Mailed: October 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Genebook LLC

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Serial No. 90269018

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Christopher P. Maiorana of Christopher P. Maiorana, P.C.,
for Genebook LLC.

Stefan M. Oehrlein, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Adlin, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Genebook LLC ("Applicant") seeks registration on the Principal Register of the mark EPIGENE (in standard characters) for "electronic database in the field of genes recorded on computer media" in International Class 9.[1]

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to

[1] Application Serial No. 90269018 was filed on October 21, 2020, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

the goods identified in the application, so resembles the identical mark EPIGENE, the subject of two Principal Register registrations owned by the same Registrant, for the following goods (with emphasis added):

> Diagnostic preparations for medical purposes, in International Class 5, and
>
> Apparatus for medical diagnostic testing in the fields of cancer or other tissue-based diagnostic testing, cytology and cell-based testing, in International Class 10,[2]

as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. The appeal is fully briefed. For the reasons that follow, we reverse the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Notably, Applicant did not make of record any evidence on its behalf during the prosecution of the Application now on appeal.

[2] Registration Nos. 5224531 and 5224532 were issued on June 13, 2017. The translation statement for both registrations states: "The wording 'EpiGene' has no meaning in a foreign language." The cited registrations each include additional goods in the respective identified classes. However, the quoted goods identified above in the main text are the only ones on which the Examining Attorney relies for the refusal. Office Action of September 20, 2021 at TSDR 5; Examining Attorney's Brief, 8 TTABVUE 16. Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

Applicant attaches to its brief as Ex-A a webpage from the 23andMe Ancestry + Traits Service; as Ex-B a webpage from a third-party company named Bio-Rad; and as Ex-C a Fact Sheet of unknown origin, entitled "Understanding COVID-19 PCR Testing."[3] Applicant explains that Ex-B already was made of record by the Examining Attorney during prosecution, and that Ex-A and Exh-C merely provide clarification of materials introduced by the Examining Attorney.[4] The Examining Attorney objects to the Board's consideration of Ex-A and Ex-C as having been untimely filed.[5]

The Examining Attorney's objection is sustained, and Ex-A through Ex-C will not be considered. The record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). Because Applicant's new evidence, Ex-A and Ex-C, was untimely submitted during this appeal, we disregard it. *See In re Inn at St. John's, LLC* , 126 USPQ2d 1742, 1744 (TTAB 2018) ("The evidence submitted with Applicant's appeal brief that Applicant did not previously submit during prosecution … is untimely and will not be considered."), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019). As Ex-B already was properly made of record by the Examining Attorney, we will consider the version of this document contained in the prosecution history. *See In re Lorillard Licensing Co., LLC*, 99 USPQ2d 1312, 1315 (TTAB 2011) (As a general rule, the Board discourages attaching exhibits to briefs that previously have been made of record.).

[3] Applicant's Brief, 6 TTABVUE 20-28.

[4] Applicant's Brief, 6 TTABVUE 4; Applicant's Reply Brief, 9 TTABVUE 4. Applicant further argues in its Reply that the Examining Attorney was able to respond to the content of these exhibits, and that the Examining Attorney was not prejudiced.

[5] Examining Attorney's Brief, 8 TTABVUE 4.

II. Likelihood of Confusion: Applicable Law and Analysis

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), 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) ("*DuPont*") *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.,* 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We have considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.,* 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("the various evidentiary factors may play more or less weighty roles in any particular determination"). Moreover, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to source, and to protect

registrants from damage caused by registration of marks and goods that are likely to cause confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,* 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.,* 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont,* 177 USPQ at 566.

A. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, considering their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

As Applicant concedes, its mark and Registrant's mark are identical.[6] Because they are identical, Applicant's and Registrant's marks are likely to engender the same connotation and overall commercial impression when considered in connection with Applicant's and Registrant's respective goods. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd,* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

The first *DuPont* factor supports a finding that confusion is likely.

