

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	88139376
LAW OFFICE ASSIGNED	LAW OFFICE 125
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/88139376/large
LITERAL ELEMENT	PARADIGM
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.

ARGUMENT(S)

The Office Action denies applicant’s mark due to a likelihood of confusion. The Office Action provides, in part, that applicant’s mark PARADIGM and registrant’s mark PARADIGM are identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” Please note, the list of goods has been further defined to include orthopedic surgical hip products, devices, and instruments.

In evaluating likelihood of confusion between two marks, one must compare the entirety of the marks. *Estate of P.D. Beckwith, Inc., v. Commissioner*, 252 U.S. 538 (1920). A likelihood of confusion determination is based on the factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973). Applicant respectfully submits that an analysis between the two marks using the Du Pont factors shows that the marks are not confusingly similar, as discussed further below.

1. Applicant’s applied for goods are dissimilar from the registrant’s mark’s goods.

When properly evaluated in their entireties, applicant’s PARADIGM mark and registrant’s PARADIGM mark are used in conjunction with completely different goods and services. Applicant’s mark is for orthopedic *surgical* hip products, devices, and instruments while the registrant’s mark is related to non-surgical knee braces.

To support the allegation that registrant’s and applicant’s goods are similar, the Office Action cites websites showing both knee braces and orthopedic instruments and devices. However, evidence of one company selling multiple products does not necessarily mean that the products are similar. The websites referenced are all generic medical supply companies that generally provide a large number of different health-related supplies. *Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329 (T.T.A.B. 1979) (“Not everything that is sold by a large retail establishment selling a plethora of otherwise unrelated goods is necessarily connected, within the meaning of § 2(d) of the Act, to every other product that happens to be displayed or offered under the same roof.”). The health field is much too broad of an umbrella to say that anything under it is related. *Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) (Finding blood analyzer machines unrelated to drugs stating “The most favorable inference that may be drawn from the evidence regarding the similarity of goods is that both parties’ products are used in the medical or health care field. However, such a broad inference is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion as to the source of the products involved in the present suit.”).

The cited websites actually show that the goods are so dissimilar that they require completely separate categories and placements within the website. For example, the Deroyal and Henry Schien websites place the applicant’s goods in a surgical supplies section while knee braces are in a separate orthopedic section. The Medline website places knee braces under a therapy and rehabilitation category while the

surgical supplies are under other categories such as general sterile/ surgical instruments. Medline also separates the consumers of these products by having a section just for surgery centers. The Knapp Surgical website sells surgical supplies, and the Office Action's highlighted surgical knee immobilizer is a device used for the purposes of keeping the knee immobilized during total knee implant reconstruction surgery (which is very different from the cited registration's non-surgical goods). The Medical Supply Group website places knee braces under an orthopedics category while surgical instruments are under a surgical category. Finally, the Shop Med Vet website sells medical and veterinary supplies and places knee braces under a leg and knee braces category while applicant's goods are listed under a surgical supplies category.

The Office Action also cited registered third-party marks which manufacture both knee braces and orthopedic surgery instruments and devices under the same mark. All of the marks the Office Action cited have long lists of a variety of goods that they relate to except for CERACROWN serial number 78780553 and HB serial number 86057383, both of which focus on dental equipment. For example, a small sampling of the goods that AMERINET CHOICE serial number 75592648 is registered for includes bandages, surgical scrubs, medical waste containers, knee pads, and male continence devices. None of the cited registered marks are used for specific specialized items like the registrant's mark and the applicant's mark. These marks that have many different medical items do not show that a consumer would be confused between two marks that have a specific set of goods they represent. *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) (noting that two of the third-party registrations were given little probative weight because they were issued to entities selling a wide variety of goods and services.).

1. The target consumers are two different sophisticated professionals who are unlikely to confuse the goods or the marks.

