

11-25-2002

U.S. Patent & TMO/c/TM Mail RcptDt. #73

17A13

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

Applicant: Ela Medical :
Serial No: 76/269,892 :
Filed: June 8, 2001 :
Mark: ELA SWIFT :
Our Ref: EMD 0104289 :

02 DEC 16 11 06:58
TRADEMARK TRIAL AND APPEAL BOARD

NOTICE OF APPEAL

Box TTAB
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Applicant, by its undersigned attorney, hereby appeals to the Trademark Trial and Appeal Board from the decision of the trademark Examining Attorney refusing registration. Applicant is simultaneously filing a Request for Reconsideration, a copy of which is attached. Therefore, Applicant requests that this Appeal be stayed while the Examining Attorney considers that request.

A check for the \$100 Official fee for a single-class application is attached. If this amount is incorrect, please charge any deficiency or overage to applicant's attorney's Deposit Account No. 23-0825.

12/12/2002 KIBBONS 00000059 76269892


01 FC:6403

100.00 OP

Dated: New York, New York
November 22, 2002

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
Diane B. Melnick
Attorneys for Applicant
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF MAILING

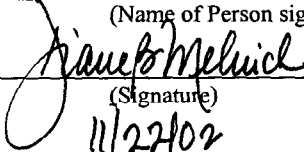
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Diane B. Melnick

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(Signature)

11/22/02

(Date of Signature)

11-25-2002

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #73

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ela Medical :
Serial No: 76/269892 : Jennifer Stiver Chicoski
Filed: June 11, 2001 : Examining Attorney
Mark: ELA SWIFT : Law Office 115
Our Ref: EMD 0104289 :

REQUEST FOR RECONSIDERATION

Box RESPONSES
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

This is in response to the final Office Action mailed on May 22, 2002. A Notice of Appeal is being filed simultaneously herewith.

REMARKS

The Examining Attorney has made final the refusal of registration, under Section 2(d) of the Trademark Act, on the basis of U.S. Reg. No. 1912406 for the mark SWIFT for product identified as a "tip component or coronary catheters." The Applicant respectfully requests reconsideration of this decision.

Confusion is unlikely with the cited registration for several reasons: 1) the marks themselves are distinct, 2) the cited registration is entitled only to a limited scope of protection, in light of its suggestive nature and high level of dilution, 3) the goods are different, and

4) the sophistication of the consumers of the goods, and the goods themselves, eliminates any likelihood of confusion. Evidence as to each of the above elements has already been properly made of record. Additional comments in support of registration are provided below.

1) The Marks are Different.

The inclusion of the house mark ELA in the Applicant's mark makes a significant distinction in the appearance and pronunciation of the marks, and that house mark cannot be ignored in the assessment of a potential likelihood of confusion.

Here, the common element is the term SWIFT. The addition of the house mark ELA is sufficient to distinguish the marks, as to their appearance, pronunciation, and connotation and to prevent consumer confusion. The Examining Attorney states that the addition of a house mark is not sufficient to avoid a finding of confusion, but there is a substantial body of case law which holds that confusion is not likely if the house mark is added to a highly suggestive or descriptive mark.¹ This is just such a case, as discussed in Section 2 below.

¹ Section 1207.01(b)(iii) of the TMEP provides, in pertinent part, as follows (emphasis added):

Exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because *it is merely descriptive or diluted*. See, e.g., *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Where the common element is a highly suggestive English word, which suggests to the consumer a desired aspect of the products, as does the term SWIFT, the addition of the element ELA is more than enough to distinguish the mark and prevent confusion among consumers.

The house mark ELA has been used on medical products since 1978. See registration particulars, attached as Exhibit 1. Because of this longstanding use, the consumer would recognize this mark and identify it as the source of the goods. In viewing the registrant's goods, the commercial impact of that house mark would not be present, and the consumer would not believe that those goods emanate from the Applicant.

2) SWIFT is a Highly Suggestive Mark.

The registered mark consists of the word SWIFT. The dictionary definition of "swift" (previously attached as Exhibit 1) indicates that it connotes speed and rapid response. The Examining Attorney has not addressed the substantial evidence of suggestiveness that has been provided in the previous Response to Office Action. There can be no dispute that the term "swift" has a meaning in the English language. Additional dictionary definitions are attached as Exhibit 2. There also can be no dispute that the term has a meaning which is applicable in the context of the goods which are referenced in the registration, and that the term refers to a desirable characteristic of the goods. It suggests to the consumer that the product acts quickly to accomplish the desired result.

Thus, the mark SWIFT is suggestive for these goods, both those identified in the registration and in the application, so that the registered mark is entitled to only a narrow scope of protection. When a mark is suggestive, even small differences in the marks and the goods are sufficient to distinguish them so as to avoid confusion. See In re AMF, In re L'Oréal S.A. Inc.,

222 USPQ 925 (TTAB 1984) (finding HAUTE MODE for hair coloring cream shampoo not confusingly similar to its English equivalent, HI-FASHION SAMPLER for fingernail enamel); 181 USPQ 797, 798 (TTAB 1974).

These suggestive marks are entitled to just a narrow scope of protection. Here, the cited registration consists of just such a suggestive mark, and so another mark can exist on the register with a degree of distinction which is not as great. Here, the house mark ELA is more than enough to prevent any confusion.

3) The Purchasers are Sophisticated.