B. Similarity or Dissimilarity and Nature of the Goods

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods … as described in an application or registration ….'" *In re Detroit*

[6] Applicant's Brief, 6 TTABVUE 4.

Athletic, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567). "[B]ecause the marks [here] are identical, the degree of similarity between the goods ... required for confusion to be likely declines." *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *11 (TTAB 2020).

"This factor considers whether 'the consuming public may perceive [Applicant's and Registrant's goods] as related enough to cause confusion about the source or origin of the goods ….'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)). The issue, however, "is not whether purchasers would confuse the … goods, but rather whether there is a likelihood of confusion as to the source of the goods." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012)

The goods need not be identical, but need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Where, as in this case, Applicant's mark is identical to Registrant's mark, there need only be a viable relationship between the goods to find that there is a likelihood of confusion. *See In re Shell Oil Co.*, 26 USPQ2d at 1689 (contemporaneous use of identical or nearly identical marks can lead to the assumption that there is a common source even when the goods are not competitive or intrinsically related).

> Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the

> same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration[s].

In re Ox Paperboard, LLC, 2020 USPQ2d 10878, at *5 (TTAB 2020)

Where evidence shows that the goods at issue have complementary uses, and thus are used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (bread and cheese are often used in combination); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (finding medical MRI diagnostic apparatus and medical ultrasound devices to be related, based in part on the fact that such goods have complementary purposes because they may be used by the same medical personnel on the same patients to treat the same disease).

Applicant's identified goods are "electronic database in the field of genes recorded on computer media." As noted above, the only goods identified in the cited Registrations on which the Examining Attorney bases the refusal to register under Trademark Act Section 2(d) are "diagnostic preparations for medical purposes" and "apparatus for medical diagnostic testing in the fields of cancer or other tissue-based diagnostic testing, cytology and cell-based testing." If we find these goods similar or related to Applicant's goods, this is enough to support an affirmance of the Section 2(d) refusal as to the second *DuPont* factor. We need not consider whether each of Registrant's recited goods is related to Applicant's goods for purposes of

a *DuPont* analysis, as it is sufficient if likelihood of confusion is found with respect to any product recited in each cited registration. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335 , 209 USPQ 986, 988 (CCPA 1981)).

Before we set out to review the evidence the Examining Attorney made of record, we pause to provide the definition of a "database," as that term is used in Applicant's identification of goods. A database is "a usually large collection of data organized especially for rapid search and retrieval (as by a computer)."[7] We recognize that many of the DNA testing companies about which the Examining Attorney submitted evidence provide their customers with "reports" of their DNA test results. Obviously the reports contain data, which we can safely assume relates to DNA or genomics. However, there is no evidence in the record that any of these companies offer an "electronic database in the field of genes recorded on computer media" with search and retrieval capability to their customers. Rather, it appears that many of these companies offer printed reports to their customers the nature of which is not entirely clear. While these printed reports "may" be created via access to an electronic database, we have no basis for finding that these reports are themselves "databases" as that term is defined and understood in this field.

[7] https://www.merriam-webster.com/dictionary/database. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014) *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

With that said, in this appeal the evidence of relatedness of the respective goods the Examining Attorney relies upon consists of screen captures from third-party websites, as follows:

- Color (color.com) – genetic testing, reporting and counseling services regarding family history of certain medical diseases, including cancers. The site discusses use of saliva test kits for use at home or at a clinic. The testing is accomplished with the use of sequencing[8] methods and customized software tools. There is no mention of this company offering or even providing information from a genetic database to the relevant consumers. [Office Action of March 22, 2021 at TSDR 14-43].
- 23andME Health + Ancestry Service (23andme.com) – genetic testing, reporting and education services regarding family history of certain medical diseases, including breast cancer. The site discusses use of saliva test kits for use at home. The testing is done at a lab. The site content also discusses sponsorship of a healthcare professionals community to help medical providers and their patients navigate genetics together. The site's sponsor additionally notes its employment of researchers and collaborators to make discoveries using data and survey information. The information provided by the 23andME service is not intended to be a diagnosis tool for the detection of disease, but only to provide genetic information. There is no mention of this company offering or providing diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers. [Office Action of March 22, 2021 at TSDR 44-70].
- Futura Genetics (futuragenetics.com) – genetic testing and reporting services regarding family history of certain medical diseases, including cancers. The site discusses use of saliva test kits for use at home. The sponsor's report includes the scientific data that was used to generate it. There is no mention of this company offering or providing diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers. [Office Action of March 22, 2021 at TSDR 71-78].

