

This Opinion is not a
Precedent of the TTAB

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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 Surgical Specialties Corporation (US), Inc.
—

Serial No. 86010502
Serial No. 86010504
Serial No. 86081312
—

Kevin S. Costanza of Seed Intellectual Property Law Group PLLC
for Surgical Specialties Corporation (US), Inc.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Zervas, Greenbaum, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Surgical Specialties Corporation (US), Inc. (“Applicant”) filed applications to register on the Principal Register three marks for use in connection with “medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use,” in International Class 10. The three marks are set forth below:

SURGICAL SPECIALTIES CORPORATION¹

¹ Application Serial No. 86010502 was filed on July 15, 2013, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). No claim is made to the exclusive right to use the terms SURGICAL and CORPORATION apart from the mark as shown.

SURGICAL SPECIALTIES²



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In each case, Applicant subsequently filed an allegation of use and a request that the mark be registered under Trademark Act Section 2(f), on the ground that the mark had acquired distinctiveness. Regarding the two standard character marks, Applicant stated dates of first use and first use in commerce of 1997. Regarding the stylized mark, Applicant stated dates of first use and first use in commerce of January 2014.⁴

In each case, the Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant's goods. On consideration of Application's claim of acquired distinctiveness, the Examining Attorney maintained the refusal of registration and ultimately made the refusal final.

² Application Serial No. 86081312 was filed on October 2, 2013, under Section 1(b) of the Trademark Act. No claim is made to the exclusive right to use SURGICAL apart from the mark as shown.

³ Application Serial No. 86010504 was filed on July 15, 2013, under Section 1(b) of the Trademark Act. No claim is made to the exclusive right to use CORPORATION apart from the mark as shown. Color is not claimed as a feature of the mark.

⁴ Applicant's allegation of use for the stylized mark originally gave 1997 as the date of first use, but Applicant amended this date to January 2014 by an amendment filed November 17, 2014.

The Examining Attorney also refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods, so resembles the registered marks shown below as to be likely to cause confusion, or to cause mistake, or to deceive. The cited marks are registered in the name of a single entity for the services as set forth below:

| <u>Reg. No.</u> | <u>Mark</u> | <u>Services</u> |
|-----------------|---|---|
| 3869465 | <p>AMERICAN SURGICAL SPECIALTIES COMPANY</p> <p>Section 2(f)</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | <p>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.</p> |
| 3988543 | <p>AMERICAN SURGICAL SPECIALTIES COMPANY</p> <p>Section 2(f)</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | <p>Maintenance and repair of surgical and medical devices, instruments and equipment.</p> |
| 3988544 | <p>AMERICAN SURGICAL SPECIALTIES COMPANY</p> <p>Section 2(f)</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | <p>Education services, namely, providing training services in the field of proper use, storage, maintenance and repair of surgical and medical devices, instruments and equipment</p> |

| | | |
|---------|---|--|
| 3980038 |  <p>Section 2(f) as to AMERICAN SURGICAL SPECIALTIES COMPANY</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | 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. |
| 3988545 |  <p>Section 2(f)</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | Maintenance and repair of surgical and medical devices, instruments and equipment |
| 4004998 |  <p>Section 2(f) as to AMERICAN SURGICAL SPECIALTIES COMPANY</p> <p>Disclaimed: SURGICAL SPECIALTIES COMPANY</p> | Education services, namely, providing training services in the field of proper use, storage, maintenance and repair of surgical and medical devices, instruments and equipment. |

In each case, after the Examining Attorney made his refusals final, Applicant appealed and filed a request for reconsideration. The Examining Attorney denied the requests for reconsideration, and Applicant's appeals proceeded.

The issues raised by Applicant's three appeals are identical or highly similar. The briefs and evidentiary record in all cases are essentially identical. Accordingly, we will address all three appeals in a single opinion. Citations to the briefs and record refer to the filings in application Serial No. 86010502 unless otherwise noted. We have, of course, considered all arguments and evidence filed in each case, including any arguments and evidence not specifically discussed in this decision.

