

This Opinion is not a
Precedent of the TTAB

Mailed: September 18, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Foundation Medicine, Inc.

v.

Albert F. Czap

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Opposition No. 91243763
—

Douglas R. Wolf, John L. Strand and Ryan M. Van Olst of
Wolf, Greenfield & Sacks, P.C. for Foundation Medicine, Inc.

Margaret N. McGann and Jonathan H. Love of
Parsons, Behle & Latimer for Albert F. Czap.

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Before Wellington, Adlin and Hudis,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Albert F. Czap seeks registration of FOUNDATIONAL MEDICINE REVIEW, in standard characters (MEDICINE REVIEW disclaimed), for “journals in the field of medicine” in International Class 16, and “providing on-line non-downloadable articles in the field of medicine and health care” in International Class 41.¹ In its notice of opposition, Opposer Foundation Medicine, Inc. pleads ownership

¹ Application Serial No. 87763474 was filed January 20, 2018 under Section 1(b) of the Trademark Act, based on an alleged bona fide intent to use the mark in commerce.

of two registrations for the mark FOUNDATION MEDICINE, both over five years old, in the forms and for the services set forth below:

<u>Mark</u>	<u>Services</u>
<p>FOUNDATION MEDICINE (standard characters, MEDICINE disclaimed)²</p>	<p>“electronic storage of medical data and medical information for healthcare professionals” in International Class 39;</p> <p>and</p> <p>“cancer genomic and molecular medical testing for diagnostic or treatment purposes; cancer diagnostic services; providing medical information through the collection and analysis of cancer-associated genetic and treatment information; providing medical data/information to healthcare professionals” in International Class 44</p>
<p> (MEDICINE disclaimed)³</p>	<p>“online portal featuring links to medical and scientific research in the field of cancer treatment and diagnosis and clinical trials information; providing collected and analyzed medical information in the field of cancer genomics and treatment information for cancer for scientific research purposes” in International Class 42;</p> <p>and</p> <p>“online portal featuring patient medical test results from medical testing for diagnosis or treatment purposes and links to medical information; genomic</p>

² Registration No. 4150592, issued May 29, 2012; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Registration No. 4776494, issued July 21, 2015. The registration includes this description of the mark, claiming colors as indicated: “The mark consists of a green generally hexagon shape where the bottom corner is separate and both legs extend upwards and then outwardly at angle with ‘FOUNDATION’ in orange above ‘MEDICINE’ in gray.”

	and genetic and molecular medical testing for cancer diagnostic or treatment purposes; diagnostic services, namely, medical diagnostic testing for cancer; providing collected and analyzed medical information in the field of cancer genomics and treatment information for cancer for diagnostic and treatment purposes; providing medical data and information to healthcare professionals” in International Class 44
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While Opposer primarily relies on is pleaded registrations, it also alleges prior use of FOUNDATION MEDICINE for “medical and scientific research, the provision of medical information, and related online portals.” As grounds for opposition, Opposer alleges under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), that use of Applicant’s mark would likely cause confusion with Opposer’s mark.⁴ In his answer, Applicant denies the salient allegations in the notice of opposition and asserts a purported “affirmative defense” which merely amplifies his denials.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application. In addition, Opposer

⁴ Opposer argues in its brief that it owns a “family” of marks, but failed to so plead, and the issue was not tried. We have therefore considered each of Opposer’s pleaded marks separately, without regard to Opposer’s “family” argument. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (“Petitioner’s reference to a family of marks in its brief will not be considered because this claim was neither pleaded nor tried by the parties.”).

introduced:

Notice of Reliance on portions of Applicant's responses to Opposer's written discovery requests, dictionary definitions, several of its unpleaded registrations and third-party registrations ("Opp. NOR"). 11 TTABVUE.⁵

Testimony Declaration of John Truesdell, its Senior Director and Lifestyle Leader, and the exhibits thereto ("Truesdell Dec."). 12 TTABVUE.

