

This Opinion is Not a
Precedent of the TTAB

Mailed: December 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TST Biomedical Electronics Co., ltd.

Serial No. 98033208

John J. O'Malley and Carey Kulp of Volpe Koenig,
for TST Biomedical Electronics Co., Ltd.

Matthew Digan, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

Before Heasley, Dunn, and Cohen,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

TST Biomedical Electronics Co., Ltd. (Applicant) seeks registration on the
Principal Register of the mark IPRO-LAB (in standard characters) for the goods listed
below:

Diagnostic preparations for medical purposes; chemical preparations for
medical purposes, namely, for in vitro diagnostic use; diagnostic biomarker
reagents for medical purposes; immunoassay reagents for medical use; Medical
diagnostic reagents for pregnancy purposes; Medical diagnostic reagents for
hepatitis; chemical reagents for medical purposes; diagnostic reagents for

medical purposes; reagent paper for medical purposes, in International Class 5.¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark PRO-LAB (in standard characters) for the goods listed below on the Supplemental Register as to be likely to cause confusion, to cause mistake, or to deceive.

Reagent paper for medical purposes; Reagents and media for medical and veterinary diagnostic purposes; Reagents for medical use; Clinical medical reagents; Diagnostic kits comprised of medical diagnostic reagents and assays for testing of bodily fluids for use in disease detection, namely, COVID-19; Drug testing kits comprised of medical diagnostic reagents and assays for testing body fluids; Drug testing kits comprised of medical diagnostic reagents and assays that test for the presence of drugs; Medical diagnostic reagents; Medical diagnostic reagents and assays for testing body fluids for microorganisms; Medical diagnostic reagents and assays for testing of body fluids; Nucleic acid sequences and chemical reagents for medical and veterinary purposes, in International Class 5.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

¹ Application Serial No. 98033208 filed June 8, 2023 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce.

The application originally included goods and services in International Classes 10, 42, and 44. Pursuant to Applicant's request to divide, a child application (App. Serial No. 98975954) was created with those classes so the subject application retains the only class to which the refusal pertains. May 29, 2025 Office Action TSDR 1-2.

² Registration No. 6822794 issued August 16, 2022. The registration also includes goods in International Class 1 and 9, but these goods were not cited as a basis for the refusal.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive”15 U.S.C. § 1052(d). Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on likelihood of confusion. *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (*DuPont*). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and of the goods or services (*DuPont* factors one and two). *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017). These two factors, together with the third, fourth, and fifth *DuPont* factors, are addressed in this decision.

A. Similarity or Dissimilarity and Nature of the Goods, Channels of Trade and Classes of Purchasers, and Conditions of Sale

We address the factors assessing the similarity or dissimilarity of the parties’ goods, trade channels and purchasers, and conditions of purchase. *DuPont*, 476 F.2d at 1361. With each factor, our determination must be based not on evidence of current use by Applicant, but on the identification of goods in the subject application, which

would define the scope of any registration that would ultimately issue. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323-24 (Fed. Cir. 2014).

We turn first to the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Detroit Athletic Co.*, 903 F.3d at 1307 (quoting *DuPont*, 476 F.2d at 1361). It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981).

Here, the goods of the subject application and the cited registration involve multiple overlapping goods. More specifically, the application and registration use the identical wording “reagent paper for medical purposes.” In addition, we find that the registration’s broad wording “reagents for medical use,” “clinical medical reagents,” and “medical diagnostic reagents,” encompass all goods of the type described, including the application’s more narrow “diagnostic biomarker reagents for medical purposes,” “immunoassay reagents for medical use,” “medical diagnostic reagents for pregnancy purposes,” “medical diagnostic reagents for hepatitis,” “chemical reagents for medical purposes,” and “diagnostic reagents for medical purposes,” making the goods legally identical. See *In re Solid State Design Inc.*, No. 87269041, 2018 TTAB LEXIS 1, *16 (“The identification leaves the goods broadly described as ‘[d]ownloadable mobile applications for mobile phones and mobile electronic devices,’ and we must deem those goods to include all ‘goods of the nature

and type described therein,'] which encompass Applicant's more specifically identified type of '[c]omputer application software for mobile phones.'" (internal citation omitted).

