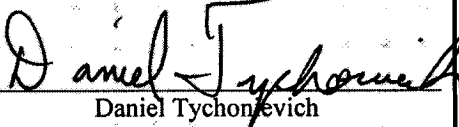


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
) Zimmer Technology, Inc.)
)
 Serial No.: 78/717,996)
)
 Filed: 09/21/2005)
)
 Mark: TRANSFX)
)
 Class: 10)
)
 Examining Attorney: David Collier)
)
 Law Office: 104)
)
 Attorney Docket No.: ZTI-T02681e)

I hereby certify that this correspondence is
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 Box 1451, Alexandria, VA 22313-1451
 on 7-3-2007

 Daniel Tychonovich
 Date: July 3, 2007

APPEAL BRIEF

Commissioner for Trademarks
 P.O. Box 1451
 Alexandria, VA 22313-1451

Sir:

Applicant Zimmer Technology, Inc. submits the following brief for consideration in the appeal to the Trademark Trial and Appeal Board of the Examining Attorney's refusal to register its TRANSFX mark.

INDEX OF CITED CASES

- *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970).
- *In re Digirad Corp.*, 45 U.S.P.Q. 2d 1841 (T.T.A.B. 1998).
- *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).



- *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992), *reh'g denied*, 1992 U.S. App. LEXIS 1505 (Fed. Cir. Feb. 4, 1992), *reh'g, en banc, denied*, 1992 U.S. App. LEXIS 2473 (Fed. Cir. Feb. 20, 1992).
- *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972).
- *In re Reach Electronics, Inc.*, 175 U.S.P.Q. 734 (T.T.A.B. 1972).

ARGUMENT

The Examining Attorney has refused registration of Applicant's mark TRANSFX for a "medical device, namely, an external fixation system for bone securement and stabilization comprised of aluminum, titanium, stainless steel or carbon fiber bone anchors, pins, rods, rings, wires and clamps in International Class 010" based upon U.S. Registration No. 2,501,225 (the '225 Registration) for the mark TRANSFIX for an "arthroscopic surgical implant comprising artificial material." The Examining Attorney has asserted that there is a likelihood of confusion under 15 U.S.C. §1052(d) between Applicant's mark and the mark in the '225 Registration.

Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's refusal to register Applicant's TRANSFX mark. Based upon the below analysis, it is clear that there is not any likelihood of confusion between Applicant's mark and the mark in the '225 Registration.

As noted by Examining Attorney, the guidelines for determining the likelihood of confusion are set forth in TMEP §§ 1207 *et seq.* These guidelines, in turn, are drawn from *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The test for likelihood of confusion is a multifaceted test whose outcome does not hinge on a single factor. Rather, the factors must be examined and weighed based upon the relevant facts in the case analyzed. When *DuPont* is applied to the instant case, it appears that the following factors are the most relevant:

- Similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

- The similarity or dissimilarity and nature of the goods or services as described in a registration in connection with which a prior mark is in use.
- The conditions under which and buyers to whom sales are made, i.e., “impulse” versus careful, sophisticated purchasing.
- The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

1. Applicant’s Mark Has a Different Appearance, Sound, Connotation and Commercial Impression than That of the Cited Registration When the Marks are Viewed in Their Entireties

The Examining Attorney has asserted that the marks are similar in sound and appearance. Applicant believes that the Examining Attorney is clearly mistaken, as Applicant’s mark TRANSFX and the mark TRANSFIX in the cited ‘225 Registration differ in appearance, sound, connotation, and commercial impression when considered in their entireties. The appearance and sound of the marks is significantly different as applicant’s mark consists of the term “TRANS” followed by the consonants “F” and “X,” whereas the mark in the cited registration has the appearance and sound of the single word "TRANSFIX." Furthermore, Applicant's mark is a fanciful term that ends in four consonants, whereas the mark in '225 Registration is a common word of ordinary meaning found in the dictionary.