Applicant introduced:

Notice of Reliance on dictionary definitions, portions of Opposer's responses to Applicant's written discovery requests, official records, Internet printouts and third-party registrations ("App. NOR"). 13 TTABVUE.

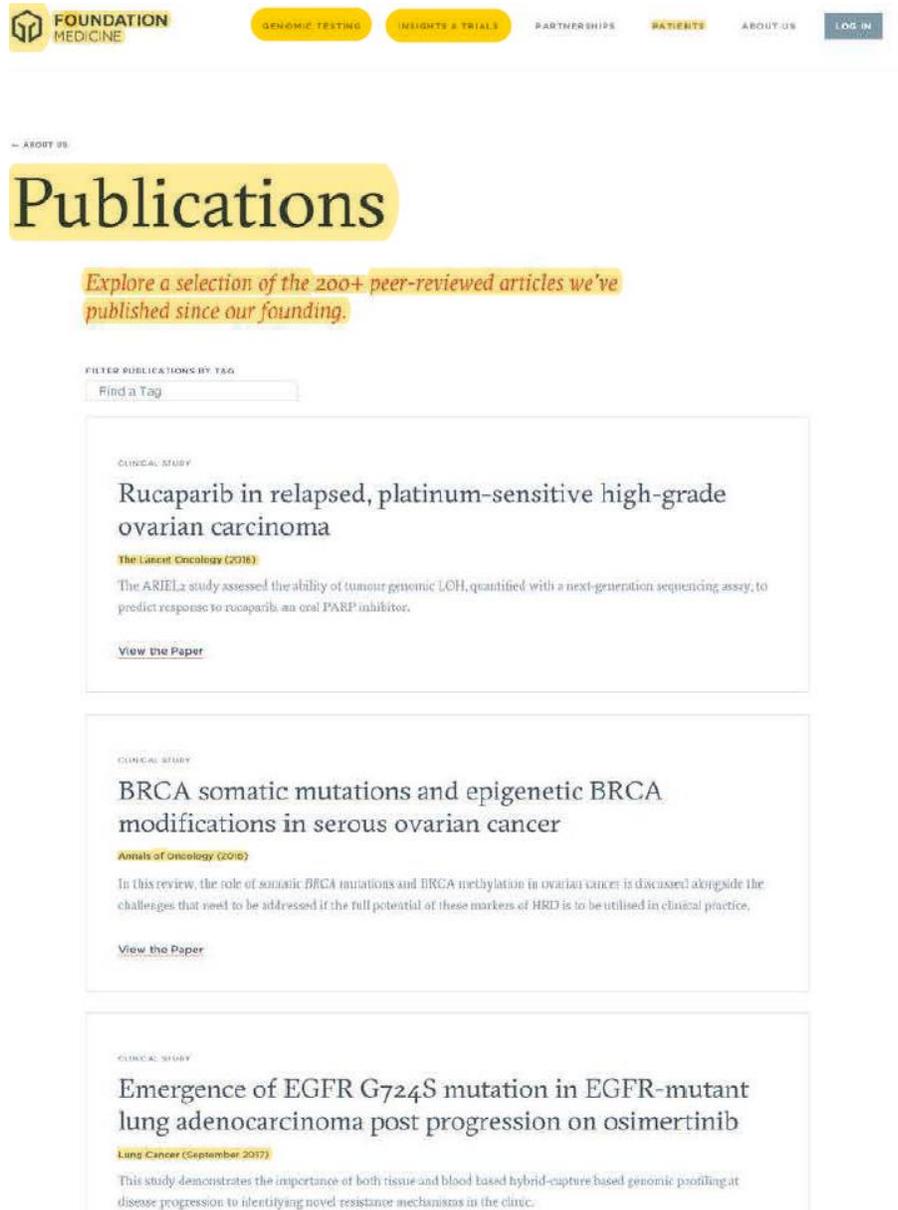
II. The Parties and Their Marks

Opposer, which refers to itself as "The Molecular Information Company," claims on its website to connect "physicians and their patients to the latest cancer treatment approaches," and to be "making precision medicine a reality for thousands." 12 TTABVUE 3, 19 (Truesdell Dec. ¶ 7 and Ex. C). More specifically, Opposer claims to have "developed a fully informative genomic profile to identify a patient's individual molecular alterations and match them with relevant targeted therapies and clinical trials." *Id.* at 31 (Truesdell Dec. Ex. E).

