

From: Morris, Caile

Sent: 2/13/2018 5:10:03 PM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 79200619 - RESCUESLEEVE - 7443.172 - Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 2

Files: 2018-02-13_17-08-34.jpg, 79200619.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79200619

MARK: RESCUESLEEVE



CORRESPONDENT ADDRESS:

JOSEPH W BERENATO III
BERENATO & WHITE LLC
6550 ROCK SPRING DRIVE
SUITE 240
BETHESDA, MD 20817

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Waldemar Link GmbH & Co. KG

CORRESPONDENT'S REFERENCE/DOCKET NO:

7443.172

CORRESPONDENT E-MAIL ADDRESS:

uspto.filings@bw-iplaw.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 2/13/2018

INTERNATIONAL REGISTRATION NO. 1328949

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusals made Final in the Office action dated May 31, 2017 are maintained and continue to be Final: Trademark Act Section 2(d) for a likelihood of confusion with a registered mark. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final

Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Specifically, applicant has not provided evidence that is substantially different from that provided in the Response to Office Action on May 22, 2016. Applicant has provided Internet evidence of third-party use in three instances to add to its nineteen third-party registrations for broad medical goods that include various phonetic equivalents of the word "RESCUE" to bolster the argument that the word "RESCUE" is weak in the general medical goods field.

Generally speaking, this is not persuasive because this argument considers all medical goods to be similar to each other, which is not the case. The goods have to be similar to various kinds of surgical implants. The only registration for another kind of surgical implant that uses the word "RESCUE", or phonetic equivalents thereof, is registrant's mark. The other submitted third-party registrations are only related to applicant and registrant's goods in the sense that they are used for a medical purpose, not that they are related or similar to surgical implants specifically. While the submitted third-party registrations may show that the term "RESCUE" is diluted in the emergency medical field, it does not show that the term is diluted for surgical implants. *See, e.g.*, U.S. Reg. Nos. 2695656, 5116528, 1944711, 3325841, 4250522, 2661100, 4165688, 5188507, & 4517745 (all for various kinds of emergency medical supplies), applicant's 5/22/17 Response, Ex. 4.

As to the submitted third-party Internet webpages showing various products using the term "RESCUE" or a phonetic equivalent thereof, this evidence is unpersuasive to show that "RESCUE" is diluted for surgical implants because it considers two uses on dental implants and one use on sinus implants from a company outside of the United States. *See* applicant's 12/8/17 Petition to Revive Abandoned Application, Ex. I-III.

In regards to the dental implants, the channels of trade are distinct between orthopedic surgical implants and dental surgical implants. The consumers purchasing the goods work in different types of workplaces, meaning that suppliers for a hospital or physicians' practice are not the same as suppliers for a dental practice. These consumers buy disparate goods, as the surgical implants and related accessories for dental surgery are not similar to those required for orthopedic surgery. Finally, the manufacturers of such products do not tend to overlap between providing dental surgical implants and orthopedic surgical implants.

In regards to the sinus implants, the company appears to be operating outside of the United States, and thus does not add to a dilution analysis for usage of a term within the United States. *See* <http://www.medical-instinct.de/en/company/> (showing that Medical Instinct Deutschland GmbH is headquartered in Germany).

Finally, applicant's arguments regarding the similarity of the goods and the trade channels of the goods do not provide a different perspective from what was mentioned in the initial Response to Office action. As the trademark examining attorney has previously stated, being a sophisticated purchaser within the medical field does not mean that the purchaser is immune from source confusion for related goods.

Accordingly, the request is denied.

As applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Caile Morris/

Examining Attorney

Trademark Law Office 123

(571) 270-0764

caile.morris@uspto.gov

Company

Medical Instinct Deutschland > - Company

SHARE KNOW-HOW – BOOST YOUR SUCCESS!

Medical Instinct® headquartered in Bovenden, Germany, is internationally active in the field of implant dentistry, restorative dentistry and oral tissue regeneration. On the basis of highest quality standards and ultramodern production processes, we provide our users exclusively with high-tech products "made in Germany". As, however, the success of a dental office or clinic depends not only on the range of the appropriate products, with Medical Pepp® we have established a unique practice marketing concept which enables Medical Instinct® users to successfully positioning themselves and to stand out from other medical practices. Thus, we offer you one of the most beautiful products ever: that is success.

