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

Proceeding	86081312
Applicant	Surgical Specialties Corporation (US), Inc.
Applied for Mark	SURGICAL SPECIALTIES
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON APPEAL

Applicant : Surgical Specialties Corporation (US), Inc.
Serial No. : 86/081,312
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APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

Applicant appeals the Examining Attorney's refusal to register the mark SURGICAL SPECIALTIES on two grounds:

1. There is no likelihood of confusion between Applicant's mark for "medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use" and the following U.S. Trademark Registrations:
 - i. U.S. Registration No. 3,869,465 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY 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";
 - ii. U.S. Registration No. 3,980,038 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY and design 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";
 - iii. U.S. Registration No. 3,988,543 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY for "maintenance and repair of surgical and medical devices, instruments and equipment";
 - iv. U.S. Registration No. 3,988,544 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY 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";

- v. U.S. Registration No. 3,988,545 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY and design for “maintenance and repair of surgical and medical devices, instruments and equipment”; and
- vi. U.S. Registration No. 4,004,998 for the mark AMERICAN SURGICAL SPECIALTIES COMPANY and design 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.”

Collectively (“AMERICAN SURGICAL Marks”).

- 2. Applicant’s mark has acquired distinctiveness given nearly two decades of continuous and substantially exclusive use.

Applicant respectfully submits that the Examining Attorney failed to appreciate the significant differences between Applicant’s mark, SURGICAL SPECIALTIES, and the dominant portion of the registrant’s marks AMERICAN SURGICAL. A proper comparison of the marks shows that the marks create an overall commercial impression that is highly distinct. The cited AMERICAN SURGICAL Marks are inherently weak and entitled only to a narrow scope of protection. Further, substantial differences between Applicant’s claimed goods and the registrant’s claimed services establish that consumer confusion is unlikely. Still further, the highly technical and sophisticated nature of Applicant’s goods and the registrant’s services evince that the relevant purchasers are expected to exercise a heightened level of care in making purchasing decisions. And still further, absence of consumer confusion for nearly two decades of coexistence confirms that consumer confusion is highly unlikely.

Finally, Applicant’s use of the mark in connection with the recited goods for nearly two decades sufficiently demonstrates that Applicant’s mark has acquired distinctiveness.

II. PROCEDURAL HISTORY

On October 02, 2013, Applicant applied to register the mark SURGICAL SPECIALTIES for “medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use.”

In an Office Action dated October 30, 2013, the Examining Attorney refused registration under Lanham Act § 2(d) on the grounds that there is a likelihood of confusion between Applicant’s SURGICAL SPECIALTIES mark and the AMERICAN SURGICAL Marks. *See* October 30, 2013 Office Action. The Examining Attorney also refused registration under Lanham Act § 2(e)(1) on the grounds that Applicant’s SURGICAL SPECIALTIES mark is merely descriptive. The Applicant disclaimed the term “SURGICAL” in a response filed on April 30, 2014. *See* Office Action Response April 30, 2014.

On May 20, 2014, the Examining Attorney issued a final refusal, continuing and maintaining the refusals on the grounds of likelihood of confusion with the AMERICAN SURGICAL Marks under Lanham Act § 2(d) and that the mark is merely descriptive under Lanham Act § (2)(e)(1). *See* Office Action May 20, 2014.

On October 31, 2014, Applicant amended the application to allege use dating back to at least as early as 1997 and submitted a specimen, which were accepted and entered into the record. *See* Notice of Acceptance of Amendment to Allege Use November 01, 2014.

On November 06, 2014, Applicant filed a Notice of Appeal together with a Request for Reconsideration, reiterating that there is no likelihood of confusion between Applicant’s mark SURGICAL SPECIALTIES and the cited AMERICAN SURGICAL Marks because of significant differences in the marks and the claimed goods and services, among other things. Applicant also explained to the Examining Attorney that in light of Applicant’s use of the mark for nearly two decades, Applicant’s mark has acquired distinctiveness, and thus should be registrable under Lanham Act § 2(f). *See* Request for Consideration and Notice of Appeal November 06, 2014.

