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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79139080

MARK: JOY



CORRESPONDENT ADDRESS:

MARIE-ANNE MASTROVITO

ABELMAN FRAYNE & SCHWAB

666 THIRD AVENUE

NEW YORK, NY 10017

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: Siemens Medical Instruments Pte. Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

MAMastrovito@lawabel.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 4/2/2015

INTERNATIONAL REGISTRATION NO. 1183243

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated August 28, 2014 is maintained and

continues to be final: Trademark Act Section 2(d) Likelihood of Confusion Refusal. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

FINAL SECTION 2(d) REFUSAL CONTINUED AND MAINTAINED

Registration of the applied-for mark remains refused because of a likelihood of confusion with the marks in U.S. Registration Nos. **4081775** and **4232061**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the previously enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of the Marks

Applicant's mark is JOY in standard character form, owned by Siemens Medical Instruments. The registered marks are MEDIJOY and MEDJOY in standard character form, owned by Kabushiki Kaisha Top.

As stated in the previous Office actions, the marks are confusingly similar because they feature the word JOY as the dominant portion of the mark. Applicant contends that the marks look and sound different and have different commercial impressions. However, the difference between the marks is merely descriptive wording. The word JOY is the only element in the applied-for mark. The registered marks merely add the descriptive terms MEDI and MED, commonly known acronyms referencing the medical industry. See attached definitions. Thus, these terms are less significant in terms of affecting the mark's commercial impression, and renders the word JOY the more dominant element of the marks.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

Therefore, the marks are confusingly similar.

Comparison of the Goods

Applicant's goods are "medical hearing aids" in International Class 10. Registrant's goods are "hearing aids for the deaf" in International Class 10.

Applicant's and registrant's goods are related for the following reasons.

In addition to the evidence provided in the previous Office actions, applicant will note the attached Internet evidence consisting of third party websites. This evidence establishes that the same entity commonly manufactures medical hearing aids and hearing aids for the deaf and markets the goods under the same mark. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In*

re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). Specifically, the attached evidence includes:

- Starkey website featuring medical hearing aids for the deaf: <http://www.starkey.com>
- Widex website featuring medical hearing aids for the deaf: <http://www.widexusa.com>
- Siemens website featuring medical hearing aids for the deaf: <http://www.siemens.com>
- Audibel website featuring medical hearing aids for the deaf: <http://www.audibel.com>

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Moreover, the trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a representative sample of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, medical hearing aids and hearing aids for the deaf, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Applicant contends that there is no evidence of use of the marks MEDJOY and MEDIJOY by the registrant. However, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv).

Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Thus, upon encountering applicant's and registrant's marks used on the identified goods, consumers are likely to be confused and mistakenly believe that the respective goods emanate from a common source.

Accordingly, registration of the applied-for mark remains refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4081775 and 4232061. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Joanna E. H. Fiorelli/

Trademark Examining Attorney

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Rank	Abbr.	Meaning	
	MED	Medical	
	MED	Media	
	MED	Master of Education	
	MED	Ministry of Economic Development	
	MED	Medium	
	MED	Mediterranean Region	
	Med	Median (linguistics)	
	MED	Mediterranean Sea	
	MED	Median	
	MED	Middle English Dictionary	
	MED	Male Erectile Dysfunction	
	MED	Minimum Effective Dose	
	MED	Marine Equipment Directive (EU, also seen as MarED)	
	MED	Mise en Demeure (French legal term for registered letter demanding payment of a debt or other corrective measures)	
	MED	Marine Emergency Duties (Canada)	
	MED	Multiple Epiphyseal Dysplasia	
	MED	Minimal Effective Dose	

MED	Multiple Exit Discriminator (BGP)	
MFD	Manhattan Engineer District (Manhattan Project)	
MED	Micro-Enterprise Development	
MED	Mid-continent Ecology Division (US EPA)	
MED	Minimal Erythemat Dose	
MED	Multi Effect Distillation (desalination units)	
MED	Mystery of Edin Drood (musical)	
MED	Mobile and Embedded Devices (Microsoft)	
MED	Manufacturing Engineering Division (American Society of Mechanical Engineers)	
MED	Mean Effective Dose	
MED	Main Entry Door (aircraft cabin)	
MED	Marine Engine Driver	
MED	Minimum Euclidean Distance	
MED	Mobile Emergency Department	
MED	Medinah, Saudi Arabia - Madinah-Prince Mohammad Bin Abdulaziz (Airport Code)	
MED	Molecular Electronic Device	
MED	Maison de l'Economie Développement	
MED	Median Edge Detector	

MED	Medical Edge University	
MED	Manipulative Electronic Deception	
MED	Multiple Element Damage	
MED	Mad Elk Disease	
MED	Medical Electronics and Device Technology Center (Taiwan, ROC; part of Industrial Technology Research Institute)	
MED	Multi-Expansion Descriptor (Cisco)	
MED	Multiplexer Entry Descriptor	
MED	Momentum Exchange Device	
MED	Message Element Dictionary	
MED	Maintenance Electrical Department	
MED	Maritime Exercise Directive	
MED	Maintenance Engineering Directive	
MED	Microwave Evaporation and Drying	
MED	Mobile Energy Depot	
MED	Mu Epsilon Delta (student organization)	
MED	Minority Enterprise Development	
MED	Multicultural Education Department (various locations)	
MED	Middle East Department (International Monetary Fund)	

MED	Middle Eastern Dance	
MED	Medical Payments	
MED	Macmillan Essential Dictionary	

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