1. Refusals under Section 2(e)(1).

We will first address the refusals under Section 2(e)(1) of the Trademark Act. Section 2(e)(1) provides for the refusal of registration of "a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(1). However, Section 2(f) of the Trademark Act provides that "nothing ... shall prevent the registration of a mark used by the applicant that has become distinctive of the applicant's goods in commerce." 15 U.S.C. § 1052(f). Under Section 2(f), a mark that is otherwise barred from registration under Section 2(e)(1) can still obtain registration if the applicant proves that the mark has become distinctive. *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009), *citing* *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Inasmuch as applicant is seeking registration under Section 2(f), there is no issue that its mark is merely descriptive. *The Cold War Museum*, 92 USPQ2d at 1629 (“where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”); *see also Yamaha*, 6 USPQ2d at 1005. In order to register its mark under Section 2(f), Applicant bears the burden of proving that its mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant.”). The amount and character of such evidence depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. “[L]ogically that standard becomes more difficult as the mark’s descriptiveness increases.” *Yamaha*, 6 USPQ2d at 1008, *citing* 1 Gilson, TRADEMARK PROTECTION AND PRACTICE, §2.09, at 2-73 (“[i]n general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning”); and 1 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION §15:10, at 683 (“the more descriptive the term, the greater the evidentiary burden to establish secondary meaning”). *See also In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005); and *In re Bongrain*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990).

In order to fully assess Applicant's claim under Section 2(f), we will first consider the degree to which Applicant's marks are descriptive of Applicant's goods, which are "medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use." The Examining Attorney has made of record the following relevant dictionary definitions:

surgical: 1. Of, relating to, or characteristic of surgeons or surgery.
 2. Used in surgery.⁵

specialty:
pl. specialties: 1. A special pursuit, occupation, aptitude, or skill. ...
 2. A branch of medicine or surgery, such as cardiology or
 neurosurgery, in which a physician specializes; the field or
 practice of a specialist.⁶

corporation: 1. A body that is granted a charter recognizing it as a
 separate legal entity having its own rights, privileges, and
 liabilities distinct from those of its members.⁷

See also similar definitions from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fifth ed. 2014) at Office Action of May 18, 2015 at 93-95 and 123. The Examining Attorney has also submitted the following definition:

surgical specialty: A specialty of healthcare in which interventions constitute a significant component of patient management.⁸

⁵ Definition from <education.yahoo.com/reference/dictionary>, Office Action of October 30, 2013 at 105-6.

⁶ *Id.* at 107-8.

⁷ *Id.* at 109-110.

⁸ Definition from <medical-dictionary.thefreedictionary.com>, Office Action of May 15, 2014 at 94.

The record also includes copies of web pages on which the expression “surgical specialties” is used in the context of surgical instruments. We note, in particular, the following (underscore added):

Surgical Product Information

...

Specialty Instrumentation

Our general instruments are fully complemented by an extensive selection of instrumentation for all surgical specialties. Whether for in-office dermatological procedures or cardiovascular surgery in the OR, Miltex is able to meet the full range of instrument needs for all surgical settings ...⁹

Teleflex, a global provider of medical devices, offers a full line of surgical instruments under the Pilling and KMedic brands. These instruments span across many surgical specialties, including Cardiovascular, Thoracic, Ear/Nose/Throat, Orthopedic, Laparoscopy, Neurosurgery, Gynecology, Plastic, Bariatric, and General Surgery.¹⁰

ArthorCare is leveraging these technologies in order to offer a comprehensive line of surgical devices to capitalize on a multi-billion dollar market opportunity across several surgical specialties, including its two core product areas consisting of Sports Medicine and Ear, Nose, and Throat as well as other areas such as spine, wound care, urology and gynecology.¹¹

⁹ Office action of November 14, 2014 at 5.

¹⁰ *Id.* at 7.

¹¹ *Id.* at 8.