On November 14, 2014, the Examining Attorney issued an Office Action continuing and maintaining the refusal on the ground of likelihood of confusion with the AMERICAN SURGICAL Marks under Lanham Act § 2(d). Despite use of the mark for nearly two decades, the Examining Attorney refused to withdraw the Lanham Act § 2(e)(1) refusal and requested that the Applicant submit additional evidence. *See* Office Action November 14, 2014.

On May 12, 2015, Applicant responded to the Office Action, again, reiterating that there is no likelihood of confusion between Applicant's mark SURGICAL SPECIALTIES and the cited AMERICAN SURGICAL Marks because of significant differences in the marks and the claimed goods and services, among other things. The Applicant also brought to the Examining Attorney's attention that just because the template for submitting a Lanham Act § 2(f) declaration specifies "five years' use," it does not mean that Applicant has used the mark for only five years, given that Applicant's use of the word mark dates back to 1997—which, in and of itself, can be *prima facie* evidence of acquired distinctiveness. *See* Office Action Response May 12, 2015.

On May 18, 2015, the Examining Attorney issued a final Office Action continuing and maintaining the refusal on the ground of likelihood of confusion with the AMERICAN SURGICAL Marks under Lanham Act § 2(d). Further, despite use of the mark for nearly two decades, the Examining Attorney maintained and continued to refuse to withdraw the Lanham Act § 2(e)(1) refusal and requested that the Applicant submit additional evidence. *See* Office Action May 18, 2015.

III. ARGUMENT

A. There Is No Likelihood of Confusion Between Applicant's Mark and the Cited AMERICAN SURGICAL Marks

Applicant appeals the Examining Attorney's finding that a likelihood of confusion exists between Applicant's SURGICAL SPECIALTIES mark and the cited AMERICAN SURGICAL Marks. Under Lanham Act § 2(d)(1), a mark that can distinguish an applicant's goods from the goods of others shall not be refused registration on the principal register unless it "so resembles a

registered mark or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, to deceive.” 15 U.S.C. § 1052(d)(1). Likelihood of confusion has been said to be synonymous with “probable” confusion -- it is not sufficient if confusion is merely “possible.” *American Steel Foundries v. Robertson*, 269 U.S. 372, 70 L. Ed. 317, 46 S. Ct. 160 (1926).

This standard is the same “likelihood of confusion” rule used as the test of trademark infringement. *Glenwood Labs., Inc. v. American Home Prods. Corp.*, 455 F.2d 1384 (C.C.P.A. 1972). Likelihood of confusion depends on whether the purchasing public would mistakenly assume that the applicant’s goods originate with, are sponsored by, or are in some way associated with the goods or services sold under a cited registration or trademark. *FBI v. Societe: “M. Bril & Co.”*, 172 U.S.P.Q. 310 (T.T.A.B. 1971). The factors used for determining likelihood of confusion are set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) and include, among others:

- the similarity of the marks,
- the similarity of the goods or services involved,
- the degree of care likely to be exercised by purchasers,
- descriptive usage of terms in the marks, and
- the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 671-672, 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984).

Applicant respectfully submits that there is no likelihood of confusion for at least the following reasons:

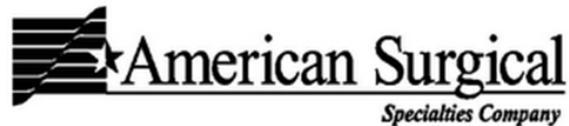
- 1) substantial differences between the dominant portion of the cited marks -- AMERICAN SURGICAL -- and Applicant’s mark – SURGICAL SPECIALTIES -- avoid a likelihood of confusion;

- 2) cited AMERICAN SURGICAL Marks are weak and only entitled to a narrow scope of protection;
- 3) Applicant's goods and the registrant's services are not sufficiently related or marketed in such a way that they would be encountered in situations that would create the incorrect assumption that they originate from the same source;
- 4) goods and services in question are both from the highly technical medical field, where consumers are expected to exercise a heightened level of care; and
- 5) absence of instances of confusion for nearly two decades confirms that consumers are unlikely to be confused.