The focus in an ex parte appeal on assessing the goods as listed in the application and registration differs from the focus in a district court infringement case on assessing the goods in actual use by the parties. *See Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F2d 1201, 1205 (1st Cir. 1983) ("The Beckman analyzer is a massive instrument, weighing from 350 lbs. to 550 lbs., depending upon the model. It is used only in the chemistry laboratories of hospitals or research institutions, and is not employed to analyze or measure any of Astra's drugs. ... Astra's products, on the other hand, consist mainly of local anesthetics, cardiovascular medicines, and prefilled syringes."). Because the assessment is different, we disagree with Applicant's argument³ that the *Astra* court's finding, that the parties' respective goods as actually used by the parties were insufficiently related to create a likelihood of confusion, should be followed here. *See In re FCA US LLC*, 2018 TTAB LEXIS 116, *12 n.18 ("In innumerable cases, the Board hears arguments about how the parties' actual goods, services, customers, trade channels, and conditions of sale are narrower or different from the goods and services identified in the applications and registrations. But as stated in equally innumerable decisions of our primary reviewing court, we may consider any such restrictions only if they are included in the identification of goods or services."), *aff'd* 778 Fed. Appx. 962 (Fed. Cir. 2019).

³ 7 TTABVUE 6-7.

The third and fourth *DuPont* factors assess “the similarity or dissimilarity of established, likely-to-continue trade channels” and “the conditions under which and buyers to whom sales are made, *i.e.*, ‘impulse’ vs. careful, sophisticated purchasing.” The relevant purchaser for Applicant’s and Registrant’s goods is an individual, group, or business interested in medical testing and/or diagnosis. Where, as here, the goods are identical in-part, we presume the channels of trade and classes of purchasers are the same for such goods. *Stone Lion*, 746 F3d at 1323.

As to the conditions of purchase, “[p]urchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005). In view of the inherent nature of the respective goods for testing and diagnosis for medical purposes, we find Applicant’s and Registrant’s potential or actual consumers will exercise a higher degree of purchasing care than for general consumer products. Purchasers of medical equipment or diagnostic services are more likely to distinguish between marks and goods than is the general consuming public. *See, e.g., In re N.A.D.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (“The record shows the machines to be elaborate, sizeable, complex pieces of technical apparatus of the kind which would be purchased only in consultation with an anesthesiologist or someone with equivalent technical knowledge. In other words, only very sophisticated purchasers are here involved who would buy with great care and unquestionably know the source of the goods.”).

On the other hand, there is no evidence of record regarding the pricing or complexity of Applicant's or Registrant's goods, and there are no restrictions in the respective identifications to medical professionals, scientific researchers or laboratory personnel. That is, over-the-counter medical testing reagents (such as for COVID or illegal substances) are available to the general consumer and encompassed by Applicant's description of "diagnostic reagents for medical purposes." While we can agree with Applicant's general statement that the medical industry is "heavily regulated, highly technical, and commercially competitive field,"⁴ Applicant's goods are not restricted to this field. When the goods or services could appeal to sophisticated and unsophisticated purchasers, "Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'" *Stone Lion Cap. Partners*, 746 F.3d at 1325.

B. Strength or Weakness of the Mark of the Cited Registration

Because the strength or weakness of the cited mark PRO-LAB (in standard characters) informs our comparison of the marks, we address Applicant's argument that the cited mark is weak and entitled to a narrow scope of enforcement.⁵ "Two of the *DuPont* factors (the fifth and sixth) consider strength." *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). The fifth *DuPont* factor concerns "[t]he fame of the prior mark (sales, advertising, length of use)," whereas the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of "[t]he

⁴ 4 TTABVUE 10.

⁵ 4 TTABVUE 13-14.

number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361.

Here, as in most *ex parte* cases, the record includes no evidence of any fame of the registered mark. *See In re i.am.symbolic, LLC*, 2015 TTAB LEXIS 369, at *22, *aff’d*, 866 F.3d 1315 (Fed. Cir. 2017) (“Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an *ex parte* proceeding.”). Moreover, Applicant submitted no evidence of third-party use under *DuPont* factor six. Applicant’s argument that the cited mark is weak is based on the cited registration issuing on the Supplemental Register, which indicates that at the time of registration, the mark was not inherently distinctive. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1299 (CCPA 1972).