The Office Action's assertions regarding the similarity of the goods does not sufficiently factor in the sophistication of the target consumers. Both applicant's target customers and the target customers of the registrant are likely to be highly sophisticated and thus are not likely to be confused by different goods. When consumers exercise heightened care in evaluating products, there is not a strong likelihood of confusion, even among similar marks. Here, the target consumers of the applicant's goods are highly trained medical professionals and surgeons with years of experience purchasing and using surgical supplies and similar goods.

“Where the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers. Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary consumer.”

3 *McCarthy on Trademarks*, § 23:101. See also, Thomas R. Lee, et al., “Trademarks, Consumer Psychology, and the Sophisticated Consumer,” Emory L.J. 57: 575-650 (2007) (citing a string of court cases for the proposition that “[c]ourts consistently presume that professional buyers are sophisticated (higher in motivation and ability) and thus exercise a high degree of care in product categories within their area of expertise or responsibility.”). Here, the goods offered by the applicant's and registrant's marks are clearly within the area of expertise of medical professionals, and thus these consumers will presumably exercise a high degree of care.

Further, as surgeons and medical professionals are highly skilled and well-trained professionals, they are unlikely to confuse surgical instruments with non-surgical knee braces. Indeed, customers of medical supplies are very likely to be extremely discerning, especially considering both the tremendously high cost of medical services and the fact that that surgeries can often be a matter of life and death. The level of care likely to be exhibited by customers of the divergent goods in question significantly minimizes the likelihood of confusion asserted by the Office Action. TMEP § 1207.01(d)(vii). Therefore, Applicant's applied for surgical goods are entirely different from non-surgical knee braces with different target consumers and thus, applicant's goods are readily distinguished from the goods of the registrant's mark, and there is no likelihood of confusion between the marks.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	010
DESCRIPTION	
Orthopedic hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers	

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	010
TRACKED TEXT DESCRIPTION	
<p>Orthopedic hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers; Orthopedic surgical hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers</p>	
FINAL DESCRIPTION	
Orthopedic surgical hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers	
FILING BASIS	Section 1(b)
ATTORNEY SECTION (current)	
NAME	Fred J.M. Price
ATTORNEY BAR MEMBERSHIP NUMBER	NOT SPECIFIED
YEAR OF ADMISSION	NOT SPECIFIED
U.S. STATE/ COMMONWEALTH/ TERRITORY	NOT SPECIFIED
FIRM NAME	Bond, Schoeneck & King, PLLC
STREET	One Lincoln Center
CITY	Syracuse
STATE	New York
POSTAL CODE	13202
COUNTRY	US
PHONE	315-218-8000
FAX	315-218-8100
EMAIL	bskpto@bsk.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	C0508T
ATTORNEY SECTION (proposed)	
NAME	Fred J.M. Price
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	Bond, Schoeneck & King, PLLC
STREET	One Lincoln Center
CITY	Syracuse
STATE	New York
POSTAL CODE	13202

COUNTRY	United States
PHONE	315-218-8000
FAX	315-218-8100
EMAIL	pto@conmed.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	C0508T
CORRESPONDENCE SECTION (current)	
NAME	FRED J.M. PRICE
FIRM NAME	Bond, Schoeneck & King, PLLC
STREET	One Lincoln Center
CITY	Syracuse
STATE	New York
POSTAL CODE	13202
COUNTRY	US
PHONE	315.218.8130
EMAIL	pto@conmed.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	C0508T
CORRESPONDENCE SECTION (proposed)	
NAME	Fred J.M. Price
FIRM NAME	Bond, Schoeneck & King, PLLC
STREET	One Lincoln Center
CITY	Syracuse
STATE	New York
POSTAL CODE	13202
COUNTRY	United States
PHONE	315-218-8000
FAX	315-218-8100
EMAIL	pto@conmed.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	C0508T
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Fred J.M. Price/
SIGNATORY'S NAME	Fred J.M. Price
SIGNATORY'S POSITION	attorney of record
DATE SIGNED	12/09/2019
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Mon Dec 09 15:31:10 EST 2019
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20191209153110667062-8813 9376-7002c92d9f2e6f520484 56aca989657e1ff54a4ef0575 b8c7e56f2e295456779b-N/A- N/A-20191209152627856253

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 09/20/2020)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **88139376** PARADIGM(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/88139376/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Office Action denies applicant's mark due to a likelihood of confusion. The Office Action provides, in part, that applicant's mark PARADIGM and registrant's mark PARADIGM are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." Please note, the list of goods has been further defined to include orthopedic surgical hip products, devices, and instruments.

