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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In Merck KGaA

Serial No. 76354586

H. John Campaign of Graham, Campaign P.C. for Merck KGaA

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Before Holtzman, Zervas and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Merck KGaA, applicant, has filed an application to register the mark EMD LEXIGEN (standard character form) for "pharmaceutical and biopharmaceutical products for the treatment of cancer, MDS, genetic disorders and immunological disorders; novel protein drugs for use in the area of oncology, immune therapies and for the treatment of metabolic disorders" in International Class 5 and "scientific research and development in the area of pharmacy, medicine, biology and genetics, developing treatments for serious and life-threatening diseases as

well as broad technology platforms that will lead to new therapies" in International Class 42.¹

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods and services, so resembles the registered marks LEXGEN.COM (in standard character form) for "providing an online computer database in the field of genetic research" in International Class 42² and LEXGEN (in standard character form) 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 publications, 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 network; collaborative research and development services in the

¹ Application Serial No. 76354586 filed December 27, 2001. The application was originally filed under Section 1(b) and Section 44 of the Trademark Act. 15 U.S.C. §§1051(b) and 1126. On October 28, 2002, applicant deleted the Section 1(b) claim and the application proceeded under Section 44(d) and (e).

² Registration No. 2570600, issued May 21, 2002 to Lexicon Genetics Inc.

field of molecular biology and genetics" in International Class 42.³

When the refusal was made final, applicant appealed and filed a request for reconsideration. After the examining attorney denied the request for reconsideration, the appeal was resumed. The appeal is fully briefed. No oral hearing was requested. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., 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).

³ Registration No. 2689750, issued February 25, 2003 to Lexicon Genetics Inc.

We first consider whether applicant's mark and registrant's marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first du Pont factor, 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 overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, the meaning or connotation of a mark must be determined in relationship to the named goods or

services. See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987).

LEXIGEN and LEXGEN, differ only by the addition of the "I" in applicant's mark. While applicant argues that the pronunciation is different because the term LEXIGEN in its mark consists of three syllables in comparison to LEXGEN in registrant's marks which consist of only two syllables, the examining attorney argues that "the addition of the letter 'I' between LEX and GEN does not make the marks sufficiently different in that the letter 'I' actually has a soft sound in the word LEXIGEN" and the "visual and aural difference in the basic words LEXGEN and LEXIGEN is negligible." Br. unnumbered p. 5. We agree with the examining attorney that the 'I' in applicant's mark is a negligible difference. This highly similar element comprises the entirety of registrant's mark in Registration No. 2689750 and the dominant portion of registrant's mark in Registration No. 2570600. The .COM in registrant's mark used in connection with the recited online computer database services would be perceived as a top level domain (TLD) indicator and thus has no meaningful source identifying significance. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); and *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002). In

this regard, we take judicial notice of the following definition of the term TLD:⁴

"(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the generic top-level domains, such as .com, .org, and .net and the country codes, such as .ca, .uk and .jp."

McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001).

With regard to applicant's argument that the GEN part of the marks is weak, applicant has submitted no evidence to support that argument. Applicant's mere reference in its brief that "thirty seven registered or applied-for marks for use in connection with genetic research contain the GEN component" (br. p. 13) is unsupported by any copies of the registrations and has no probative value. In addition, applications serve only as evidence that the applications were filed. In re Phillips Van Heusen Corp., 63 USPQ2d 1047 (TTAB 2002). Moreover, GEN is not the only point of similarity in the marks; rather, it is the combination of the identical beginning, LEX, and ending, GEN, that creates a similarity between the marks.

⁴ 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) (Board may take judicial notice of dictionary definitions).

While the appearance of applicant's mark is slightly different from the mark in the registrations due to the presence of the letters "EMD" in applicant's mark and the .COM in one of registrant's marks, we do not find these differences sufficient to distinguish the marks. As noted above, the .COM in registrant's mark has no meaningful source identifying significance. Further, we do not find that the addition of the lettering EMD obviates the similarity of the marks such that confusion would not be likely. Applicant's argument that EMD is its house mark and thus would serve to distinguish the marks is not well taken.⁵ However, even if we consider EMD to be a house mark, generally, likelihood of confusion is not avoided by the addition of a house mark to an otherwise confusingly similar mark. "It is the general rule that the addition of extra matter such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them." In re Dennison Mfg. Co., 229 USPQ 141, 146 (TTAB 1986), citing Menendez v. Holt, 128 U.S. 514, 521 (1888). In certain circumstances, a house mark may make a sufficient

⁵ We further note that the exhibits attached to applicant's reply brief consisting of material not previously made of record are untimely and have not been considered. See Trademark Rule 2.142(d) (record in application should be complete prior to filing an appeal).

distinction if the marks in their entireties convey significantly different commercial impressions or the similar element is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or weak. See *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (CCPA 1967). Here, LEXIGEN and LEXGEN present a similar commercial impression, and there is no evidence of record to suggest that they are weak terms. We are also not persuaded by applicant's argument that the lettering EMD dominates over the term LEXIGEN in its mark. The applied-for mark is in standard character form, therefore, in actual use EMD could appear in smaller letters than LEXIGEN.

