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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re ConMed Corporation*

Serial No. 88202718

Frederick J.M. Price of Bond Schoeneck & King, PLLC for ConMed Corporation.

Chioma (Bata) Oputa, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

Before Goodman, Larkin, and Lebow,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

ConMed Corporation ("Applicant") seeks registration on the Principal Register of the standard-character mark CONMED UNIFY for "surgical devices, namely, a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures, electrosurgical generator apparatus, namely, electrosurgical generators with argon beam coagulation capabilities used only for laparoscopic surgeries and sold only by

authorized and exclusive sales representatives who do not also sell suture needles and sutures" in International Class 10.[1]

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the standard-character mark UNIFY, registered on the Principal Register for "surgical needles and sutures" in International Class 10,[2] as to be likely, when used on or in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed.[3] We affirm the refusal to register.

## I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant attached to its appeal brief a declaration of Angelo Cirino, Applicant's Senior Product Manager for Energy Marketing. 16 TTABVUE 22-23. The declaration purports to respond to the December 7, 2021 Final Office Action issued by the

[1] Application Serial No. 88202718 was filed on November 21, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce.

[2] The cited Registration No. 3832983 issued on August 10, 2010 and has been maintained.

[3] Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's brief appears at 16 TTABVUE and its reply brief appears at 19 TTABVUE. The Examining Attorney's brief appears at 18 TTABVUE.

Examining Attorney after the second of the two remands of the application on appeal discussed below. *Id.* at 22.

The Examining Attorney argues that the declaration "was untimely submitted during an appeal" and "objects to this evidence and requests that the Board disregard it." 18 TTABVUE 6. Applicant does not address the Examining Attorney's objection in its reply brief.

We sustain the Examining Attorney's objection. "The evidence submitted with Applicant's appeal brief that Applicant did not previously submit during prosecution (including the request for reconsideration)," or on the two remands on appeal discussed below, "is untimely and will not be considered." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (citing Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d)), *aff'd*, 777 Fed. App'x 516 (Fed. Cir. 2019)). We have given the Cirino declaration attached to Applicant's appeal brief no consideration in our decision.

## II. Prosecution and Procedural History, and Record on Appeal[4]

We summarize briefly the history of the application and appeal because they provide useful background for our analysis of the refusal to register.

Applicant initially sought registration of its mark for goods identified as "surgical devices, namely, a modular multifunction energy platform including surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical

[4] Citations in this opinion to the application record, including the request for reconsideration and its denial, are either to pages in the Trademark Status and Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO"), or to TTABVUE pages containing additional evidence on Applicant's two requests on appeal for remand of the application to the Examining Attorney for consideration of that evidence.

procedures, electrosurgical generator apparatus including accessories and related handpieces, and/or argon beam generators including related accessories and handpieces" in Class 10.

The Examining Attorney issued an Office Action refusing registration under Section 2(d) based on the cited registration and requiring amendment to Applicant's identification of goods.[5] The Examining Attorney made of record USPTO electronic records regarding the cited registration,[6] pages from Applicant's website at conmed.com,[7] and pages from the websites of third-party sellers of surgical products.[8] In its response, Applicant argued against the Section 2(d) refusal and amended its identification of goods to "surgical devices, namely, a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures, electrosurgical generator apparatus and accessories therefor, namely, electrosurgical handpieces and electrodes, electrosurgical generators with argon beam coagulation, argon tanks, footswitches, and air filtration units."[9]

[5] February 7, 2019 Office Action at TSDR 1.

[6] *Id.* at TSDR 2-3.

[7] *Id.* at TSDR 7-10.

[8] *Id.* at TSDR 11-16. The Examining Attorney also noted a prior pending application as a possible bar to registration, but that application later became abandoned. August 4, 2020 Final Office Action at TSDR 1.

[9] May 29, 2019 Response to Office Action at TSDR 1-6.

Following a suspension of the application, the Examining Attorney issued an Office Action making final the refusal to register under Section 2(d),[10] and making of record additional pages from the websites of third-party sellers of surgical products.[11]

Applicant appealed and requested reconsideration.[12] The Examining Attorney denied Applicant's request, and made of record a dictionary definition of the word "unify."[13] The appeal was then resumed. 5 TTABVUE 1.

