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THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HSI Service Corp.

Serial No. 78172835

Marya Lenn Yee of Donovan & Yee, LLP for HSI Service Corp.

James A. Rauen, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney)

Before Seeherman, Bucher and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On September 10, 2002, HSI Service Corp. (applicant)
filed an intent-to-use application to register CRITERION on
the Principal Register in standard character form for
"gloves for medical, dental and veterinary use." Applicant
later filed its amendment to allege use claiming first use
of the mark and first use of the mark in commerce on March
1, 2003.

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The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of current Registration No. 2,528,119, issued January 8, 2002, for CRITERION in standard character form for:

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.

The examining attorney issued a final refusal and applicant appealed. For the reasons stated below, we affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent & Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. The opinion in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. We must determine whether there would be a likelihood of confusion by weighing all of the evidence bearing on those factors in each case according to the unique circumstances of each

case. Id., 177 USPQ at 567. We discuss below the factors relevant here.

Comparison of the Marks

Applicant agrees that the marks of the parties are identical. Applicant's Reply Brief at 1. Applicant does argue, though, that "since the marks at issue are used 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's Brief at 8. Neither the application nor the cited registration include a company name or house mark. Both marks consist of CRITERION only. As the examining attorney points out, the cases cited by applicant discussing the effect of house marks involve infringement actions, not an ex parte proceeding related to registration. Those cases are not relevant here.

We must restrict our consideration to the marks as they appear in the application and registration. If the registration should issue to applicant, it would entitle applicant, as it does the registrant, to certain presumptions, including a presumption of the registrant's "exclusive right to use the registered mark in commerce" under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). This presumption would apply whether the registered mark is used by itself or with other elements.

Accordingly, we cannot consider company names, house marks, or other potentially distinguishing elements, which may be used with either mark but are not included in the mark in the application or registration. Therefore, we conclude that the marks are identical for purposes of our determination here. This weighs significantly in favor of the position taken by the examining attorney. Amcor, Inc. v. Amcor Indus., Inc., 210 USPQ 70, 78 (TTAB 1981).

Comparison of the Goods and Channels of Trade

Applicant's principal arguments relate to alleged differences between the goods and the channels of trade for the goods of applicant and registrant. Applicant argues that its goods, "inexpensive, disposable one-time use infection control products," differ from registrant's "sophisticated and highly specialized equipment." Applicant's Brief at 3. Applicant also argues that applicant and registrant employ distinct distribution channels. Applicant states that it sells its goods "via its own distribution network, e.g., mail order and online ordering and telephone sales." Id. at 7. Applicant states further, "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." Id. at 8.

The examining attorney first correctly points out that the focus of the inquiry is not the likelihood of confusion between the goods, but rather the source of the goods, citing In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984). He argues further that the goods of the applicant and registrant are related as illustrated by "the frequency with which they are sold under the same mark." Examining Attorney's Brief at 3.

To support his position the examining attorney has provided copies of numerous registrations claiming use of the same mark on the types of goods identified in both the application and the cited registration. Among those are the following:

Reg. No. 2,598,178 for ALLEGIANCE & design, for goods including "oxygen and respiratory masks" and "medical, surgical, industrial laboratory and general purpose gloves";

Reg. No. 2,131,738 for NEUROMEDICAL SUPPLIES, INC., for goods including "medical gloves" and "respiration monitors";

Reg. No. 2,032,589 for MEDIC MASTER and design, for goods including "gloves for medical use" and "monitors (respiration)";

Reg. No. 1,833,258 for CHEMOPROTECT, for goods including "medical products used for chemotherapy, namely, . . . gloves" and "respiratory masks";

Reg. No. 2,009,884 for Quadned, Inc. and design, for goods including "anesthetic masks," "respiration monitors" and "medical examination and surgical gloves and gowns";

Reg. No. 1,520,736 for THE BEST OF HEALTH, for goods including "apparatus for artificial respiration" and "disposable gloves for medical use";

Reg. No. 1,890,355 for ASTRA, for goods including "medical goods, namely, . . . gloves" and "inhaler to assist in inhaling pharmaceutical products";

Reg. No. 2,062,719 for LICA MEDICAL PRODUCTS INC., for goods including "nebulizers" and "latex examination gloves";

Reg. No. 1,025,682 for MEDI-PAK, for goods including "latex exam gloves, procedure gloves, vinyl exam gloves" and "nebulizers";

Reg. No. 2,640,015 for NOVAPLUS and design, for goods including "exam gloves" and "anesthesia masks";

These registrations are not evidence that these marks are in use, but they are of some probative value and do indicate that the goods of applicant and registrant are of a type which may emanate from the same source. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The registrations provided by the examining attorney also indicate more broadly that the same mark has been registered for medical equipment and supplies ranging from goods which are less specialized and less expensive to goods which are more specialized and more expensive. The registrations also illustrate that the same mark has been registered for medical gloves along with more specialized products in a variety of medical fields.

