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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86081312

MARK: SURGICAL SPECIALTIES



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Surgical Specialties Corporation (US), I ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

110129.20579

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the trademark SURGICAL SPECIALTIES in standard character form. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that the applicant's mark, when

used in connection with the identified goods, so resembles the marks shown in U.S. Registration Nos. 3869465, 3980038, 3988543, 3988544, 3988545, and 4004998 as to be likely to cause confusion, to cause mistake, or to deceive. Registration was also refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the grounds that the mark is merely descriptive of the identified goods. Finally, registration was refused on the Principal Register under Trademark Act Section 2(f) on the grounds that the evidence provided by the applicant was insufficient to establish that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods. See TMEP §1212.05(a).

FACTS

On October 2, 2013, applicant Surgical Specialties Corporation (US), Inc.. filed an intent-to-use trademark application seeking registration on the Principal Register of the mark SURGICAL SPECIALTIES in standard character form for “medical devices.” In an Office Action mailed October 30, 2013, the examining attorney refused registration under Trademark Act Section 2(d) on the grounds that the applicant’s mark, when used in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 3869465, 3980038, 3988543, 3988544, 3988545, and 4004998 as to be likely to cause confusion, to cause mistake, or to deceive. Registration was also refused on the Principal Register under Trademark Act Section 2(e)(1) on the grounds that the mark is merely descriptive of the identified goods. Finally, the examining attorney required that the applicant amend the identification of goods.

On April 30, 2014, the applicant responded and argued against the refusals under Section 2(d) and Section 2(e)(1), amended the identification of goods, and submitted a disclaimer of the wording SURGICAL apart from the mark as shown. On May 20, 2014, the examining issued a Final Office Action.

The examining attorney made final the refusals under Section 2(d) and Section 2(e)(1) and stated that the identification of goods requirement had been satisfied.

On October 30, 2014, the applicant submitted an amendment to allege use, which was accepted by the examining attorney on October 31, 2014. On November 6, 2014, the applicant filed a Request for Reconsideration in which the applicant submitted a claim of acquired distinctiveness under Trademark Act Section 2(f). The applicant also noted the instant appeal. The examining attorney then issued a non-final Office Action on November 14, 2014. The examining attorney maintained the refusals under Section 2(d) and Section 2(e)(1) and required that the applicant submit additional evidence showing that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods.

On May 12, 2015, the applicant responded and argued against the requirement that the applicant submit additional evidence to show that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods. The applicant also argued against the refusal under Section 2(d). On May 18, 2015, the examining attorney issued a subsequent Final Office Action. The examining attorney made final the refusals under Section 2(d) and Section 2(e)(1) and also made final the requirement that the applicant submit additional evidence showing that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods.

The proceedings with the Board were resumed on June 12, 2015. The applicant filed its appeal brief on August 11, 2015. The file was forwarded to the examining attorney for statement on August 20, 2015.

ISSUES

- (1) Whether the applicant's mark, when used in connection with the identified goods, so resembles the marks shown in U.S. Registration Nos. 3869465, 3980038, 3988543, 3988544, 3988545, and 4004998 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).
- (2) Whether the mark SURGICAL SPECIALTIES, when used in connection with the applicant's goods, is merely descriptive of those goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*
- (3) Whether the applicant has met its burden of proving that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01.

ARGUMENT

THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, MEANING AND OVERALL COMMERCIAL IMPRESSION AND THE GOODS AND SERVICES OF BOTH ARE CLOSELY RELATED CREATING A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods.

The overriding concern is to prevent buyer confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974). Here, the marks of the parties are confusingly similar and the goods and services are closely related and are sold/provided through the same channels of trade.

A. The Marks Are Confusingly Similar

In the present case, the applicant seeks registration of SURGICAL SPECIALTIES in standard character form for “medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use.”

