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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215699
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No.: 85/806,379
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For the mark: HOLAIRA
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Boston Scientific Corp. and
Asthmatx, Inc.

Opposers,

v.

Opposition No. 91215699

Holaira, Inc.

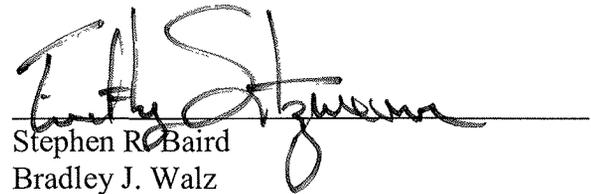
Applicant.

OPPOSERS' NON-CONFIDENTIAL TRIAL BRIEF

Respectfully submitted,

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DESCRIPTION OF THE RECORD

By operation of the Trademark Rules, the pleadings and the file of the subject application are of record. Opposers rely on their first Notice of Reliance consisting of Opposers' Certificates of Registration, Applicant's responses to Opposers' discovery, and third-party dictionary entries and website printouts. [Dkt. No. 12, Exs. 1–25.] Opposers also rely on a Second Notice of Reliance consisting of third-party website printouts. [Dkt. No. 23, Exs. 68–72, 77.]

The Parties entered into a stipulation that enabled the Parties to submit via affidavit the Expert Report of Dr. Nunberg and documents produced during discovery that were created either by Opposers, Applicant, or Applicant's marketing agency Six Degrees. [Dkt. No. 14, Ex. 26] Opposers rely on the First Affidavit of Opposers' counsel, which attached documents produced by Applicant during discovery. [Dkt. No. 14, Exs. 27–67.] The Parties entered into a stipulation that enabled Opposers to submit the Declaration of Narinder Shargill through an affidavit of counsel. [Dkt. No. 25, Ex. 73.] Opposers rely on the Second Affidavit of Opposers' Counsel, including the Declaration of Narinder Shargill. [Dkt. No. 25, Exs. 74–76.]

Opposers further rely on the testimonial depositions of Karen Passafaro, Boston Scientific Corp.'s Vice-President of Marketing, Endoscopy Division and of Matthew Sprague, Boston Scientific Corp.'s Controller, Endoscopy Division. [Dkt. No. 24]

Applicant submitted a Notice of Reliance consisting of printouts regarding third-party registrations, third-party website internet printouts, Opposers' responses to Applicant's discovery requests, and documents from prior proceedings before the Trademark Trial and Appeal Board ("Board"). [Dkt. Nos. 15–16, Exs. 1–81.] Applicant also submitted the Affidavit of Applicant's counsel, which included documents produced by Opposers during discovery. [Dkt. No. 20, Exs. 82–97.] Applicant also took a testimonial deposition of Dennis Wahr, Applicant's CEO. Applicant has not yet submitted the transcript of this testimonial deposition to the Board.

STATEMENT OF ISSUES

Whether Applicant's proposed HOLAIRA mark for "Medical devices for treating obstructive lung diseases; medical apparatus and instruments for treating obstructive lung diseases" is likely to cause confusion with Opposers' ALAIR[®] marks for "Medical therapeutic devices for use in the treatment of pulmonary diseases, namely, catheters, probes, generators, bronchoscopes, and electrodes" and "Training and teaching in the field of surgery and treatment of pulmonary diseases, namely training and teaching in the use and operation of medical devices for bronchial surgery or treatment, and distribution of course materials, namely printed materials and electronic media, in connection therewith."

INTRODUCTION

Over 15 years ago, Opposers developed the first medical device to treat obstructive lung diseases. Opposers named the device the ALAIR[®] Bronchial Thermoplasty System. Opposers' ALAIR[®] System has achieved significant commercial success. Opposers also have used the ALAIR[®] mark in connection with training and educational services. Opposers obtained registrations for the ALAIR[®] mark more than 10 years ago. They are now incontestable.

Applicant has begun to develop a medical device to treat obstructive lung diseases too. With full knowledge of Opposers' prior and incontestable registered rights in the ALAIR[®] mark, and after considering 37 possible alternative marks, Applicant decided to move forward with the only mark that raised internal flags because of the remarkable similarity to Opposers' ALAIR[®] mark, namely, Applicant's proposed HOLAIRA mark.

Both devices are designed to treat obstructive lung diseases. Applicant's proposed HOLAIRA mark incorporates the entirety of the ALAIR[®] mark and both share the same stressed LAIR syllable. Moreover, each of the coined marks has the same meaning, both have been coined to suggest the devices provide air to "all" or the "whole" of the lung. The marks are nearly phonetically identical and they are too visually similar to avoid a likelihood of confusion, especially because the goods, channels of trade, and classes of consumer are all identical.

Accordingly, registration of the HOLAIRA mark would create a likelihood of confusion with Opposers' previously registered ALAIR[®] mark.

STATEMENT OF FACTS

A. Opposers' Creation and Adoption of the ALAIR® Mark.

Opposers' predecessor, Bronchus Technologies Inc. ("Bronchus"), was founded as a start-up company to develop new device-based treatments for obstructive lung diseases, namely, emphysema and asthma. [Dkt. No. 22, Passafaro Dep. at 100:21–101:11.] One of the devices developed by Bronchus would later become the ALAIR® device, "the first device-based therapy" for severe asthma. [*Id.* at 173:18–24.]

In the late 1990s, Bronchus was conducting research and development into pre-clinical prototypes of medical devices for treatment of pulmonary diseases. [*Id.* at 10:6–14.] Around that time, Bronchus adopted the ALAIR® mark for a medical device designed to treat obstructive lung diseases. [*Id.* at 9:7–14.] As a name for this device, Bronchus coined the term ALAIR® from the two terms "all" and "air," connoting a commercial impression that the ALAIR® device constituted a permanent solution for asthma patients, opening up airways to allow the patient to breathe air into all parts of the lungs. [Dkt. No. 22, Passafaro Dep. at 9:15–24.] As a coined mark, consumers can pronounce the ALAIR® mark in multiple ways, but the natural pronunciation is uh-lair, with the primary stress on the second syllable, LAIR (phonetically written as /ə'ler/). [Dkt. No. 14, Ex. 27, Nunberg ¶ 16.]