Applicant filed a Request for Remand to the Examining Attorney shortly before its appeal brief was due for consideration of additional evidence consisting of a declaration of Newsha Nami, Applicant's Global Product Manager, and Exhibits 1-6 thereto. 6 TTABVUE 8-39.[14] Applicant also sought to amend its identification of goods as follows:

> surgical devices, namely, a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures, electrosurgical generator apparatus and accessories therefor, namely, electrosurgical handpieces and electrodes, electrosurgical generators with argon beam coagulation capabilities, argon tanks, footswitches, and air filtration units and sold only by authorized and exclusive sales representatives who do not also sell suture needles and sutures.

[10] August 4, 2020 Final Office Action at TSDR 1.

[11] *Id.* at TSDR 2-20.

[12] February 4, 2021 Request for Reconsideration at TSDR 1-9.

[13] March 9, 2021 Denial of Request for Reconsideration at TSDR 12.

[14] We will cite the Nami Declaration by paragraph and exhibit number (e.g., "Nami Decl. ¶ 6: Ex. 3") and by TTABVUE pages (e.g., "6 TTABVUE 10, 20-28").

*Id.* at 7. The Board granted Applicant's request, suspended the appeal, and remanded the application to the Examining Attorney for consideration of the additional evidence. 7 TTABVUE 1.

On remand, the Examining Attorney issued another Final Office Action maintaining the Section 2(d) refusal and denying Applicant's request to amend its identification of goods on the ground that the proposed amendment exceeded the scope of the existing identification of goods.[15]

The appeal was subsequently resumed. 9 TTABVUE 1. Shortly before Applicant's appeal brief was due, Applicant filed a second Request for Remand, stating that Applicant "is currently gathering additional evidence internally from an employee and externally from certain customers of Applicant . . . ." 10 TTABVUE 1. The Board denied this request because "the mere filing of the request for remand is not sufficient for the Board to forward the file to the Examining Attorney for consideration," 11 TTABVUE 1, and gave Applicant 20 days in which to "resubmit its request for remand, accompanied by the additional evidence." *Id.*

Applicant subsequently filed another Request for Remand accompanied by a declaration of its Senior Product Manager for Energy Marketing, Mr. Cirino, and Exhibits 1-6 thereto. 12 TTABVUE 1-49.[16] Applicant also sought to amend its identification of goods as follows:

> surgical devices, namely, a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical

[15] July 6, 2021 Final Office Action at TSDR 1.

[16] We will cite the Cirino Declaration in the same manner as the Nami Declaration.

> procedures, electrosurgical generator apparatus, namely, electrosurgical generators with argon beam coagulation capabilities used only for laparoscopic surgeries and sold only by authorized and exclusive sales representatives who do not also sell suture needles and sutures.

*Id.* at 6. The Board again granted Applicant's request, suspended the appeal, and remanded the application to the Examining Attorney for consideration of the additional evidence and Applicant's proposed amendment to the identification of goods. 13 TTABVUE 1.

On the second remand, the Examining Attorney issued another Final Office Action that maintained the Section 2(d) refusal, but accepted Applicant's request to amend its identification of goods.[17] The Examining Attorney made of record third-party webpages offering electrosurgical needles sold by Applicant,[18] displaying a page from Applicant's product catalog,[19] and displaying products used in electrosurgery.[20]

The Board subsequently resumed the appeal, 15 TTABVUE 1, and Applicant and the Examining Attorney filed their briefs.

## III. Analysis of Section 2(d) Refusal

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used

[17] December 7, 2021 Final Office Action at TSDR 1.

[18] *Id.* at TSDR 2.

[19] *Id.* at TSDR 3.

[20] *Id.* at TSDR 4-5.

on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.,* 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

"In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services." *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *29 (TTAB 2021) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant discusses these two key *DuPont* factors, as well as the third factor, the "similarity or dissimilarity of established, likely-to-continue trade channels," and the fourth factor, the "conditions under which, and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. 16 TTABVUE 4-20.

**A. Similarity or Dissimilarity of the Marks**

"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73

USPQ2d 1689, 1691 (Fed. Cir. 2005)). "'Similarity in any one of these elements may be sufficient to find the marks confusingly similar.'" *Id.* (quoting *Inn at St. John's,* 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014)).