While Opposer seems to primarily focus on developing medical tests, it also has used its pleaded standard character mark since 2010 and its pleaded design mark since 2013 in connection with "the provision of information and data in the fields of

⁵ Citations to the record reference TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

medicine and healthcare.” *Id.* at 2-3 (Truesdell Dec. ¶¶ 4-5). This includes offering “online portals featuring the FOUNDATION MEDICINE Marks and links to medical and scientific research in the fields of cancer treatment, diagnostics, and clinical trial information,” as shown below:



Id. at 3, 13 (Truesdell Dec. ¶ 6 and Ex. B).

Opposer provides information under its pleaded marks not just to researchers, healthcare providers and biopharmaceutical companies, but also to “patients and families of patients who may have been diagnosed with cancer.” *Id.* at 4-5 (Truesdell Dec. ¶¶ 10-11). Opposer claims to have published “over 200 peer-reviewed articles,” and provides links to at least some of them, apparently on its website:

FMI Publication List		
	Title	Published
2011		
1	Comprehensive next-generation cancer genome sequencing in the era of targeted therapy and personalized oncology	Q2 2011
2	Cancer biomarkers, companion diagnostics and personalized oncology	Q3 2011
3	Whole Cancer Genome Sequencing by Next-Generation	Q4 2011
2012		
4	Identification of new ALK and RET gene fusions from colorectal and lung cancer biopsies	Q1 2012
5	Next Generation Sequencing Identifies and Immunohistochemistry Confirms a Novel Crizotinib Sensitive ALK Rearrangement in a Patient with Metastatic Non-small Cell Lung Cancer	Q3 2012
6	Targeted genomic sequencing of pediatric Burkitt lymphoma identifies recurrent alterations in antiapoptotic and chromatin-remodeling genes.	Q4 2012
2013		
7	The Role of Companion Diagnostic Testing in Payer Decision Making	Q1 2013

Id. at 7, 89- 128 (Truesdell Dec. ¶ 13 and Ex. U).

Applicant “has not sold, or offered for sale, any goods or services under Applicant’s mark.” 11 TTABVUE 10 (Applicant’s Response to Opposer’s Interrogatory No. 4). Applicant nevertheless claims that his goods and services “are offered to the public for no cost to consumers.” *Id.* Applicant does not claim any use of his involved mark prior to the filing date of his involved application, however. In any event, Applicant claims that his “articles in the field of medicine and health care” are provided on the

“foundationalmedicine.com” website, as well as via Applicant’s Facebook, Twitter and LinkedIn accounts. *Id.* at 11 (Applicant’s Response to Opposer’s Interrogatory No. 6).

III. Likelihood of Confusion

Before addressing whether the parties’ marks are likely to be confused, we must first consider whether Opposer is entitled to bring this proceeding. If it is we must then consider whether priority is at issue and if it is which party has it. *See* 15 U.S.C. §§ 1052(d) and 1063.

A. Opposer’s Entitlement to Statutory Cause of Action⁶

To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, such as a cause of action for likelihood of confusion, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Here, Opposer has established its entitlement to bring this proceeding because it has a “real interest” and a “reasonable belief of damage.” *Australian Therapeutic*, 2020 USPQ2d 10837 at *3. Indeed, Opposer’s pleaded registrations, which were properly made of

⁶ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

record, 1 TTABVUE 9-14, establish that it is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

B. Priority Is Not At Issue

Because Applicant has not counterclaimed to cancel either of Opposer's pleaded registrations, priority is not at issue with respect to the marks and goods and services identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In any event, Opposer has established common law use of its mark, prior to Applicant's filing date, for "provision of information and data in the fields of medicine and healthcare." 12 TTABVUE 2-3 (Truesdell Dec. ¶¶ 4-5).

C. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record 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) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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."). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55

USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

1. The Goods and Services

The parties' services are identified broadly in the involved application and pleaded registrations, such that Applicant's services encompass Opposer's services and vice versa. Specifically, under both of its pleaded marks Opposer provides "medical data/information to healthcare professionals," which is broad enough to encompass Applicant's "providing on-line non-downloadable articles in the field of medicine and health care."⁷ While Applicant's "journals in the field of medicine" are identified as goods, that is of little consequence here where Opposer's services are essentially the same – "providing medical data/information." In fact, whether the information is provided in online/electronic journals (or through the "online portal" identified in

⁷ Applicant argues that "[w]hen viewed in the proper context, Opposer's 'medical and treatment information/data' is a reference to the results of Opposer's genomic testing and diagnostic services." 16 TTABVUE 20. However, as Applicant points out in his discovery responses, we must base our determination "on the basis of the description of the goods" and services in Opposer's pleaded registrations. 11 TTABVUE 11-12 (responses to Opposer's Interrogatory Nos. 6, 7). "We have no authority to read any restrictions or limitations into the registrant's description of goods" based on evidence of actual marketplace use. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009). *See also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) ("It is well established that the Board may not read limitations into an unrestricted registration or application.") (quoting *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)). Furthermore, and for essentially the same reason, to the extent Applicant argues that confusion is unlikely because consumers will exercise care in purchasing the parties' goods and services, we must base our decision on the least sophisticated purchasers for those goods and services. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014).

Opposer's pleaded design mark registration), or through traditional journals distributed on paper, is not substantively relevant. In short, Opposer's services are legally identical to Applicant's goods and services.⁸ *Cf. In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) ("We agree with the Board's initial observation that, with modern technology, the line between services and products sometimes blurs . . . careful analysis is required to determine whether web-based offerings, like those JobDiva provides, are products or services."); *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006) ("Because of the . . . blurring between services and products that has occurred with the development and growth of web-based products and services it is important to review all the information in the record to understand both how the mark is used and how it will be perceived by potential customers.").

Even if Opposer's "providing medical data/information" does not encompass Applicant's "journals in the field of medicine," the record makes clear that these goods and services are closely related. Indeed, Opposer provided digitized examples of articles it published in journals in the field of medicine. 12 TTABVUE 7, 130-153 (Truesdell Dec. ¶ 13 and Ex. V).

⁸ In any event, Opposer introduced a number of third-party registrations showing marks registered for services similar to Opposer's services on the one hand, and the types of goods and services identified by Applicant on the other. 11 TTABVUE 78-133. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *See In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).

Moreover, because the goods and services are legally identical, we must presume that the channels of trade and classes of purchasers are as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). To the extent that Opposer's services and Applicant's goods are not legally identical, Opposer has established that their channels of trade overlap. 12 TTABVUE 7, 90-128, 130-153 (Truesdell Dec. ¶ 13 and Exs. U and V).

The legal identity of (and close relationship between) the goods and services and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

2. The Marks

The marks are quite similar "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Indeed, the only difference between Applicant's mark on the one hand, and Opposer's standard character mark and the literal portion of Opposer's design mark on the other, is that Applicant's mark adds

the suffix “al” to FOUNDATION, and the merely descriptive or generic term REVIEW to the end of the mark. These are distinctions without a meaningful difference.

In fact, in his brief, Applicant argues that the first word in his mark, FOUNDATIONAL, “is an adjective.” 16 TTABVUE 16. When added to an adjective, the suffix “al” means “of, relating to, or characterized by.”⁹ Thus, not only does the suffix AL do little to distinguish the word FOUNDATIONAL from the word FOUNDATION (on which it is based) in appearance or sound, but the terms also convey the same meaning. In fact, as Opposer points out in its brief, Applicant introduced dictionary evidence revealing that “foundational” means “of, relating to, or forming or serving as a base or foundation,” with one example of usage of the term being “foundational volumes.” 13 TTABVUE 23-25; 15 TTABVUE 18.

