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

Applicant : HSI Service Corp.

Serial No. : 78/172,835

Examiner James A. Rauen, Esq.

Filed : October 10, 2002

Law Office 103

Mark : CRITERION

Commissioner for Trademarks
Trademark Trial and Appeal Board
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APPLICANT'S BRIEF ON APPEAL

I. INTRODUCTION

Applicant HSI Service Corp. ("Applicant") submits this brief on appeal and asserts that its mark CRITERION, when used in connection with gloves for dental, medical and veterinary use, does not so resemble CRITERION Registration No. 2,528,119 ("Cited Mark") for artificial respiratory apparatus and instruments that it is likely to cause confusion, or to cause mistake, or to deceive, and the Examining Attorney's decision to refuse it registration should therefore be reversed.

II. SUMMARY OF PROCEEDINGS

On October 10, 2002, Applicant filed an intent-to-use application to register the mark CRITERION for "gloves for medical, dental and veterinary use." The Examining Attorney refused the application based on likelihood of confusion with the Cited Mark in an Office Action dated April 17, 2003, and made his refusal final in an Office Action dated February 20, 2004,



finding Applicant's arguments, submitted on June 25, 2003, unpersuasive. Applicant subsequently, on March 24, 2004, submitted an Amendment to Allege Use and shortly thereafter, on April 29, 2004, filed simultaneously a Request for Reconsideration and a Notice of Appeal. On June 4, 2004, the Examining Attorney granted Applicant's Request for Reconsideration but maintained his final refusal of Applicant's mark.

III. ARGUMENTS

According to Section 2(d), a trademark shall be refused registration if it so resembles a mark registered that it is likely to, when used in connection with applicant's goods, cause confusion, or to cause mistake, or to deceive. When determining whether or not likelihood of confusion exists, the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) should be considered.

In this case, Applicant's mark cannot, after carefully considering the differences in goods, their marketing and trade channels, the sophistication of the relevant consumers and other distinguishing circumstances, be said to so resemble the Cited Mark that it is likely to cause confusion, or to cause mistake, or to deceive, as maintained by the Examining Attorney.

A. Similarity of the Marks

Applicant does not disagree with the Examining Attorney that its mark is identical with the Cited Mark, but contends that a consideration of all other relevant factors preclude a finding of likelihood of confusion. *See, In re Albert Trostel & Sons Co.*, U.S.P.Q.2d 1783, 1786 (T.T.A.B. 1993) (no likelihood of confusion was found between two identical marks as a result of consideration of other relevant factors).

B. Relatedness of the Goods

Applicant's goods and the goods covered by the Cited Mark are not so related as to cause any likelihood of confusion as to the source of the goods.

The Examining Attorney argues that merely because the marks are identical, the relationship between the goods need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. This does not, however, mean that when, as here, the goods are not only significantly different, but are marketed and promoted under circumstances and conditions that make it unlikely for the relevant consumers to mistakenly believe that the goods originate from a single source, consumer confusion is likely to occur simply because the marks are identical. *See, Amcor, Inc. v. Amcor Industries, Inc.*, 210 U.S.P.Q. 70, 78 (T.T.A.B. 1981); TMEP §1207.01(a)(i).

Applicant's goods are inexpensive, disposable one-time use infection control products that are very different from the sophisticated and highly specialized equipment covered by the Cited Mark, *i.e.*, "artificial respiratory apparatus and instruments, namely, continuous positive airway pressure regulators and positive pressure ventilation devices for regulating pressure and air and gas flow during a breathing cycle, monitors for monitoring respiratory pressure and air and gas flow delivered and exhaled during a breathing cycle and pulse oximetry devices; nebulizers; masks used for administering respiratory therapy and anesthesia; inhalers; medical tubing used for delivering respiratory gases; and parts and fittings for all the aforesaid goods." Applicant's goods are used by the hundreds daily or weekly in any ordinary healthcare office while the goods offered under the Cited Mark only are used in specific instances of artificial respiratory treatment and therapy. This makes consumer confusion as to their source highly unlikely.

The fact that the goods at issue are all classified in International Class 10 and can be categorized as medical supplies or equipment does not dictate a finding that the goods are substantially similar. *See, W.W.W. Pharmaceutical Co. Inc. v. The Gillette Co.*, 25 U.S.P.Q.2d 1593 (S.D.N.Y. 1993) (products were held not similar even though both products were generally defined as personal care products); TMEP §1207.01(a)(iv) (there is no rule that certain goods are *per se* related).