"The proper test regarding similarity 'is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.'" *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). "'The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than a specific impression of marks.'" *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)).[21]

Applicant's mark is CONMED UNIFY in standard characters, and the cited mark is UNIFY in standard characters. Applicant argues that its CONMED UNIFY mark "denotes a (1) different appearance, (2) different sound, and (3) different meaning or connotation and a distinct commercial impression as compared to the Cited Mark." 16 TTABVUE 5. Applicant emphasizes the presence of its CONMED house mark at the beginning of its mark, arguing that "consumers will focus on the first, unique and inherently distinctive (i.e., dominant) word of Applicant's Mark – 'CONMED' – and not the less distinctive, weaker and less dominant common second word – 'UNIFY - . . . ." *Id.* at 5-6.

[21] The average customer of the goods identified in the application is a hospital or other medical facility that provides electrosurgical procedures.

Applicant argues that the word UNIFY that is common to the marks "is either descriptive or, at best, highly suggestive of the Cited Mark's goods (surgical needles and sutures)" because "to 'unify' means to join, bring things together or merge items," *id.* at 6,[22] and the "main function of surgical needles and sutures is to join/bring (sew) body tissue together separated by trauma or a purposeful incision." *Id.* Applicant further argues that the "'UNIFY' portion of Applicant's Mark is similarly highly suggestive of Applicant's Goods" because "Applicant's Goods include a modular multifunction energy platform which joins/brings together surgical smoke evacuation devices with electrosurgical generators." *Id.* According to Applicant, "the common portion of Applicant's Mark and [the] Cited Mark is the descriptive or highly suggestive, 'weak' and less dominant term 'UNIFY,' and the mere presence of this lone common portion is insufficient to support a finding of a likelihood of confusion." *Id.* at 6-7.

Applicant also argues that its mark "conveys a different commercial impression and denotes a different connotation as to compared to the Cited Mark," *id.* at 7, because CONMED UNIFY "connotes 'to join together medical devices/systems' as applied to Applicant's Goods," while UNIFY "connotes 'to join/bring body tissue together separated by trauma or a purposeful incision' as applied to the Cited Mark's Goods . . . ." *Id.* at 8.

[22] Applicant attached to its appeal brief a page from the MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) containing a definition of the verb "unify." 16 TTABVUE 21. The Examining Attorney did not object to this definition, but instead addressed it on the merits. 18 TTABVUE 10, so we will consider it for whatever probative value it may have.

The Examining Attorney responds that "the average purchaser, who retains a general rather than specific impression of trademarks is likely to assume a connection between the parties because the marks share the identical wording 'UNIFY' and identify closely related goods." 18 TTABVUE 8. She argues that "[a]lthough the applied-for mark contains the additional wording 'CONMED', it is well established that adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d)," *id.*, that "the registered mark is entirely incorporated within the applied-for mark," and that "[i]ncorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d)." *Id.* at 9.

The Examining Attorney rejects Applicant's argument that CONMED is the dominant portion of its mark "because 'CONMED' could be viewed as the house mark for 'UNIFY'" and "[a]dding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d)." *Id.* She also rejects Applicant's argument regarding the significance of "UNIFY" because Applicant "has not provided any sufficient evidence to support its assertion that the term 'UNIFY' is descriptive, highly suggestive, or weak," and "[i]n particular, [A]pplicant has not provided evidence of widespread third-party use of similar marks with similar goods." *Id.* at 10. According to the Examining Attorney,

> Applicant merely provides a definition of the word "UNIFY" and its own interpretation of what the word

> means in connection with applicant's and registrant's goods. . . . [T]his evidence and analysis is not enough to support applicant's assertion that the term "UNIFY" is insignificant. As stated in the previous Office action, the marks identify closely related goods and the meaning of the term "UNIFY" does not change in connection with such goods. Thus, the term "UNIFY" in the marks conveys the same idea, stimulates the same mental reaction, and has the same overall meaning in both the applicant's and registrant's marks.

*Id.*

In its reply brief, Applicant argues that "consumers are unlikely to assume a connection between the marks because CONMED is an additional arbitrary or fanciful word in Applicant's mark that has nothing to do with the product in [sic] which it is associated with, while the overlapping/common element—'UNIFY'—is a descriptive or, at best, highly suggestive, and a relatively weaker term." 19 TTABVUE 5. Applicant points again to the dictionary definition of "unify" and argues that the Examining Attorney does not provide another definition "nor does she deny the purpose/function of the respective Goods." *Id.* at 6. Applicant acknowledges that CONMED is a house mark, but concludes that "the addition of a house mark in situations with similar facts has been determined sufficient to render the marks as a whole sufficiently distinguishable." *Id.* at 7.