[8] See definition of "sequencing" in note 11 below.

- Qiagen (quiagen.com) – seller of PCR[9] diagnostic instruments, test kits, analysis software and assays[10] for detection and quantification of oncology biomarkers. There is no indication that this company offers or even provides information from genetic databases in connection with its products. [Office Action of March 22, 2021 at TSDR 80-95].
- Azura Genomics (azuragenomics.com) – seller of PCR diagnostic instruments software and testing kits for DNA quantification and analysis of genetic variants. There is no indication that this company offers or even provides information from genetic databases in connection with its products. [Office Action of March 22, 2021 at TSDR 96-108].
- DSS (dssimage.com) – seller of PCR amplification and detection instruments, automated sample preparation devices, tubes and pipetting. There is no indication that this company offers or even provides information from genetic databases in connection with its products. [Office Action of March 22, 2021 at TSDR 109-10].
- Abbott (molecular.abbott) – seller of hematology probes to extract tissue samples, PCR assays for detection of genetic variants and mutations, reagent and control kits. In our view, it is unclear whether this company offers or provides information from genetic databases in connection with its products. [Office Action of March 22, 2021 at TSDR 111-25].
- Genesight (genesight.com) – pharmacogenomic testing and reporting services for analyzing genetic variations in DNA, to inform a medical provider about

[9] A polymerase chain reaction (or "PCR") is a laboratory method used to make many copies of a specific piece of DNA from a sample that contains very tiny amounts of that DNA. PCR allows these pieces of DNA to be amplified so they can be detected. PCR may be used to look *for* certain changes in a gene or chromosome, which may help find and diagnose a genetic condition or a disease, such as cancer. It may also be used to look at pieces of the DNA of certain bacteria, viruses, or other microorganisms to help diagnose an infection. National Cancer Institute (https://www.cancer.gov/publications/dictionaries/cancer-terms/def/pcr), Office Action of March 22, 2021 at TSDR 79.

[10] An "assay" is a laboratory test to find and measure the amount of a specific substance. National Cancer Institute (https://www.cancer.gov/search/results?swKeyword=assay, last visited October 18, 2022). We take judicial notice of a medical-technical definition provided on a publicly available government website, the National Cancer Institute of the National Institutes of Health. *Cf.* Fed. R. Evid. 201(b)(2) ("The court may judicially notice a fact that is not subject to reasonable dispute because it … can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned."). *See, e.g., In re tapio GmbH*, 2020 USPQ2d 11387, at *13 n.46 (TTAB 2020) (Board took judicial notice of 2010 U.S. Census records for the top 1,000 surnames); *see also, United States v. Garcia,* 855 F.3d 615 (4th Cir. 2017) (taking judicial notice of facts on U.S. Citizenship and Immigration Services' ("USCIS") website because it is a governmental source whose accuracy cannot be questioned); *Hong v. Rec. Equip., Inc.*, 2019 USPQ2d 410124, at n.3 (W.D. Wash. 2019) (the court may take judicial notice of information published on a government website).

genes that may impact how a patient metabolizes or responds to certain medications. The site discusses use of cheek swab test kits for use at home or at a medical provider. The testing is done at a lab. There is no mention of this company offering or providing diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers in connection with its services. [Office Action of September 20, 2021 at TSDR 7-23].

