

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:
Human Genome Sciences, Inc.

Appl. No.: 75/792,421

Filed: September 3, 1999

Mark: **FAS TR**

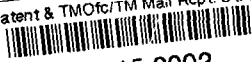
Examining Attorney: Marlene D. Bell

Law Office: 105

Atty. Docket: 1488.1350000/TGD/KNR

**Applicant's Ex Parte Appeal Brief
in Support of Registration of its Trademark Application**

U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57



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I. INTRODUCTION

Applicant has appealed the Examining Attorney's final refusal of Application Serial No. 75/792,421. The Examiner's refusal is based on the allegation that Applicant's mark FAS TR is likely to cause confusion with Registration Nos. 1,991,859 and 2,010,660, both for the mark FASTRNA. Applicant submits that the Examining attorney has refused registration of its mark in error, and respectfully requests that the Board reverse the refusal.

II. STATEMENT OF RELEVANT FACTS

Pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), Applicant, Human Genome Sciences, Inc., filed a trademark application on September 3, 1999 for the mark FAS TR for use in connection with "proteins and/or nucleic acids and pharmaceutical preparations containing proteins and/or nucleic acids."

On January 3, 2000, the Examiner issued a refusal of the mark based on Section 2(d) of the Trademark Act, alleging that the applied for mark was likely to cause confusion with Registration Nos. 1,991,859 and 2,010,660 owned by BIO 101 for the mark FASTRNA, for use with "diagnostic and process reagent kits and components for rapid isolation and purification of nucleic acid for scientific or research use" and "medical diagnostic and process reagent kits and components for rapid isolation and purification of nucleic acid for laboratory use." In that action, the Examiner also

required amendment of the identification of goods and requested that Applicant submit information regarding the significance of the mark FAS TR.

On June 30, 2000, Applicant filed a Response to the Office Action, arguing against the likelihood of confusion refusal, amending the identification of goods, explaining the lack of significance of the mark and forwarding payment of an additional class fee. On June 18, 2001, the Examiner made a final refusal of the mark based on likelihood of confusion. The Examiner also maintained that the identification of goods was unacceptable. On December 18, 2001, Applicant filed a Notice of Appeal along with a Request for Reconsideration of the likelihood of confusion refusal. Applicant also submitted an amendment to the identification of goods. The Examiner denied the Request for Reconsideration as to the likelihood of confusion refusal. However, the Examiner gave no indication as to whether Applicant's amendment to the identification of goods was acceptable. The Applicant therefore assumes that the Examiner had no objections to the amendment, and that the identification of goods has been accepted.

Therefore, the only issue on appeal is whether the mark FAS TR, for use in connection with "genetically engineered reagents for scientific and research use, namely, nucleic acids and proteins for use in diagnosis and development of pharmaceutical preparations for the treatment of diseases; and pharmaceutical preparations containing proteins and nucleic acids for the treatment of diseases" is confusingly similar to the mark FASTRNA for diagnostic kits.

III. ARGUMENT

A. Similarity of the Marks

In determining likelihood of confusion between marks, one must consider the principal factors set out in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Among these factors are (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, meaning and commercial impression; (2) the strength of the marks as evidenced by the number and nature of similar marks in use on similar goods; and (3) the similarity or dissimilarity of the goods. *Id.* Not all the factors set forth in *DuPont* must be considered in the determination. In fact, one factor by itself may be dispositive of the issue of confusion, especially if that one factor is the similarity/dissimilarity of the marks. *Champagne Louis Roederer v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998), *see also Keebler Co. v. Murray Bakery*, 866 F.2d 1386, 1388, 9 USPQ2d (BNA) 1739 (Fed. Cir. 1989). Applicant submits that the subject marks are so dissimilar in appearance, sound, meaning and commercial impression that confusion is unlikely based on this factor alone.

1. The subject marks are not similar in sound, appearance or meaning and generate very different commercial impressions.

In addressing the similarity of the marks in both the initial and final Office Actions, the Examiner stated that the marks share the letter string "FASTR." The Examiner further alleged that Applicant merely "omitted the last two letters in the Registrant's mark, specifically the letters "NA" and then inserted a space between the letters "S" and "T" to create its mark. However, the mere fact that two marks contain similar elements does not alone render them confusingly similar.

The addition and deletion of portions of marks and the distinctions in the overall appearance and commercial impression created by the marks must also be considered. The deletion of letters (and addition of spaces) may suffice to distinguish marks such that confusion is not likely. For example, in *Kellogg Company v. Pack'Em Enterprises, Inc.*, the Federal Circuit upheld the Board's decision that the marks FROOTEE ICE for "flavored liquid frozen into bars" and FROOT LOOPS for "dessert sundaes, shakes and frozen confections" were not confusingly similar, stating that "the only similarity between the marks is that one begins with FROOT and the other begins with FROOTEE," 951 F.2d 330 (Fed. Cir. 1991). The Court further upheld the Board's decision that this single factor was dispositive of the issue of likelihood of confusion. *Id.* Hence, without even considering the similarity of the goods, the Board held that the marks were so dissimilar as to make confusion unlikely, despite the fact that they shared the letter string "FROOT." *See also Delicato*

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