This distinction also gives applicant’s mark a separate and unique connotation and commercial impression than the mark of the cited registration, especially since “F” and “X” are often used as an abbreviation for “effects.” On the other hand, the mark in the cited registration has a separate connotation and commercial impression of the one word “TRANSFIX” which is pronounced as spelled.

Supporting Applicant's position is the case *In re Reach Electronics, Inc.*, 175 U.S.P.Q. 734 (T.T.A.B. 1972), wherein the Board found no likelihood of confusion between the marks REACH and REAC and stated that:

While "power supplies" are common to both the subject applications and the cited registration, nevertheless, in the context which they appear, the goods of the parties are directed to different segments of the electronics field. Applicant's goods are devoted primarily to the communication field and registrant's products are intended primarily for measuring, testing and computing. This difference may be slight and even insufficient when the marks are identical or substantially similar. But, "REAC" and "REACH" are literally words apart from each other. The one letter difference referred to by the examiner is quite significant herein because "REACH" is a commonly used dictionary word which possesses a meaning unlike "REAC" which is and would be recognized as a play on "react" or "reactor". And by reason thereof, "REACH" would be readily distinguishable from "REAC" in appearance, and it does not sound like "REAC" when spoken. Thus, the differences between the marks "REACH" and "REAC" are deemed sufficient to obviate any likelihood that purchasers would attribute the products sold thereunder to the same source.

In re Reach Electronics at 735 (emphasis added).

The same is true in this case where TRANSFX and TRANSFIX are words apart from one another so that the fanciful term "TRANS" "F" "X" has a completely different sound, meaning and commercial impression from the common dictionary word "TRANSFIX."

2. Applicant's Goods are Distinct from those of the Cited Registration

Although applicant's goods and the goods specified in the '225 Registration may both be broadly classified as medical devices or instruments, this does not mean that they are related or that consumers would likely believe that they come from the same source. The goods in the '225 Registration pertain to an arthroscopic surgical implant comprising artificial material. As such, the goods are "implanted" or placed inside the patient using the arthroscopic surgery technique. In particular, the goods in the cited registration are used for ligament repair and grafting as discussed in Arthrex, Inc.'s website www.arthrex.com.

On the other hand, applicant's goods provide "external" stabilization for bone securement. As such, although applicant's goods are anchored to the bone, the majority of the goods (i.e., support structure) are external to the body of the patient and not implanted therein. See attached Exhibit A as an example of applicant's goods.

The mere fact that the goods in both the '225 Registration and applicant's goods can be broadly classified as medical devices or instruments does not mean that they are related or that consumers would likely believe they come from the same source. When comparing trademarks and their goods, it is impermissible to broadly characterize goods to find a likelihood of confusion. *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970). In *Colgate*, the dentifrice goods associated with PEAK and the deodorant goods associated with PEAK PERIOD were both deemed personal "toilet preparations." However, the court distinguished the goods associated with both marks, indicating that the goods of the PEAK mark were medicinal in nature and, thus, differed from the PEAK PERIOD mark where the goods related to human sanitation. Based on the differences between the goods, the court held that there was no likelihood of confusion. Similarly, in *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972), the detergent goods associated with the ALL and the window, mirror, and chrome cleaner ALL CLEAR! marks were broadly categorized as being "household cleaners." Again, the court distinguished the goods of the two marks and found no likelihood of confusion existed.

More recently, the prohibition against broadly categorizing goods to find likelihood of confusion was affirmed in *In re Digirad Corp.*, 45 U.S.P.Q. 2d 1841 (T.T.A.B. 1998). Here, the Examining Attorney refused to register DIGIRAD for, briefly, nuclear imaging equipment because of prior registrations for the mark DIGIRAY which covered, briefly, x-ray imaging equipment. The Examining Attorney claimed that the goods of both marks could be classified together in a general category of "medical diagnostic equipment"; therefore, a likelihood of confusion existed between them. The Trademark Trial and Appeal Board disagreed. It found that the goods covered by the marks, even though both were sold to hospitals, differed; consequently, it reversed the refusal to register the mark DIGIRAD (even though the marks also differed by only one letter). See also *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992), *reh'g denied*, 1992 U.S. App. LEXIS 1505 (Fed. Cir. Feb. 4, 1992), *reh'g, en banc, denied*, 1992 U.S. App. LEXIS 2473 (Fed. Cir. Feb. 20, 1992), where it was held that there was no likelihood of confusion between the mark EDS for computer services offered to the medical field and the mark E.D.S. for power supplies and battery chargers incorporated into medical equipment.