In fact, even the owner of the Cited Mark does not believe that consumer confusion is likely to occur between its CRITERION mark for respiratory apparatus and instruments and disposable infection control products sold under the identical mark. In response to an Office Action dated October 29, 1999, the owner of the Cited Mark admitted that their products and disposable infection control products are "sufficiently distinct that it is highly unlikely consumers would believe there is any association between the respective sources." It also admitted that, unlike infection control products, their respiratory products are sold via specialized distributors; hence consumer confusion was unlikely because of price differences and the fact that the prospective consumers are highly sophisticated and exercise a high standard of care in view of their specific needs. This also supports the contention that it is highly unlikely for consumer confusion as to the source of the goods at issue to occur. *See, Exhibit C in Applicant's Request for Reconsideration; 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition* §23:78 (evidence proving that the owner of the Cited Mark believes that there will be no likelihood of confusion is relevant); *In re Albert Trostel & Sons Co.* at 1786 (significant consideration was given to registrant's statement that there was no likelihood of confusion between two identical marks).

The Examining Attorney nevertheless argues that these statements made by the owner

of the Cited Mark are of limited value because they were made in reference to different goods and not specifically in reference to Applicant's goods. However, statements made in reference to "disposable paper infection control products for hospital, medical and/or dental use, namely, gowns, examination table paper, bibs, tray covers" should be considered to have value in reference to other disposable infection control products, namely, gloves.

The Examining Attorney also argues that the goods are confusingly related simply because third-party registrations that cover both gloves and goods related to respiratory equipment exist. Such evidence may, but does not necessarily have to, have probative value and suggest that the goods at issue are of a type that may emanate from a single source. *See*, TMEP §1207.01(d)(iii). Here, such evidence must be afforded limited significance and is insufficient to conclude that likelihood of confusion exists, particularly in view of the circumstances surrounding the marketing and distribution of the goods at issue, which makes it highly unlikely for consumers to mistakenly believe that the goods originate from the same source. *See, In re Albert Trostel & Sons Co.* at 1786 (even though the same consumers would encounter both marks, no likelihood of confusion was found between identical marks as a result of knowledgeable consumers).

Furthermore, the marks have, since at least as early as March 1, 2003, co-existed in the market without any reported instances of consumer confusion. While Applicant agrees with the Examining Attorney that the test is likelihood of confusion and not actual confusion, it should be noted that existence of instances of actual confusion is one of the factors that may be taken into account when determining whether or not consumer confusion is likely. A search of the Register shows that numerous CRITERION marks for a wide variety of goods co-exist, which indicates that consumers do not consider all goods bearing the CRITERION mark to

originate from the same source. In fact, the Cited Mark already co-exists with, *e.g.*, a prior third-party registration, CRITERION Registration No. 799,609 for artificial teeth. Since several registrations exist that cover both artificial teeth and respiratory equipment and instruments, Applicant's goods cannot be said to be more closely related to artificial respiratory apparatus and instruments than these products are to artificial teeth. *See*, Exhibit B in Applicant's Request for Reconsideration. Applicant's mark should therefore also be allowed to co-exist on the Register.

C. Sophistication of Consumers

The fact that the relevant consumers are healthcare professionals is a very important factor in deciding whether or not there is any likelihood of confusion as to the source of the goods and in this case weighs against a finding of likelihood of confusion. Given their sophistication and specific needs, healthcare professionals are highly sophisticated and discriminating and will only purchase goods used in their practice after careful consideration. *See*, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:101; *Warner-Hudnut, Inc. v. Wander Company*, 126 U.S.P.Q. 411 (C.C.P.A. 1960) (physicians are a discriminating public); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786 (1st Cir. 1983) (no likelihood of confusion found between ASTRA for pharmaceutical preparations and syringes, and ASTRA for blood analyzer); TMEP §1207.01(d)(viii) (circumstances suggesting care tend to minimize likelihood of confusion).