Bronchus filed an intent-to-use application for the ALAIR® mark on December 3, 1999. [*Id.* at 9:25–10:3; Dkt. No. 12, Ex. 1.] The mark was first used in connection with the ALAIR® medical device and its components during clinical trials in or around 2000. [Dkt. No. 22, Passafaro Dep. at 10:4–14.] The ALAIR® mark has been continuously used from that time to the present. [*Id.*]

Around the year 2002, Bronchus was split into two companies: Bronchus continued to develop the emphysema product and Opposer Asthmatx, Inc. ("Asthmatx") was created to

further develop the asthma product, the ALAIR[®] device. [*Id.*] The application matured into Registration No. 2,856,168, with the Certificate of Registration issuing on June 22, 2004. [Dkt. No. 12, Ex. 1.] The ALAIR[®] mark is registered on the Principal Register in connection with “medical therapeutic devices for use in the treatment of pulmonary diseases, namely, catheters, probes, generators, bronchoscopes, and electrodes” (“Opposers’ Goods”) in International Class 10. [*Id.*] Registration No. 2,856,168 has since become incontestable. [*Id.*, Exs. 1, 3.]

Asthmatx also began use of the ALAIR[®] mark in connection with medical training services during clinical trials for the ALAIR[®] device, around the year 2000. [Dkt. No. 22, Passafaro Dep. at 14:9–17.] The ALAIR[®] mark has been continuously used in connection with these training services since that time. [*Id.* at 13:6–15:1.] Asthmatx filed a service mark application on October 11, 2006 for its ALAIR[®] mark in connection with “training and teaching in the field of surgery and treatment of pulmonary diseases, namely training and teaching in the use and operation of medical devices for bronchial surgery or treatment, and distribution of course materials, namely printed materials and electronic media, in connection therewith,” (“Opposers’ Services”) which matured into Registration No. 3,380,080 on February 12, 2008. [*Id.*, Ex. 2.] Registration No. 3,380,080 has since become incontestable. [*Id.*, Ex. 4.]

In 2010, Opposer Boston Scientific Corp. (“Boston Scientific”) acquired Asthmatx along with all rights in and to the ALAIR[®] device and trademark. [*Id.* at 10:15–25.]

B. The ALAIR[®] Device.

At the time Opposers developed the ALAIR[®] device, they created “a whole new category to treat severe asthma, the first device-based therapy, and so the procedure was coined Bronchial Thermoplasty.” [Dkt. No. 22, Passafaro Dep. at 174:16–175:8.] Bronchial Thermoplasty “was delivered by the Alair[®] System.” [*Id.*] Opposers “chose to link the Alair Bronchial Thermoplasty

System together.” [*Id.* at 176:25–177:9.] “The Alair[®] System is a very strong product name . . . and then Bronchial Thermoplasty was the new category of the procedure to treat asthma, and [Opposers] were the first and only treatment.” [*Id.*]

The ALAIR[®] device consists of a controller/generator, a catheter, a bronchoscope, and electrodes. [*Id.* at 11:1–22.] The controller delivers RF energy from the controller through the catheter and bronchoscope, to the lung. [*Id.*] “The system uses targeted thermal ablation to reduce airway smooth muscle.” [Dkt. No. 13, Sitzmann Aff. at Ex. 28.]

Asthma is considered both a pulmonary disease and an “obstructive lung disease.” [Dkt. No. 12, at Exs. 20, 21, 22, 25.] In fact, chronic obstructive pulmonary disease (“COPD”) is commonly known as an “umbrella term for a group of usually progressive lung disorders with overlapping signs and symptoms, including asthma, bronchiectasis, chronic bronchitis, and emphysema.” [Wahr Dep.,¹ Opp. Ex. 8 at p. 5.] The symptoms of COPD and asthma often overlap. [Dkt. No. 25, at Ex. 74, Shargill Decl. ¶ 3.] “[COPD] is that large catchall, if you will. So an asthma patient could develop COPD, or a constant constriction of their airway, because of having asthma for so many years. So that’s an asthma patient with a COPD crossover.” [Dkt. No. 22, Passafaro Dep. at 181:9–20.] The medical community has coined a new term for this overlap, “Asthma-COPD Overlap Syndrome” (“ACOS”), and has utilized this term in researching, diagnosing, and treating obstructive lung diseases. [*Id.* at 181:9–20, 184:18–24; Dkt. No. 23, Exs. 68, 69, 70; Dkt. No 25, at Ex. 74, Shargill Decl. ¶ 3.]

The ALAIR[®] device is approved by the U.S. Food and Drug Administration (“FDA”) for the treatment of adults with severe asthma. [Dkt No. 22, Passafaro Dep. at 12:6–13; 17:13–19.] Opposers currently have “no direct competitors in the device business for severe asthma.” [*Id.* at

¹ Applicant has not yet filed the transcript of Mr. Wahr’s deposition with the Trademark Trial and Appeal Board, thus Opposer is unable to provide a docket number.

18:2–4.] Pharmaceuticals do not compete with the ALAIR[®] device, nor are pharmaceuticals marketed in the same channels. [*Id.* at 166:15–23, 172:11–19.] The only potentially competitive product is the device under development by Holaira, Inc. [Dkt. No. 22, Passafaro Dep. at 18:2–14.]

C. Opposers’ Marketing of the ALAIR[®] Device.

Opposers initially used the ALAIR[®] mark as part of their clinical trials. [Dkt. No. 22, Passafaro Dep. at 10:4–14.] During this period, Opposers focused on marketing toward physicians who could perform the procedure. [*Id.* at 16:3–20.] Opposers next focused on marketing toward physicians who might refer patients to an asthma center. [*Id.* at 16:11–20.] After making the general physician community aware of the ALAIR[®] Bronchial Thermoplasty System, Opposers began to focus more heavily on marketing directly toward patients. [*Id.* at 16:15–20.]

Opposers have marketed and continue to market the ALAIR[®] Bronchial Thermoplasty System and procedure toward clinics, doctors, and patients in a number of different ways. Among these efforts, Opposers market the ALAIR[®] device through direct-to-physician communications, direct sales forces, trade shows, symposia, physician lecture dinner meetings, and through the use of consultant physicians for peer-to-peer educational efforts. [*Id.* at 15:13–24, 23:17–24:2.] Opposers also advertise in trade journals as well as encourage physicians “to publish case studies and case series about their procedures and their results.” [Dkt. No. 22, Passafaro Dep. at 33:18–34:9.] Since 2010 through the present, Opposers have attended four major trade shows on an annual basis, including the American College of Chest Physicians, the American Thoracic Society, the American Academy of Asthma Allergy and Immunology, and the American College of Allergy, Asthma, and Immunology. [*Id.* at 38:11–39:3.] These trade

shows have a large attendance, with approximately 15,000 to 21,000 total attendees. [*Id.* at 40:3–11.] Opposers also attend regional meetings, such as the Florida Allergy Society and the Greater Cleveland Allergy Society. [*Id.* at 39:4–8.] With regard to regional events, Opposers attend between 40 and 60 events per year. [*Id.* at 39:18–25.]