- GeneDx (genedx.com) – genetic and genomic testing, exome and genome sequencing,[11] reporting and counseling services for diagnosing rare disorders and diseases. Specimens are collected by means of testing kits, tests are performed, analyzed and interpreted by technical and clinical staff. Test results are provided to healthcare provider. The analysis services promoted on this website are accomplished with the aid of the company's novel tools, software and internal database for interpretation evidence. There is no mention of this company offering or providing diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers in connection with its services. [Office Action of September 20, 2021 at TSDR 24-40].
- Circle DNA (circledna.com) – DNA tests, reports, and counseling services related to cancers and disease risks, diet, fitness, wellness and carrier conditions. Saliva samples are collected via in-home testing kits, and tested at a lab. Reports are issued through a mobile app. There is no mention of this company offering or providing diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers in connection with its services. [Office Action of September 20, 2021 at TSDR 41-57].
- Bio-Rad (bio-rad.com) – seller of PCR assays, reagent kits, diagnostic systems software for detection and quantification of genetic mutations causing cancers and diseases. There is no indication that this company offers or even provides information from gene databases in connection with its products. [Office Action of September 20, 2021 at TSDR 58-76].
- ThermoFisher Scientific (thermofisher.com) – seller of PCR instruments and parts therefor, data analysis software, assays, calibration and verification kits, primers and probes for detection and analysis of gene mutations. There is no indication that this company offers or even provides information from gene databases in connection with its products. [Office Action of September 20, 2021 at TSDR 77-87].

[11] Deoxyribonucleic acid ("DNA") is the chemical compound that contains the instructions needed to develop and direct the activities of nearly all living organisms. An organism's complete set of DNA is called its "genome." "Sequencing" means to determine the exact order of the bases in a strand of DNA. National Human Genome Research Institute, National Institutes of Health (https://www.genome.gov/about-genomics/fact-sheets/A-Brief-Guide-to-Genomics, last visited October 19, 2022),

- Analytik Jena (analytic-jena.us) – seller of PCR devices, DNA/RNA extraction kits, assays and reagents for virus detection gene research. There is no indication that this company offers or provides information from gene databases in connection with its products. [Office Action of September 20, 2021 at TSDR 88-101].
- CentoGenome (centogenome.com) – genome biochemical testing, sequencing, classification, disease diagnosis and reporting services utilizing a rare disease databank. There is no discussion on the site that diagnostic preparations or medical diagnostic testing apparatus are offered for sale to the relevant consumers in connection with the company's services. [Denial of Reconsideration of March 29, 2022 at TSDR 10-27].
- Chai (chaibio.com) – seller of PCR machines, software, mixes, tube and cap strips. There is no indication that this company offers or provides information from gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 28-44].
- CRI Genetics (crigenetics.com) – Health and ancestry DNA testing and reporting services. There is no mention of this company offering or providing information from gene databases in connection with its services. [Denial of Reconsideration of March 29, 2022 at TSDR 45-62].
- Edvotek (edvotek.com) – seller of PCR machines and testing lab stations. There is no indication that this company offers gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 63-71].
- Genesig (genesig.com) – seller of PCR instruments, genotyping kits. There is no indication that this company offers or even provides information from gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 72-77].
- Invitae (invitae.com) – Gene testing services to detect risk of developing cancer, heart disease and other chronic conditions. Testing performed with saliva sample collection kits sent to a lab. Results shared with health care provider. Genetic counseling services are available. There is no mention that this company offers or provides information from gene databases in connection with its services. [Denial of Reconsideration of March 29, 2022 at TSDR 78-84].
- Roche (lifescience.roche.com) – seller of PCR systems and DNA isolation kits. There is no indication that this company offers or provides information from gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 85-93].
- Nebula Genomics (nebula.org) – DNA testing, whole genome sequencing and reporting services to examine ancestry, health, diet and physical activity. This company provides a genomic research library for application to patient's DNA test results. The site recommends sharing test data with a health care professional or genetic counselor for clinical analysis. The patient's data can be

used for carrier screening, evaluation of disease risks and rare disease diagnosis. There is no mention of this company offering diagnostic preparations or apparatus in connection with its services. [Denial of Reconsideration of March 29, 2022 at TSDR 94-115].

