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

Proceeding	79200619
Applicant	Waldemar Link GmbH & Co. KG
Applied for Mark	RESCUESLEEVE
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Submission	Applicants Request for Remand and Amendment
Attachments	RESCUESLEEVE.pdf(169061 bytes)
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Date	04/24/2018

The Examining Attorney is thanked for the courtesy of a telephone call on April 23, 2018 during which the proposed amendment was discussed.

Applicant respectfully submits this Amendment, Request for Reconsideration and Request for Remand pursuant to TMEP § 715.04(b), and requests that the identification of goods and services be amended as follows:

Custom-made surgical ~~Surgical~~ instruments and implants, comprising artificial material, for joint replacement and use by healthcare providers; custom-made prostheses, in particular custom-made endoprotheses but not spinal endoprotheses, for use by healthcare providers; custom-made endoprosthetic implants, but not spinal endoprosthetic implants, made of artificial materials, for use by healthcare providers; custom-made artificial acetabulum implants, for use by healthcare providers; custom-made artificial hip joint implants for use by healthcare providers, custom-made artificial knee joint implants for use by healthcare providers.

Applicant's RESCUESLEEVE mark stands refused under Section 2(d) of the Lanham Act based upon alleged likely confusion with U.S. Registration No. 4060424 for the mark RESCUE as applied to "spinal implants composed of artificial materials for use in spine surgery."

The *DuPont* factors that are affected by the above amendments to the identification of goods include, at least, (1) the conditions under which and buyers to whom sales are made, *i.e.*, "impulse" versus careful, sophisticated purchasing, and (2) the similarity or dissimilarity of established, likely-to-continue trade channels. See TMEP § 1207.01; *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

1. The Conditions Under Which and Buyers to Whom Sales Are Made

As now defined in the identification of goods, Applicant's mark applies to custom-made surgical instruments and implants, custom-made prostheses, custom-made endoprotheses, custom-made endoprosthetic implants, custom-made artificial acetabulum implants, custom-made artificial hip joint implants, and custom-made artificial knee joint implants.

Applicant's custom-made surgical instruments, implants, and (endo)prostheses are, by their very nature, sold exclusively to professionals, in particular orthopedic surgeons and more typically hospitals specializing in prosthetic surgery. This is not a situation in which sales are made to both professionals and the general public. An ordinary purchaser of the general public lacks the skill, aptitude, education, and facilities to collaborate with Applicant to design and manufacture a custom-made product. Often, there is much collaboration between the Applicant

and the physician/hospital to meet the needs of the patient, and extensive discussions and exchanges of information, including medical records, are necessary due to both the complexity of the technology and the high cost of the equipment. See *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786, 790 (1st Cir. 1983). The physicians and hospitals who work with Applicant to custom make goods and purchase Applicant's custom-made goods are very sophisticated, and exercise a high level of care in their field of expertise. As such, the purchasers are very discriminating and less likely to be confused as to the source of goods they purchase. The sophistication of discriminating purchasers is "important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'" *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

2. Channels of Trade

Applicant's goods are completely custom made and can only be accessed directly from Applicant. There is no way to purchase Applicant's goods in "normal" channels of trade. Nor can Applicant's goods be ordered by the general public or purchased "off the self." "Custom made" means working directly with Applicant to customize the surgical instrument, implant, or prosthesis for the patient. Accordingly, there cannot be overlapping channels of trade between Applicant's goods and the goods of the cited registration.

3. The Number of Similar Marks

Applicant has cited numerous marks incorporating the prefix "rescue" associated with goods involving medical products. While the examining attorney disagrees, the plethora of "rescue" marks in this space makes evident that surgeons, hospitals, and others in the field have the ability to distinguish between various medical products goods due to their sophistication, knowledge and experience. These numerous "rescue" marks dealing with medical products cannot simply be disregarded.

4. Differences between the Goods

During the telephone call the Examining Attorney remarked that the goods in Reg. No. 4060424 have no restrictions and are broadly worded. Applicant disagrees. The goods of the cited registration are limited to "spinal implants composed of artificial materials for use in spine surgery." By their very nature the goods are limited to "spinal implants" for use solely in "spine surgery." Applicant's goods expressly exclude goods that might be useful in spine surgery. They are not spinal implants.

Applicant's goods, on the other hand, are for joint replacement surgery. The spine is not a joint. Orthopedic surgeons recognize readily that Applicant's custom-made joints, particularly hip and knee replacement prostheses, are totally unrelated to spinal implants. One cannot be used for the other. A conclusion to the contrary must ignore the persons who buy these goods, the persons who implant these goods, and the persons who have a need for these goods.

5. Conclusion

In summary, neither Applicant nor the Registrant sells its respective goods and/or services to the general public. Each market is professional, distinct, and sophisticated. Because the conditions under which and buyers to whom sales of custom-made goods are made are so specific, there can be no likelihood of confusion between the marks.