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Searching for specialty surgical instruments doesn't have to be hard! ... Browse some of the most popular instruments in a variety of surgical specialties using the links below!¹²

We note also a list entitled "Surgical Specialties" listing numerous fields of medicine;¹³ a company called Florida Surgical Specialties that distributes "Surgical Instrumentation and other O.R. related products";¹⁴ and third-party uses of the expression "specialty surgical instruments" in a descriptive sense.¹⁵

It is clear from the evidence that the term "surgical specialties" has been used as the general name of the various fields of use for which Applicant's goods are made. This expression and the mark SURGICAL SPECIALTIES (Serial No. 86081312) are therefore very highly descriptive of the purpose or use of the identified goods. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (A term is merely descriptive of goods if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods.)

With respect to the mark SURGICAL SPECIALTIES CORPORATION (Serial No. 86010502), we note the Examining Attorney's remark that "the applicant is a corporation that provides surgical apparatuses and instruments for various surgical specialties ..." In the world of commerce, in which a very large share of the entities doing business are "corporations," the addition of the business entity designation

¹² *Id.* at 16

¹³ *Id.* at 9-10.

¹⁴ *Id.* at 13.

¹⁵ *Id.* at 16, 19.

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CORPORATION does nothing to increase the distinctiveness of Applicant's mark. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004) (wording that creates the impression of a commercial entity "bears no trademark significance"), discussing *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888). We do not, of course, ignore the word CORPORATION in our assessment of the mark, and we note that, unlike SURGICAL SPECIALTIES, which describes the use and purpose of the goods, SURGICAL SPECIALTIES CORPORATION describes a business entity that is involved in the field in which Applicant's goods are used. The latter mark has slightly more potential for distinctiveness as a source indicator than the former; but the increase in potential is very slight.

Finally, with respect to Applicant's stylized mark (Serial No. 86010504), we note that the wording of the mark has essentially the same potential for distinctiveness as the mark SURGICAL SPECIALTIES CORPORATION, but the stylized form of the lettering and the layout of the mark bring added potential for trademark function. However, the style of lettering is not distinctive, except for two of the letters, namely, the letter I as it appears in SURGICAL and as it first appears in SPECIALTIES. The stylized form of these two letters is relatively subtle and would not necessarily be noticed by customers. The layout of the mark (the three words stacked vertically, with CORPORATION rendered in smaller lettering) is also highly conventional and is a layout in which customers would readily expect other companies to present the words SURGICAL SPECIALTIES CORPORATION.

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Overall, this stylized mark is the one with the strongest potential for acquiring distinctiveness as a trademark.

We turn next to consider the evidence presented by Applicant to show that its marks have acquired distinctiveness as its source indicators. In each case, the evidence consists of three components: Applicant's stated dates of first use; and two statements of Applicant's counsel, all as discussed below.

(a) Dates of first use.

With respect to Applicant's two standard character marks, Applicant stated its dates of first use on the electronic form of its amendment to allege use,¹⁶ as follows:

FIRST USE ANYWHERE DATE 00/00/1997

FIRST USE IN COMMERCE DATE 00/00/1997

With respect to Applicant's stylized mark, Applicant originally stated its dates of first use as "00/00/1997,"¹⁷ but then amended them to "At least as early as 01/00/2014."¹⁸

In all three cases, the amendment to allege use was verified with a declaration signed by Applicant's counsel.

(b) Statements of counsel.

In each case, the record contains the following unverified statements made by Applicant's counsel:

¹⁶ Amendment to Allege Use filed October 30, 2014 at 1.

¹⁷ Application Serial No. 86010504, Amendment to Allege Use filed October 30, 2014 at 1.

¹⁸ Application Serial No. 86010504, Voluntary Amendment filed November 17, 2014 at 1.