However, the law is clear that a mark registered on the Supplemental Register may be cited as a bar to registration under Trademark Act Section 2(d). *In re Morinaga Nyugyo Kabushiki Kaisha*, 2016 TTAB LEXIS 448, at *16. “[T]he owner of a Supplemental Register registration can rely on the Office to cite its registered mark against any other applied-for mark that the Office deems confusingly similar.” *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 2018 TTAB LEXIS 121, at 15 n. 30. “It is not material whether or not registration on the Supplemental Register implies that there is a degree of descriptiveness to that mark, as appellant argues. Such registration may be cited under section 2(d) in a determination of likelihood of

confusion, an inquiry separate from that of descriptiveness.” *In re Research & Trading Corp.*, 793 F.2d 1276, 1278 (Fed. Cir. 1986).

The mark PRO-LAB combines the common terms PRO, a recognized abbreviation of “professional” and LAB, a recognized abbreviation of “laboratory.”⁶ Where a mark comprises a dictionary term, the definition generally supplies its connotation. *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (“The Board relied on dictionary definitions of the terms ‘stratus’ and ‘strata’ to evaluate similarities in the connotation of each mark.”). As applied to the medical diagnosis and testing goods of Registrant, the relevant public would perceive the term as merely descriptive. The presence of the hyphen in the mark PRO-LAB does not alter our finding. *See Peterson v. Awshucks SC, LLC*, No. 92066957, 2020 TTAB LEXIS 520, at *18 (“Punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks, generally does not significantly alter the commercial impression of the mark.”); *In re Mecca Grade Growers, LLC*, No. 86358219, 2018 TTAB LEXIS 64, at *17 (“The inclusion of a hyphen in Applicant’s mark [MECHANICALLY FLOOR-MALTED] has no effect on the mere descriptiveness of the mark as a whole.”).

Because the registered mark PRO-LAB is merely descriptive and issued on the Supplemental Register, the scope of protection is circumscribed.

⁶ Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/pro> and <https://www.merriam-webster.com/dictionary/lab>, both accessed Dec. 1, 2025. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, No. 85214191, 2014 TTAB LEXIS 94, *6 n.4, *aff’d*, 823 F.3d 594 (Fed. Cir. 2016).

C. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor, which assesses the similarity or dissimilarity of Applicant's and Registrant's marks. *DuPont*, 476 F.2d at 1361. We analyze the marks in their entirety, considering their appearance, sound, meaning and commercial impression. *Id.* See also *Detroit Athletic*, 903 F.3d at 1303. The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012). "The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks." *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 TTAB LEXIS 281, at *11 (TTAB 2018).

While there is no explicit rule that we must find marks similar where an applicant's mark incorporates the entirety of the registrant's mark, the fact that it does typically increases the similarity between the two. See, e.g., *China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 1341 (Fed. Cir. 2007) (applicant's mark CHI PLUS is similar to opposer's mark CHI both for electric massagers). When considering the marks, we keep in mind that, where, as here, "the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *In re Viterro*, 671 F.3d 1358, 1363 (Fed. Cir. 2012)).

Applicant seeks to register the mark IPRO-LAB, and Registrant's mark is PRO-LAB. The marks only differ in the addition of the prefatory letter I in Applicant's mark. Further, PRO-LAB is the entirety of the mark shown in the cited registration and is subsumed in its entirety by Applicant's IPRO-LAB mark. Based on the identical six letter hyphenated literal element PRO-LAB, the marks are visually and aurally similar, and have a similar connotation.

With respect to the impact of the prefatory letter I, the Examining Attorney submitted a Wikipedia page on "Internet-related prefixes" which states in part:⁷

Internet-related prefixes such as e-, i-, cyber-, info-, techno- and net- are added to a wide range of existing words to describe new, Internet- or computer-related flavors of existing concepts, often electronic products and services that already have a non-electronic counterpart.

i-, standing for internet, was used as early as 1994 by iVillage, an internet community site by and for women. More recent examples include the BBC's iPlayer, and Google's former iGoogle service.