Further, as to connotation, we analyze the connotation of the mark in relationship to the named goods. See *In re Sears*, supra. There is nothing in the record to point to a specific connotation for any of the marks, however, given their similarity in appearance both beginning with LEX and ending with GEN they would likely evoke a similar connotation. Applicant's argument that the derivation of registrant's marks stems from registrant's name Lexicon Genetics Inc. is speculation and, in any event, such derivation would be lost on consumers when LEXGEN is seen without Lexicon Genetics as we must presume given that the

registered marks do not include Lexicon Genetics. The same holds true for applicant's mark in that the application is for EMD LEXIGEN without reference to Lexigen Pharmaceuticals Corporation, the company acquired by applicant.

In view of the above, we find that the points of similarity between applicant's mark EMD LEXIGEN, and registrant's marks LEXGEN and LEXGEN.COM outweigh the dissimilarities. Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

We turn now to a consideration of the goods and services identified in the application and the cited registrations. It is well settled that goods or services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods or services themselves, but rather whether purchasers are likely to confuse the source of the goods or services. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's services as they are described in the registrations and without limitations that are not reflected therein. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002);

and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registrations describe goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods or services, and that they are available to all classes of purchasers for the described goods or services. See In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992).

The examining attorney argues that "The applicant and registrant both use their marks in association with research and development services in the field of biology and genetics. In addition to these identical services the applicant and registrant use their respective marks on other related goods and services. The applicant uses its mark on goods which are a product of biology and genetic research and development. The registrant uses its mark on services of providing databases, information and publications featuring biology and genetic research and development." Br. unnumbered p. 7.

In support of her position that applicant's pharmaceuticals and scientific research services, and

registrant's online database and research services are related, the examining attorney has submitted excerpts from their respective websites. See, for example, registrant's website www.lexicon-genetics.com stating that:

Lexicon Genetics Incorporated today announced the launch of Lexgen.com, a genomics Internet exchange which contains a substantial portion of Lexicon's OmniBank® gene sequence database and library of 60,000 knockout mouse clones for use in determining the function of genes. Through Lexgen.com, researchers at pharmaceutical and biotechnology companies and academic institutions throughout the world will be able to conduct Web-based bioinformatics mining of genes at no charge...The advent of genomics and upcoming completion of the Human Genome Project represent an opportunity for the development of drugs that are more effective and have fewer side effects...Lexicon Genetics is focused on the discovery of breakthrough treatments for human disease...We are working both independently and through strategic collaborations and alliances to accelerate the development and commercialization of our discoveries.

See also applicant's website www.emdlexigen.com

stating that:

We are a research-driven company focused on developing new generations of therapies for cancer and other serious and life-threatening diseases.

As identified in the application, applicant's scientific research and development services in the area of biology and genetics encompass registrant's collaborative research and development services in the field of molecular biology and genetics in Registration No. 2689750. In

addition, registrant's research services are related to applicant's pharmaceuticals inasmuch as they are the types of goods that emanate from registrant's services. Further, applicant's pharmaceuticals and scientific research services in the area of genetics are related to registrant's online database in the field of genetic research in Registration No. 2570600 because pharmaceuticals and genetics are the subject matter of registrant's database.

Thus, the similarity of the goods and services weighs in favor of a finding of likelihood of confusion.

The identification of goods and services in the application does not limit the channels of trade in any way. We must presume they travel in the channels of trade ordinary for these goods and services. Therefore, the applicant's and registrant's channels of trade, including registrant's services specifically identified as being provided online, overlap.

With regard to the class of potential customers, the examining attorney argues that "applicant's and registrant's goods and services are provided to or are of interest to the same class of customer, i.e., those interested in genetic research and in the development of new drugs and drug therapy platforms." Br. unnumbered p.

8. The examining attorney supports her position by again pointing to the excerpts from applicant's and registrant's websites made of record. While the identification of goods and services may not be restricted by extrinsic evidence, In re Bercut-Vandervoort & Co., 229 USPQ 763 (TTAB 1986), this evidence simply confirms what is apparent from the identifications and is not disputed by applicant.

This evidence also underscores applicant's argument that the overlapping consumers are sophisticated and would exercise great care in purchasing the respective goods and services. Specifically, applicant argues that "It is hard to imagine that scientists, doctors, researchers or chemists would exercise anything less than a high degree of care and caution when purchasing such different goods or services as pharmaceutical and biopharmaceutical products for the treatment of cancer, MDS, genetic disorders...Clearly, the respective purchasers of applicant's goods and services and registrant's services, under the normally prevalent conditions of the marketplace for such goods and services, exercise a high degree of care and knowledge in the selection of a particular product for the treatment of cancer, MDS, genetic disorders and immunological disorders, or genetic database." Br. p. 17.

The examining attorney, citing *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988), argues that even if the overlapping consumers are sophisticated, confusion may occur because sophistication in and knowledge of a particular field does not automatically mean they are immune from source confusion and further there is no evidence of record to suggest otherwise. We find that based on the identification of goods and services potential purchasers would exercise a high degree of care and would necessarily have some sophistication in the fields of biology and genetics. Thus, this factor weighs against a finding of likelihood of confusion.

However, despite the possible sophistication of potential purchasers of the respective goods and services, we find that because the marks are similar, the goods and services are legally identical in part and otherwise closely related, and the channels of trade are the same or overlapping, confusion is likely between applicant's mark and the cited registrations. Finally, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

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Decision: The refusal to register applied to both International Classes in the application under Section 2(d) is affirmed as to both registrations.