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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Biolex, Inc.

Serial No. 76633841

Edward M. Prince, of Alston & Bird LLP for Biolex, Inc.

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Before Zervas, Walsh, and Ritchie de Larena, Administrative
Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

Biolex, Inc. filed an application to register the mark
LEX SYSTEM, in standard character format, for
"manufacturing of plants, recombinant protein, and other
organisms and biomolecules to order and/or specification of
others in the field of biotechnology" in International
Class 40, and "research, development, and consultation
services in the field of biotechnology, namely, genetic
engineering of plants and other organisms, recombinant
protein and other biomolecules, discovery and production in
plants and other organisms and purification of recombinant

proteins and other biomolecules produced in plants and other organisms; product research and development for discovering and making recombinant proteins and other recombinant biomolecules in plants and other organisms for pharmaceutical preparations and for other applications, and consultation services for the discovery and production of pharmaceutical preparations" in International Class 42.¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark LEX SYSTEM, when used in connection with the identified services, so resembles the following three registered marks, all registered to the same registrant, as to be likely to cause confusion (collectively, the "THREE CITED REGISTRATIONS"):

1. LEXGEN, for "providing access to a genomic database consisting of molecular biology and genetic research information via a global computer information network; computer services in the nature of providing online publication, namely, scientific journals and newsletters in the field of molecular biology and genetic research; providing online molecular biology and genetic research information and resources to others via a global computer

¹ Application Serial No. 76633841, filed January 10, 2005, originally filed pursuant to Section 1(a) of the Trademark Act, 15 USC §1051(a), amended to a Section 1(b) application, alleging a bona fide intent to use. Applicant has disclaimed the exclusive right to use "SYSTEM" apart from the mark as shown.

network; collaborative research and development services in the field of molecular biology and genetics."²

2. LEXGEN.COM, for "providing an online computer database in the field of genetic research."³

3. LEXVISION, for "providing a database consisting of molecular biology and genetic research information."⁴

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs. For the reasons discussed herein, the Board affirms the final refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d)

² Registration No. 2689750, issued February 25, 2003 for a typed drawing in International Class 42, claiming first use and first use in commerce on April 1, 1999.

³ Registration No. 2570600, issued May 21, 2002 for a typed drawing in International Class 42, claiming first use and first use in commerce on April 1, 1999.

⁴ Registration No. 2548260, issued March 12, 2002 for a typed drawing in International Class 42, claiming first use and first use in commerce on April 1, 2000.

goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We consider each of the factors as to which applicant or the examining attorney presented arguments or evidence.

The similarity or dissimilarity
and nature of the services

Applicant is seeking registration of its mark for certain types of manufacturing, research and development services in biotechnology. Applicant's International Class 42 services are identical in part to those identified by the LEXGEN registration for "collaborative research and development services in the field of molecular biology and genetics."⁵ The remaining services identified in the THREE CITED REGISTRATIONS are also related to applicant's identified services in both International Class 40 and 42, and would be used in connection with, and are integral to, research and development services in the biotechnology field.

The examining attorney has introduced evidence of third party registrations to show that applicant's and registrant's goods are likely to be perceived by the relevant consuming public as emanating from a common source. Third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that

⁵ LEXGEN, Reg. No. 2689750.

they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993 (TTAB 1993)). In particular, the following third party registrations introduced by the examining attorney cover both "research and development" within biotechnology -- as identified both by applicant and by registrant, and an "online computer database" within biotechnology -- as identified by registrant:

1. VACCINESHOPE.COM, for, *inter alia*, both "providing an on-line computer database in the field of health"; and "product research and development in the field of vaccines and biologicals."⁶

2. INPHARMATICA, for, *inter alia*, both "providing an on-line computer database in the fields of biology, genomics, . . . biotechnology . . . "; and "conducting scientific research and development of products and treatments for others."⁷

3. PROTEOME SYSTEMS INTEGRATED PROTEOME TECHNOLOGY, for, *inter alia*, "providing an on-line database in the field of chemical research, biotechnology, and proteome technology"; and "research and product development for

⁶ Registration No. 2856191, issued June 22, 2004 for a design in International Class 42, claiming first use and first use in commerce on January 23, 2004.

⁷ Registration No. 2944193, issued April 26, 2005, for a design in International Class 42, claiming first use and first use in commerce on February 1, 2003.

others in the field of chemical research, biotechnology, and proteome technology.”⁸

4. BIOEXPRESS, for, *inter alia*, “providing an on-line interactive computer database in the field of biotechnology”; and “technical research and consulting services in the field of biotechnology.”⁹

5. DECIPHER, for, *inter alia*, “providing, developing, distributing and licensing of computer services and database [sic] in the field of genomics, proteomics, bioinformatics and related activities”; and “providing consultation and research in the field of biotechnology, microbiology, genomics, bioinformatics and related activities.”¹⁰

Applicant argues that the focus of its services are quite different from what is or may be offered by registrant via the THREE CITED REGISTRATIONS, since applicant’s identified services do not include databases. The point, however, is not confusion as to the services that may be rendered by applicant or by registrant, but rather confusion as to the *source* of those services. *In re TSI Brands Inc.*, 67 USPQ2d 1657 (TTAB 2002); *Albert*

⁸ Registration No. 2806965, issued January 20, 2004 for a design in International Class 42, claiming first use May 31, 1999 and first use in commerce on October 31, 1999, with disclaimers included.

