

TRADEMARK
ATTORNEY DOCKET NO. 11325-00008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 76/653,359)	Applicant: Cynosure, Inc
)	
Filed: January 11, 2006)	Trademark: CYNERGY
)	
International Class: 10)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

TRANSMITTAL LETTER

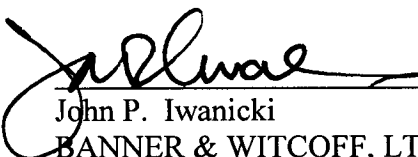
In regard to the above identified application, we are transmitting herewith the attached:

1. Appeal Brief of Appellant, and
2. Return postcard.

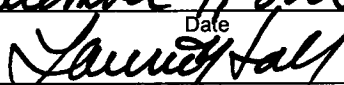
The Commissioner is hereby authorized to charge any additional fees or credit overpayment to Deposit Account No. 19-0733.

Respectfully submitted,

Dated: December 4, 2008

By 
 John P. Iwanicki
 BANNER & WITCOFF, LTD.
 28 State Street, 28th Floor
 Boston, MA 02109
 Telephone: (617) 720-9600
 Facsimile: (617) 720-9601

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December 4, 2008
 Date

 Laurie Hall



12-08-2008

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Applicant: Cynosure, Inc
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APPEAL BRIEF OF APPELLANT

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Laurie Hall

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I. Description of the Record

On January 11, 2006, Appellant Cynosure, Inc. filed an application to register the mark CYNERGY on the Principal Register under Section 1(a) alleging a date of first use of March 7, 2005 and a date of first use in commerce of March 7, 2008. Appellant is the owner of U.S. Registration No. 2,030,348 to CYNOSURE and Registration No. 3,223,669 to CYNOSURESPA.

On June 26, 2006, the Examining Attorney mailed an office action refusing to register the mark under Section 2(d) alleging that Appellant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 2,678,708 to SYNERGIE PEEL for medical devices used for microdermabrasion and 2,748,689 SYNERGY VERSITREL for an implantable pulse generator for pain as to be likely to cause confusion, to cause mistake, or to deceive. The Examining Attorney identified prior pending application serial no. 79/019918 to ELEKTA SYNERGY as a basis for a further refusal to register if the application issued into a registration. The Examining Attorney proposed the Appellant amend the description of goods to recite "medical lasers for the cosmetic treatment of the face and skin, vascular treatment, and hair removal."

On October 10, 2006, the Appellant filed an amendment and response to the office action traversing the refusal to register, but amending the goods to recite "medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment." On December 4, 2006, the Examining Attorney issued a notice of suspension indicating that the refusal to register based on US Registration No. 2,748,689 (SYNERGY VERSITREL) was withdrawn but that the refusal to register based on US Registration No. 2,678,708 (SYNERGIE PEEL) was maintained.

The application was suspended pending disposition of application serial no. 79/019918 to ELEKTA SYNERGY.

On October 24, 2007, Appellant filed a response to the notice of suspension. On June 27, 2008, the Examining Attorney issued a final office action withdrawing application serial no. 79/019918 to ELEKTA SYNERGY as a potential bar to registration but maintaining the refusal to register based on US Registration No. 2,678,708 (SYNERGIE PEEL). On September 10, 2008, Appellant filed a request for reconsideration of the final refusal to register, amending the recitation of goods to read “medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners.” On October 8, 2008, the Examining Attorney denied the request for reconsideration.

On December 1, 2008, the appellant filed a notice of appeal of the final refusal to register.

II. Statement of the Issues

The issue presented for appeal is whether registration of Appellant’s mark CYNERGY as applied to medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners is likely to cause confusion with U.S. Registration Nos. 2,678,708 to SYNERGIE PEEL for medical devices used for microdermabrasion.

III. Argument

The Examining Attorney has refused registration under Trademark Act Section 2(d), asserting that a likelihood of confusion exists between Appellant's mark CYNERGY and the mark in U.S. Registration Nos. 2,678,708 (SYNERGIE PEEL).

1. Likelihood of Confusion

Appellant asserts that there is no likelihood of confusion between Appellant's mark and Registrant's mark, due to (1) the sophistication of the purchasers for such products, as well as the circumstances under which sales are made, and (2) the dissimilarity of marks in their entirety. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

a. Relatedness of Goods

Appellant has amended the goods and services to indicate that the medical lasers are sold directly to licensed medical practitioners. This clarifies that the Appellant's goods as sold under the mark are not over the counter goods sold to the general public. These lasers are FDA-approved medical devices and are not available except to doctors and medical practitioners. These doctors are sophisticated purchasers who are careful about the product and the brand they purchase.