Applicant's CONMED UNIFY mark adds Applicant's house mark CONMED to the cited mark UNIFY. Applicant acknowledges that "[i]t is generally true that, as the Examining Attorney noted, the insertion of a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section

2(d)," 16 TTABVUE 7, and, based on the record before us, we find that the addition of CONMED to UNIFY does not do so here.

We turn first to the claimed conceptual weakness of the word "unify" in the context of the involved goods. Both Applicant and the Examining Attorney offered definitions of "unify" from the MERRIAM-WEBSTER DICTIONARY as "to bring together; combine," 16 TTABVUE 21, and "to make into a unit or a coherent whole,"[23] respectively. Neither definition suggests, much less describes, a feature or attribute of surgical needles and sutures, or electrosurgical devices and apparatus.[24] As the Examining Attorney notes, the record is also devoid of evidence that UNIFY is conceptually weak for surgical needles and sutures, or electrosurgical devices and apparatus, because it "'is commonly registered for similar goods or services.'" *Embiid*, 2021 USPQ2d 577, at *34 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)).

Accordingly, the record does not support Applicant's arguments that the word UNIFY is highly suggestive, descriptive, or weak, and that UNIFY means one thing when it is used as the registrant's mark for surgical needles and sutures and a different thing when it is used as part of Applicant's CONMED UNIFY mark for

[23] March 9, 2021 Denial of Request for Reconsideration at TSDR 2.

[24] Applicant made of record pages from the registrant's website that display and discuss the registrant's UNIFY surgical needles and sutures. Nami Decl. ¶ 7; Exs. 5-6 (6 TTABVUE 10, 31-39); Cirino Decl. ¶ 13; Exs. 5-6 (12 TTABVUE 20, 41-49). One of the pages lists "[c]haracteristics of UNIFY Nylon Microsutures." Nami Decl. Ex. 6 (6 TTABVUE 38); Cirino Decl. Ex. 6 (12 TTABVUE 48). There is nothing in that list of characteristics, or elsewhere on the registrant's website, that supports the meaning of the word UNIFY that Applicant attributes to it in the cited mark.

electrosurgical devices and apparatus. We find that UNIFY is not suggestive or descriptive of the involved goods.

Our finding is buttressed by the fact that the cited registration issued on the Principal Register without a requirement of a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and we thus must presume that UNIFY is inherently distinctive for surgical needles and sutures. *New Era*, 2020 USPQ2d 10586, at *10; *Tea Bd. of India v. Republic of Tea*, 80 USPQ2d 1881, 1899 (TTAB 2006) ("A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods."). The Examining Attorney similarly did not require a disclaimer of the word UNIFY in Applicant's mark, suggesting that the word is also inherently distinctive as part of Applicant's mark for the identified electrosurgical devices and apparatus.

With respect to Applicant's argument regarding the different meanings of UNIFY in the respective marks, the Federal Circuit and the Board have recognized that identical marks can have different meanings in the context of different goods. *See*, *e.g.*, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) ("Opposer's COACH mark, when applied to fashion accessories, is clearly either arbitrary or suggestive of carriage or travel accommodations (e.g., stagecoach, train, motor coach, etc.), thereby engendering the commercial impression of a traveling bag (e.g., a coach or carriage bag). On the other hand, applicant's

COACH marks call to mind a tutor who prepares a student for an examination."); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (applicant's mark CROSS-OVER for brassieres was "suggestive of the construction of the brassieres," while the cited mark CROSSOVER was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which 'crosses over' the line between informal and more formal wear (i.e., is appropriate for either use), or the line between two seasons."); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (BOTTOMS UP for men's suits, coats, and trousers found to be associated with the drinking phrase meaning "drink up!," while BOTTOMS UP for ladies' and children's underwear did not have the same connotation). But Applicant's claim that UNIFY refers in the cited mark to the "main function of surgical needles and sutures[, which] is to join/bring (sew) body tissue together separated by trauma or a purposeful incision," while UNIFY refers in its mark to "a modular multifunction energy platform which joins/brings together surgical smoke evacuation devices with electrosurgical generators," 16 TTABVUE 6, is based entirely on "the argument of Applicant's counsel, which is 'no substitute for evidence.'" *Embiid*, 2021 USPQ2d 577, at *40 (quoting *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *15 (TTAB 2019)).[25] There is simply "no evidence here, or other reason to find," *id.*, at *21, that UNIFY has one meaning in the cited mark for surgical needles and sutures, and a second and different meaning as part of Applicant's mark for electrosurgical devices and

[25] Neither of Applicant's declarants testified about the meaning of the word UNIFY in Applicant's mark.

apparatus, "based on the nature of the respective goods." *Id.*[26] On this record, we find that UNIFY would have the same general meaning, and create the same general impression, in both marks.