- PreciGenome (precigenome.com) – seller of PCR machines, assays, screening and detection kits and reagents, swabs and virial transport media for applications such as point-of-care molecular diagnostics tests, food safety and environment testing, agriculture, or research lab use. There is no indication that this company offers or provides information from gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 116-130].
- Prevention Genetics (preventiongenetics.com) –Diagnostic exome testing and reporting services intended for health care providers looking for a genetic diagnosis for patients with genetic diseases. There is no indication that this company offers or provides information from gene databases in connection with its products. [Denial of Reconsideration of March 29, 2022 at TSDR 131-134].
- TellmeGen (tellmegen.com) – DNA testing services to determine predisposition to diseases, carriers of diseases, pharmacological compatibility, personal traits, wellness states and ancestry. The company's laboratory utilizes a global screening array containing genetic markers. Testing is performed with saliva sample kits sent to a lab. The samples are analyzed for production of test reports. There is no evidence that this company offers diagnostic preparations or medical diagnostic testing apparatus for sale to the relevant consumers in connection with the company's services. [Denial of Reconsideration of March 29, 2022 at TSDR 135-155].

Although the Examining Attorney's evidence comprises hundreds of website pages culled from a myriad of sources, from the point of view of relevant consumers, we find this material insufficient to show that Applicant's goods and Registrant's identified goods are related enough to cause confusion about their source or origin, even if they were promoted and sold under identical marks.

Looking at the Examining Attorney's evidence as a whole, we see very little evidence that the circumstances surrounding the marketing of the respective goods is such that it could give rise to the mistaken belief that they emanate from the same source. We further observe de minimis proof that the respective goods at issue have

complementary uses, that they are often used together or that they are otherwise bought by the same purchasers for the same or related purposes, such that confusion would be likely if the goods were marketed under the same mark.

For example, the providers of genetic testing services such as Color, Chai, CRI Genetics and others made of record do not mention offering gene databases or providing information from gene databases in connection with their services. 23andMe, GeneDx and Nebula Genomics do mention performing their services utilizing what could be considered gene databases, but there is no mention they offer the identified goods in the cited registrations for sale in connection with those services. Conversely, sellers of genetic testing equipment such as Qiagen, Azura Genomics, Analytik Jena and others do not offer gene databases or information from gene databases in connection with their products.

Our colleague, in concurrence, believes that the requisite showing of relatedness between Applicant's and Registrant's goods has been made in three pieces of evidence made of record by the Examining Attorney: Abbott, GeneDx and CentoGenome. The concurrence appears to suggest inferences can be made (regarding these three pieces of evidence) in view of the "limitations [and] practicalities [of,] and allowances" for, the nature of ex parte examination. Whatever difficulties are faced in obtaining proof to support a refusal to register, the burden necessarily remains with the Examining Attorney to support the refusal with evidence, and we simply do not have that here. *See In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) ("If it is customary or expected that [the goods and services at issue are related under normal trade practices] …, it

would be the Examining Attorney's burden to show these trade practices and in the absence of evidence on this matter, we conclude that the goods and services are not so related that confusion would be likely."); *In re Planprint Co.*, 229 USPQ 621, 624 (TTAB 1986) (When "the Office's burden to demonstrate that confusion is likely has not been met …, the mark is approved for publication …").

From the dearth of evidence in this case, the second *DuPont* factor does not support a finding that confusion is likely.