1. The Dominant Portion AMERICAN SURGICAL and SURGICAL SPECIALTIES is Significantly Different to Avoid Likelihood of Confusion

The Board has repeatedly held that more weight can be given to a particular, dominant feature of a mark, provided that the ultimate conclusion rests on consideration of the marks in their entireties. *See, e.g., Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 U.S.P.Q.2d 1783 (T.T.A.B. 2006). As consumers are more inclined to focus on the first portion of the mark, the first portion is generally the dominant portion of the mark. *See, e.g., Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (“[It is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”). Furthermore, disclaimed matter will not generally constitute the dominant portion of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 U.S.P.Q.2d 1699, 1702 (T.T.A.B. 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression....”).

In this case, the dominant portion of the cited AMERICAN SURGICAL Marks is AMERICAN SURGICAL. The cited registrations include three registrations for the following logo:



As shown above, the dominant feature is the first portion of the mark, AMERICAN SURGICAL, which is substantially larger and more prominent than the portion “Specialties Company,” located in small font and at a lower corner – in stark contrast to Applicant’s mark “SURGICAL SPECIALTIES.”

Furthermore, the registrant disclaimed the portion “SURGICAL SPECIALTIES COMPANY.” Therefore, given the disclaimer and the first and prominently displayed portion of the cited registrations, the dominant feature is indisputably AMERICAN SURGICAL.

Moreover, while the registrant also owns registrations for the word mark AMERICAN SURGICAL SPECIALTIES COMPANY, the registrant’s use of the mark shows that it holds itself out as “American Surgical.” For example, in the header to the “American Surgical” web site (*see* “AmSurg Web Header” submitted with Applicant’s Response April 30, 2014), the company holds itself out as “American Surgical,” with “Specialties Company” spaced apart, below, and separated by a horizontal line from the dominant portion of the mark. This usage carries through to the copy on the registrant’s web site, where it repeatedly truncates its house mark and name to “American Surgical” on the site when referring to itself (*see id.* “AmSurg Copy1,” “AmSurg Copy2” and “AmSurg Copy3”). As a result of this consistent formatting and usage, the consumer has grown to recognize and identify the registrant as AMERICAN SURGICAL. This prevents consumers from mistaking registrant with SURGICAL SPECIALTIES.

Therefore, not only are AMERICAN SURGICAL SPECIALTIES COMPANY and SURGICAL SPECIALTIES different in sight, sound, meaning, and commercial impression, the dominant portion of the cited marks AMERICAN SURGICAL is so distinct from SURGICAL SPECIALTIES that consumer confusion is unlikely. The only shared word is SURGICAL which has been disclaimed by both the registrant and Applicant. It is remarkable that the Examining Attorney, while apparently conceding that the dominant portion is AMERICAN SURGICAL (*see* Office Action May 15, 2014 at 5), fails to appreciate the significant differences between the AMERICAN SURGICAL and SURGICAL SPECIALTIES marks.

In sum, the two marks begin with different words; the logo versions of the two marks are drastically different in appearance; and the words that are shared between the two marks are descriptive and weak. Therefore, the marks are significantly different to avoid likelihood of confusion.

2. The Registrant's Mark AMERICAN SURGICAL SPECIALTIES COMPANY Is Weak and Only Entitled to a Very Narrow Scope of Protection

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. *Sure-Fit Products Co. v. Saltzon Drapery Co.*, 254 F.2d 158, 160, 117 U.S.P.Q. 295 (C.C.P.A. 1958) (marks SURE-FIT and RITE-FIT, both for slip covers, held not confusingly similar).