"In this case, the marks [UNIFY] and [CONMED UNIFY] are more similar than they are different. Applicant has taken registrant's mark and added its '[house] mark' to it," and "[i]t is not clear why the addition of the word [CONMED] would avoid confusion." *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (finding that VANTAGE TITAN for "medical magnetic resonance imaging diagnostic apparatus, namely, MRI diagnostic apparatus" was confusingly similar to TITAN for a "medical diagnostic apparatus, namely, medical ultrasound device"). CONMED UNIFY "is more likely to be considered another product from the previously anonymous source of" UNIFY surgical needles and sutures. *Id. See also In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007) ("When, as in this case, the common part of the marks is identical, purchasers familiar with the registrant's mark are likely to assume that the house mark simply identifies what had previously been an anonymous source.") (finding that CLUB PALMS MVP for casino services was confusingly similar to MVP for the same services).[27]

[26] Applicant's argument also assumes, without supporting evidence, a level of subtlety of consumer perception that is inconsistent with our working assumption, in the absence of evidence to the contrary, that the average customer of the involved goods "retains a general rather than specific impressions of the marks." *Embiid*, 2021 USPQ2d 577, at *11.

[27] The Board recently reiterated that "'[t]he weighing of the relevant [*DuPont*] factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user'," *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *17 (TTAB 2021) (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)), under the doctrine of reverse confusion. A purchaser who first encounters

Due to the common presence of the inherently-distinctive word UNIFY in the marks, we find that UNIFY and CONMED UNIFY are far more similar than dissimilar in appearance, sound, and connotation and commercial impression, and the first *DuPont* factor supports a finding of a likelihood of confusion.

### B. Similarity or Dissimilarity of the Goods, Channels of Trade, and Buyers to Whom Sales Are Made

The second *DuPont* factor "'considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,' while the third *DuPont* factor considers 'the similarity or dissimilarity of established, likely-to-continue trade channels.'" *Embiid*, 2021 USPQ2d 577, at *29 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d, 1047, 1051-52 (Fed. Cir. 2018) (internal quotation omitted)). In this section, we will "also discuss the portion of the fourth *DuPont* factor that addresses the 'buyers to whom sales are made.'" *Sabhnani*, 2021 USPQ2d 1241, at *19 (quoting *DuPont*, 177 USPQ at 567).

#### 1. Similarity or Dissimilarity of the Goods

The goods identified in the application are "surgical devices, namely, a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures, electrosurgical generator apparatus, namely, electrosurgical generators with argon beam coagulation capabilities used only for laparoscopic surgeries and sold only by authorized and exclusive sales representatives who do not also sell suture needles

Applicant's CONMED UNIFY mark and later encounters the cited UNIFY mark may view the cited mark as a shortened version of Applicant's mark. *Id.*, at *38-39.

and sutures."[28] The goods identified in the cited registration are "surgical needles and sutures."

"The goods need not be identical, but 'need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.'" *Embiid*, 2021 USPQ2d 577, at *22 (quoting *Coach Servs.*, 101 USPQ2d at 1722 (internal citation omitted)).

> Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration.

*Id.*, at *22-23 (quoting *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)).

Applicant's arguments "focus principally on the channels of trade and sophistication of purchasers, rather than the relationship between the respective goods as such." *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1646 (TTAB 2009) (affirming refusal to register CYNERGY for "medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed

[28] "The Board may take judicial notice of dictionary definitions, including online dictionaries, definitions in technical dictionaries and translation dictionaries that exist in printed format, and we elect to do so here." *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *2 n.17 (TTAB 2019) (taking judicial notice of the meaning of "sequencing" and "binding."). We take judicial notice that "laparoscopic surgery" is "[s]urgery done with the aid of a laparoscope," which is a "thin, tube-like instrument with a light and a lens for viewing." National Cancer Institute (cancer.gov, last accessed on July 20, 2022).

medical practitioners" based on registration of SYNERGIE PEEL for "medical devices used for microdermabrasion"). Applicant "rests its arguments with regard to the goods principally on the restricted channels of trade for its goods, as specified in the identification of goods, and most emphatically on the sophistication of the purchasers of its goods . . . ." *Id.* at 1647.