C. Similarity or Dissimilarity of Trade Channels

The second *DuPont* factor "considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *In re Detroit Athletic*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USPQ at 567). The trade channels factor considers the modalities and means (e.g., print, media, store aisles or shelves, or online) by which the respective products are marketed, *see In re Majestic Distilling,* 65 USPQ2d at 1204, sold or distributed in relative proximity, *see Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

"In the absence of meaningful limitations in either the application or the cited registrations, [we] properly presume[] that the [respective] goods travel through all usual channels of trade and are offered to all normal potential purchasers." *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1750 (Fed. Cir. 2017). This presumption, however, is not a substitute for proof, which is absent here. The Examining Attorney's evidence simply does not demonstrate that Applicant's goods and Registrant's identified goods are marketed, sold or distributed in relative proximity – whether via websites advertising genetic testing and reporting services,

or by means of websites promoting the sale of genetic testing equipment and related materials (such as testing kits and reagents).

Due to the absence of evidence, the third *DuPont* factor does not support a finding that confusion is likely.

D. Sales conditions and Degree of Purchaser Sophistication

In its brief, Applicant discusses "[t]he conditions under which the sales are made are [by means of] careful, sophisticated purchasing[,]", and that purchasers of these products are made by sophisticated buyers.[12] Unfortunately, Applicant does not direct us to any evidence properly made of record to support these arguments. *See In re Simulations Publ'ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence."); *Galen Med. Assocs., Inc. v. United States*, 369 F.3d 1324, 1339 (Fed. Cir. 2004) ("Statements of counsel ... are not evidence.").

Notwithstanding the absence of proof to support Applicant's contentions concerning purchasing conditions and buyer sophistication, notably the nature of Applicant's genetic databases and Registrant's diagnostic preparations and medical diagnostic testing apparatus are typically not purchased by ordinary consumers. These goods in the Application and the identified goods in the cited Registrations would likely be purchased by sophisticated buyers. While we are required to base our decision to "on the least sophisticated potential purchasers." *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir.

[12] Applicant's Brief, 6 TTABVUE 15-17

2014), even the least knowledgeable archetypal buyer of Applicant's goods and Registrant's identified goods would be a healthcare professional or genomic researcher who is astute and careful in making decisions to purchase these products. To the extent home gene tests are marketed to ordinary consumers, even they will exercise heightened purchaser care when it comes to testing for genetic risk factors affecting their health.

The fourth *DuPont* factor does not support a finding that conclusion is likely.

E. The Fame of the Registered Mark

Applicant argues that the Examining Attorney did not "provide[] [evidence] indicating the fame of the prior registered mark[]."[13] However, as the Examining Attorney points out, "[b]ecause the types of evidence bearing on the fame of a registered mark include the volume of sales, advertising expenditures, and length of use of the mark, and such evidence normally is not publicly available, trademark examining attorneys are not expected to submit evidence regarding the fame of a cited registered mark in ex parte proceedings."[14] *See In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016) (citing *In re Thomas,* 79 USPQ2d 1021, 1027 n.11 (TTAB 2006)). When no evidence of fame has been provided, this *DuPont* factor is usually treated as neutral. *See Id.*, 118 USPQ2d at 1086 – and we do so here.

[13] Applicant's Brief, 6 TTABVUE 17.

[14] Examining Attorney's Brief, 8 TTABVUE 14.

F. Other *DuPont* Factors

Applicant presents arguments on some of the other *DuPont* factors, such as the number and nature of similar marks in use on similar goods (factor 6), the market interface between Applicant and Registrant (factor 10), and the variety of goods on which the Registered mark is or is not used (factor 9).[15] However, Applicant did not provide any evidence supporting its discussion of these factors, and we therefore consider them neutral in our analysis.

III. Balancing the Likelihood of Confusion Factors

The marks shown in the Application and cited Registrations are identical. However, the Examining Attorney did not provide sufficient proof regarding the similarity or relatedness of the respective goods, or the degree of overlap (if any) of trade channels. The purchasing conditions of the respective products and the sophisticated nature of the buyers do not support a finding that confusion is likely. All other likelihood of confusion factors argued by Applicant and the Examining Attorney are neutral in view of the evidence (or lack thereof) submitted during prosecution. On this record, having balanced the *DuPont* factors for which there is evidence and argument, we find that confusion between Applicant's mark and goods, and Registrant's mark and identified goods of the cited registrations, is not likely.

