’s and the registrant’s goods, there is virtually no opportunity for confusion to arise. Accordingly, we need not consider the *du Pont* factor of the similarities of the marks . . .”).

Applicant’s goods and services are marketed to a very specific consumer, namely, oncologists. In contrast, Aviir’s services are marketed to cardiologists. Generally, oncologists do not conduct or order tests to assess the risk of cardiovascular disease, and vice versa. Therefore, Applicant’s Mark would rarely if ever be encountered in close proximity to the Cited Marks, making confusion highly unlikely.

Where the relevant goods and services are unrelated, confusion, even with identical marks, is generally found unlikely. *See McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029, 1031-33, 17 USPQ2d 1599 (S.D.N.Y. 1990) (finding no confusion where one party was using the mark COMSTOCK for computer database services that relayed stock exchange information from traditional sources like Standard & Poor’s and Dow Jones, and another party was using the same mark for money management services). The court in *Comstock* found that although the marks were used in the general financial services industry, the services were “as

completely unrelated as night and day” because the investors using the money management services would never confuse the management services with the services relaying stock market information. *Id.* at 1034. Consistent with reasoning from *Comstock*, it is hard to imagine that a cardiologist would believe that the provider of genetic testing for hereditary cancer is the same entity that provides laboratory services for assessing the risk of heart attack, or vice versa.

f. The Cited Marks are Weak

Another factor that weighs in favor of registration of Applicant’s Mark is that the Cited Marks are inherently weak. A mark is “commercially weak if the mark lacks significance in the market place for identifying the origin of goods.” *Oxford Indus., Inc. v. JBJ Fabrics, Inc.*, 6 USPQ2d 1756, 1760 (S.D.N.Y. 1988). According to the Federal Circuit, “[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 USPQ2d 1453 (Fed. Cir. 1992) (quoting *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295 (C.C.P.A. 1958)). When making a determination as to the likelihood of confusion between two marks, the Examining Attorney must consider the relative strengths of the marks in question, judged in part by the number of similar marks in use in connection with similar goods. *Plus Prods.*, 722 F.2d at 1005-06. Extensive third-party use of marks containing certain shared terms is evidence that a mark is weak. *See Gen. Mills, Inc.*, 824 F.2d at 626 (“Determining that a mark is weak means that consumer confusion has been found unlikely because the mark’s components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related.”).

The words “mi” and “risk” are used extensively, including in a number of active applications and registrations for marks, with goods and services related to cardiovascular health. *See* Exhibit H to Applicant’s Request for Reconsideration, Sept. 18 2014. For example, the company Personal Genomics S.r.l sells a DNA test kit under the name MI Risk (Myocardial Infarction Risk) for testing an individual’s predisposition of developing cardiovascular problems. *Id.* at *1. Other examples include DECODE MI, Reg. No. 4,105,772, registered in February 2012 for “blood testing apparatus, namely, tests and test kits for diagnostic testing for myocardial infarction” in Class 010 (*Id.* at* 2); LIFESIGN MI, Reg. No. 1,893,627, registered in May 1995 for “cardiac protein test kit consisting primarily of solutions and marker panels for the detection of myocardial infarction” in Class 005 (*Id.* at *5); MI VISOR, Reg. No. 4,132,920, registered in

April 2012 for “surgical devices and instruments, namely, cardiothoracic surgical retractors” in Class 010 (*Id.* at *11); and MI SUTURE BELT, Reg. No. 4,396,591, registered in September 2013 for “surgical devices and instruments, namely, cardiothoracic suture organizers” in Class 010 (*Id.* at *13).

The weakness of the Cited Marks, combined with the admitted strength of Applicant’s Mark, further support Applicant’s position that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks.

g. Conclusion

Based on the foregoing, Applicant contends that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks. The combination of the differences between the commercial impression of the marks, the services, the channels of trade and the sophistication of the consumers make confusion of these marks unlikely. Therefore, applicant respectfully requests that the Board reverse the Section 2(d) refusal and allow Applicant’s Mark to proceed to registration.

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Respectfully Submitted,



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