Applicant argues that "[a]lthough Applicant's Goods and the Cited Mark's Goods are medical devices, Applicant's Goods and the Cited Mark's Goods are *neither* identical *nor* sufficiently similar or related to create a likelihood of confusion." 16 TTABVUE 8 (emphasis supplied by Applicant). According to Applicant, "a category like 'medical field' is essentially meaningless, providing no indication as to the type or purpose of the goods. When considering the similarity of goods in the 'medical field,' one must look at the specific medical field of use and overlapping use of the goods, if any." *Id.* at 8-9.[29]

Applicant further argues that

> Applicant's Goods are technically distinct, not complimentary, and very different in purpose, function, use, structure, and purchase price compared to the Cited Mark's Goods. Applicant's Goods are durable, advanced surgical equipment products including a modular multifunction energy platform consisting of surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures, and electrosurgical generators with argon beam cut and coagulation capacities. . . . Smoke evacuation devices and electrosurgical

[29] In its reply brief, Applicant repeats its argument that "[w]hen considering the similarity of goods in the 'medical field,' one must look at the specific medical field of use and overlapping use of the goods, if any." 19 TTABVUE 7 (citing *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399 (TTAB 2010)). We do not understand the Examining Attorney to argue that the goods are related simply because they are all used in the "medical field."

> generators are robust and sophisticated intelligence based capital hardware components, include multiple software based functionalities, and require particularized training to program and/or use. During a surgical procedure, an electrosurgical generator apparatus/electrosurgical unit ("ESU") is used to make an incision on a patient while using energy to cauterize the tissue immediately to prevent blood loss. The surgery . . . then takes place through this cauterized incision. *Id.* The electrosurgical incision and cauterization of tissue generates smoke, which is evacuated by vacuum suction per use of a smoke evacuator.

*Id.* at 9-10 (citations omitted).

We display below two of Applicant's devices sold under marks other than CONMED UNIFY:


Cirino Decl. ¶¶ 9-10; Exs. 1, 3 (12 TTABVUE 18, 22-23, 30-31).

Applicant further argues that "[u]like the Applicant's Goods, the Cited Mark's Goods are not capital products nor components or accessories for the Applicant's Goods," 16 TTABVUE 11; that "needles and sutures are not used as substitutes for

the Applicant's Goods, nor are needles and sutures used during electrosurgical procedures performed by the Applicant's Goods," *id.* at 12; that "unlike Applicant's Goods, surgical needles and sutures are nonreusable, single use, non-computer hardware/software intelligent, disposable commoditized products;" and that "[t]here is simply no structural, functional, use or process of manufacturing similarity between the Applicant's Goods and the Cited Mark's Goods." *Id.*

Applicant's brief displays an example of a surgical needle taken from the registrant's website:


*Id.* (citing Cirino Decl. ¶ 13; Ex. 6 (12 TTABVUE 20, 46).

Applicant further argues that needles of the sort identified in the cited registration are not used in electrosurgical procedures and are not components of or accessories for electrosurgical products. *Id.* at 13. According to Applicant,

> "microneedles" is a term used for a specific type of electrosurgical electrode, an accessory for an electrosurgical device through which electrical energy is directed to a surgical site to perform functionality similar to the functionality described above with respect to electrosurgical devices. . . . Despite sharing the generic product name "needle," the surgical needles of the Cited Mark's Goods are *not* electrosurgical electrodes, nor could they be used as such. . . . They are a specific medical instrument used in conjunction with suture (as called out

> in the Cited Mark's description), and shown above. . . . Neither device (a microneedle or a surgical needle) may stand-in or be utilized to provide the functionality of the other, nor do they work in conjunction with the same surgical products.

*Id.* (record citations omitted) (emphasis supplied by Applicant).