In the office action mailed June 27, 2008, the Examining Attorney states that

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Appellant notes that TMEP §1207.01(d)(vii) from which the Examining Attorney is referencing, includes one final sentence, that states as follows:

However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. §1207.01(d)(vii), last sentence.

Appellant maintains that medical personnel are sophisticated, and that even if they were not (an admission Appellant does not make) the circumstances regarding the purchasing of Appellant's goods sold under the mark clearly show that purchasers take great care in such purchases.

The first reason is price. Appellant's CYNERGY medical lasers sell for \$90,000 to \$170,000. These certainly are not inexpensive commodity items that are purchased on impulse. These medical lasers are capital expenditures. Any professional contemplating purchasing such a device would make careful consideration because of the large investment of money. There is always less likelihood of confusion where goods are expensive and purchased after careful consideration. *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d at 489; 212 USPQ at 252. A doctor is not going to purchase a \$90,000+ medical laser in the mistaken belief as to the source of the laser or that it is a microdermabrasion device.

The second reason is sales and training. Appellant sells its medical lasers to doctors through a direct sales force. The sales force works directly with a potential purchasing doctor to answer their questions and assist them in making purchase decisions. Appellant's sales force also arranges for installation of the medical laser system, and initial product training. Appellant also provides additional training programs and services to prospective and present customers.

These circumstances conclusively show that a purchaser of Appellant's goods, even if the purchaser purchases Registrant's goods for the same office, is not going to be confused about the

source. The price and direct sales staff who work with the purchaser show that there is little chance for confusion on the purchaser's part.

Similarly, purchasers of microdermabrasion machines sold under Registrant's mark are also sophisticated and careful purchasers. Appellant notes that in Appellant's previous response filed on October 24, 2007, Appellant stated on page 6 that "Registrant's microdermabrasion devices are over-the-counter, that is, they can be purchased and used by anyone without restriction." Appellant notes that is statement is incorrect, and Appellant apologizes for this mistake.

In most jurisdictions, microdermabrasion devices can not be purchased and used by anyone. Most states require a certificate/license as an aesthetician or cosmetologist in order to purchase and use the machine. Certification as an aesthetician or cosmetologist typically requires the completion of several hundred hours of coursework and/or training. As an example, in the Commonwealth of Massachusetts, all cosmetologists must be certified and registered. Mass. General Laws, Title XVI, Chapter 112, Section 87II. Registration as a cosmetologist requires completion of 300 hours in coursework from an approved school, and also satisfactory completion of an examination. Mass. General Laws, Title XVI, Chapter 112, Section 87V. Most other states have similar registration requirements. Because of these requirements, such aestheticians and cosmetologists have experience with microdermabrasion devices, and are sophisticated in purchasing them.

Also, microdermabrasion machines typically cost anywhere from \$8,000 to \$15,000. These are not cheap devices, and a sophisticated purchaser will use great care in making a purchasing decision.

Therefore, Appellant asserts that purchasers of Registrant's microdermabrasion machines are also sophisticated and careful purchasers, due to the cost of the machines, and the training and certification that the purchasers have received. Such a purchaser is not going to mistakenly buy a \$90,000+ laser thinking it is a microdermabrasion machine. Similarly, such a purchaser is not going to be confused about the source of the respective goods.

Because of the sophistication of purchasers, the cost of the goods, and the involvement of sales staff in the purchasing process, the relevant purchasers of the goods sold under Appellant's mark and the relevant purchasers of the goods sold under Registrant's mark are not going to be confused as to the source of the respective goods.

b. Similarity of the Marks

Turning to a comparison of the marks, the Examining Attorney has concluded that Appellant's mark CYNERGY is confusingly similar to Registrant's mark SYNERGIE PEEL. The Examining Attorney indicated that the first word of Registrant's mark is dominant, and then compared that word to Appellant's mark, to conclude that they are confusingly similar. Applicant disagrees, and asserts that the Examining Attorney has reached this conclusion based on an improper dissection of the marks, and Applicant asserts that the marks are not confusingly similar when they are compared in their entirety.

TMEP §1207.01 states:

The basic principle in determining confusion between marks is that marks must be **compared in their entireties** and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion **cannot be predicated on dissection of a mark, that is, on only part of a mark** (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, **provided the ultimate conclusion rests on consideration of the**

marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

The Examining Attorney also indicated the Registrant disclaimed the word PEEL in the mark SYNERGIE PEEL. The Examining Attorney indicated that disclaimed matter is less significant when comparing marks. However, disclaimed matter is still part of a mark, and can not be ignored when performing a comparison.

TMEP §1213.10 states:

A disclaimer does not remove the disclaimed matter from the mark. **The mark must still be regarded as a whole**, including the disclaimed matter, in evaluating similarity to other marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991).

