Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Vibrynt, Inc.

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Serial No. 77701760

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Jill M. Pietrini and Paul A. Bost of Manatt, Phelps & Phillips for Vibrynt, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

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Before Quinn, Bergsman and Shaw,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Vibrynt, Inc. filed, on March 29, 2009, an intent-to-use application to register the mark PREVAIL (in standard characters) for "medical devices, namely, abdominal implants and delivery systems therefor" in International Class 10.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark PEEK PREVAIL (in

standard characters) for "surgical implants comprising artificial material" in International Class 10[1] as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, and both appeared at an oral hearing.

Applicant argues that the marks are distinguishable; that the goods are not related and move in different trade channels to different customers; that the purchase of the respective goods requires care and sophistication; and that the cited mark is weak due to third-party use. In support of its arguments, applicant introduced nine declarations of physicians (seven abdominal surgeons and two orthopedic surgeons), a Wikipedia entry, excerpts of third-party websites, an excerpt from a printed publication,[2] and copies of third-party registrations and applications.

The examining attorney maintains that the marks are similar, with the term PREVAIL dominating over the term PEEK. The examining attorney is not persuaded by applicant's evidence of third-party uses and registrations of "PREVAIL." With

[1] Registration No. 3616753, issued May 5, 2009.

[2] An additional article from a printed publication was attached to the reply brief. The examining attorney objected to this evidence (but did not object to a second article because it was not previously available); the Board, in an order dated April 14, 2011, sustained the objection, indicating that the objected-to article (identified by applicant as Exhibit B to its reply brief) does not form part of the record on appeal.

respect to the goods, the examining attorney states that, as they are described in the application and cited registration, the goods are presumed to be identical. The examining attorney does not dispute that the conditions under which the goods are purchased suggest care and sophistication, but goes on to argue that even sophisticated purchasers are not immune from source confusion.

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). In any likelihood of confusion analysis, however, 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).

We first focus our consideration on the *du Pont* factor of the similarity/dissimilarity between the marks. We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1960 (Fed. Cir. 2005), *quoting In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. 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.

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. *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 a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.").

Applicant and the examining attorney have a difference of opinion over which portion is the dominant portion of registrant's mark, with applicant contending that PEEK is dominant, while the examining attorney contends that PREVAIL is dominant. Of significant importance, of course, is the role of PEEK in registrant's mark. Throughout all of the prosecution of the application, neither applicant nor the examining attorney attributed any meaning to PEEK as applied to registrant's goods. It was not until applicant filed its request for reconsideration

that the issue of the descriptiveness of the acronym "PEEK" was first raised. In that request, applicant asserted as follows:

> In the medical community, the term "PEEK" is a term of art referring to the organic thermoplastic "polyether ether-ketone." Polyether ether-ketone is a biomaterial frequently used in medical implants that, due to its organic composition, is easily accepted by the body and is resistant to wear. In particular, PEEK is used with orthopedic implants because it is highly biocompatible to the body and the body will not attempt to attack the orthopedic device as if it is an infection.
> (Request for Reconsideration, July 12, 2010, pp. 3-4).

In support of this argument, applicant submitted an excerpt of Wikipedia showing that thermoplastic polyether ether-ketone, referred to as "PEEK," assists the body to build up fibrous tissue to protect an orthopedic implant (such as used in hip replacements) from being attacked by the body. Applicant also submitted the declarations of two orthopedic surgeons who attested to similar facts.

Irrespective of any meaning of the letters PEEK as an acronym for "poly ether-ketone," we find that registrant's mark, PEEK PREVAIL, when considered in its entirety, is similar to applicant's mark PREVAIL. We recognize that the PEEK portion of registrant's mark is the first portion, and that the first portion of a mark is the one most likely to be remembered by purchasers. *See, e.g., Presto Prods., Inc. v. Nice-Pak Prods.,*

Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). However, the evidence suggests that the first portion may have some descriptive significance or connotation, thereby diminishing its distinctiveness. In any event, registrant's mark includes PREVAIL, which is identical to the entirety of applicant's mark. Given the commonality of this term in both marks, the marks are similar in sound and appearance. As to meaning, the presence of PEEK in registrant's mark may give the overall mark a more specific meaning relative to the medical field;[3] however, both marks suggest that the respective goods will assist a patient in prevailing over a medical infirmity. These similarities between the marks PEEK PREVAIL and PREVAIL engender overall commercial impressions that are similar. Any difference in meaning is outweighed by the similarities between the marks.

The overall similarity between the marks in their entireties is a factor that weighs in favor of a finding of likelihood of confusion.

In an attempt to diminish the distinctiveness of the cited registration, applicant introduced evidence of five third-party registrations,[4] five common law uses, eight business names and

[3] This presence, however, cannot be used to limit registrant's goods when such limitation is not also reflected in the identification set forth in the cited registration.

