

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

4/23/02

Hearing:
March 13, 2002

Paper No. 14
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NycoMed Amersham PLC¹

Serial No. 75/527,785

Friedrich Kueffner for NycoMed Amersham PLC.

Marlene D. Bell, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Nycomed Amersham PLC has filed an application to
register the mark TOMOJET for "medical apparatus, namely,
devices for the administration of contrast media."²

¹ The application was originally filed by Spectrospin AG, which subsequently changed its name to Bruker AG. The application has since been assigned to NycoMed Amersham PLC and this assignment has been recorded by the Assignment Branch at reel 2378, frame 627. The caption of this proceeding reflects this assignment.

² Serial No. 75/527,785, filed July 30, 1998 under Section 44(e) of the Trademark Act based on German Registration No. 398 07 162, with a claim of priority under Section 44(d) of the Trademark Act based on a German application filed February 11, 1998.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of a likelihood of confusion with the mark TOMOSCAN, which is registered for "medical X-ray scanning systems for total body and head studies."³

The refusal has been appealed and applicant and the Examining Attorney have filed briefs.⁴ Both participated in the oral hearing.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*⁵ factors that are relevant in view of the evidence of record. Two key considerations in any *du Pont* analysis are the similarity or dissimilarity of the respective marks and the similarity

³ Registration No. 1,117,184, issued May 1, 1979, first renewal.

⁴ The Examining Attorney has requested in her brief that we consider the attached results of a search conducted on the X-Search database during the course of examination of the application. Although she states that the search results are part of the record, there is no evidence that the results as such were ever forwarded to the applicant for consideration. Thus, the Examining Attorney is in effect requesting us to take judicial notice of material which the applicant has never had the opportunity to review or respond to during the course of examination. While the Board will take judicial notice of dictionary definitions and other readily available reference works, we will not take judicial notice of applications or registrations which reside in the Office. See *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985). In line with this reasoning, we will not take judicial notice of the results of an X-search done by an Examining Attorney which is simply part of her work product and to which applicant has never had access.

⁵ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

or dissimilarity of the goods with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Insofar as the respective goods are concerned, applicant has conceded that a relationship exists between the two types of medical apparatus. Both are used in the field of tomography. In view of this relationship, we must assume that the goods would travel in the same channels of trade and would be available to the same class of purchasers. There are no limitations in the application or registrations which would imply otherwise. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Thus, the dispositive factor in our analysis must be the similarity or dissimilarity of the respective marks, TOMOJET and TOMOSCAN. The Examining Attorney takes the position that the common prefix TOMO- is the dominant feature of the marks. She argues that consumers are likely to believe that registrant has simply expanded its line of medical goods and, while retaining the distinctive element TOMO-, has attached a different term which is suggestive of

the different goods as a suffix. Thus, she asserts, while in TOMOSCAN, TOMO- would refer to tomography and -SCAN to a scanner, in the mark TOMOJET, the term TOMO- would again refer to tomography and -JET would be suggestive of devices for the injection of contrast media.

Applicant contends that the term TOMO- is not the distinctive element in the marks, but rather is weak because it is a portion of the word "tomography." Applicant points to the dictionary definition made of record by the Examining Attorney of the term "tomography"⁶ as evidence that the term is descriptive of the goods of both applicant and registrant. Applicant also refers to third-party registrations for marks containing the prefix TOMO-, although only two expired registrations are listed.

Applicant argues that the term -JET is not descriptive of applicant's goods because contrast media are not injected in the form of a jet, but instead are injected into patients very slowly through syringes. Applicant contends that it is the second portions of the marks which will be impressed upon the minds of purchasers. Applicant likens the situation here to that in Land-O-Nod Co. v.

⁶ The definition of "tomography" is "any of the several techniques for making detailed x-rays of a predetermined plane section of a solid object while blurring out the images of other planes." *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

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Paulison, 220 USPQ 61 (TTAB 1983), in which the Board found no likelihood of confusion when the marks CHIROPRACTIC and CHIROMATIC were used with mattresses, the Board taking into account the suggestiveness of the term CHIRO- for bedding designed to provide healthful support to the body.

While the involved marks must be considered in their entireties, it is not improper to consider that a portion of a mark (which is common to a corresponding portion of the other mark) may be weak in the sense that it is descriptive, highly suggestive or in such common use by others in the same field as to not have much source-distinguishing significance. See *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597 (TTAB 1982), *aff'd*, 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983). The mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). The addition of other matter to a merely descriptive or highly suggestive designation may result in the creation of a mark which may be readily distinguished from another composite mark containing this same descriptive or highly suggestive designation. See *Land-O-Nod Co. v. Paulison*, *supra*.

While applicant has failed to substantiate its claim of widespread third-party use of the prefix TOMO, we are convinced by the dictionary definition of the term "tomography" of the highly suggestive nature of the prefix TOMO- when used in connection with goods designed for use in the field of tomography. As such, we cannot agree with the Examining Attorney that the prefix TOMO- is the distinctive element of the respective marks.

Instead, in view of this highly suggestive nature of the prefix TOMO-, we find the addition of the suffixes -JET and -SCAN adequate to make the marks TOMOJET and TOMOSCAN distinguishable one from the other. The marks as a whole differ in appearance and sound. While the suffix -SCAN may have some suggestive significance with respect to the nature of goods with which it is being used, the suffix -JET has not been shown to have a similar significance. In fact, applicant strongly contests any suggestive connotation for the suffix, as applied to its goods. Certainly, no similar pattern in the derivation of the two suffixes is readily apparent. The commercial impressions created by the two marks are different.

Accordingly, we find that there is no likelihood of confusion from the contemporaneous use of the marks TOMOJET and TOMOSCAN in connection with, respectively, devices for

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the administration of contrast media and medical X-ray scanning systems for total body and head studies.

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

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