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. *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970). *See also Floss Aid Corp. v. John O. Butler Co.*, 205 U.S.P.Q. 274 (T.T.A.B. 1979) (marks FLOSSMATE and FLOSSAID, both for floss holders, held not confusingly similar due to the highly suggestive nature of the marks); *Wooster Brush*

Co. v. Prager Brush Co., 231 U.S.P.Q. 316 (T.T.A.B. 1986) (mark POLY FLO for paint brushes held not confusingly similar to opposer’s POLY PRO and EASYFLO marks for paint brushes and POLY-GLO mark for paint applicators due to the highly suggestive nature and common use of the terms POLY, PRO, FLO(W) and GLO(W) by paint brush manufacturers); *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953 (T.T.A.B. 2006) (marks BOX SOLUTIONS and Design and BOX and Design held not confusingly similar in connection with legally identical goods in part due to the highly suggestive nature of the common element BOX); *United Foods Inc. v. J. R. Simplot Co.*, 4 U.S.P.Q.2d 1172 (T.T.A.B. 1987) (mark QUICK ‘N CRISPY held not confusingly similar to QUICK ‘N CHEESY and other “QUICK ‘N” marks for various frozen vegetables due to the highly suggestive nature of the common elements); *Roux Laboratories, Inc. v. Kaler*, 214 U.S.P.Q. 134 (T.T.A.B. 1982) (marks HYPER-OXIDE and SUPEROXIDE, both for hair coloring solutions, held not confusingly similar due to inherent weakness of the marks); *Penn Dairies, Inc. v. Pennsylvania Agricultural Cooperative Marketing Assoc.*, 200 U.S.P.Q. 462 (T.T.A.B. 1978) (marks PENN BEST and PENSUPREME held not confusingly similar due to the laudatory nature of the suffixes and geographic significance of the prefixes); *Sunbeam Corp. v. Green Bay Tissue Mills, Inc.*, 199 U.S.P.Q. 695 (T.T.A.B. 1978) (marks PURE BREW and CLEAR BREW, both for coffee-making products, held not confusingly similar due to differences in sound and appearance in light of the highly suggestive nature of the marks); *In re Haddock*, 181 U.S.P.Q. 796 (T.T.A.B. 1974) (marks MINI-BASS and LIL’ BASS, both for fishing lures, held not confusingly similar despite synonymous meaning due to highly suggestive nature of the marks).

In this case, the record unequivocally establishes that the AMERICAN SURGICAL Marks are inherently weak marks. As discussed above, the registrant disclaimed SURGICAL SPECIALTIES COMPANY as being descriptive. Further, the remaining portion of the mark “AMERICAN” was deemed geographically descriptive and admitted by the registrant, as evidenced by the registrant’s amendment to assert acquired distinctiveness based on use since February 1997 under Lanham Act § 2(f). Indeed, the Examining Attorney in rejecting

Applicant's mark as being merely descriptive under Lanham Act § 2(e)(1) asserts that the terms SURGICAL SPECIALTIES are descriptive. 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 portion, AMERICAN SURGICAL, is sufficiently different from SURGICAL SPECIALTIES to preclude the likelihood of consumer confusion.

3. Differences in Applicant's Goods and Registrant's Services Reiterate the Distinct Commercial Impressions Created by the Respective Marks, and, Thus, Further Reduce the Likelihood of Confusion.

The nature and scope of a party's goods must be determined on the basis of the goods recited in the application or registration. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002); TMEP § 1207.01(a)(iii). Applicant's claimed goods are "medical devices, namely, surgical apparatus and instruments for medical, dental and/or veterinary use." In contrast, the registrant claims the following services for the six cited registrations: two registrations are for wholesale services, two registrations are for educational services, and two registrations are for maintenance and repair services. 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, which reinforces the distinct commercial impressions created by the respective marks. Moreover, the registrant does not even manufacture its own goods, but merely provides wholesale, educational, and repair and maintenance services.