The court emphasized this requirement in *Giant Food, Inc. v. Nation's Foodservice, Inc.*:

However, it is well settled that the disclaimed material **still forms a part of the mark and cannot be ignored in determining likelihood of confusion**. *Industria Espanola de Perlas Imitacion, S.A. v. National Silver Co.*, 459 F.2d 1049, 173 USPQ 796 (C.C.P.A. 1972); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965). Such disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence. Therefore, the disclaimer portions of the mark **must be considered** in determining the likelihood of confusion); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983)

The Examining Attorney has determined that SYNERGIE is the dominant part of Registrant's mark SYNERGIE PEEL, and thereafter excludes the part PEEL from any further analysis. Appellant asserts that the Examining Attorney's subsequent analysis based only on the dominant part leads to an incorrect conclusion that the marks are confusingly similar. Appellant

asserts that when comparing the marks in their entirety, the marks have different appearance, connotation, and sound. These factors cause the marks to be dissimilar, and unlikely to cause any confusion among purchasers, especially when considered in connection with the marketing of Appellant's goods by a direct sales force.

c. Appearance

Having determined that SYNERGIE is the dominant part of the Registrant's SYNERGIE PEEL mark, the Examining Attorney then asserts that SYNERGIE and CYNERGY are confusingly similar in appearance. Appellant disagrees with this conclusion. Even at this level, there are differences between these words. The words both start and end with different letters. The unusual spelling of Appellant's mark helps draw a viewer's attention to difference, and provides a connotation to purchasers regarding the Appellant's name, Cynosure Inc., as will be discussed below.

Further, Appellant asserts that when the marks are properly compared **in their entirety**, there are even stronger differences. The differences between Appellant's CYNERGY and Registrant's SYNERGIE PEEL are many. Taken as a whole, there is only an overlap of 5 letters out of 13 total characters. Further, the marks both start with a different letter, and end in very different ways. Comparing these marks in their entirety, the appearance of these marks gives a different impression.

d. Connotation

Appellant further asserts that the marks are not confusingly similar based on the connotation of Appellant's mark. Appellant's other registered trademarks include CYNOSURE

(U.S. Registration no. 2,030,348) and CYNOSURESPA (U.S. Registration no. 3,223,669). Appellant's mark CYNERGY includes the same three starting letters, and strongly suggests a similarity to Appellant's name (and registered trademark) CYNOSURE. The unusual spelling provides customers with a general impression related to Cynosure, Inc., and such customers are highly likely to recollect the mark in the connotation of Appellant's name and product lines, especially given the direct sales force marketing of the product. In contrast there is no such connotation between Appellant's mark CYNERGY and the Registrants mark SYNERGIE PEEL, and customers would not recollect the marks in relation to each other.

e. Sound

Appellant moreover asserts that the marks are also dissimilar in sound. Although typically a correct pronunciation can not be relied upon to avoid a likelihood of confusion (TMEP §1207.01(b)(vi)), in the present case, the connotation leads customers to pronounce the Appellant's mark CYNERGY differently from the Registrants mark SYNERGIE PEEL.

As previously described, the relation of Appellant's mark CYNERGY to Appellant's name and trademark CYNOSURE causes purchasers to recollect Appellant's family of marks in a similar way. This relation would also cause customers to pronounce the marks in a similar manner, that is, with a long "I" sound in the first syllable. Appellant's CYNOSURE is pronounced "sine oh sure", and purchasers would pronounce the mark CYNERGY "sine er gy" based on the relationship. As previously described, Appellant's goods and channels of trade depend upon trained sales staff who work with customers. Therefore such customers are exposed to the proper pronunciation of CYNERGY, and are not likely to confuse it with Registrant's mark SYNERGIE PEEL.

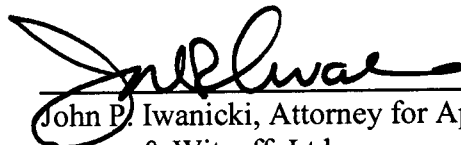
Finally, Appellant notes that when comparing the marks in their entirety, there can be no confusion in pronunciation, since Registrant's mark SYNERGIE PEEL has an entire extra word at the end, that makes it impossible for the marks to be phonetically equivalent.

In summary, when the marks are properly compared in their entirety, the marks have different appearance, different connotation, and different sounds. All these factors decrease any likelihood of confusion between the marks. This, combined with the sophistication of the customers, cost of goods, and sales staff, makes any likelihood of confusion as to the source of the goods impossible.

For at least the above reasons, there is no likelihood of confusion between Appellant's mark CYNERGY and Registrant's mark SYNERGIE PEEL.

Respectfully submitted,

Date: December 4, 2008



John P. Iwanicki, Attorney for Applicant
Banner & Witcoff, Ltd.
28 State Street, 28th Floor
Boston, MA 02109
Telephone: (617) 720-9600
Fax: (617) 720-9601