Opposers also have made direct-to-patient advertising a primary focus of their marketing of the ALAIR[®] Bronchial Thermoplasty device and procedure. [Dkt. No. 22, Passafaro Dep. at 25:6–19.] These marketing efforts include television, radio, digital advertising, and print media. [*Id.* at 15:13–21, 24:2–9.] Opposers have created patient testimonial videos, DVDs, a television commercial, websites, flyers, brochures, and other print material, all designed specifically for patients. [*Id.*, at 25:9–19, 35:5–37:5, 41:3–24, 45:15–23, Opp. Exs. 3, 4, 5.] Opposers distribute these patient materials at events such as patient health fairs, round tables, asthma walks, town hall style meetings, and other patient events to advertise the ALAIR[®] Bronchial Thermoplasty System and procedure. [Dkt. No. 22, Passafaro Dep. at 36:1–23, 96:12–18, Opp. Ex. 3; Dkt. No. 17, Ex. 79 p. 6.] Many of these marketing materials have been made available in Spanish for Opposers' Spanish-speaking patients. [*Id.* at 53:9–54:5.]

The patient-centered marketing materials direct patients to visit Opposers' website to find out more about ALAIR[®] Bronchial Thermoplasty System and treatment. [Dkt. No. 22., Passafaro Dep. at 36:24–37:5.] The website includes additional marketing materials, information, brochures, and videos regarding obstructive lung disease, alternative treatment options, information about the ALAIR[®] device, and about Bronchial Thermoplasty. [*Id.* at 36:24–37:5, 51:24–52:21, Opp. Exs. 5, 6, 7.] Opposers' website also includes a survey tool marketed directly to potential patients to evaluate whether they are a candidate for the ALAIR[®] Bronchial Thermoplasty treatment. [Dkt. No. 22, Passafaro Dep. at 48:11–49:18.] The result of

the survey is a printout branded with the ALAIR[®] mark that a patient can bring to their regular physician to request Alair[®] Bronchial Thermoplasty. [*Id.* at 50:1–52:15.] The website also provides additional information regarding Opposers’ procedure, including contact information for physicians and clinics that perform the procedure. [*Id.* at 51:1–55:15.]

Over the last ten years, Opposers [REDACTED] [REDACTED] [Dkt. No. 22, Passafaro Dep. at 21:18–22:23, Opp. Exs. 1, 2.] In 2014, [REDACTED] [*Id.* at Opp. Ex. 2.] In total, Opposers [REDACTED] [*Id.* at Opp. Exs. 1, 2.]

As a result of this significant investment, the ALAIR[®] Bronchial Thermoplasty System and procedure has received significant press, having been featured on *Good Morning America*, the *CBS Morning Show*, in the *Wall Street Journal*, *San Francisco Chronicle*, and the *New York Times*. [Dkt. 22, Passafaro Dep. At 56:7–57:2.] In 2006, Opposers’ ALAIR[®] device was featured in the magazine *Popular Science* as an “Innovation of the Year.” [Dkt. No. 12, Ex. 16.] In 2014 alone, the ALAIR[®] System received more than 400 instances of media coverage. [Dkt. 22, Passafaro Dep. at 57:6–19.] In that same year, Opposers’ <www.BTforAsthma.com> website received more than 300,000 visitors. [Dkt. No. 22, Passafaro Dep. at 51:24–52:1.]

D. The Market for Opposers’ ALAIR[®] Bronchial Thermoplasty System and Treatment.

The market for Opposers’ ALAIR[®] Bronchial Thermoplasty System and treatment includes “physicians and patients.” [Dkt. No. 22, Passafaro Dep. at 33:18–22.] Opposers’ market also includes hospitals, clinics, referring doctors, and other health care professionals and entities. [Dkt. No. 17, Ex. 79 p. 6.] The customer base consists of the health care entities and clinics where the procedure is performed, pulmonologists who would perform the procedure, doctors or

physicians who might refer their patients to a pulmonologist and, most importantly, the prospective patients because they are the individuals who make “the ultimate decision as to whether to purchase the treatment offered.” [*Id.*]

Another customer base includes the insurance companies and medical societies that control the ability and willingness of insurance companies to provide coverage and reimbursement for medical treatment. [Dkt. No. 22, Passafaro Dep. at 30:9–31:15.] New medical procedures must obtain FDA approval, be proven safe and effective, and then convince the American Medical Association (“AMA”) to issue approval codes. [*Id.* at 30:20–31:21.] Opposers invested significant sums in marketing the ALAIR[®] Bronchial Thermoplasty device and procedure. [Dkt. No. 24, Passafaro Dep. Opp. Exs. 1, 2.] By late 2012, more than 100 centers offered ALAIR[®] Bronchial Thermoplasty and the AMA issued its approval code in early 2013. [*Id.* at 32:15–21.] Name recognition is important to obtaining greater reimbursement; for that reason, Opposers “continue to work with the [medical] societies to get a stronger society support and stronger endorsement by every society, both the thoracic and the allergy, and [Opposers] think that over time if [Opposers] get more of these societies to come together to support it, that the payers will start, too.” [*Id.* at 33:7–17.]

Since becoming commercially available in 2010 through the first quarter of 2015, Opposers ██████████ under its ALAIR[®] mark. [*Id.* at Opp. Ex. 8.] Most recently from 2012 through 2014, Opposers ██████████ under its ALAIR[®] mark. [*Id.*]

E. Applicant’s Adoption of the HOLAIRA Mark.

Holaira, Inc. (“Applicant”) was originally founded in 2008 under the name Innovative Pulmonary Solutions, Inc. (“IPS”). [Wahr Dep. at 13:14–23.] IPS was founded in 2008 with the

goal of developing a device-based treatment for obstructive lung diseases. [Dkt. No. 14, Ex. 31 at pp. 3–4.]

In September 2012, IPS hired Dennis Wahr as its CEO. [Wahr Dep. at 13:5–6; 13:24–14:5.] Shortly after joining IPS, Mr. Wahr determined that IPS should change its name. [*Id.* at 27:22–28:8.] IPS hired a marketing consultant, Lorraine Marshall Wright, and third-party marketing agency Six Degrees to assist in the development of a new name and trademark. [*Id.* at 29:19–30:2.]

Throughout the renaming process, IPS was aware of Opposers’ use of the ALAIR[®] mark in connection with Opposers’ Goods. [Wahr Dep. at 106:21–25; Dkt. No. 12, Ex. 5.] In a

[REDACTED] [Dkt. No. 14, Ex. 28 at

p. 8.] IPS informed Six Degrees that [REDACTED]

[REDACTED] [*Id.*, Ex. 39 at p. 3.] IPS provided Six Degrees with ALAIR[®] marketing materials in order to assist in the naming process. [*Id.*] Six Degrees ultimately provided IPS with 38 different choices, the HOLAIRA mark was the only choice that contained the letter string LAIR. [Dkt. No. 14, Ex. 33 at p. 16.]