As indicated [in Applicant's amendment to allege use], the applicant has been using SURGICAL SPECIALTIES CORPORATION as a mark in connection with the marketing and sale of medical devices since at least as early as 1997. During that seventeen (17) year time period, consumers have grown to recognize SURGICAL SPECIALTIES CORPORATION as an indicator of the source of origin of the associated medical devices. Accordingly, the mark has acquired distinctiveness or secondary meaning, and is registrable on the Principal Register under Section 2(f).¹⁹

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before this statement.²⁰

Applicant argues in its brief, "The Trademark rules provide that five years of continuous and substantially exclusive evidence [*sic*] can be *prima facie* evidence of acquired distinctiveness. 37 C.F.R. § 2.41(b). In this case, Applicant has used the mark for well over five years – in fact, for nearly two decades. As such, this factor weighs heavily in favor of a finding of acquired distinctiveness."²¹ The Examining Attorney argues:

[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.²²

[T]he number of the years that the applicant has used a particular mark is only part of the analysis with respect

¹⁹ Request for reconsideration filed November 6, 2014 at 1.

²⁰ *Id.* at 2.

²¹ Applicant's brief at 13, 7 TTABVUE 18.

²² Examining Attorney's brief, 9 TTABVUE 22.

to a claim of acquired distinctiveness. ... 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.²³

On the point of exclusivity of use, Applicant points out that “while the Examining Attorney identified third-party use of ‘surgical,’ ‘specialties’ and ‘surgical specialties,’ there is no evidence in the record that another party is using the trademark ‘Surgical Specialties Corporation.’”²⁴

Applicant has submitted the bare minimum of evidence for the purpose of demonstrating that its marks have come to be recognized as its source indicators: a verified statement that Applicant has used its marks since 1997 (or, in the case of the stylized mark, since 2014) and an unverified statement²⁵ that it has used the marks substantially exclusively and continuously for five years. The evidence lacks any other meaningful detail. There is no evidence to show that the mark has been used vigorously, as opposed to desultorily; no evidence to show that it has ever been advertised; no evidence to indicate the geographic range of the distribution of Applicant’s goods or the number of goods that have been sold under the mark; and no evidence to show that any customer has ever noticed the mark or received any particular impression of it. The conclusory statement that the mark has acquired distinctiveness comes from Applicant’s outside counsel, with no explanation of why

²³ *Id.*, 9 TTABVUE 24.

²⁴ Applicant’s brief at 13, 7 TTABVUE 18.

²⁵ Trademark Rule 2.41(a)(2) prescribes that an acceptable claim of distinctiveness based on five years of use may be made “by way of *verified* statements ...,” noting that “further evidence may be required.” 37 C.F.R. § 2.41(a)(2) (emphasis added). The fact that Applicant’s distinctiveness claims are not verified reduces their probative weight.

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outside counsel would be familiar with the operations of Applicant's business or knowledgeable with respect to customer perceptions in Applicant's marketplace. Evidence of this type carries little probative weight.

The principle that proof of five years of substantially exclusive and continuous use of a mark may suffice as *prima facie* evidence of acquired distinctiveness, to which Applicant alludes, is set forth in Section 2(f) of the Trademark Act itself ("The Director may accept as prima facie evidence that the mark has become distinctive ... proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made."). The Federal Circuit, noting this statutory "suggestion," has observed that "the 'exact kind and amount of evidence necessarily depends on the circumstances of the particular case', and 'Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts.'" *Yamaha*, 6 USPQ2d 1008, quoting *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985).

Under the present circumstances, where we have found each of Applicant's three marks to be quite highly descriptive (albeit in varying degrees), we find Applicant's evidence insufficient to demonstrate that any of its marks have acquired distinctiveness. The small amount of Applicant's evidence regarding substantially exclusive use of its marks is undermined by evidence of record showing that third parties have used the wording "surgical specialties" (which constitutes the most prominent component of Applicant's marks) in a highly descriptive manner in the

relevant industry. With respect to the stylized mark, the claim of five years' use is undermined by the inconsistent statement that the mark was adopted only in 2014. Inasmuch as we find that Applicant has failed to demonstrate that its marks have acquired distinctiveness under Section 2(f), we affirm the Examining Attorney's refusals under Section 2(e)(1).

