

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
Sept. 23, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merck KGAA

Serial No. 78212355

H. John Campaign and John M. Keene of Graham, Campaign P.C.
for Merck KGAA.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Walters, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark DUOPATH (in standard character form) for goods
identified in the application (as amended) as "qualitative
and quantitative assay products, namely, diagnostic
reagents for scientific or research use in the field of
food hygiene," in International Class 01, and "qualitative

assays, namely medical reagents for use in in-vitro-diagnostic procedures in human and veterinary medicine," in International Class 05.¹

The Trademark Examining Attorney has issued a final refusal to register applicant's mark on the ground that the mark, as applied to applicant's goods, so resembles the mark DUOSET, previously registered on the Principal Register for "biological reagents for use in research applications to identify cytokines by immunoassay,"² in International Class 01, as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal to register. The appeal is fully briefed, but no oral hearing was requested.

Initially, we must discuss certain evidentiary matters. First, we have given no consideration to applicant's bare assertion, in its main appeal brief, that

¹ Serial No. 78212355, filed on February 7, 2003. The bases for registration originally were intent-to-use under Trademark Act Section 1(b), 15 U.S.C. §1051(b), and Trademark Act Section 44(e), 15 U.S.C. §1126(e). Applicant subsequently deleted the Section 1(b) basis, and the application now is based solely on Section 44(e). The Section 44(e) basis is based, in turn, on applicant's ownership of German Registration No. 302 38 245, which expires on August 31, 2012.

² Registration No. 2103520, issued October 7, 1997; affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged.

"there are over 330 live applications and registrations for marks containing the term DUO." The record does not support this assertion, nor is this assertion a matter of which we will take judicial notice. Second, applicant has attached to its reply brief, and requests that we take judicial notice of, a TESS listing showing eighty-six applications and registrations of marks containing the term DUO in International Classes 01 and 05. This evidence is not of a type of which we will take judicial notice. Moreover, the listing fails to show what are the goods or services identified in these applications and registrations. Most importantly, this evidence is untimely and therefore will not be considered. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). Third, applicant, in its reply brief, has requested that we take judicial notice that "[an] online search of the term DUO via GOOGLE produced about 15,500,000 hits." Again, this assertion is not supported by the record, is not something of which we will take judicial notice, and is untimely under Trademark Rule 2.142 in any event. However, we shall take judicial notice of the dictionary definition of "duo" which applicant has attached to its reply brief, and of the dictionary definition of "cytokine" attached to its main brief. (We note that the Trademark Examining Attorney has

attached the same definition of "cytokine" to her brief on appeal.³

As for the Trademark Examining Attorney's evidence, we note that, with her final Office action, she submitted printouts from various Internet websites. The copies of these printouts, as they appear in the record, contain neither the URL addresses for the various websites, nor the date of the search in which the website printouts was made. However, applicant has not objected to this evidence on that (or any other) basis, and, in its main appeal brief, has included these printouts in its listing of the evidence of record, stating further that the printouts resulted from a search conducted on May 14, 2004 (the date of mailing of the final Office action). In these circumstances, we deem the website printouts to be of record.

Thus, the evidence of record on appeal consists of the following: the dictionary definition of "cytokine" from Stedman's Medical Dictionary (27th ed.), submitted separately by both applicant and the Trademark Examining Attorney; the dictionary definition of "duo" from Webster's Ninth New Collegiate Dictionary), submitted by applicant

³ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); TBMP §704.12(a)(2d ed. rev. 2004).

with its reply brief; the Trademark Examining Attorney's X-Search evidence, attached to her final Office action, which shows that there are only two X-search listings (applicant's application and the cited registration) retrieved by a search for applications or registrations with "DUO" as part of the mark and in which the term "reagents" appears in the identification of goods; and the Internet website printouts attached to the Trademark Examining Attorney's final Office action.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (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/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a comparison of the marks DUOPATH and DUOSET, under the first *du Pont* factor. We must determine

whether the marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression.

The term "duo," in its combining form, is defined as "two." Webster's Ninth New Collegiate Dictionary (1990) at 389. We agree with applicant's contention that "duo," so defined, is a common English word or prefix, and that it therefore is weak as used in the respective marks. We also agree with applicant's contention that the marks, viewed in their entireties, do not look or sound alike, that they have different meanings ("two paths" versus "two sets"), and that the overall commercial impressions of the marks are different. The fact that both marks start with the term DUO is not sufficient to render the marks similar when viewed in their entireties. Rather, we find that the presence of the very different words PATH and SET in the respective marks outweighs the only point of similarity between the marks, i.e., the presence in each mark of the combining form DUO. Overall, we find that the marks are dissimilar.

Turning next to the issue of the similarity or dissimilarity of the goods under the second *du Pont* factor, we note that both applicant and the Trademark Examining

Attorney rely on the following dictionary definition (in pertinent part) of "cytokine":

Any of numerous hormonelike, low-molecular-weight proteins, secreted by various cell types, that regulate the intensity and duration of immune response and mediate cell-cell communication. ... Cytokines are produced by macrophages, B and T lymphocytes, mast cells, endothelial cells, fibroblasts, and stromal cells of the spleen, thymus and bone marrow. They are involved in mediating immunity and allergy and in regulating the maturation, growth and responsiveness of particular cell populations, sometimes including the cells that produce them (autocrine activity). A given cytokine may be produced by more than one type of cell. Some cytokines enhance or inhibit the action of other cytokines. ... Cytokines have been implicated in the generation and recall of long-term memory and the focusing of attention. Some of the degenerative effects of aging may be due to a progressive loss of regulatory capacity by cytokines. Because cytokines derived from the immune system (immunokines) are cytotoxic, they have been used against certain types of cancer.

Stedman's Medical Dictionary (27th Edition 2000) at 452.

First, we note that the Trademark Examining Attorney has offered no evidence or argument demonstrating that applicant's Class 01 goods, "qualitative and quantitative assay products, namely, diagnostic reagents for scientific or research use in the field of food hygiene," are related to the goods identified in the cited registration. In view thereof, and given the dissimilarity of the marks, we find

that the Section 2(d) refusal as it pertains to applicant's Section 01 goods must be reversed.

As for the Section 2(d) refusal as it applies to applicant's Class 05 goods, we note that the Trademark Examining Attorney has submitted evidence, i.e., the website printouts from various companies, which, she argues, show the relatedness of applicant's Class 05 goods and registrant's Class 01 goods. However, we are not persuaded that this evidence establishes that the goods are related, for likelihood of confusion purposes. The goods, as identified in the application and registration, appear to be used in different settings for different purposes.

Even if the goods were to be considered to be related, we find that the marks are sufficiently dissimilar to avoid a finding of likelihood of confusion.

Moreover, we agree with applicant's contention that the purchasers of these goods, i.e., professionals in the scientific and medical fields, are technically sophisticated and careful purchasers of these types of goods, a fact which further reduces any likelihood of source confusion.

In summary, even if we assume that some relationship between registrant's goods and applicant's Class 05 goods

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exists,⁴ that fact is outweighed in this case by the overall dissimilarity of the marks, and the sophistication of the purchasers and the care with which purchases of these products would be made.

Decision: The Section 2(d) refusal is reversed.

⁴ Again, there is no evidence from which we might conclude that applicant's Class 01 goods are related to registrant's goods. See *supra* at pp. 7-8.