Six Degrees conceived the HOLAIRA mark as meaning “the whole lung.” [Dkt. No. 14, Ex. 33 at p. 11.] Applicant’s CEO stated that the name resonated with IPS because the device could treat “all the airways, the whole thing, the whole lung.” [Wahr Dep. at 40:6–13.] Like the ALAIR[®] mark, the HOLAIRA mark’s primary stressed syllable is the second syllable, LAIR. [Dkt. No. 14, Ex. 27, Nunberg ¶ 14.] The natural pronunciation of the mark would be huh-lair-uh, written phonetically as /hə’lerə/. [*Id.*] However, it is often difficult to hear an initial ‘H’

sound, especially among Spanish speakers where the ‘H’ is silent. [Dkt. No. 24, Ex. 27, Nunberg ¶¶ 15, 18.]

[REDACTED] [Dkt. No. 14, Exs. 43, 44, 61.] [REDACTED]

[REDACTED] [Id., Exs. 41, 43, 45.]

Before IPS decided to move forward with the HOLAIRA mark, [REDACTED]

[REDACTED] [Id., Ex. 41.] IPS decided on HOLAIRA later that day. [Dkt. No. 14, Exs. 43, 44, 61.]

Shortly thereafter, Six Degrees began developing marketing materials for the HOLAIRA mark at least as early as [REDACTED] including messaging blueprints, logos, and website content. [Id., Exs. 46, 47, 48, 49, 50.] Applicant’s marketing plan mimicked Opposers’ marketing plan for the ALAIR[®] System. Just as Opposers created a new procedure name—Bronchial Thermoplasty—Applicant created “Targeted Lung Denervation.” [Dkt. No. 22, Passafaro Dep. at 178:25–179:4; Wahr Dep. at 90:21–92:6.] Second, similar to Opposers’ marketing of the Alair[®] Bronchial Thermoplasty System, Applicant plans to market its product as the “Holaira Lung Denervation System.” [Dkt. No. 22, Passafaro Dep. at 11:1–12, 50:1–14, 114:2–5; Wahr Dep. at 14:8–15:1.] Third, just like Opposers, Applicant plans to emphasize the name of the procedure in its marketing of the HOLAIRA system, having already purchased the domain names for the procedure, including TLDPROCEDURE.com. [Dkt. No. 14, Ex. 48.]

As early as [REDACTED] IPS was preparing its plan to roll out the new HOLAIRA mark. [Dkt. No. 14, Ex. 50.] On that same day, Six Degrees shared the proposed designs for the

HOLAIRA logo. [Dkt. No. 14, Exs. 36, 52, 53.] By that time, Six Degrees had [REDACTED]

[REDACTED] of the HOLAIRA mark. [*Id.*, Exs. 54, 55, 56, 57, 58.]

On December 19, 2012, IPS filed an intent-to-use application for the HOLAIRA mark in connection with “medical devices for treating obstructive lung diseases; medical apparatus and instruments for treating obstructive lung diseases” (“Applicant’s Goods”). [Applicant’s Application.] Applicant stated that it has no intention of amending or clarifying this description. [Wahr Dep. at 74:4–13.] On January 28, 2013, IPS changed its name to Holaira, Inc. [*Id.*] Applicant did not use the HOLAIRA mark (“Applicant’s Mark”) prior to the application filing date of December 19, 2012. [Dkt. No. 12, Ex. 6.]

F. Applicant’s Medical Device.

Applicant developed a “therapeutic device for treating obstructive lung diseases.” [Dkt. No. 14, Ex. 31 p. 4.] The device consists of a console delivering RF energy, a catheter, bronchoscope, and electrode. [Dkt. No. 14, Ex. 28 at p. 9.] The device “[e]mploys RF energy to ablate the nerve input to the lungs[.]” [Dkt. No. 14, Ex. 30 at p. 2.] “[T]he ALAIR[®] System and the HOLAIRA system . . . are virtually identical: both use a bronchoscope, catheter, and RF Controller and both use RF energy in the bronchial tubes. The only differences are the amount of energy used during the respective procedures and the location within the lungs where the energy is applied.” [Dkt. No. 24, Ex. 74, Shargill Decl. ¶ 8.]

Applicant’s identification of goods description is broad enough to encompass devices, apparatus, and instruments to treat asthma, emphysema, the broader COPD diagnosis, and all other obstructive lung diseases. [Applicant’s Application.] Applicant is currently seeking an FDA indication for “patients with moderate to severe COPD.” [Wahr Dep. at 53:2–5.] However,

Applicant's device is "[n]ot approved for use" or "commercial sale." [Wahr Dep. at 49:16–19.]
Applicant has "no US clinical sites yet." [Wahr Dep. at 56:24–25.]

In fact, Applicant considered Opposers' ALAIR[®] Bronchial Thermoplasty System to be a competitive device. [Dkt. No. 14, Ex. 28 at p. 8, Ex. 30 p. 12, Ex. 32 at pp. 39–43, Ex. 38.]

Applicant informed [REDACTED]

[REDACTED] [Dkt. No. 14, Ex. 30 at p.

1.] Applicant forecasted a [REDACTED] [*Id.* Ex. 30

at p. 11.] In this presentation, Applicant [REDACTED]

[REDACTED] as shown on the slide below:

IMAGE REDACTED

[Dkt. No. 14, Ex. 30 at p. 12.²] Applicant’s CEO stated “could our device eventually at some point be used to treat asthma? The answer is yes[.]” [Wahr Dep. at 99:1–5; 81:12–82:3.]

G. Applicant’s Marketing Plans for the HOLAIRA Device.

Applicant’s device is “[n]ot approved for use” or “commercial sale.” [Wahr Dep. at 49:16–19.] Nevertheless, Applicant identified its target segments for brand positioning as interventional pulmonologists, pulmonologists, primary care physicians, investors, hospital administrators, payers, the FDA, patients, caregivers, and employees. [Dkt. No. 14, Ex. 33 at p. 5.] In its messaging blueprint, Applicant included consumers, specifically patients and caregivers. [*Id.*, Ex. 34 at p. 3.] Applicant even crafted a specific three-part “Consumer Message.” [*Id.* at p. 8; *see also id.*, Ex. 3 at p. 1.]