Everyday supplies, such as disposable infection control products, are as a result of their particular purpose purchased by healthcare professionals on a regular basis at a low cost. For example, Applicant's goods are sold in boxes of 100 gloves at an approximate cost of \$6.00 per box. Highly specialized and very costly respiratory equipment are however

obviously purchased very differently in that healthcare professionals exercise a much higher standard of care when making a once in a while purchase of a very expensive piece of equipment. *See, Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390, 1396 (T.T.A.B. 1991) (buyers of sophisticated medical equipment are exercising great care in selection and as a result no likelihood of confusion was found between "medical instruments used for clinical measurement of human performance functions" and a wide range of laboratory and medical equipment); *Blue Bell Bio-Medical v. Cin-Bad*, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) (medical professionals exercise a high degree of care when purchasing a major piece of equipment). *See, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition* §23:95-96 (the price level of the goods is an important factor in determining the amount of care the purchaser will use). Hence, it is highly unlikely for consumer confusion to occur as to source or affiliation of the goods at issue.

D. Channels of Trade

In addition to being purchased by sophisticated consumers, the goods at issue are sold in different channels of trade and are marketed and promoted under such circumstances that preclude any likelihood of confusion as to their source. Everyday supplies, such as disposable infection control products, are sold and distributed very differently from highly specialized respiratory equipment because of the difference in their sophistication and price.

Applicant's goods are sold via its own distribution network through, *e.g.*, mail order and online ordering and telephone sales. Consumers are made aware of the source of the goods they are purchasing through the sales representatives or through Applicant's mail order or online catalogs. For example, in order to purchase goods through Applicant's website (www.henryschein.com), a consumer has to set up an account with Applicant, which would

preclude any likelihood of confusion as to the source of the goods. Similarly, the goods covered by the Cited Mark are sold via its own dealers, who emphasize its particular source of origin. It should also be noted that expensive and specialized respiratory equipment often are sold via sales representatives, rather than online and telephone sales, because of the sophistication of the product. *See*, Exhibit B in Applicant's Request for Reconsideration. The goods at issue would therefore not be sold or offered in the same channels or outlets, and consumers would not encounter the goods under such circumstances and conditions that would suggest that they originate from the same source.

The Examining Attorney argues that since no limitation as to the trade channels has been made as to the Cited Mark, it should be assumed that the goods travel in all normal channels of trade and that the goods are available to all consumers. Applicant is not arguing that a limitation as to the channels of trade has been made, but it does contend that the normal channels of trade and potential consumers for sophisticated respiratory equipment are quite different from those for disposable infection control products and that they are such in this case to preclude a finding of likelihood of confusion.

As a result of the differences in goods and their particular distribution practices, the relevant consumers, health care professionals, are not likely to be confused as to the origin of Applicant's goods and those covered by the Cited Mark.

E. Use of Company Name and House Mark

In addition, since the marks at issue are both used in connection with their respective owner's company name and house mark, any likelihood of confusion as to the source of the goods is further prevented.

Applicant, a Fortune 500 company and today the largest distributor of healthcare products

to office-based practitioners in the combined North American and European markets with sales reaching \$3.4 billion in 2003, uses its CRITERION mark in connection with its well-known HENRY SCHEIN company name and house mark. *See*, Exhibit A in Applicant's Request for Reconsideration. The owner of the Cited Mark similarly uses its company name and house mark in connection with its mark. *See*, Exhibit A in Applicant's Response to Office Action

Contrary to the Examining Attorney's opinion, just as the use of a company name together with a mark may decrease the likelihood of consumer confusion, use of a house mark may be a negating factor in finding likelihood of confusion since the marks should be compared in their entireties, which include any distinguishing feature such as a house mark. *See*, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:43.

As a result of Applicant's use of its company name and house mark in connection with its mark, prospective consumers will immediately recognize Applicant as the source of its goods and will in no way believe that Applicant somehow is connected or associated with the owner of the Cited Mark. This fact, particularly together with the substantial differences in the goods and trade channels and in view of the sophistication of the relevant consumers, supports a finding of no likelihood of confusion as to the particular source of the goods at issue. *See*, *Vitarroz Corporation v. Borden, Inc.*, 209 U.S.P.Q. 969 (2nd Cir. 1981) (no likelihood of confusion between BRAVO'S and BRAVO as marks were presented in association with company names); *Blue Bell Bio-Medical v. Cin-Bad*, at 1876 (labels on medical carts which indicated their origin were found to dispel any potential confusion).

IV. CONCLUSION

For all the foregoing reasons, the Board should find that Applicant's mark does not so resemble the Cited Mark that it is likely to cause confusion or to cause mistake, or to deceive,

and reverse the Examining Attorney's decision to refuse it registration and allow the application to proceed to publication.

Dated: 1/7/05

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