In evaluating likelihood of confusion between two marks, one must compare the entirety of the marks. *Estate of P.D. Beckwith, Inc., v. Commissioner*, 252 U.S. 538 (1920). A likelihood of confusion determination is based on the factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973). Applicant respectfully submits that an analysis between the two marks using the Du Pont factors shows that the marks are not confusingly similar, as discussed further below.

1. Applicant's applied for goods are dissimilar from the registrant's mark's goods.

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are under other categories such as general sterile/ surgical instruments. Medline also separates the consumers of these products by having a section just for surgery centers. The Knapp Surgical website sells surgical supplies, and the Office Action's highlighted surgical knee immobilizer is a device used for the purposes of keeping the knee immobilized during total knee implant reconstruction surgery (which is very different from the cited registration's non-surgical goods). The Medical Supply Group website places knee braces under an orthopedics category while surgical instruments are under a surgical category. Finally, the Shop Med Vet website sells medical and veterinary supplies and places knee braces under a leg and knee braces category while applicant's goods are listed under a surgical supplies category.

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CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 010 for Orthopedic hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Orthopedic hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers;~~ Orthopedic surgical hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers

Class 010 for Orthopedic surgical hip products, devices, and instruments, namely, suture passers, suture retrievers, all-suture anchors, traction tables, drill bits, drill guides, instrument trays, cannulas, obturators, retractable blades, shaver blades, articulating biters, articulating graspers, stopcocks, knot pushers, and a joint access kit, including portal savers

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

The applicant's current attorney information: Fred J.M. Price. Fred J.M. Price of Bond, Schoeneck & King, PLLC, is located at

One Lincoln Center
Syracuse, New York 13202
US

The docket/reference number is C0508T.

The phone number is 315-218-8000.

The fax number is 315-218-8100.

The email address is bskpto@bsk.com

The applicants proposed attorney information: Fred J.M. Price. Fred J.M. Price of Bond, Schoeneck & King, PLLC, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

One Lincoln Center
Syracuse, New York 13202
United States

The docket/reference number is C0508T.

The phone number is 315-218-8000.

The fax number is 315-218-8100.

The email address is pto@conmed.com

Fred J.M. Price submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

The applicant's current correspondence information: FRED J.M. PRICE. FRED J.M. PRICE of Bond, Schoeneck & King, PLLC, is located at

One Lincoln Center
Syracuse, New York 13202
US

The docket/reference number is C0508T.

The phone number is 315.218.8130.

The email address is pto@conmed.com

The applicants proposed correspondence information: Fred J.M. Price. Fred J.M. Price of Bond, Schoeneck & King, PLLC, is located at

One Lincoln Center
Syracuse, New York 13202
United States

The docket/reference number is C0508T.

The phone number is 315-218-8000.

The fax number is 315-218-8100.

The email address is pto@conmed.com

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Fred J.M. Price/ Date: 12/09/2019

Signatory's Name: Fred J.M. Price

Signatory's Position: attorney of record

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: FRED J.M. PRICE
Bond, Schoeneck & King, PLLC

One Lincoln Center
Syracuse, New York 13202

Mailing Address: Fred J.M. Price
Bond, Schoeneck & King, PLLC
One Lincoln Center
Syracuse, New York 13202

Serial Number: 88139376

Internet Transmission Date: Mon Dec 09 15:31:10 EST 2019

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201912091531106

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