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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GenScript Corporation

Serial No. 77139261

Thomas D. Foster for GenScript Corporation.

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108 (Andrew Lawrence, Managing Attorney).

Before Quinn, Wellington, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

GenScript Corporation filed an application to register the mark "ONE-STEP WESTERN," in standard character format, for "reagents for scientific or medical research use," in International Class 1.¹ The trademark examining attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), based on a likelihood of confusion with the following two registrations, registered to two different entities:

¹ Application Serial No. 77139261, filed March 23, 2007, pursuant to Section 1(a) of the Trademark Act, 15 USC §1051(a), alleging a date of first use of June 1, 2005, and first use in commerce of October 1, 2005.

1. "ONESTEP," for "chemicals for the synthesis and purification of DNA," in International Class 1.²

2. "1-STEP," for "reagents for centrifugation, isolation and separation of biological materials for research laboratory purposes," in International Class 1.³

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) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

² Registration No. 1897917, issued February 8, 1994, for a typed drawing, claiming first use and first use in commerce on June 15, 1994. Section 8 affidavit accepted; renewed.

³ Registration No. 2128095, issued January 13, 1998, for a typed drawing, claiming first use and first use in commerce on February 28, 1992, and claiming acquired distinctiveness in accordance with Section 2(f) of the Trademark Act; 15 USC §1052(f). Sections 8 and 15 affidavits accepted and acknowledged; renewed.

the marks"). We consider each of the factors as to which applicant or the examining attorney presented arguments or evidence.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *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 same first two syllables, "one," (or "one-" or "1-") and then "step." The differential expressions of the number "one" (or "one-" or "1-") sound the same and have the same connotation. For both cited registrations, the term "ONESTEP" (or "1-STEP") constitutes the whole of the mark. Applicant adds only the word "WESTERN," arguing that this produces a different commercial impression.

The examining attorney has submitted a definition of "western" in relevant part as: "(1) (a) coming from the west; (b) lying toward the west: of, relating to, or characteristic of a region conventionally designated West." *Merriam-Webster's Collegiate Dictionary* (10th ed. 2002). We find it likely that consumers would either not notice this addition of an adjective or would be confused into believing that applicant's "WESTERN" is simply a line of goods produced or endorsed by registrants, perhaps with the

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goods being produced or sold in the West. The mere addition of a term to a registered trademark does not obviate a likelihood of consumer confusion. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Cola-Cola Bottling Co. v. Joseph E. Seagrams & Sons, Inc.*, 526 F.2d 556 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" AND "CREST CAREER IMAGES"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"). Accordingly, we find the words "ONE-STEP" to be the dominant portion of applicant's mark. In analyzing the marks in their entirety, a particular feature or portion of the mark may be given greater weight if it makes an impression upon purchasers that would be remembered and relied upon to identify the services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). See also *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on consideration of the marks in their entirety").

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when

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subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their 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). Although there are certain differences between applicant's mark and the two cited registrations, the similarities are more significant. Accordingly, when we view and compare applicant's mark and the two cited registered marks in their entireties, we conclude that applicant's mark is similar to each of the cited registered marks in appearance, sound, connotation and commercial impression.

Applicant argues that the term "ONESTEP" (or "1-STEP") is commonly used, and that therefore the two cited registered marks are "weak." In its request for reconsideration, applicant referred to a list of 498 "active and cancelled registrations and pending and abandoned applications" containing the words "one" and "step" (not necessarily in that order or together as a phrase). Applicant did not include copies of the listed registrations/applications. In order to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the

electronic records of the Office, should be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n. 2 (TTAB 1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Merely listing such registrations/applications, as applicant has done here, is insufficient to make them of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998). We note, however, that the examining attorney did not object to the list in the denial of request for reconsideration, and instead raised the objection for the first time in her appeal brief. Since the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a time when applicant could have cured the error, we deem the objection to have been waived. See TBMP §1207.03 (2d ed. revision 1 2004), citing *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945, n4 (TTAB 2000). Accordingly, we have considered the list, but hasten to note that it has very little probative value regarding the weakness of the term "one step." Specifically, applicant's list does not provide any information about the nature of the goods or services covered by any particular registration listed, nor does it explain how they may or may not be related to those identified in the application or the cited registrations. It merely states the serial and registration no. (if any), the word mark, and whether the mark is live or dead. We do not consider more than the information provided by the

applicant. See TBMP §1208.02 ("Thus, if applicant has provided only a list of registrations numbers and/or marks, the list will have very limited probative value.")