ARGUMENT

I. OPPOSERS HAVE ESTABLISHED STANDING AND PRIORITY

Opposers have made the pleaded registrations of record. [See Dkt. No. 12, Exs. 1, 2.] Therefore, Opposers have established standing to oppose the application. *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000).

Applicant’s application for the proposed HOLAIRA mark was filed on an intent-to-use basis and Applicant admitted that it has not used the HOLAIRA mark in commerce. [Applicant’s Application; Dkt. No. 12, Ex. 6.] The registration date of Opposers’ Registration No. 2,856,168 is June 22, 2004 and the registration date of Registration No. 3,380,080 is February 12, 2008, both of which predate Applicant’s application filing date of December 19, 2012. [*Compare* Applicant’s Application *with* Dkt. No. 12, Exs. 1, 2.] Opposers have therefore

² Although the slide was identified as “Holaira Confidential” in 2013, Applicant produced this document without any confidentiality designation, and the presentation was displayed at a Piper Jaffray conference. [Wahr Dep. 87:24–25.] Out of an abundance of caution, Opposers have redacted this chart.

established priority to use the ALAIR[®] mark in connection with “medical therapeutic devices for use in the treatment of pulmonary diseases, namely, catheters, probes, generators, bronchoscopes, and electrodes” and “training and teaching in the field of surgery and treatment of pulmonary diseases, namely training and teaching in the use and operation of medical devices for bronchial surgery or treatment, and distribution of course materials, namely printed materials and electronic media, in connection therewith.” *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974).

II. APPLICANT’S PROPOSED HOLAIRA MARK IS LIKELY TO CAUSE CONFUSION WITH OPPOSERS’ ALAIR[®] MARK

Section 2(d) of the Lanham Act prohibits registration of a mark on the Principal Register that would create a likelihood of confusion. 15 U.S.C. § 1052(d). The evidentiary factors the Board considers in determining a likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). These factors include, among others, the similarity of the marks, relatedness of the goods and/or services, overlapping channels of trade and classes of purchasers for the goods and/or services, the strength of the senior user’s mark, and the intent of the junior user. *Id.* The relevance and weight to be given the various factors may differ from case to case, and the Board is not required to consider every *du Pont* factor. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004). Nevertheless, key considerations are the similarities between the marks and the relatedness of the goods recited in the parties’ registration and application. *Mattel Inc. v. Funline Merch. Co.*, 81 U.S.P.Q.2d 1372, 1374 (T.T.A.B. 2006). The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. *See In re Majestic Distilling Co.*, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003).

The *du Pont* factors for which there is evidentiary support are the: (1) similarity of the marks; (2) relatedness of the goods; (3) overlapping channels of trade; (4) overlapping class of consumers; (5) overall strength of Opposers' ALAIR[®] marks; and (6) the intent of the junior user. Consideration of the relevant *du Pont* factors demonstrates that Applicant's HOLAIRA mark is likely to cause confusion with Opposers' ALAIR[®] marks.

In determining whether likelihood of confusion exists, all doubts must be resolved in favor of the senior user. *Nina Ricci S.A.R.L. v. E.T.F. Enter., Inc.*, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989). This is because the newcomer has the opportunity of avoiding confusion and is charged with the obligation to do so. See *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993); *In re G.B.I. Tile & Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1372 (T.T.A.B. 2009).

Importantly, evidence regarding actual marketplace use of the marks, current offering of goods or services, or any restrictions on channels of trade or class of consumers is all irrelevant if such restrictions are not set forth in the applications and registrations at issue. *Stone Lion Capital Partners v. Lion Capital LLP*, 110 U.S.P.Q.2d 1157, 1163 (Fed. Cir. 2014). Indeed, “[i]t would make little sense for the Board to consider only the parties current activities when the intent-to-use application, not current use, determines the scope of this post-grant benefit. Parties that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application.” *Id.*; *Octocom Sys., Inc. v. Houston Comp. Servs. Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990).

A. The ALAIR[®] and HOLAIRA Marks Create Similar Overall Commercial Impressions.

The HOLAIRA mark is identical in meaning, nearly identical in sound, and is too visually similar to avoid a likelihood of confusion. To determine whether the marks are similar for purposes of assessing the likelihood of confusion, the Board considers the sight, sound, and

meaning to compare the commercial impression of each mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005).

When the goods at issue are identical or closely related, as they are here, less similarity between the marks is necessary to support a finding of likelihood of confusion. *In re Mighty Leaf Tea*, 94 U.S.P.Q.2d 1257, 1260 (Fed. Cir. 2010). Opposers' Goods are identical to Applicant's Goods, therefore less similarity between the marks is necessary to support a finding of a likelihood of confusion. [Applicant's Application; Dkt. No. 12, Exs. 1, 2.]; *see also In re Mighty Leaf Tea*, 94 U.S.P.Q.2d at 1260. Additionally, strong marks are given protection over a greater spectrum of variations in visual format. *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). Opposers' ALAIR[®] mark is strong and therefore entitled to broader protection over wider variations in visual formats. *See id.*

1. The ALAIR[®] and HOLAIRA marks have identical meanings.

The HOLAIRA and ALAIR[®] marks are both coined terms suggesting the same meaning. If "both marks are coined terms that look alike and sound alike, and there are no known differences in the meaning to distinguish them, the marks engender a similar commercial impression." *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1741 (T.T.A.B. 2014) (finding IKEA and AKEA to create similar overall commercial impressions). Here, both marks are coined terms without known, distinctive meanings, which "renders confusion more likely." *E.I. du Pont de Nemours and Co. v. Yoshida Int'l Inc.*, 185 U.S.P.Q. 597, 604 (E.D.N.Y. 1975) (TEFLON and EFLON).

Opposers' ALAIR[®] mark is a coined term derived from the words 'all' and 'air.' Applicant's mark is a combination of the terms 'whole' and 'air.' The terms 'all' and 'whole' are synonyms. [Dkt. No. 12, Exs. 8, 9, 12, 13.] The ALAIR[®] mark connotes the idea of providing

air to all of the lung; the HOLAIRA mark connotes the idea of providing air to the whole lung. Applicant's own CEO used the two phrases interchangeably, stating that he chose the HOLAIRA mark because it suggested the device could open "all the airways, the whole thing, the whole lung." [Wahr Dep. at 40:6–13.] Accordingly, the ALAIR[®] and HOLAIRA marks have the very same meaning.

2. The ALAIR[®] and HOLAIRA marks are nearly identical in sound.

"There is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Indus., Inc. v. Spartan Chem. Co., Inc.*, 77 U.S.P.Q.2d 1698, 1701 (T.T.A.B. 2006); T.M.E.P. § 1207.01(b)(iii). Similarity in sound can be so substantial that it "outweighs any differences in appearance and meaning." *Centraz Indus., Inc.*, 77 U.S.P.Q.2d at 1701; *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985) (finding HUGGIES and DOUGIES to be confusingly similar).