The registrations relied on by the Examining Attorney to establish that the goods are related are clearly not dispositive in this case based upon the above. Applicant also disagrees with Examining Attorney's assertion that the identification of registrant's goods is "very broad." The identification of goods in the '225 Registration is quite narrow and specific to a "arthroscopic surgical implant comprising artificial material," and there is no overlap with Applicant's goods for "an external fixation system," which as clearly seen in Exhibit A, differs greatly from an implant.

3. Sophisticated Purchasing

An additional factor from *DuPont* that shows there is no likelihood of confusion between applicant's mark and the mark in the cited registration is the sophistication of the purchasers. Because of the nature of the goods, the purchasers of both applicant's goods and the goods related to the cited registration tend to be sophisticated physicians and/or surgical facilities. In addition, because of the very specific maladies that the goods are designed to be used in connection with, the persons purchasing the devices will be extremely careful and knowledgeable. It is hard to imagine a case where the purchasers would tend to be more careful or knowledgeable about the goods and sources therefor. Furthermore, these types of goods are not subject to impulse buying. Therefore, it is extremely unlikely that purchasers will be confused as to the source of the goods.

The Examining Attorney has argued that just because the purchasers may be sophisticated or knowledgeable does not necessarily mean that they would be sophisticated or knowledgeable in the field of trademarks. However, this belies the careful evaluation, review, research and source identification that physicians and surgical facilities undertake when purchasing such goods. The T.T.A.B. recognized and acknowledged the sophistication of the purchasers that purchase medical equipment as another reason for reversing the Examining Attorney in the *Digirad* case. *In re Digirad Corp* at 1845.

4. The Marks Have Been Used Concurrently Without Any Evidence of Actual Confusion

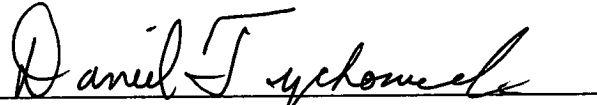
Another factor of *DuPont* is the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. The '225 Registration asserts that

the mark TRANSFIX has been used since June 1997. Furthermore, applicant and/or its predecessor in interest have continually used the mark TRANSFX since at least as early as December 2001. As such, there has been almost five years of concurrent use of the cited registration and applicant's mark, and applicant is not aware of any actual confusion among consumers. Accordingly, this is another factor that establishes that there is no likelihood of confusion between applicant's mark and the mark in the '225 Registration.

Therefore, the most significant factors of *DuPont* in this case all clearly indicate that there is no likelihood of confusion between applicant's mark TRANSFX and the mark in the cited registration.

It is believed that the application is in condition for publication, and Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's refusal to allow the subject application to proceed to publication.

Respectfully submitted,



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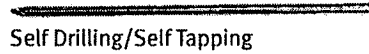
daniel.tychonievich@bakerd.com

EXHIBIT A
 Serial No. 78/717,996
 Mark: TRANSFX (ZTI-T02681e)