Also, while applicant has characterized the goods in the cited registration as highly specialized and very costly, that characterization may not apply to all of the goods listed. For example, nebulizers, inhalers, masks and tubing may be less expensive than monitors. Some of these goods also may be replaced with some frequency. Without further evidence as to the nature and cost of these items we do not assume that all of the goods identified in the registration are highly specialized and very costly.

Applicant also points out that it is "a Fortune 500 company and 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." Applicant's Brief at 8-9. Applicant has only provided the pages from its catalog related to medical gloves, however. Nonetheless, in view of its substantial sales volume and its leading position in the distribution of "healthcare products," the record suggests that applicant itself offers a range of medical products and, therefore, that a variety of healthcare products may come from a single source.

Applicant has also argued that the registrant has previously stated that its products are not related to "disposable infection control products" in the process of

securing the cited registration. Applicant's Brief at 4. Registrant made these statements in arguments it made to the PTO in 1999. The examining attorney has argued, and we agree, that we should not rely on arguments made more than five years ago with respect to different circumstances, including different parties and different goods, than those at issue here.¹ Likewise, we reject applicant's suggestion that, for purposes of our determination here, we consider the representations registrant made at that same time with regard to its trade channels.

Accordingly, after considering all of the relevant evidence of record, we conclude that the goods of the applicant and registrant are related.

With regard to the channels of trade for the goods, neither the application nor the registration include any restrictions as to the channels of trade. As we indicated above, applicant has indicated that its own channels of trade and those of the registrant are somehow restricted. We must consider the goods as described in the application and registration and, in the absence of any restrictions in the channels of trade in either the application or

¹ The goods in the prior registration for CRITERION cited against the registrant were "disposable paper infection control products for hospital, medical and/or dental use; namely, gowns, examination table paper, bibs, tray covers." This registration lapsed before the registration cited here issued.

registration, assume that they travel in all trade channels appropriate for such goods. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). Furthermore, on balance, the evidence of record indicates that the goods of applicant and registrant could travel through the same or overlapping channels of trade. Accordingly, we conclude that the channels of trade of the applicant and registrant are the same or overlapping.

Sophistication of Purchasers

Applicant has also argued that the purchasers of both applicant's and especially registrant's goods are sophisticated and, therefore, less prone to confusion. Applicant's Brief at 6. We note again that registrant's products appear to vary in complexity and cost. We do not assume that all of registrant's goods are very specialized and very costly. Neither are we prepared to assume that all of the purchasers of applicant's goods are highly sophisticated. On this record, we cannot assume that applicant's goods, nor that all of the registrant's goods, are necessarily purchased by high-level medical professionals. Also, as we have noted many times, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560

(TTAB 1983). This is particularly the case where, as here, the marks are identical. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). Accordingly, we conclude that the sophistication of relevant purchasers does not diminish the likelihood of confusion in this case.

Similar Marks In Use on Similar Goods

Applicant has also argued that the cited registered mark is weak as a result of third-party use. Applicant's Brief at 6. However, applicant only refers to one potential use of CRITERION in a relevant field, that is, Registration No. 799,609 for CRITERION for "artificial teeth."² Id. Evidence of use in other fields has no bearing on the strength or weakness of the mark in the medical products field. In re Melville, 18 USPQ2d at 1389. Furthermore, as we have noted previously, prior registrations, by themselves, are not evidence that a mark is in use. Id. at 1388. Most importantly, a single potential use in a relevant field is insufficient to establish that a mark is weak, particularly a mark such as CRITERION, which appears to be arbitrary. Id. at 1389.

² "Artificial teeth" are more closely related to applicant's goods than registrant's goods in any event. Consequently, any effect on the strength of registrant's mark, the issue at hand, is more remote.

Therefore, we reject applicant's argument that CRITERION is a weak mark in the medical products field.

Actual Confusion

Applicant has also argued that there has been no actual confusion. Applicant's Brief at 5. There is no indication here that there has been a true opportunity for actual confusion to occur. Applicant's mark has only been in use since March 1, 2003, and we have no evidence as to the extent of applicant's use or registrant's use. Furthermore, we have consistently declined to accord any weight to representations regarding the absence of actual confusion in an ex parte proceeding where the registrant has no opportunity to respond. In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Therefore, we do not ascribe any weight to applicant's contention that there has been no actual confusion for the purpose of our determination of likelihood of confusion in this case.

In conclusion, we have weighed all evidence related to the du Pont factors regarding likelihood of confusion presented in this case and determined that there is a likelihood of confusion between applicant's mark and the cited mark. The principal factors dictating this result are the fact that the marks are identical and the goods of

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applicant and registrant, as identified, are related and travel in the same or overlapping channels of trade.

Decision: The refusal to register applicant's mark on the ground of likelihood of confusion is affirmed.