Applicant's HOLAIRA mark incorporates the entirety of Applicant's ALAIR[®] mark. Applicant has transposed the initial letter A- of Opposers' ALAIR[®] mark to the end of Applicant's HOLAIRA mark and merely added the largely silent letters HO- to the beginning. These minor changes have little effect on the pronunciation of the marks. [Dkt. No. 13, Ex. 27 Nunberg ¶¶ 15, 18.]

The letter 'H' at the beginning of Applicant's HOLAIRA mark is not likely to be pronounced. "Slight differences in the sound of similar marks do not avoid the likelihood of confusion." *In re Energy Telecomms'ns & Elec. Assoc.*, 222 U.S.P.Q. 350, 352 (T.T.A.B. 1983) (finding ENTELEC & Design to create a similar overall commercial impression as INTELECT). The letter H is merely an "aspirating" sound that is often suppressed. [Dkt. No. 13, Ex. 27

Nunberg ¶¶ 15, 18.] This is particularly true for Spanish speakers—or English speakers who are familiar with the Spanish word “hola”—because the letter ‘h’ is silent when it appears at the beginning of a Spanish word. [*Id.* ¶ 18.] Accordingly, the letter H fails to provide any phonetic difference between the two marks. *See In re Energy Telecommc’ns & Elec. Assoc.*, 222 U.S.P.Q. at 352 (disregarding the additional letter ‘T’ because it “is discernible only if the mark is perfectly pronounced”).

The natural placement of the primary stressed syllables causes Applicant’s HOLAIRA mark to be nearly identical in sound to Opposers’ ALAIR[®] mark. The structure of the English language requires “every multisyllabic word” to have one primary stressed syllable, with the remaining syllables reduced to unstressed vowels, represented phonetically as the symbol /ə/. [Dkt. No. 13, Ex. 27 Nunberg ¶ 13.] The natural pronunciations of ALAIR[®] and HOLAIRA place the primary stress on the same syllable, –LAIR–. [*Id.* ¶¶ 14, 16.] As a result, when the two marks are pronounced naturally, “HOLAIRA and ALAIR[®] are actually near-homonyms, distinguished only by the presence of the unstressed final /ə/, which is itself often difficult to discern before a following vowel.” [*Id.* ¶ 17.] Because the natural pronunciation is a reasonable pronunciation, if not the most likely pronunciation, “there is no salient phonetic feature that makes the two names clearly distinct.” [*Id.*] The two marks are therefore highly similar in sound.

3. The ALAIR[®] and HOLAIRA marks are visually similar.

Opposers’ ALAIR[®] mark and Applicant’s HOLAIRA mark share the syllable LAIR. The LAIR syllable is the primary stressed syllable of both Opposers’ ALAIR[®] and Applicant’s HOLAIRA mark. [*Id.* ¶¶ 14, 16.] “People are more likely to pay attention to stressed syllables than to unstressed ones.” [*Id.* ¶ 19] This tendency explains why some words are commonly shortened, such as “raccoon” to “coon,” “opossum” to “possum,” and “because” to “cause.”

[*Id.*] Accordingly, the fact that Applicant’s HOLAIRA mark shares the same, primary stressed LAIR syllable as Opposers’ ALAIR[®] mark establishes that the marks are visually similar. [*Id.*]

Further, Applicant’s HOLAIRA mark incorporates the entirety of Opposers’ ALAIR[®] mark. Applicant has merely transposed the initial letter ‘A’ to the end of the mark. Applicant’s use of the letter string HO- fails to distinguish the two marks. Indeed, unstressed syllables are often dropped by speakers, as noted in the examples above. Further, “[u]nstressed syllables are more prone to typing errors and misspellings than stressed syllables and more likely to be misidentified and misremembered.” [*Id.* ¶ 20.] Accordingly, consumers are apt to misidentify and misremember the HO- portion, especially because the HO- portion is likely to be pronounced in the same manner as the A- portion of Opposers’ ALAIR[®] mark.

4. The ALAIR[®] and HOLAIRA marks create similar overall commercial impressions.

The similarities in sight, sound, and meaning between the ALAIR[®] and HOLAIRA marks are too significant to avoid a likelihood of confusion. This is especially true because, as discussed in more detail below, the ALAIR[®] mark is strong, the goods are identical, the channels of trade overlap, and the goods are directed to the same classes of consumers. *See Jules Berman & Assoc., Inc. v. Consol. Distilled Prods., Inc.*, 202 U.S.P.Q. 67, 70–71 (T.T.A.B. 1979) (finding CHULA and KAHLUA to be confusingly similar when used in connection with identical goods); *Yamaha Int’l Corp. v. Stevenson*, 196 U.S.P.Q. 701, 703 (T.T.A.B. 1977) (finding a likelihood of confusion between YAMAHA and MAKAHA in connection with identical goods). Therefore, the similarity of the marks factor strongly favors Opposers.

B. Applicant's Goods Are Identical to Opposers' Goods, and Closely Related to Opposers' Services.

1. Opposers' Goods and Applicant's Goods are identical.

The identification of goods descriptions for the Application and Opposers' Reg. No. 2,856,168 are identical. The nature and scope of a party's goods must be determined on the basis of the goods recited in the application or registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002); 15 U.S.C. § 1115(a) ("Any registration . . . shall be prima facie evidence . . . of the registrant's exclusive right to use the registered mark in commerce on or in connection with **the goods identified in the registration**") (emphasis added). Opposers' Goods as identified in the goods description set forth in Opposers' Registration No. 2,856,168 is "medical therapeutic devices for use in the treatment of pulmonary diseases, namely, catheters, probes, generators, bronchoscopes, and electrodes." [Dkt. No. 12, Ex. 1.] Applicant's Goods are identified in the application as "[m]edical devices for treating obstructive lung diseases; medical apparatus and instruments for treating obstructive lung diseases." [Applicant's Application.]

When the identification of goods description identified in an Opposers' registration is broad enough to encompass the goods identified in the opposed application, "the legal effect of this fact is that the goods . . . are to be considered the same for the opposition." *Int'l Paper Co. v. Valley Paper Co.*, 175 U.S.P.Q. 704, 705 (C.C.P.A. 1972). Here, the identification of goods description set forth in Opposers' Reg. No. 2,856,168 is broad enough to encompass Applicant's Goods. Both Applicant's Goods and Opposers' Goods are "medical devices." [Dkt. No. 12, Ex. 1; Applicant's Application.] Opposers' medical devices are used in the treatment of "pulmonary diseases" while Applicant's Goods are used for treatment of "obstructive lung diseases." [*Id.*]

“Pulmonary” is defined as “relating to the lungs.”³ Accordingly, “obstructive lung diseases” are a subset of “lung diseases” and therefore Opposers’ Goods are identical to Applicant’s Goods.

