

From: Gaynor, Barbara

Sent: 2/6/2009 4:51:02 PM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 76653359 - CYNERGY - 11325-00008

Attachment Information:

Count: 3

Files: microderma-1.jpg, microderma-2.jpg, 76653359.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/653359

MARK: CYNERGY



CORRESPONDENT ADDRESS:

JOHN P. IWANICKI
BANNER & WITCOFF, LTD.
28 STATE ST FL 28
BOSTON, MA 02109-1775

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Cynosure, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

11325-00008

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Examining Attorney's final refusal to register its mark CYNERGY. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on the identified goods, so resembles the mark in U.S. Registration No. 2,678,708 as to be likely to cause confusion, to cause mistake, or to deceive.

FACTS

The applicant has applied to register CYNERGY, in standard character form, for "Medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners."¹ U.S. Registration No.

¹ Application Serial No. 76/653359, filed on January 11, 2006, based on the applicant's use of the mark in commerce since March 7, 2005.

2,678,708 is SYNERGIE PEEL, in typed form, for “Medical devices used for microdermabrasion.” Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant’s mark, when used on the identified goods, so resembles the mark in U.S. Registration No. 2,678,708 as to be likely to cause confusion, to cause mistake, or to deceive. On June 27, 2008, the Section 2(d) refusal was made final. On October 8, 2008, the applicant’s request for reconsideration was denied. The sole issue to be decided on appeal is whether the applicant’s mark is likely to cause confusion with U.S. Registration No. 2,678,708.

ARGUMENTS

THE APPLICANT’S MARK IS LIKELY TO CAUSE CONFUSION WITH U.S. REGISTRATION NO. 2,678,708 UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003).

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001).

A. The Applicant's Mark and the Registrant's Mark are Similar

The applicant's mark is CYNERGY in standard character form. The registrant's mark is SYNERGIE PEEL in typed form.

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the dominant wording in the marks are phonetic equivalents: CYNERGY v. SYNERGIE. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980).

The applicant "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." (Applicant's Brief, p. 6).

The fact that one feature of a mark may be more dominant than other features of the mark is just one factor to consider when determining similarity of marks. That determination does not circumvent the first step of the analysis – the Examining

Attorney's determination that the marks are highly similar when compared in their entireties:

[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. 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.

In re National Data Corp., *supra*, 224 USPQ at 751.

The words "CYNERGY" and "SYNERGIE" have been given greater weight in the likelihood of confusion analysis because they are both phonetic equivalents of the word "synergy," and they are phonetic equivalents of each other. The applicant's mark consists solely of the word "CYNERGY." The registrant's mark consists of the word "SYNERGIE" followed by the descriptive word "PEEL," which has been disclaimed by the registrant. Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The applicant argues that "[t]he 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." (Applicant's Brief, p. 7). The word "PEEL" in the registrant's mark has been given less weight in the likelihood of confusion analysis because it is descriptive when used in conjunction with the registrant's microdermabrasion devices, and it has been disclaimed by the registrant. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be

compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). The word “PEEL” in the registrant’s mark merely describes the function or use of the microdermabrasion devices, namely, to “peel” dead skin cells from the skin’s surface.² This is not a case where a descriptive word, “PEEL,” is combined with nondescriptive wording, “SYNERGIE,” in such a way that the descriptive significance of the word “PEEL” in relation to the goods is lost and the combination functions as a unit. “SYNERGIE PEEL” is not a unitary mark.

The applicant argues that the marks are different in appearance, connotation, and sound. While the marks are not identical in sound and appearance, they do not have to be for there to be a likelihood of confusion. The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). The focus is on the recollection of the average purchaser who

² “Microdermabrasion” is “a cosmetic procedure in which the face is sprayed with abrasive crystals to remove dead epidermal cells.” See the attached excerpt from <http://dictionary.reference.com/browse/microdermabrasion>, which is a definition of “microdermabrasion” from *Webster's New Millennium™ Dictionary of English*, Preview Edition (v 0.9.7). The examining attorney respectfully requests that the Trademark Trial and Appeal Board take judicial notice of the attached definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 217 USPQ 505 (Fed. Cir. 1983).

normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979).

In this case, the applicant's mark and the registrant's mark create the same overall commercial impression because of the words "CYNERGY" and "SYNERGIE" in the marks. The applicant's mark consists solely of the word "CYNERGY." The registrant's mark consists of the word "SYNERGIE" followed by the descriptive word "PEEL," which has been disclaimed. "CYNERGY" and "SYNERGIE" are both phonetic equivalents of the word "synergy" and create the same commercial impression.

The applicant argues that:

[Its] 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.

(Applicant's Brief, pp. 8-9).

There is no evidence of record that consumers are familiar with the applicant's prior registrations for CYNOSURE and CYNOSURESPA such that they would make the connection between those two registrations and the mark in the present application. Even if consumers are aware of the applicant's prior registrations, the mark at issue in this case, CYNERGY, does not contain the same common wording as those two registrations. The applicant's two prior registrations both contain the wording "CYNOSURE," the proposed mark does not. The proposed mark does not even contain the common prefix "CYNO-" of the two prior registrations. The CYNERGY mark has more in common

with the cited registration than it does with either of the applicant's two prior registrations.

The dominant wording in the applicant's mark and the registrant's mark are phonetic equivalents. The marks are thus similar in sound and overall commercial impression. The marks are sufficiently similar under Section 2(d) of the Trademark Act such that a likelihood of confusion exists between the applicant's mark and the registrant's mark.

B. The Applicant's Goods and the Registrant's Goods are Related

The applicant's goods are "Medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners." The registrant's goods are "Medical devices used for microdermabrasion."