In addition, the record includes the transcript of an October 25, 2011 NPR story, excerpted below:⁸

Steve, Myself and i: The Big Story of a Little Prefix by Geoff Nunberg

In the meantime, the Internet had come of age, chewing up a succession of prefixes along the way. First there was cyber-, which conjured up the opening sequence of Star Trek ...

Then came the Internet boom and the prefix e-. ...

After a while, that prefix was getting old, too, as the boundaries between online and offline got blurry: Where do the real banks and newspapers leave off and their e-clones begin? And then there was i-. The prefix had actually been around for several years before Apple adopted it for those gumdrop-colored iMacs that Jobs introduced in 1999. According to Apple's ad agency, i- was

⁷ January 11, 2025 Office Action TSDR 8-9.

⁸ *Id.* at 13-16.

meant to stand for “internet” with overtones of “individual” and probably the first-person pronoun as well. ...

It isn't just about computer science anymore, either. That isn't where you go to find out how technology changes people's lives, and where it fails them, or how to make it less intrusive and more humane. Those are the questions people are taking up at the Schools of Information that have sprung up at research universities like UCLA, Toronto and Washington - iSchools, for short. It's a different i-, but it too stands in for a connection between technology and the social world.

Based on this evidence, the Examining Attorney contends that the prefatory letter I in Applicant's mark will connote the descriptive term “Internet” and convey that the PRO-LAB goods are accessible through the Internet.⁹ Applicant does not dispute this connotation, but argues, without citing to any evidence, that the letter I may also connote association with innovation, individuality, and digital tools, and this is enough to distinguish the marks.¹⁰ Aside from attorney argument, which is “no substitute for evidence,” *Cai*, 901 F.3d at 1371 (quotation omitted), there is nothing to suggest that the letter I would have a different connotation or that IPRO-LAB will have a different meaning or connotation from PRO-LAB as applied to the identified goods in the application and the cited registration.

We find the prefatory letter I will be perceived as describing that the PRO-LAB testing and diagnostic goods now are aided by Internet tools. *See Heritage All. v. Am. Pol'y Roundtable*, 133 F.4th 1063, 1068 (Fed. Cir. 2025) (“As to the components [of the mark IVOTERGUIDE and IVOTERGUIDE.COM]: The Board had, and cited, substantial-evidence support for its determination that the prefix ‘I’ generally refers

⁹ 6 TABVUE 7-8.

¹⁰ 4 TTABVUE 12-13.

to something Internet-based.”); *RxD Media, LLC v. IP Application Dev. LLC*, 2018 TTAB LEXIS 37, at * 41 (“The ‘I’ prefix means Internet-enabled or accessible and the word ‘Pad’ refers to a notepad for writing notes.”); *In re Zanova, Inc.*, 2001 TTAB LEXIS 340, at *16-17 (“When we consider the possible significance of ‘I’ in ITOOL to prospective purchasers of applicant's goods or services, we find that they will readily accept ‘I’ as meaning ‘Internet,’ and the NEXIS references applicant has distinguished do not suggest otherwise.”).

D. Balancing the Factors

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. As discussed, no evidence was submitted with respect to *DuPont* factor six, and it is neutral. While *DuPont* factors four and five weigh against a finding of likelihood of confusion, we find they are greatly outweighed by *DuPont* factors one, two and three, which weigh heavily in favor of a finding of likelihood of confusion. In other words, notwithstanding the conceptual weakness of the common term PRO-LAB as applied to medical testing and diagnostic goods, and the somewhat higher degree of care exercised by customers in purchasing such goods, because Applicant’s mark IPRO-LAB and the registered mark PRO-LAB are applied to identical goods which are presumed to travel in identical channels of trade to identical consumers, the addition of the prefatory letter I in Applicant’s mark does not distinguish the marks, but connotes goods aided by Internet tools.

When we balance the *DuPont* factors, we conclude that Applicant's IPRO-LAB mark is likely to create confusion with the registered mark PRO-LAB. 15 U.S.C. § 1052(d).

II. Decision

The refusal to register Applicant's mark is affirmed.