Further, Applicant’s medical apparatus and instruments are also identical to Opposers’ medical devices. The terms “apparatus” and “device” are synonyms. [Dkt. No. 12, Exs. 10, 11.] Opposers’ devices treat “pulmonary diseases,” which includes all lung diseases, including obstructive lung diseases. Therefore, Opposers’ medical devices for the treatment of pulmonary diseases are also identical to Applicant’s medical apparatus and instruments for the treatment of obstructive lung diseases. As a result, the relatedness of the goods factor strongly favors Opposers.

2. Opposers’ Services are closely related to Applicant’s Goods.

“It is well recognized that confusion in trade is likely to occur from the use of similar or the same marks for goods and products on the one hand and for services involving those goods and products on the other.” *Steelcase Inc. v. Steelcare Inc.*, 219 U.S.P.Q. 433, 436 (T.T.A.B. 1983); T.M.E.P. § 1207.01(a)(ii). Often the goods are complementary, with one party’s goods utilized in the other party’s services. *Steelcase Inc.*, 219 U.S.P.Q. at 436.

Here, Opposers’ Services, as identified in the services description in the registration, are “[t]raining and teaching in the field of surgery and treatment of pulmonary diseases, namely training and teaching in the use and operation of medical devices for bronchial surgery or treatment, and distribution of course materials, namely printed materials and electronic media, in connection therewith.” [Dkt. No. 12, Ex. 2.] Applicant’s Goods, as set forth in the Application,

³ See Merriam-Webster’s online dictionary entry available at <http://www.merriam-webster.com/dictionary/pulmonary>. The Board may take judicial notice of this definition pursuant to T.B.M.P. § 704.12. *Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385, 1393 (T.T.A.B. 1999)

are “[m]edical devices for treating obstructive lung diseases; medical apparatus and instruments for treating obstructive lung diseases.” [Applicant’s Application.]

Opposers’ Services include training and teaching regarding medical devices for bronchial surgery or treatment. Applicant’s identification of goods description is broad enough to include medical devices for bronchial surgery or treatment. Accordingly, Opposers’ Services are broad enough to include teaching and training involving Applicant’s Goods. Therefore, Opposers’ services are complementary to Applicant’s Goods and the two are closely related. *In re Cook Medical Tech. LLC*, 105 U.S.P.Q.2d 1377, 1380 (T.T.A.B. 2012); *Ultratan Suntanning Ctrs. v. Ultra Tan Int’l AB*, 49 U.S.P.Q.2d 1313, 1316 (T.T.A.B. 1998).

C. The Channels of Trade Overlap.

Applicant’s Goods and Opposers’ Goods travel in identical channels of trade. The “question of registrability of an applicant’s mark must be made on the basis of the identification of goods set forth in the application . . . regardless of what the record may reveal as to the particular channels of trade.” *Stone Lion Capital Partners, L.P.*, 110 U.S.P.Q.2d at 1162. “An application with no restriction on trade channels cannot be narrowed by testimony that the applicant’s use is, in fact, restricted [to particular trade channels.]” *Id.* (citations omitted). Absent any restrictions in the identification of goods description, it is presumed that the goods travel in all normal and usual channels of trade. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Assoc.*, 1 U.S.P.Q.2d 1813, 1814–15 (Fed. Cir. 1987).

Applicant’s Goods and Opposers’ Goods are both medical devices for treatment of lung diseases. [Applicant’s Application; Dkt. No. 12, Ex. 1.] Applicant admitted that Applicant’s Goods, as set forth in Applicant’s Application, do not identify a specific channel of trade. [*Id.*, Ex. 7.] Applicant also admitted that Opposers’ ALAIR[®] registrations, Reg. Nos. 2,856,168 and 3,380,080 do not identify a specific channel of trade. [*Id.*] Therefore, Applicant’s Goods and

Opposers' Goods both travel in the same normal channels of trade for medical devices for treatment of lung diseases.

Additionally, when the identification of goods description identified in an opposer's registration is broad enough to encompass the goods identified in the opposed application, "the legal effect of this fact is that the . . . channels of trade are to be considered the same for the opposition." *Int'l Paper Co.*, 175 U.S.P.Q. at 705. Opposers' Goods are broad enough to encompass the Applicant's Goods as identified in Applicant's Application. Therefore, the channels of trade are the same. Accordingly, the similarity of trade channels factor strongly favors Opposers.

D. Opposers' Goods and Applicant's Goods Appeal to the Same Classes of Consumers.

Opposers' Goods and Applicant's Goods appeal to all classes of consumers and therefore the same classes of consumers, too. The "question of registrability of an applicant's mark must be made on the basis of the identification of goods set forth in the application . . . regardless of what the record may reveal as to the particular . . . class of purchasers to which sales of the goods are directed." *Stone Lion Capital Partners, L.P.*, 110 U.S.P.Q.2d at 1162. An application with no restrictions on classes of consumers "cannot be narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers." *Id.* (citations omitted). Instead, absent any restrictions, the Board considers "all potential customers" of the goods and services. *Id.* at 1162.

Applicant admitted that Applicant's Goods, as set forth in Applicant's Application, do not identify a specific class of consumer. [Dkt. No. 12, at Ex. 7.] Applicant also admitted that Opposers' ALAIR[®] registrations, Reg. Nos. 2,856,168 and 3,380,080 do not include a specific class of consumer. [*Id.*] Accordingly, Opposers' Goods and Applicant's Goods appeal to the

same classes of consumers. Therefore, the similarity of class of consumers factor strongly favors Opposers.

E. Opposers' Marks Are Conceptually and Commercially Strong.

Trademark strength is a product of both conceptual strength and commercial strength. *Tea Bd. of India v. The Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1899 (T.T.A.B. 2006). Conceptual strength depends on the placement of a mark on the spectrum of distinctiveness. *See id.* Coined and fanciful terms are “entitled to the most protection the Lanham Act can provide.” *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 230 U.S.P.Q. 831, 834 (2d Cir. 1986); *Jockey Int’l Inc. v. Butler*, 3 U.S.P.Q.2d 1607 (T.T.A.B. 1987). Commercial strength turns on the degree of public recognition of the mark. *Id.*

The ALAIR[®] mark is a coined term with no dictionary definition. The ALAIR[®] mark therefore receives the highest level of protection under the Lanham Act. *Lois Sportswear, U.S.A., Inc.*, 230 U.S.P.Q. at 834. Also, the record does not contain any evidence of third-party use of similar marks, or registration of similar marks on the Principal Register and Opposers’ have successfully enforced its rights in the ALAIR[®] mark against third-parties. [Dkt. No. 12, Ex. 17.] Opposers’ ALAIR[®] mark is therefore a conceptually strong mark.