The word REVIEW, which is the trailing term in Applicant’s mark and absent from Opposer’s marks, is merely descriptive or generic for Applicant’s “journals” and “articles.” 11 TTABVUE 51 (defining “review” as “a magazine containing articles of criticism and appraisal, often in a specific field”). This is why Applicant disclaimed MEDICINE REVIEW in his involved application, and why the term is entitled to less weight in our analysis. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that

⁹ merriam-webster.com/dictionary/AL. 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*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)).

While Opposer’s design mark is not quite as close to Applicant’s mark, it is still highly similar. In fact, the design element is not particularly distinctive, and as a result the literal portion of the mark, by which consumers will call for Opposer’s services, is dominant. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”).

In short, FOUNDATION MEDICINE (in both its standard character and design forms) and FOUNDATIONAL MEDICINE REVIEW are highly similar in appearance, sound, meaning and commercial impression, so much so that some consumers familiar with Opposer’s marks could even perceive Applicant’s as identifying one of Opposer’s publications. This factor also weighs heavily in support of finding a likelihood of confusion.

3. The Strength of Opposer’s Marks

Opposer argues that its marks are commercially strong, based on: use of the standard character mark since 2010 and the design mark since 2013; promotional efforts, including not insubstantial but not overly impressive advertising expenses

between 2015-2018; and media exposure in publications including The Boston Globe, Forbes and Wired. 15 TTABVUE 28-31. Applicant argues that Opposer's marks are weak based on third-party registrations of marks containing the term FOUNDATION "in the medical and healthcare industry." 16 TTABVUE 23-24. Applicant does not specify whether it is referring to commercial or conceptual weakness, however.¹⁰

Opposer's commercial strength evidence is not enough to convince us that its marks are entitled to more than an average level of protection for marks registered on the Principal Register. The advertising figures are not overwhelming and there is insufficient evidence that Opposer's marks have had a substantial impact on the consuming public.

Applicant's third-party registration evidence is quantitatively and qualitatively insufficient to show that Opposer's mark is conceptually weak. In each of the seven third-party registrations Applicant relies upon, 13 TTABVUE 316-327, either the marks, or the goods or services, or both, are too different from Opposer's mark and services for the third-party registrations to be probative. *See In re i.am.symbolic*, 123 USPQ2d at 1751-52 ("Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications."); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d

¹⁰ Applicant asserts that the third-party registrations establish use of the registered marks. They do not. *In re Mucky Duck*, 6 USPQ2d at 1470 n.6 (third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them").

874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on *similar goods*’ ... It is less relevant that ‘Century is used on unrelated goods or services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”) (quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)); *In re Inn at St. Johns, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). In addition, in several of the registrations upon which Applicant relies, FOUNDATION is used to identify charitable or association services.

We find that Opposer’s marks are entitled to a normal scope of protection for marks registered on the Principal Register.¹¹ This factor is neutral.

IV. Conclusion

The parties’ marks are quite similar, their goods and services are legally identical or at least closely related and the channels of trade are presumed to overlap. Confusion is likely.

Decision: The opposition to registration of Applicant’s FOUNDATIONAL MEDICINE REVIEW mark on the ground of likelihood of confusion is sustained.

¹¹ Opposer half-heartedly argues about other *du Pont* factors which are not relevant on the record presented. There is no evidence of actual confusion of record, or that there has been an opportunity for actual confusion to occur, and this factor is therefore irrelevant. Moreover, while Applicant may have been aware of Opposer or one or more of its marks prior to filing his involved application, that is insufficient to establish bad faith. *Action Temporary Services, Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989) (“*mere knowledge of the existence of the prior user* should not, by itself, constitute bad faith”).