System Components

Large/Intermediate Components

Pins



Self Drilling/Self Tapping



Self Tapping



Trocar Tip



Central Threaded Pin

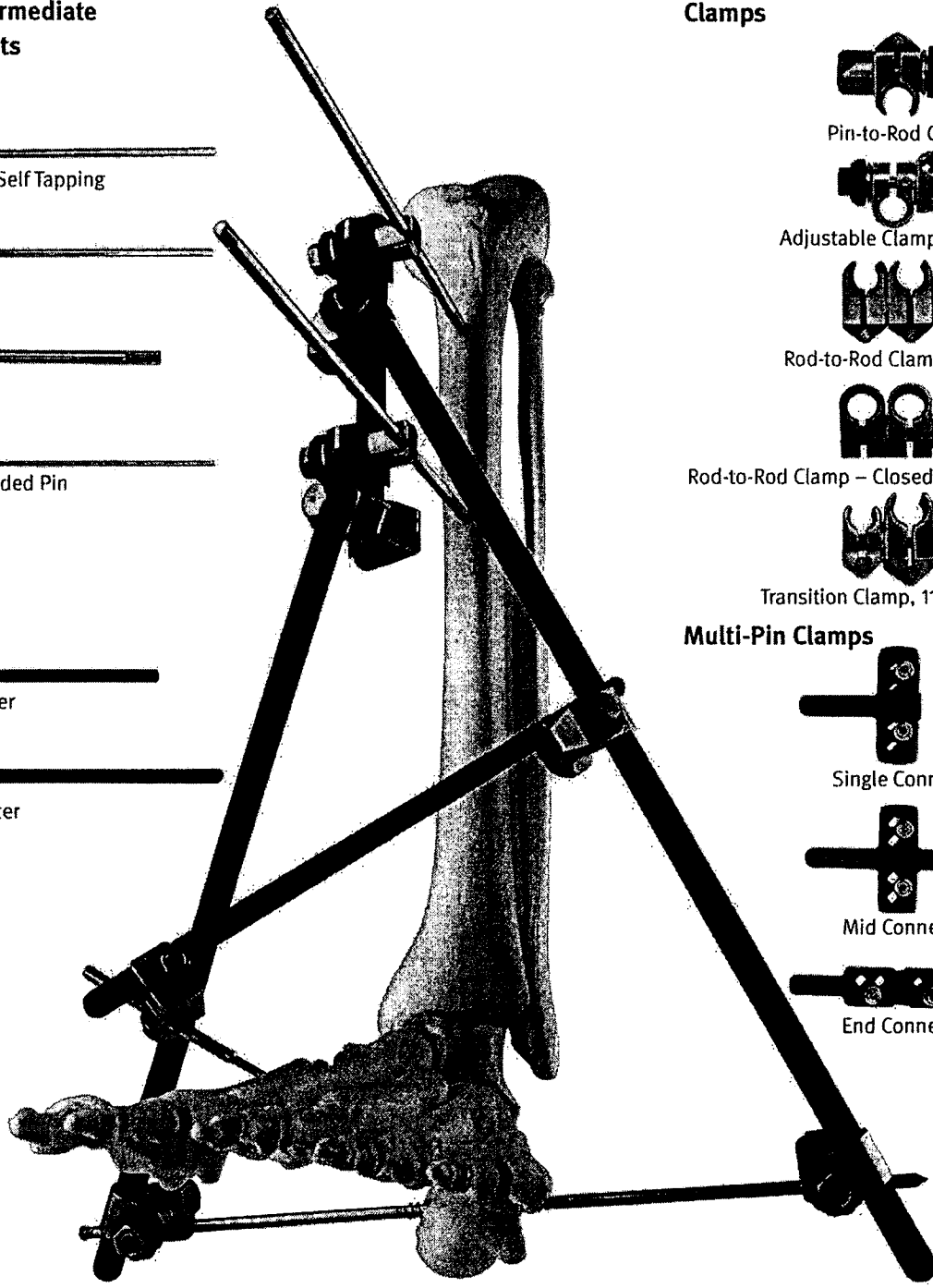
Rods



8mm diameter



11mm diameter



Clamps



Pin-to-Rod Clamp



Adjustable Clamp (Large Only)



Rod-to-Rod Clamp - Open



Rod-to-Rod Clamp - Closed (Intermediate Only)



Transition Clamp, 11mm to 8mm

Multi-Pin Clamps



Single Connect



Mid Connect



End Connect