When determining commercial strength, the same evidence used to decide the presence or absence of secondary meaning is considered because the evidence is of the same nature. 2 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* 11:82, at 11-249 (4th ed. 2004). Determining the strength of any mark requires weighing circumstantial evidence of sales and marketing expenses. *Id.*, at 11:83, 11-255. Long use of the mark in commerce is also a consideration in determining whether a mark is strong. *See In re Uncle Sam Chem. Co.*, 229 U.S.P.Q. 233, 235 (T.T.A.B. 1986).

Opposers have used the ALAIR[®] mark in commerce since at least as early as 1999 and the ALAIR[®] goods and services have been commercially available since May 2010 [Dkt. No. 22, Passafaro Dep. at 10:17–22, 14:14–17.] Over the last three years, Opposers [REDACTED] [REDACTED] under the ALAIR[®] mark. [See Dkt. No. 22 Passafaro Dep. at Ex. 8.] In total from May 2010 through the first quarter of 2015, [REDACTED] [REDACTED] [Id.]

Opposers' ALAIR[®] device has received significant press and has been featured on Good Morning America, the CBS Morning Show, in the Wall Street Journal, San Francisco Chronicle, and the New York Times. [Dkt. 22, Passafaro Dep. at 56:7–57:2.] In 2006, Opposers' ALAIR[®] device was featured in the magazine Popular Science as an “Innovation of the Year.” [Dkt. No. 12, Ex. 16.] In 2014 alone, the ALAIR[®] System received more than 400 instances of media coverage. [Dkt. No. 22, Passafaro Dep. at 57:6–19.] In that same year, [REDACTED] [REDACTED] [Id. at 51:24–52:1.]

Opposers have similarly spent a significant amount of money annually to promote its ALAIR[®] mark. [Id. at Ex. 1, 2] On average, Opposers [REDACTED] to promote its ALAIR[®] mark. [Id.] In total, Opposers [REDACTED] to promote its ALAIR[®] mark. [Id.] Accordingly, Opposers' ALAIR[®] mark is commercially strong.

Opposers' ALAIR[®] mark is registered in connection with medical devices, educational and training services. [Dkt. No. 12, Exs. 1, 2.] Marks that are used on a variety of goods or services are stronger and entitled to broader protection because it is more likely that consumers would assume a connection between the goods or services. *In re Wilson*, 57 U.S.P.Q.2d 1863, 1867 (T.T.A.B. 2001). Accordingly, Opposers' use and registration of the ALAIR[®] mark on a variety of goods and services lends further strength to the ALAIR[®] mark.

The 15 years that Opposers have used the ALAIR[®] mark along with its significant sales and marketing expense figures, and significant media exposure establish that, overall, Opposers' ALAIR[®] mark is strong; thus, entitled to a broad scope of protection.

F. Applicant Intended to Create an Association with Applicant's ALAIR[®] Mark.

The intent of the applicant is relevant under the thirteenth *du Pont* factor. *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q.2d 1883, 1891 (T.T.A.B. 2008). Knowledge of the prior registrant's rights can weigh in favor of a finding of wrongful intent. *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 168 U.S.P.Q. 110, 112–13 (C.C.P.A. 1970) (relying in part on the fact that applicant “was fully apprised of [registrant's] mark for approximately eight years.”).

In reversing the Board's dismissal of the oppositions in *Carlisle Chem. Works*, the CCPA reasoned that “[Applicant] had a wide range of potential marks from which to make a selection and chose one which contains essentially identical syllables of [registrant's] mark, arranged in reverse order.” *Id.* Similar to *Carlisle*, Applicant had a wide variety of potential marks to choose from. In fact, Opposers' ALAIR[®] System is the only other device-based therapy for obstructive lung diseases. [Dkt. No. 24, Passafaro Dep. at 17:24–18:14.] Therefore, the only mark that Applicant needed to avoid was Opposers' ALAIR[®] mark because it is the only other device of its kind. Six Degrees [REDACTED] [Dkt. No. 14, Ex. 33 at p. 16.] Only [REDACTED] [*Id.*] Yet this is the mark that Applicant chose.

Applicant sought to capitalize on the success of Opposers' ALAIR[®] mark. Applicant was aware of Opposers' rights in the ALAIR[®] mark throughout the entire renaming process. [Wahr Dep. at 106:21–25; Dkt. No. 12, Ex. 5.] Applicant provided ALAIR[®] marketing materials to Six Degrees. [Dkt. No. 14, Ex. 39.] Applicant mirrored Opposers' marketing strategy, creating a new name for the procedure, “targeted lung denervation,” and emphasizing this coined procedure

name as Applicant's domain name, TLDPROCEDURE.com. [Wahr Dep. at 90:21–92:6; Dkt. No. 14, Ex. 48.]

Further, Applicant considered the ALAIR[®] Bronchial Thermoplasty System to be a competitive product and [REDACTED]

[REDACTED] [Dkt. No. 14, Ex. 28 at p. 8.]

Applicant was also aware of the strength of the ALAIR[®] mark and the extensive marketing conducted by Opposers, [REDACTED]

[REDACTED] [Dkt. No. 14, Ex. 38.] Applicant even knew that the marks were similar, [REDACTED]

[REDACTED] [Dkt. No. 14, Ex. 41.] However, as of December 4, 2012, Applicant had spent [REDACTED] before obtaining advice of an attorney regarding the availability of the HOLAIRA mark. [*Id.*, Exs. 54, 55, 56, 57, 58, 59.] As a result, Applicant was already committed to moving forward with the HOLAIRA mark.

Applicant's knowledge of the competitive nature of the goods, Opposers' commercial success, and Applicant's own subjective apprehension that the marks might be too similar, all establish that the intent factor favors Opposers.

CONCLUSION

Applicant's HOLAIRA mark is too similar to Opposers' ALAIR® mark. The goods identified in Applicant's Application are identical or closely related to the goods and services identified in Opposers' registrations. Applicant's Goods and Opposers' Goods will travel in overlapping channels of trade and appeal to the same classes of consumers. The relevant likelihood of confusion factors establishes that Applicant's proposed HOLAIRA mark is likely to cause confusion with Opposers' ALAIR® mark. Therefore, Opposers respectfully request that the Board sustain this opposition and deny registration of Applicant's HOLAIRA mark.

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