The cited registered marks, all owned by The Wallace Enterprises, Inc., are AMERICAN SURGICAL SPECIALTIES COMPANY in standard character form for “Wholesale store services, mail-order wholesale services, on-line wholesale services and wholesale ordering services in the fields of surgical and medical devices, instruments and equipment and laparoscopic surgical and medical devices, instruments and equipment,” AMERICAN SURGICAL SPECIALTIES COMPANY with a design element for “Wholesale store services, mail-order wholesale services, on-line wholesale store services and wholesale ordering services in the fields of surgical and medical devices, instruments and equipment and laparoscopic surgical and medical devices, instruments and equipment.,” AMERICAN SURGICAL SPECIALTIES COMPANY in standard character form for “Maintenance and repair of surgical and medical devices, instruments and equipment,” AMERICAN SURGICAL SPECIALTIES COMPANY in standard character form for “Education services, namely, providing training services in the field of proper use, storage, maintenance and repair

of surgical and medical devices, instruments and equipment,” AMERICAN SURGICAL SPECIALTIES COMPANY with a design element for “Maintenance and repair of surgical and medical devices, instruments and equipment,” and AMERICAN SURGICAL SPECIALTIES COMPANY with a design element for “Education services, namely, providing training services in the field of proper use, storage, maintenance and repair of surgical and medical devices, instruments and equipment.”

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Furthermore, although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 1366, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014).

The dominant portion in each of the registrant's marks is the wording AMERICAN SURGICAL SPECIALTIES COMPANY. Thus, the applicant's mark is highly similar to the dominant portion of each of the cited registered marks with respect to sound, appearance, and commercial impression. The applicant's mark and the registrant's marks share the wording SURGICAL SPECIALTIES. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

The applicant argues that the marks are not confusingly similar because the dominant portion of the registrant's marks is the wording AMERICAN SURGICAL while the dominant portion of the applicant's mark is the wording SURGICAL SPECIALTIES. However, this argument ignores the fact that the registrant's marks also include the wording SURGICAL SPECIALTIES. As noted above, marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression.

Moreover, when comparing marks, the test is not whether the marks can be distinguished in 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 and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). Here, given that the applicant’s mark and the dominant portion in each of the registrant’s marks share the wording SURGICAL SPECIALTIES, the marks are sufficiently similar to cause a likelihood of confusion under Trademark Act Section 2(d).

The applicant also argues that a likelihood of confusion does not exist in this case because the registrant’s marks are weak and only entitled to a narrow scope of protection. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board, though, have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’”); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”).

Finally, the applicant argues that, given the absence of instances of actual confusion for nearly two decades, it is clear that consumers are unlikely to be confused. The test under Trademark Act Section 2(d), though, is whether there is a likelihood of confusion. It is not necessary to show actual

confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Given the fact that the marks are highly similar with respect to sound, appearance, and commercial impression and that the applicant's mark and the registrant's marks share the wording SURGICAL SPECIALTIES, the marks are sufficiently similar to cause a likelihood of confusion in the marketplace under Trademark Act Section 2(d).

B. The Goods And Services Of The Parties Are Closely Related And Are Found In The Same Channels Of Trade

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d

1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The trademark attorney, in the Final Office Action issued May 20, 2014 and the subsequent Final Office Action issued on May 18, 2015, attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. This evidence shows that the goods and services listed therein, namely medical devices, wholesale store services featuring medical devices, and repair and maintenance of medical devices, 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). The following are examples of this evidence:

- SIEMENS in typed form (U.S. Registration No. 2508299)
- Eagle design mark (U.S. Registration No. 2884563)
- ENHANCING OUTCOMES FOR PATIENTS AND THEIR CAREGIVERS in standard character form (U.S. Registration No. 3854127)
- IKARIA in standard character form (U.S. Registration No. 3778583)

- MED SYSTEMS with a design element (U.S. Registration No. 3888894)
- AUDIFON in stylized form (U.S. Registration No. 3885436)

Further, in the Final Office Action issued May 20, 2014 and the subsequent Final Office Action issued on May 18, 2015, the examining attorney attached Internet evidence consists of the websites of entities that provide the applicant's goods and the registrant's services. This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods and services and markets the goods and/or services under the same mark and that the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's and registrant's goods and services 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). This evidence included the following examples:

- The examining attorney provided evidence from the website of AKW Medical. AKW Medical provides medical devices and equipment and the repair, sale, and calibration of such devices and equipment.
- The examining attorney provided evidence from the website of GE Healthcare. GE Healthcare provides medical devices and equipment, the sale of such goods, and the servicing of such goods.
- The examining attorney provided evidence from the website of Medtronic. Medtronic provides medical apparatuses and instruments for use in surgery, education and training services related to medical apparatuses and instruments for use in surgery, the sale of medical apparatuses and instruments for use in surgery, and technical support services related to medical apparatuses and instruments for use in surgery.