⁹ Registration No. 2875217, issued August 17, 2004 for a typed drawing in International Class 42, claiming first use and first use in commerce on December 29, 1999.

¹⁰ Registration No. 2724127, issued June 10, 2003 for a typed drawing in International Class 42, claiming first use May 1, 2001 and first use in commerce on May 10, 2001.

Trostel, 29 USPQ2d at 1784. Indeed, logically, a consumer may expect that the results of "research and development services" -- as identified both by applicant and by registrant, would be reflected in an "online computer database" -- as identified by registrant, and that they therefore emanate from a common source. Since the services identified by applicant and those identified in the THREE CITED REGISTRATIONS are partially identical and otherwise related, this *du Pont* factor weighs in favor of finding a likelihood of consumer confusion.

The similarity or dissimilarity of established,
likely-to-continue trade channels
and classes of consumers

Applicant argues that its target customers are "sophisticated consumers," and that therefore they will recognize the difference between the mark as used on its identified services in International Classes 40 and 42, and the marks in the THREE CITED REGISTRATIONS as they are or may be used in association with registrant's services. Applicant has submitted no evidence to support its argument however. Moreover, even a sophisticated consumer is not immune from source confusion. With the partially identical and otherwise related services as described above, and the similarity of the marks discussed below, even a careful, sophisticated consumer is not immune from source confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("The alleged sophistication of golfers is outweighed by the Board's

findings of strong similarity of marks and identity of goods, both of which we uphold.”)

Furthermore, there is nothing in registrant’s recitations of services that restricts registrant from targeting the same consumers as applicant. In the absence of specific limitations in the registration, we must presume that registrant’s services will travel in all normal and usual channels of trade and methods of distribution and be sold to all classes of consumers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). With applicant and registrant targeting the same classes of consumers, we find that the third and fourth *du Pont* factors generally favor a finding of likelihood of confusion.

The similarity or dissimilarity of the marks
in their entirety

Preliminarily, we note that the more similar the services at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entirety. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant

argues that the marks are not sufficiently similar. However, all share the common first syllable, LEX. The word "lex" is defined as "law."¹¹ This is an arbitrary term as applied to the services identified in the THREE CITED REGISTRATIONS. The registered marks LEXGEN, LEXGEN.COM, AND LEXVISION are therefore inherently strong.

Although we compare the marks in their entireties, we note that LEX is the dominant term in both applicant's mark, and in the THREE CITED REGISTRATIONS. Applicant has disclaimed the only other word in its mark, SYSTEM. Descriptive matter is generally viewed as a less dominant or significant feature of a mark. *In re National Data Corp.*, 224 USPQ 749, 750 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'"). In the THREE CITED REGISTRATIONS as well, the term LEX is likely to be perceived as dominant over the additional, subordinate terms "GEN," "GEN.COM," and "VISION."

Applicant argues that the word LEX is commonly-used, and that therefore the marks in the THREE CITED REGISTRATIONS are "weak." Applicant has referred in its papers of record to 16 current or pending registrations containing the term "LEX." However, 15 relate to

¹¹ American Heritage Dictionary (4th ed. 2000). The Board may take judicial notice of dictionary definitions not included in the record. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.* 213 USPQ 594, 596 (Fed. Cir. 1982).

"computers"; "computer hardware"; or computer "repair" services, including one registration for "computer hardware" with the exact mark applicant seeks to register, LEX SYSTEM.¹² The only registration cited by applicant that relates to biotechnology research services or database offerings is LEXICOSCIENCE.¹³ This is a Section 44 registration, and is not use-based. There is no evidence in the record that this mark is in use, and therefore, we accord it little probative value in our determination of the strength of the term LEX in the THREE CITED REGISTRATIONS. We also accord little probative value to the FLEX marks cited by applicant, since FLEX creates a different connotation and commercial impression than LEX. Moreover, a weak mark is still protectable, and third party usage or infringement does not entitle applicant to register a confusingly similar mark. *See Giant Food Inc. v. Roos and Mastacco, Inc.*, 218 USPQ 521 (TTAB 1982) (even owner of weak mark is entitled to protection from likelihood of confusion).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their

¹² Registration No. 3095279, issued March 31, 2005 for a design in International Class 9, claiming first use and first use in commerce on July 1, 2001.

¹³ Registration No. 2692241, issued March 4, 2003 for a typed drawing in International Classes 9 and 42, under Section 44 of the Trademark Act, 15 USC §1126.

overall commercial impression so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Although there are certain differences between applicant's mark and each of the cited registered marks, the similarities are more significant. Applicant's mark and each of the cited marks begins with "LEX," and "LEX" is the dominant element in applicant's mark and each of the cited marks. Accordingly, when we view and compare applicant's mark and each of the cited marks in their entireties, we conclude that applicant's mark is similar to each of the cited marks in appearance, sound, connotation and commercial impression.

Since the relevant, dominant portions of the marks are identical, and the marks as a whole are similar, the Board finds that the first *du Pont* factor weighs in favor of finding that there is a likelihood of consumer confusion.

Balancing The Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that the services are partially identical and otherwise related; they are likely to be sold through the same channels and to target the same consumers; and the marks are similar. It is well-established that any doubts as to likelihood of confusion are to be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). Accordingly, we find a likelihood of confusion between the mark applicant seeks to register in International Classes 40 and 42, LEX SYSTEM, and the THREE CITED REGISTRATIONS discussed herein, LEXGEN, LEXGEN.COM, and LEXVISION.

Decision: The refusal to register is affirmed.