2. The refusals under Section 2(d).

We next address the Examining Attorney's refusals under Section 2(d), which are based on the above-listed six cited registrations owned by a single entity. In comparing Applicant's marks to the cited marks, we will focus our analysis on Registrant's standard character mark AMERICAN SURGICAL SPECIALTIES COMPANY, as registered for wholesale sales services (Reg. No. 3869465) and maintenance and repair services (Reg. No. 3988543). Registrant's standard character marks are more similar to Applicant's marks than are Registrant's design marks; and Registrant's sales, repair and maintenance services are more similar to Applicant's goods than are Registrant's training services. Thus, these two registrations are most likely to support a finding of likelihood of confusion. If confusion is likely as between either of these registered marks and Applicant's marks, there is no need for us to consider the other cited registrations; and if there is no likelihood of confusion between Applicant's marks and either of these two cited marks, then there would be no likelihood of confusion with respect to the other cited marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case Applicant and the Examining Attorney have also submitted arguments relating to trade channels, the strength or weakness of Registrant's marks, the sophistication of relevant customers, the care with which they select the goods and services, and the absence of actual confusion.

A. The marks.

We first consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). For the sake of convenience, we set forth the marks at issue below, although we do not assume that the marks would necessarily be seen together in the marketplace:

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Registrant's mark:

AMERICAN SURGICAL SPECIALTIES COMPANY

Applicant's marks:

SURGICAL SPECIALTIES CORPORATION

SURGICAL SPECIALTIES



SURGICAL
SPECIALTIES
CORPORATION

While we must consider the marks in their entireties and be careful to avoid “dissection” of the marks, both Applicant and the Examining Attorney appear to acknowledge that there is nothing improper in giving more or less weight to a particular feature of a mark, for rational reasons. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “Indeed, this type of analysis appears to be unavoidable.” *Id.*

In appearance and sound, the marks are similar in that each includes the term SURGICAL SPECIALTIES. However, the marks have certain distinguishing features: AMERICAN and COMPANY in Registrant's mark create a distinction in sound and appearance; the word CORPORATION in Applicant's mark creates a difference in sound and appearance and the design elements of Applicant's stylized mark create a difference in appearance. In meaning, the marks are similar to the extent that the wording SURGICAL SPECIALTIES would, of course, mean the same thing in all the marks; moreover, we note that SURGICAL SPECIALTIES COMPANY and SURGICAL SPECIALTIES CORPORATION are, despite their

differences, virtually identical in meaning. The word AMERICAN in Registrant's mark creates a distinction in meaning between Registrant's marks and Applicant's marks. However, the distinctiveness of AMERICAN is not particularly strong, in view of its geographically descriptive nature, as used in the United States market.

Applicant urges that the dominant feature of Registrant's marks is AMERICAN SURGICAL, while the dominant portion of its own marks is SURGICAL SPECIALTIES. Although the design marks of Registrant do indeed emphasize the words AMERICAN SURGICAL, Registrant's standard character marks (on which we focus) are not limited to any particular form of display. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983), and could be presented, for example, with all wording in the same style and size of lettering. Considering the evidence, discussed above, showing that the expression "surgical specialties" is a recognized, unitary phrase, it is unlikely that customers in the marketplace would fail to connect the two words "surgical" and "specialties." Accordingly, we consider the dominant portion of Registrant's mark to be AMERICAN SURGICAL SPECIALTIES and the dominant portion of Applicant's marks to be SURGICAL SPECIALTIES (which is also the entirety of one of Applicant's marks).