[4] The third-party applications have no probative value. Third-party applications are evidence only of the fact that they have been filed. *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

one website, all involving PREVAIL for medical or healthcare goods and/or services. We initially point out that none of the uses or registrations specifically covers surgical implants, namely the specific type of goods involved in this appeal.

With respect to the third-party registrations, "[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Insofar as the evidence of actual use is concerned, we focus on a critical infirmity in applicant's evidence, namely the absence of any information regarding the extent of use of PREVAIL by third parties. That is to say, there is no way to gauge what effect, if any, these uses may have had in the minds of consumers. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 73 USPQ2d at 1693-94 (third-party use was not "so widespread as to 'condition' the consuming public"); *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1110 (TTAB 2007); and *Fort James Operating Co. v.*

Royal Paper Converting Inc., 83 USPQ2d 1624, 1629 (TTAB 2007). Thus, in the absence of evidence to corroborate the extent of the third-party uses, this evidence is entitled to only minimal probative value.

In sum, the evidence of third-party registrations and uses, while considered, is of only minimal value. At bottom, we find this factor to be neutral in our analysis.

We next turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the goods. It is well settled that the goods of the parties need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as

to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

As explained by the examining attorney, applicant's notion that registrant's goods are limited to orthopedic implants is ill founded. To the contrary, the issue of likelihood of confusion in Board proceedings is determined on the basis of the goods as they are identified in the application and the cited registration, no matter what the goods may actually be in nature. Thus, where the goods in an involved registration and/or application are broadly identified as to their nature and type such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers (as in the case of registrant's "surgical implants comprising artificial material"), it is presumed that in scope the identification of goods encompasses all the goods of the nature and type described therein, that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Registrant's identification of goods reading "surgical implants comprising artificial material" is broadly worded, not

indicating any specific type of surgery. Because registrant's identification does not limit the type of surgical implants, the identification must be broadly construed to include all types of such goods, including abdominal surgical implants comprising artificial material.

To reiterate, registrant's goods are not limited to the orthopedic field. This is a critical fact for the comparison between the goods for purposes of our likelihood of confusion analysis that must be based on the identifications of goods as identified in the respective application and cited registration.

> It is improper to decide the issue of likelihood of confusion based upon a comparison of applicant's actual goods with registrant's actual goods. If registrant's goods are broadly described in its registration so as to include types of goods which are similar to applicant's goods, then an applicant in an ex parte case cannot properly argue that, in point of fact, registrant actually uses its mark on a far more limited range of goods which range does not include goods which are similar to applicant's goods.

In re Trackmobile, Inc., 15 USPQ2d 1152, 1153 (TTAB 1990).

Insofar as the trade channels and classes of purchasers are concerned, we note that there are no limitations in either applicant's or registrant's identification of goods. Accordingly, we must presume that the implants, as identified, are marketed in all normal trade channels for such goods and to all normal classes of purchasers for such goods. *In re Elbaum*,

211 USPQ 639 (TTAB 1981). Because the implants are used in surgical procedures, we presume that the implants move through the same or similar trade channels, as for example surgical supply distributors, and are sold to the same classes of purchasers, namely surgeons and other medical professionals, such as hospital purchasing agents.

We do not intend to belabor the point, but because applicant expended so much effort in trying to distinguish the goods based on extrinsic evidence, we are compelled to specifically respond.

The record includes seven identically worded declarations (varying only in terms of the years of experience of the declarant) of abdominal surgeons, all of whom do bariatric surgery. The field of bariatrics is directed to reducing the ability of patients to overeat and to force weight loss. Bariatric surgery includes reducing the size of the patient's stomach by removing part of the stomach, bypassing part of the digestive system, and more recently by the insertion of medical implants (such as applicant's) to reduce the size of the patient's stomach or to create a feeling of fullness for the patient to stop the desire to eat. These physicians distinguish their practice from that of orthopedic surgery that is directed to the repair or enhancement of bones, joints, and vertebrae in

a patient's body. The declarants state, in pertinent part, the following:

> I am involved in the selection and purchase of the brands and types of abdominal implants used in bariatric surgery and the procedures related thereto. Abdominal implants and their associated set of surgical instruments are expensive medical devices, selling in the range of about $100 to $5,500. The final cost is typically the result of negotiations between myself, insurance provider, and/or hospital administrator, and the vendor. When I select and purchase or recommend the purchase of abdominal implants and related surgical instruments, I undergo an extensive and critical determination of the implants and instruments, the makers of the implants and instruments, and the clinical data supporting the safety and effectiveness of the implants and instruments...The sales cycle (that is, the duration of time between first being contacted by a vendor and finalizing a purchase) for abdominal implants and delivery instruments is often months.
>
> [O]rthopedic implants are wholly unrelated to abdominal implants for bariatrics...Orthopedic surgery [is a] distinct physician specialty which [does] not involve the same critical evaluation and decision making steps involved in the selection of abdominal implants for bariatric procedures.