Indeed, where similarities in marks stem only from highly suggestive or descriptive terms, it has been held on numerous occasions that marks that otherwise contain visual differences are not confusingly similar, even when used on *identical* goods. *See Sure-Fit Products Co. v. Saltzon Drapery Co.*, 254 F.2d 158, 117 U.S.P.Q. 295 (C.C.P.A. 1958) (marks SURE-FIT and RITE-FIT for slip covers); *Floss Aid Corp. v. John O. Butler Co.*, 205 U.S.P.Q. 274 (T.T.A.B. 1979) (marks FLOSSAID and FLOSSMATE for floss holders); *Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316 (T.T.A.B. 1986) (marks POLY FLO and POLY PRO

for paint brushes); *Roux Laboratories, Inc. v. Kaler*, 214 U.S.P.Q. 134 (T.T.A.B. 1982) (marks HYPER-OXIDE and SUPEROXIDE for hair coloring solutions); *Sunbeam Corp. v. Green Bay Tissue Mills, Inc.*, 199 U.S.P.Q. 695 (T.T.A.B. 1978) (marks PURE BREW and CLEAR BREW for coffee-making products); and *In re Haddock*, 181 U.S.P.Q. 796 (T.T.A.B. 1974) (marks MINI-BASS and LIL' BASS for fishing lures). Thus, where 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. As such, Applicant submits that differences in the recited goods and services further reduce the likelihood of consumer confusion.

4. Purchasers of Applicant's Medical Devices and the Cited Registrant's Wholesale, Educational, and Repair and Maintenance Services Exercise a Heightened Level of Care in Their Purchasing Decisions.

A relevant factor bearing on the likelihood of confusion issue is the conditions under which and buyers to whom sales are made. *DuPont*, 476 F.2d at 1361. In other words, circumstances suggesting care in purchasing decisions tend to minimize a likelihood of confusion. TMEP § 1207.01(d)(vii).

In *Hewlett-Packard Co. v. Human Performance Inc.*, 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991), the Board held that sophisticated medical equipment would be selected with great care by purchasers familiar with the source or origin of the products. *Citing In re N.A.D. Inc.*, 754 F.2d 996, 224 U.S.P.Q. 969, 971 (Fed.Cir.1985). Indeed, "[b]uyers of the parties' goods, as well as potential customers for the products, plainly are highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in its selection." *Hewlett-Packard*, 23 U.S.P.Q.2d at 1396.

In this case, Applicant's claimed goods are highly technical medical devices that are purchased by sophisticated consumers, while the 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. Accordingly, Applicant

submits that this factor, which the Examining Attorney has not considered, favors a finding that confusion is not likely.

5. Nearly Two Decades of Coexistence Without Any Reported Instances of Confusion Confirms that Consumers Are Unlikely to be Confused

In *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 U.S.P.Q.2d 1645, 1660 (T.T.A.B. 2010), *aff'd*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011), the Board held that absence of any reported instances of actual confusion is probative of whether confusion is likely. There, the marks in question were similar and the services were identical. The Board, however, held that if confusion was likely, then there would “be some reported instances of confusion or mistake as to source” *Id.* In this case, Applicant has been using the mark in connection with its services for at least eighteen years, while the record indicates that the registrant has been using its marks for about eighteen years. Applicant is not aware of any reported instances of actual confusion. Therefore, similar to *Citigroup*, here, absence of actual confusion over a lengthy duration confirms that confusion is unlikely. See *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 U.S.P.Q.2d 1404, 1406-1407 (T.T.A.B. 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 U.S.P.Q. 37, 48 (T.T.A.B. 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

B. Nearly Two Decades of Continuous and Substantially Exclusive Use Are Sufficient to Establish Acquired Distinctiveness

The Trademark rules provide that five years of continuous and substantially exclusive evidence 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.

IV. CONCLUSION

In sum, there is no likelihood of confusion when the marks are compared with appropriate weight given to the dominant portion of the marks. The cited AMERICAN

SURGICAL Marks are weak and entitled only to a narrow scope of protection. The differences in Applicant's recited goods and the registrant's recited services dispel any likelihood of confusion. The relevant purchasers of Applicant's goods and the registrant's services are highly sophisticated consumers, expected to exercise a heightened level of care in making purchasing decisions, which further dispels any likelihood of confusion. Further, the absence of any instances of actual confusion for a lengthy duration over which the marks have coexisted in the marketplace confirms that consumer confusion is unlikely. Finally, Applicant's use of its marks for nearly two decades is sufficient to establish acquired distinctiveness. Applicant therefore respectfully requests that the Board reverse the Examining Attorney's findings and approve Applicant's mark for publication.

Respectfully submitted,

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