Decision

The refusal to register Applicant's mark EPIGENE pursuant to Trademark Act Section 2(d) is reversed.

[15] Applicant's Brief, 6 TTABVUE 17-18.

Opinion by Adlin, Administrative Trademark Judge, concurring:

I agree with the majority that the USPTO has not established that Applicant's and Registrant's goods are "related enough to cause confusion about their source or origin." I write separately, however, because in my view **some** of the Examining Attorney's evidence does support a finding of relatedness, even though the record as a whole is ultimately not of sufficient quantity or quality to carry the day.

My narrow disagreement with the majority recognizes, and is in part based on, the limitations inherent in ex parte examination, especially when it comes to highly technical goods requiring a scientific or engineering background to completely understand, such as those in this case. *See e.g. In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003). These limitations are at least one reason why "[t]he Board takes a somewhat more permissive stance with respect to the introduction and evaluation of evidence in an ex parte proceeding than it does in an inter partes proceeding." *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 (TTAB 1996), *aff'd mem.*, 114 F.3d 1207 (Fed. Cir. 1997). The Federal Circuit does the same. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) ("The practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.").

With these limitations, practicalities and allowances in mind, I differ with the majority on the following evidence:

> Abbott (molecular.abbott) – According to the company's website, "Abbott Molecular is a pioneer and leader in oncology molecular diagnostics with its Vysis FISH assays and Abbott RealTime IDH1 and IDH2 assays." March 22, 2021 Office Action TSDR 111. The IDH2 assay is promoted

> "for in vitro diagnostic use." *Id.* at 115. These assays are thus laboratory tests used for "diagnostics," and in my view fall within Registrant's identification of "diagnostic preparations for medical purposes" or "apparatus for medical diagnostic testing in the fields of cancer …." In addition, the company's m2000 RealTime System can "centralize all molecular data into one location." *Id.* at 121. Similarly, the company's BioView product supports "mRNA imaging and analysis" and offers "report generation containing all pertinent data." *Id.* at 124-25. In my view, these products thus effectively fall within Applicant's identification of an "electronic database in the fields of genes recorded on computer media," or are close enough to a gene database that they tend to establish a relationship between Applicant's and Registrant's goods.
>
> GeneDx – This company, on a single webpage, touts its "unparalleled database," as well its "exome and genome sequencing" that offers "a rapid diagnosis," and its website also includes a webpage explaining "how diagnostic genetic testing works." September 20, 2021 Office Action TSDR 26-27. GeneDx also generates "reports" providing the results of the testing. *Id.* at 31-32. According to the website, "our database leads to more diagnostic test results," and "as the number of new patients we test grows, so does our database." *Id.* at 38. Finally, GeneDx's technology offers "prospective and retrospective data mining." While lay readers may not understand the exact nature of GeneDx's offerings, it is sufficiently clear to me that the company offers both databases including genetic information and diagnostic preparations and apparatus.
>
> CentoGenome – This company claims to offer "the most complete solution to diagnose genetically complex and undiagnosed cases." March 29, 2022 Office Action TSDR 10. Diagnosis is apparently provided through "tests" which consumers can "order" from CentoGenome. *Id.* at 22, 26. The company also offers a "rare disease-centric Bio/Databank," and provides "raw data free-of-charge for download (FASTQ, BAM VCF files). *Id.* at 11, 19. It touts "the quality of our medical reports," based in part on "best-in-class curated variant data from our Bio/Databank." To me, this also tends to establish a relationship between Applicant's and Registrant's goods.

While I view these few pieces of evidence differently than the majority, they are simply not enough on their own to establish a relationship between Applicant's and

Registrant's goods, and therefore I agree with the decision to reverse the refusal to register.[16]

[16] An inter partes proceeding challenging registration of this mark based on a different record might yield a different result.