- The examining attorney provided evidence from the website of Bard Access Systems. Bard provides medical devices and apparatuses and education and training services related to those goods.

Evidence obtained from the Internet may be used to support a determination under 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). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

Additionally, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*,

228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

Finally, the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

The applicant argues that a likelihood of confusion does not exist in this case because purchasers of the applicant's goods and the registrant's services are sophisticated purchasers that exercise a heightened level of care and, therefore, they are not likely to be confused. The Court of Appeal for the Federal Circuit and the Board, however, have held that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Further, while the applicant argues that a likelihood of confusion does not exist because the goods and services are different, the fact that the goods and services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods or services, but likelihood of confusion as to the source or sponsorship of those goods or services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

THE APPLICANT’S MARK IS MERELY DESCRIPTIVE OF THE IDENTIFIED GOODS UNDER SECTION 2(e)(1) OF THE TRADEMARK ACT.

The applicant seeks registration of SURGICAL SPECIALTIES in standard character form for “medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use.”

The applicant’s mark immediately describes characteristics of the applicant’s goods. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Furthermore, the determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b);

see, e.g., *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The examining attorney, in the subsequent Final Office Action issued on May 18, 2015, attached evidence from The American Heritage Dictionary showing that the wording SURGICAL is defined as “used in surgery” and the wording SPECIALTY is defined as “A branch of medicine or surgery, such as cardiology or neurosurgery, in which a physician specializes; the field or practice of a specialist.” Further, the attached evidence from thefreedictionary.com showed that the wording SURGICAL SPECIALTY is defined as “A specialty of healthcare in which interventions constitute a significant component of patient management.” The applicant provides surgical apparatuses and instruments for various surgical specialties in the medical, dental and veterinary fields. Therefore, the applied-for mark is merely descriptive of the identified goods because the applicant is providing surgical apparatus and instruments for various surgical specialties for medical, dental and/or veterinary use.

Moreover, the examining attorney, in the subsequent Final Office Action issued on May 18, 2015, attached evidence from various Internet websites showing that the wording SURGICAL SPECIALTY/SURGICAL SPECIALTIES is commonly used to describe the function or purpose of goods that are identical to the applicant’s goods and goods that are similar to the applicant’s goods. Examples of this evidence include the following:

- The examining attorney provided evidence from the website of O.R. Specialties. The website states that this entity provides surgical apparatuses and instruments for use in various surgical specialties.
- The examining attorney provided evidence from the website of Bard. The website states the following about this entity and their goods/services: “C.R. Bard, Inc. is a leading multinational developer, manufacturer, and marketer of innovative, life-enhancing medical technologies in the fields of vascular, urology, oncology, and surgical specialties.”
- The examining attorney provided evidence from the website of Olympus. The website states the following about this entity and their goods/services: “With a focus on research & development and manufacturing excellence, Olympus Surgical Technologies America is a pioneer in the development of devices for many surgical specialties including Urology, Gynecology, Ear Nose & Throat, and General Surgery.”
- The examining attorney provided evidence from the website of Integra. Integra provides surgical instruments for various surgical specialties.

Material obtained from the Internet is generally accepted as competent evidence. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1644-47 (TTAB 2015) (accepting Internet evidence to show false suggestion of a connection and that a name identified a particular living individual whose written consent to register was required); *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1641-42 (TTAB 2011) (accepting Internet evidence to show geographic location was well-known for particular goods); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); *In re Rodale Inc.*, 80 USPQ2d

1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); TBMP §1208.03; TMEP §710.01(b).

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d at 1642 (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

The applicant provides surgical apparatus and instruments for various surgical specialties in the medical, dental, and veterinary fields. Therefore, the applicant's mark is merely descriptive of the identified goods.

Marks comprising more than one element must be considered as a whole and should not be dissected; however, a trademark examining attorney may consider the significance of each element separately in the course of evaluating the mark as a whole. See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012) (reversing Board's denial

of cancellation for SNAP! with design for medical syringes as not merely descriptive when noting that the Board “to be sure, [could] ascertain the meaning and weight of each of the components that ma[de] up the mark”); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”).