Moreover, the listed third-party applications, as opposed to registrations, have absolutely no probative value except to show that the applications were filed. *Id*, citing *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 1998).

Therefore, we find the list to be unpersuasive as to the weakness of the cited registered marks.

Applicant did submit, however, electronic versions of twenty of the individual registrations it considered most relevant. Of the twenty, nine are use-based, live registrations on the Principal Register containing the phrase "one step" or its phonetic equivalent. Although these registrations are use-based, they are not evidence that the marks are actually in use; but they may be used in the same manner as dictionary definitions to show the relevant public's understanding of a particular term in a particular context. See *Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). Here, the nine marks relate to medical goods, but applicant has not submitted evidence to show how those goods relate to those identified in the application or in the two cited registrations.

In view thereof, based on the record before us, we are unable to find that the term "one step" is weak with respect to the involved goods. In any event, a weak mark is still protectable, and third-party usage does not

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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).

Since the relevant, dominant portion of applicant's mark is effectively identical to the two cited registered marks, 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.

The Goods

Preliminarily, we note that the more similar the marks at issue, the less similar the goods need to be for the Board to find a likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). Moreover, goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the parties' goods

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or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The application broadly identifies "reagents for scientific or medical research use." The cited Registration No. 2128095 covers a subcategory of these goods, "reagents for centrifugation, isolation and separation of biological materials for research laboratory purposes." Accordingly, applicant's identified goods partially overlap with those identified in this registration and thus are, in part, legally identical. As for the second cited registration, the examining attorney has submitted a dictionary definition of "reagent" as "a substance taking part in a chemical reaction, especially one used to detect, measure, or prepare another substance." *Encarta World English Dictionary* (North American Ed. 2007). Accordingly, we find relatedness between applicant's identified reagents and the synonymous "chemical reactions" identified in Registration No. 1897917 as "chemicals for the synthesis and purification of DNA."

The examining attorney has also introduced evidence of use-based, third-party registrations to show that applicant's and registrants' goods are likely to be perceived by the relevant consuming public as emanating from a common source. Third-party registrations which

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individually cover a number of different items and which are based on use in commerce may have probative value to the extent that 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). Applicant does not dispute the similarity of its goods to those of the registrants, but merely argues that this inquiry is not "determinative" of a likelihood of consumer confusion. However, as noted above, our analysis of the *du Pont* factors considers the similarities or dissimilarities between both the goods and the marks at issue. Here we find the goods to be related. Since the goods identified by applicant and those identified in the two cited registrations overlap and are otherwise related, the second *du Pont* factor weighs in favor of finding a likelihood of consumer confusion.

Conditions of Sale

Applicant argues that its target customers are sophisticated consumers, and that therefore they will recognize the difference between the mark ONE-STEP WESTERN as used on its identified goods and the marks in the two cited registrations as they are or may be used in association with the registrants' goods. Applicant has

submitted no evidence to support its argument however. With the overlapping and otherwise related services, and the similarity of the marks discussed above, 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 registrants' identifications of goods that restricts the registrants from targeting the same consumers as applicant. In the absence of specific limitations in the registrations and because applicant's goods are in part identical to those in one of the cited registrations, we must presume that registrants' goods 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 the registrants targeting the same classes of consumers, we find that the third and fourth *du Pont* factors generally favor a finding of likelihood of confusion.

Balancing the Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that the marks are highly similar; the goods overlap and are otherwise related; and they are likely to be sold through the same channels and to target the same consumers. 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, "ONE-STEP WESTERN," and the two cited registrations discussed herein, "ONESTEP," and "1-STEP."

Decision: The refusal to register is affirmed.