Applicant correctly points out that Registrant has disclaimed the exclusive right to use SURGICAL SPECIALTIES COMPANY apart from the mark as a whole. Indeed, on this record there is no question that the wording SURGICAL SPECIALTIES COMPANY is highly descriptive. Applicant argues:

Where a party chooses a trademark which is inherently weak, the party will not enjoy the wide latitude of

protection afforded the owners of strong trademarks. In other words, where a party uses a weak mark, competitors may come closer to the mark than would be the case with a strong mark without violation of the rights of the party choosing the inherently weak mark. ... Trademarks containing commonly used words and highly suggestive or descriptive words are generally considered as weak marks that are afforded less protection than that accorded an arbitrary or coined word. ... Therefore Applicant submits that the registrant is entitled only to a very narrow scope of protection and that the differences in the marks in their entireties and, more particularly, the dominant portions thereof, AMERICAN SURGICAL and SURGICAL SPECIALTIES, are sufficient to preclude the likelihood of consumer confusion.²⁶

The Examining Attorney, in response, points out 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,”²⁷ citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (“Confusion is confusion. The likelihood thereof is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”) and *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services”).

As noted, SURGICAL SPECIALTIES, SURGICAL SPECIALTIES COMPANY and SURGICAL SPECIALTIES CORPORATION are highly descriptive in the relevant industry. However, the record would not support a finding that these terms are devoid of the capacity to function as a mark: SURGICAL SPECIALTIES is not

²⁶ Applicant’s brief at 8-10, 7 TTABVUE 13-15.

²⁷ Examining Attorney’s brief, 9 TTABVUE 9.

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the generic name of Registrant's services, nor is SURGICAL SPECIALTIES COMPANY the generic name of Registrant's business entity. It is also clear that the marks of Applicant and Registrant have many points of similarity and are, in their entireties, strikingly similar, albeit not identical. Finally, we operate on the legal assumption, dictated by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), that Registrant's mark as a whole, AMERICAN SURGICAL SPECIALTIES COMPANY, is a valid service mark. We find that the marks at issue are sufficiently similar to each other as to be likely to cause confusion if applied to identical or closely related goods or services. Bearing that in mind, we turn to consider the other *du Pont* factors.

B. The goods and services; trade channels.

We next consider the similarity or dissimilarity of the goods and services as identified in the application and the cited registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Because Applicant's goods and Registrants' services are not the same, we ask whether the goods and services are related in some manner or whether the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source. *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722; *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

Applicant argues:

Although the claimed goods and services may be from the medical field, the differences in medical devices and wholesale, educational, and repair and maintenance services are sufficiently distinct and target different consumers ...

[W]here there are differences in the Applicant's recited goods and registrant's recited services, as in the present case, it follows that consumer confusion would be less probable than in those cases involving identical goods.²⁸

The Examining Attorney has submitted various third-party registrations that cover, on the one hand, surgical instruments and, on the other hand, wholesale store services or repair and maintenance relating to medical equipment.²⁹ Third-party registrations that are based on use in commerce and which individually cover a number of different goods and services may have some probative value to the extent that they serve to suggest that the listed goods and services are of types which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Only a few of these registrations appear to have direct relevance to this case:

| <u>Reg. No.</u> | <u>Mark</u> | <u>Goods/Services</u> |
|-----------------|-------------|--|
| 2967399 | E-CLASS | Instruments for endoscopic surgery. Repair and maintenance of medical instruments for endoscopic surgery. |

²⁸ Applicant's brief at 10-11, 7 TTABVUE 15-16.

²⁹ Office Action of October 30, 2013 at 38-104 and Office Action of May 15, 2014 at 11-67.

| | | |
|---------|-----------------|---|
| 4210185 | ALLEGRETTO WAVE | Diagnostic instruments used in ophthalmic surgical procedures. Repair and maintenance of devices and equipment for medical purposes. |
| 4109583 | MYBUY | Surgical forceps; medical scissors. Wholesale store featuring various medical apparatus and instruments. |

The Examining Attorney has also made of record advertisements, found on the Internet, offered to demonstrate that a single business may offer surgical instruments and sales of surgical instruments under the same mark. Among these we note only the following as directly relevant to this case:

Medtronic For Healthcare Professionals, offering “Electrosurgical Products” and repair services; as well as product training.³⁰

The Examining Attorney argues that “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,” citing *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). In that case, the Court found the distinction between a registrant’s goods and an applicant’s service of selling such goods to be “of little or no legal significance” for purposes of a *du Pont* analysis:

Considering the facts (a) that trademarks for goods find their principal use in connection with *selling* the goods and (b) that the applicant's services are general merchandising -- that is to say *selling* -- services, we find this aspect of the case to be of little or no legal

³⁰ Office Action of May 15, 2014 at 80-85.

significance. The respective marks will have their only impact on the purchasing public in the same marketplace.