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

In this case, the applicant and the registrant both sell medical devices for performing cosmetic procedures. In particular, the evidence attached to the June 27,

2008 and October 8, 2008 Office actions shows that microdermabrasion devices and “lasers for the cosmetic and medical treatment of the face and skin” are both used to perform the same cosmetic procedure, namely, the removal of dead skin cells. Note, for example, the following:

Microdermabrasion – Reduce Age Spots and Acne Scars

We can diminish fine lines, crow’s feet, age spots and acne scars with microdermabrasion treatment at our Colorado Springs clinic.

* * *

The Microdermabrasion Procedure

During microdermabrasion, our surgeon removes dead layers of skin with a small buffing instrument. This instrument sprays crystals onto the skin to loosen dead skin cells. The same instrument then suctions up both the crystals and the removed cells. . .

Laser Resurfacing – Reduce Fine Lines and Uneven Skin Tone

You can diminish wrinkles – especially around the eyes and mouth – with laser resurfacing. . .

* * *

The Laser Resurfacing Procedure

During the laser resurfacing procedure, Dr. Speirs slowly passes a guided laser beam over wrinkles or scars. *The laser gently removes layers of dead cells until the scar or wrinkle is less visible.*

From www.speirsclinic.com/html/skin.html, attached to the June 27, 2008 Office action. [emphasis added].

Microdermabrasion

It is one of several non-surgical skin rejuvenation techniques featured at our practice. *We recommend it as an adjunct treatment for minor skin*

problems, including fine lines, crow's feet, acne scars, sun damage, age spots, large pores and small scars. After a session, skin feels smooth and soft, and patients leave our office with a healthy glow.

It is essentially a “polishing” of the skin. *During treatment, a special device removes the layers of dead skin cells, revealing a new layer of healthy skin.* Because the treatment is so gentle, it is appropriate for patients of all skin types, and can even be used on sensitive skin.

* * *

Laser Skin Resurfacing

Laser skin resurfacing is a treatment designed to refresh the skin and remove skin irregularities such as age spots, sun damage, moderate to light wrinkling, discoloration, fine lines, blemishes, and acne scars.

Laser treatments are safe and effective for the entire face, even the most sensitive areas, including the small crow's feet near the eyes, and small lines near the mouth. *During laser resurfacing treatments, a small hand piece delivers highly precise and controlled beams of light to the skin, removing dead skin cells and revealing a fresh new layer of skin.*

Wrinkles and scars are softened or completely removed, pores are minimized, and the texture of the skin is dramatically improved. . .

From www.drrowen.com/html/skin-care.html, attached to the October 8, 2008 Office action. [emphasis added].

The evidence of record also shows that cosmetic procedures involving the applicant's laser devices and the registrant's microdermabrasion devices are performed in combination with one another as part of a comprehensive skin treatment process. From www.bakermedicalarts.com, attached to the October 8, 2008 Office action:

“Microdermabrasion is often performed in conjunction with other skin renewal procedures such as laser treatment and chemical peels.” [emphasis added]. From

www.aestheticlaser.com/ipl.html, attached to the June 27, 2008 Office action:

Intense Pulsed Light (IPL), also known as Photofacial, is a non-ablative mixture of many wavelengths of light which work beneath the skin's surface to greatly reduce brown spots, discolorations, redness, and broken capillaries. Photorejuvenation with IPL also improves skin tone and texture, and minimizes fine lines by inducing significant structural change in the epidermis and dermis. Generally, a series of three to six IPL treatments is needed to gradually give your skin a more homogenous appearance. ***Further improvement can be achieved by combining IPL with treatments such as microdermabrasion, chemical peels, and Botox.***

[emphasis added].

Further, a determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, it is presumed that the registrant's "Medical devices used for microdermabrasion" are "sold directly to licensed medical practitioners," same as the applicant's goods. The evidence attached to the June 27, 2008 final Office action and to the October 8, 2008 Office action denying the applicant's request for reconsideration supports the foregoing presumption because it shows that the applicant's goods and the registrant's goods are sold to the same consumers, namely, dermatologists, plastic surgeons, medical spas, and/or laser centers, for use in providing their services to the

general public. The applicant's and the registrant's goods travel through the same channels of trade and are sold to the same consumers.

The applicant argues that purchasers of its goods and purchasers of the registrant's goods are "sophisticated and careful." (Applicant's Brief, p. 5). The foregoing is not disputed; however, the sophistication of the purchasers does not require a finding of no likelihood of confusion. 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Further, even sophisticated purchasers may not be aware of the range of products offered by a party. *Id.*, at 1815. Given the similarities of the marks, the relatedness of the goods, and the identical channels of trade, the sophistication of the relevant purchasers of the applicant's and the registrant's goods does not diminish the likelihood of confusion in this case.

The applicant and the registrant both sell medical devices for performing cosmetic procedures, including the same cosmetic procedure of removing dead skin cells. The evidence of record shows that the goods are related, travel through the same channels of trade, and are sold to the same consumers, namely, dermatologists, plastic surgeons, medical spas, and/or laser centers. Accordingly, the applicant's goods and the registrant's goods are sufficiently related under Section 2(d) of the Trademark Act such that they could be encountered by the same consumers under circumstances that could give rise to the mistaken belief that the goods come from a common source.

CONCLUSION

For the foregoing reasons, the Examining Attorney respectfully requests that the Section 2(d) refusal be affirmed.

Respectfully submitted,

/Barbara A. Gaynor/
Barbara A. Gaynor
Trademark Examining Attorney
Law Office 115
571-272-9164

Tomas V. Vlcek
Managing Attorney
Law Office - 115