The goods are costly, and the purchaser is presumed to expend substantial thought and consideration in the purchasing decision. Also, it is highly likely that the consumer would seek out the house mark for the goods before making the purchase. As noted above, Applicant's house mark is included in this application. One of the primary reasons for this is that these types of goods are marketed to very educated consumers who have a strong level of brand recognition; those consumers will look for those indicia of corporate ownership, as a sign of quality and a mark of source. This means that, regardless of whether the house mark appears in the registrant's trademark itself, it will be seen by the consumer and carefully evaluated.

Confusion is far less likely where the purchaser makes a careful and considered decision for a costly item or service. Section 1207.01 of the *Trademark Manual of Examining Procedure* recited this specific factor as an important element of the likelihood of confusion assessment.

In this instance, all of the goods are sophisticated medical devices, which are costly and purchased with extreme care and concern. Neither the registrant's nor the applicant's goods are merchandised in bins at the corner drugstore. They are purchased with care and concern as to the

source of the goods, since they are used in complex medical matters in which require the utmost care.

On this basis, confusion is unlikely and the refusal to register is properly withdrawn.

4. Co-existence is Possible.

The distinctions in the marks, the goods, and the sophistication of the purchasers means that confusion is not reasonably likely. Therefore, the Applicant has contacted the owner of the cited registration to seek a consent/co-existence agreement.

If the arguments above are not accepted, Applicant respectfully requests that the Examining Attorney suspend this application, to allow the applicant to seek a consent agreement from the owner of the cited registration. This is permissible, within the scope of Trademark Rule 2.67.

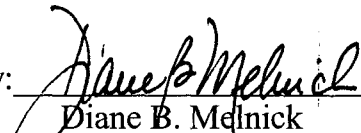
5. Conclusion.

With the above, it is respectfully requested that this application be forwarded for publication, or suspended, to allow the applicant to seek a consent agreement from the owner of the cited registration.

Dated: New York, New York
November 22, 2002

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

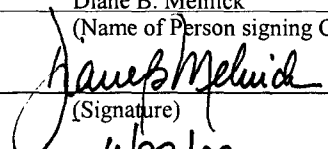
By: 
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Typed Drawing

Word Mark ELA
Goods and Services IC 010. US 044. G & S: External and Internal Pacemakers. FIRST USE: 19450000. FIRST USE IN COMMERCE: 19780913
Mark Drawing Code (1) TYPED DRAWING
Serial Number 73233223
Filing Date September 28, 1979
Published for Opposition September 8, 1981
Registration Number 1179963
Registration Date December 1, 1981
Owner (REGISTRANT) Ela Medical CORPORATION FRANCE 98, rue Maurice Arnoux Montrouge FRANCE 92120
Attorney of Record SUSAN UPTON DOUGLAS
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20020131.
Renewal 1ST RENEWAL 20020131
Live/Dead Indicator LIVE

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swift

(click to hear the word) (swĭft)

adj. *swift er, swift est*

1. Moving or capable of moving with great speed; fast. See Synonyms at *fast*¹.
2. Coming, occurring, or accomplished quickly; instant: *a swift retort*.
3. Quick to act or react; prompt: *swift to take steps*.

adv.

Swiftly. Often used in combination: *swift-running*.

n.

1.
 - a. A cylinder on a carding machine.
 - b. A reel used to hold yarn as it is being wound off.
2. Any of various small dark insect-eating birds of the family Apodidae, related to the hummingbirds and noted for their long strong wings and swift flight.
3. Any of various small, fast-moving North American lizards of the genera *Sceloporus* and *Uta*.

[Middle English, from Old English.]

swift'ly *adv.*

swift'ness *n.*

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Student Loan Consolidation - If you have \$10,000 or more in student loan debt and have started student loan repayment or are in your grace period, you may qualify for the Federal Student Consolidation Loan. Consolidation can save you up to 52% a month and could possibly lower your interest rate to 2.25%. [For more information please click here](#)



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7 entries found for **swift**.
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- swift[1, adjective]
- swift[2, adverb]
- swift[3, noun]
- Swift
- Swift[1]
- chimney swift



Main Entry: ¹**swift**

Pronunciation: 'swɪft

Function: *adjective*

Etymology: Middle English, from Old English; akin to Old English *swifan* to revolve -- more at [SWIVEL](#)

Date: before 12th century

1 : moving or capable of moving with great speed

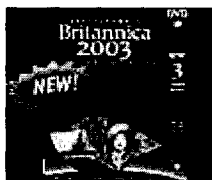
2 : occurring suddenly or within a very short time

3 : quick to respond : [READY](#)

synonym see [FAST](#)



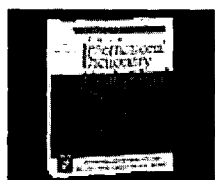
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Pronunciation Symbols



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\&\ as a and u in abut	\e\ as e in bet	\o\ as aw in law
\&\ as e in kitten	\E\ as ea in easy	\oi\ as oy in boy
\&r\ as ur/er in further	\g\ as g in go	\th\ as th in thin
\a\ as a in ash	\i\ as i in hit	\[th]\ as th in the
\A\ as a in ace	\I\ as i in ice	\ü\ as oo in loot
\ä\ as o in mop	\j\ as j in job	\u\ as oo in foot
\au\ as ou in out	\[ng]\ as ng in sing	\y\ as y in yet
\ch\ as ch in chin	\O\ as o in go	\zh\ as si in vision

For more information see the [Guide To Pronunciation](#).

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