Further, generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”). Here, the applicant provides surgical apparatuses and instruments for various surgical specialties in the medical, dental, and veterinary fields. Therefore, both the individual components and the composite result are descriptive of the applicant’s goods and, therefore, registration must be refused under Trademark Act Section 2(e)(1).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the

combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods.

Finally, determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but "whether someone who knows what the goods and[/or] services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

FIVE YEARS' USE IS INSUFFICIENT TO ESTABLISH THAT THE APPLIED-FOR MARK HAS ACQUIRED DISTINCTIVENESS UNDER SECTION 2(f) AND APPLICANT HAS FAILED TO PROVIDE ADDITIONAL EVIDENCE OF DISTINCTIVENESS.

Applicant amended the application to assert acquired distinctiveness based on five years' use in commerce. The burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

Allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark. An applicant must also provide the actual advertising material so that the examining attorney can determine how the term is used, the commercial impression created by such use, and the significance the term would have to prospective purchasers. TMEP §1212.06(b); see *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); see *In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971).

The following factors are generally considered when determining whether a proposed mark has acquired distinctiveness based on extrinsic evidence: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense, and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005); *Bd. of Trs. of Univ. of Ala. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013). A showing of acquired distinctiveness need not consider all of these

factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212.06 *et seq.*

Thus, the burden is on the applicant to establish that the purchasing public has come to view the proposed mark as an indicator of origin. The applicant's claim of acquired distinctiveness is based solely on the applicant's use of the mark in commerce since 1997. However, a claim of acquired distinctiveness based solely on the number of years the mark has been used in commerce by the applicant is insufficient in this case because the evidence provided by the examining attorney shows that the applicant did not have exclusive use of the applied-for mark in connection with the identified goods. The evidence provided by the examining attorney in the non-final Office Action issued on November 14, 2014 and the final Office Action issued on May 18, 2015 shows that the wording SURGICAL SPECIALTIES is commonly used throughout the surgical apparatuses and instruments field to describe that the applicant's goods are used in various surgical specialties. Examples of this evidence include the following:

- The examining attorney provided evidence from the website of O.R. Specialties. The website states that this entity provides surgical apparatuses and instruments for use in various surgical specialties.
- The examining attorney provided evidence from the website of Bard. The website states the following about this entity and their goods/services: "C.R. Bard, Inc. is a leading multinational developer, manufacturer, and marketer of innovative, life-enhancing medical technologies in the fields of vascular, urology, oncology, and surgical specialties."
- The examining attorney provided evidence from the website of Olympus. The website states the following about this entity and their goods/services: "With a

focus on research & development and manufacturing excellence, Olympus Surgical Technologies America is a pioneer in the development of devices for many surgical specialties including Urology, Gynecology, Ear Nose & Throat, and General Surgery.”

- The examining attorney provided evidence from the website of Integra. Integra provides surgical instruments for various surgical specialties.

Material obtained from the Internet is generally accepted as competent evidence. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1644-47 (TTAB 2015) (accepting Internet evidence to show false suggestion of a connection and that a name identified a particular living individual whose written consent to register was required); *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1641-42 (TTAB 2011) (accepting Internet evidence to show geographic location was well-known for particular goods); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Joint-Stock Co. “Baik”*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); TBMP §1208.03; TMEP §710.01(b).

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While the applicant has used the applied-for mark in commerce since 1997, the number of the years that the applicant has used a particular mark is only part of the analysis with respect to a claim of acquired distinctiveness. Since the applicant failed to provide any additional evidence to support the applicant's claim of acquired distinctiveness and because the mark is so highly descriptive of the identified goods, the applicant has failed to show that the applied-for mark has acquired distinctiveness in the marketplace in connection with the identified goods.

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013).

CONCLUSION

For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that the applicant's mark, when used in connection with the identified goods, so resembles the marks shown in U.S. Registration Nos. 3869465, 3980038, 3988543,

3988544, 3988545, and 4004998, as to be likely to cause confusion, to cause mistake, or to deceive, should be affirmed.

Furthermore, for the foregoing reasons, the refusal to register on the basis of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the grounds that the mark is merely descriptive of the identified goods should be affirmed.

Finally, the requirement that the applicant submit additional evidence to show that the applied-for mark has acquired distinctiveness in the marketplace under Trademark Act Section 2(f) should be affirmed.

Respectfully submitted,

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