Also of record are two identically worded declarations of orthopedic surgeons (with seven and nine years of experience, respectively). These declarations track the other ones, to the extent that the doctors draw significant distinctions between orthopedic implants and abdominal implants, and that the

purchase and use of orthopedic implants involve a sophisticated decision that is often three months or more. The doctors further state, in relevant part, the following:

> In the orthopedic community, the term "PEEK" is a term of art referring to the organic thermoplastic "polyether ether ketone." Polyether ether ketone is a biomaterial frequently used with orthopedic implants that, due to its organic composition, is easily accepted by the body and is resistant to wear. PEEK is particularly useful with orthopedic implants because it is highly biocompatible to the body and the body will not attempt to attack the orthopedic device as if it is an infection. PEEK allows the body to build up fibrous tissue to protect the orthopedic device from being attacked by the body...when I encounter the word PEEK in my medical specialty, I understand it to refer to, and be used with, orthopedic devices and implants.
>
> Orthopedic implants and their associated set of surgical instruments are expensive devices, selling in the range of approximately $100 to $100,000.

Registrant's goods are identified as "surgical implants comprising artificial material." As indicated by the examining attorney, this exact identification is set forth as an acceptable identification of goods in the Acceptable Identification of Goods and Services Manual ("ID MANUAL"). Applicant's arguments regarding registrant's specific goods and function, that is, that registrant's surgical implants are for orthopedic applications, must fail because an applicant may not restrict the scope of goods in an otherwise unrestricted

registration by argument or extrinsic evidence. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). In that regard, applicant's reliance on *In re Trackmobile Inc.*, 15 USPQ2d at 1153, is misplaced. In that case, the Board reiterated the well-established rule of law that "the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. It is improper to decide the issue of likelihood of confusion based upon a comparison of applicant's actual goods with registrant's actual goods." *Id.* The Board went on to state that "when the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper simply to consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing the description of goods has a specific meaning to members of the trade." *Id.* at 1154. *Trackmobile* stands for the proposition that when the nature of the goods is unclear (e.g., mobile railcar movers v. light railway motor tractors), extrinsic evidence may be used to demonstrate what a specific term means in an industry to understand whether or not one is encompassed by the other. Unlike the situation in *Trackmobile*, the nature of registrant's goods, as described in the registration's identification, is clear. The absence of the specific type of surgery for which registrant's implants are

used does not present a vacuum; it simply provides for broader protection. That is, there is nothing unclear in registrant's identification; rather, applicant is merely attempting, under the guise of providing clarity, to limit the scope of registrant's identification of goods and, thereby, the reach of the cited registration.

The similarity between the goods, channels of trade and classes of purchasers weigh in favor of a finding of a likelihood of confusion.

Insofar as the relevant purchasers are concerned, we readily acknowledge that purchasers of surgical/abdominal implants, whether physicians, hospital purchasing agents, or some other professionals involved in the purchasing decision, are likely to be very careful in making their decision after some research and discussion. This condition of sale is reflected in the declarations of the surgeons. However, even accepting that these medical professionals are sophisticated when it comes to buying surgical products, such as implants for procedures, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and related goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA

1970) ["Human memories even of discriminating purchasers...are not infallible."]. *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Nevertheless, we find that the care and sophistication of medical professionals in their purchase of surgical/abdominal implants weigh in favor of a finding of no likelihood of confusion. *See, e.g., Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399 (TTAB 2010).

In sum, the similarities between the marks and the goods, as well as the presumptions that the goods move in the same trade channels and are sold to the same classes of purchasers, weigh in favor of a finding of a likelihood of confusion; the sophistication of purchasers weighs against a likelihood of confusion. As we have explained above, the principal problem with applicant's case, as is obvious from its attempt to restrict the identification of goods in the cited registration, is registrant's broadly worded identification which, at least for purposes of our Section 2(d) analysis, forms the basis of the comparison of the goods. We find that the similarities between the marks and the goods sold thereunder outweigh any sophisticated purchasing decision. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks

outweigh sophisticated purchasers, careful purchasing decision, and expensive goods].

We conclude that purchasers familiar with registrant's "surgical implants comprising artificial material" sold under the mark PEEK PREVAIL would be likely to mistakenly believe, upon encountering applicant's similar mark PREVAIL for "medical devices, namely, abdominal implants and delivery systems therefor," that the goods originated from or are associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.