In our case the goods and services at issue, as recited in the applications and registrations, are more closely related than in *Hyper Shoppes*. Applicant's goods are surgical instruments and Registrant's services are selling surgical instruments. Thus, Registrant's service is, by its terms, to provide a trade channel for the precise goods for which Applicant wishes to register its mark. Accordingly, we find that there is a cognizable degree of commercial relationship between them.

C. Care and sophistication of customers.

Applicant argues that customers for the goods and services at issue are sophisticated and careful in the selection thereof:

Applicant's claimed goods are highly technical medical devices that are purchased by sophisticated consumers, while registrant's recited services are also related to sophisticated purchasers of medical equipment services. Therefore, the relevant purchasers are expected to exercise precautions when making purchasing decisions.³¹

Applicant's argument is not supported by evidence and we therefore have no actual information about who the purchasers are or what the process of selecting the goods and services is like. However, we can assume that the relevant customers are not ordinary consumers, but persons having some knowledge in the field of medical instruments.

³¹ Applicant's brief at 12, 7 TTABVUE 17.

D. Lack of confusion.

Applicant points out the “absence of any instances of actual confusion for a lengthy duration over which the marks have coexisted in the marketplace ...”³² Applicant’s contention that there has been no confusion is not supported by any evidence relating to the extent of use of Applicant’s and Registrant’s marks. Accordingly, we have no basis for determining whether there have been meaningful opportunities for confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Moreover, in this *ex parte* proceeding, we do not have the benefit of Registrant’s input as to whether confusion has occurred. Lacking such an evidentiary context, Applicant’s uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973).

E. Balancing the factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Despite the weakness of the common elements appearing in Applicant’s marks and the cited registered marks, *i.e.*, SURGICAL SPECIALTIES, the marks at issue are strikingly similar to each in appearance, sound, meaning, and overall commercial impression.

³² *Id.* at 13, 7 TTABVUE 18.

The words COMPANY and CORPORATION contribute no distinctiveness to the respective marks; and the word AMERICAN in Registrant's mark contributes only a limited degree of distinctiveness. Moreover, Applicant's standard character marks contain no distinctive matter to distinguish them from Registrant's marks, and the stylization of the lettering in Applicant's stylized mark is so subtle as to be overlooked. Applicant's goods are the types of goods offered through Registrant's services. Even assuming that the relevant customers exercise some degree of care, under the circumstances we find that confusion as to the sources of the goods and services is likely. Accordingly, we affirm the Examining Attorney's refusals under Section 2(d).

Decision: With respect to the three applications on appeal, the refusals under Trademark Act Section 2(e)(1) are AFFIRMED and the refusals under Trademark Act Section 2(d) are AFFIRMED.

ZERVAS, dissenting in part:

I agree with the majority's conclusion regarding the Section 2(e)(1) refusal, but I respectfully dissent from its conclusion regarding the Section 2(d) refusal. Registrant's mark includes the term AMERICAN as its first term, which is conspicuously absent from Applicant's marks. SURGICAL SPECIALTIES, a term which has been disclaimed six times by registrant, and which the majority found to be "highly descriptive in the relevant industry," cannot be the basis for finding the involved marks to be similar for goods on one hand, and for services on the other

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hand, even if the services involve the same goods. In light of such differences in the marks and goods, I would find no likelihood of confusion between the Applicant's mark and the marks of the cited registrations, and would reverse the Examining Attorney's Section 2(d) refusal for each cited mark.