The Examining Attorney responds that "the evidence of record demonstrates that, regardless of the alleged difference in purpose, function, use, structure, and/or purchase price of the goods, the goods of the parties are related in such a manner that could give rise to the mistaken belief that they emanate from the same source." 18 TTABVUE 11-12. She points to third-party webpages of companies that "sell electrosurgical generators, surgical needles, smoke evacuation devices, suturing needles, and/or sutures," *id.* at 12, as well as Applicant's own website, "which shows that [A]pplicant also sells surgical needles and sutures" and which, together with the third-party websites, "demonstrates that needles are used in electrosurgical procedures and are components or accessories for other electrosurgical products." *Id.*

In response to Applicant's arguments regarding the types of "needles" used in electrosurgery, the Examining Attorney argues that

> the evidence of record demonstrates that "Surgical needles and sutures" and "electrosurgical generators with argon beam coagulation capabilities" are marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. Specifically, the evidence of record demonstrates that multiple brands, which specialize in selling surgical products, sell both applicant's and registrant's goods. Thus, despite the fact that applicant's and registrant's products are not identical, the evidence of record supports the trademark examining attorney's assertion that the goods of the parties are related.

*Id.* at 12-13. The Examining Attorney also notes Applicant's reliance on the cited registrant's website to narrow the goods identified in the cited registration, and concludes that "the registration includes the broadly worded 'Surgical needles and sutures' which indicates the registered goods may be used for *all* types of surgery, *including* electrosurgery." *Id.* at 13 (emphasis supplied by the Examining Attorney).

In its reply brief, Applicant addresses the Examining Attorney's arguments regarding relatedness as follows:

> [The] Examining Attorney does not attempt to refute that the Applicant's Goods and the Cited Goods are technologically distinct. Likewise, [the] Examining Attorney does not attempt to refute that the process of manufacturing the respective goods is different. Similarly, [the] Examining Attorney does not attempt to refute that Applicant's Goods and [the] Cited Goods cannot be used as substitutes for each other. [The] Examining Attorney merely claims, erroneously, that [the] Cited Goods are related as they can be used in the same types of electrosurgical procedures as Applicant's Goods and are components of or accessories for electrosurgical products. . . . But this is not correct. Indeed, Angelo Cirino testified in his supporting declaration that the Cited Goods are not used during electrosurgical procedures performed by the Applicant's Goods, nor are the Cited Goods components or accessories for Applicant's Goods.

19 TTABVUE 7-8 (record citations omitted).[30]

With respect to the Examining Attorney's Internet evidence, Applicant argues that "federal court precedent holds that products should not be deemed related simply because they may be sold in or by the same kind of establishments" or "because the

[30] Applicant's first three arguments address the wrong inquiry. The "'issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods.'" *Embiid*, 2021 USPQ2d 577, at *28 n.39 (quoting *Ox Paperboard*, 2020 USPQ2d 10878, at *5).

same entity may sell and market the relevant goods, particularly where, as in the case here, the evidence of record does 'not establish that the actual and potential purchasers from each party would be the same, due to specialization among their corporate customers' departments.'" *Id.* at 8 (internal quotation omitted). The remainder of Applicant's arguments in its reply brief focus on the channels of trade and classes of purchasers for the goods, which we address below under the third and fourth *DuPont* factors. *Id.* at 8-9.

"We begin with the identifications of goods . . . in the registration and application under consideration." *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019). The cited registration covers goods identified as "surgical needles and sutures," with no limitation on their type. Applicant argues that these broadly-identified goods do not include "microneedles, a term used for a specific type of electrosurgical electrode, an accessory for an electrosurgical device through which electrical energy is directed to a surgical site to perform functionality similar to the functionality described above with respect to electrosurgical devices." 16 TTABVUE 13. The evidentiary support for this argument in Applicant's appeal brief is the "February 8, 2022 Cirino Declaration 3, para. 3, attached hereto as Exhibit 2," *id.*, which we have excluded above as untimely. The record shows that Applicant produces and sells goods identified as "MicroNeedles," which its "Advanced Surgical Product Catalog" lists as one of the "Electrosurgical Accessories" that it offers,[31] and the website at serfinitymedical.com offers a "Conmed Electrosurgical Electrode 1 Inch Stainless

[31] December 7, 2021 Final Office Action at TSDR 3.

Steel Needle Disposable Sterile" for $12.99, which the website describes as having an "electrosurgical electrode" application and being "disposable."[32]

As noted above, the identification of "surgical needles" in the cited registration contains no "'limitation regarding the nature of the identified goods," so we must presume that they include "'all goods of the type identified, without limitation as to their nature or price.'" *Embiid*, 2021 USPQ2d 577, at *27 (quoting *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *8 (TTAB 2020)).[33] "[C]onsidering the full scope of the goods . . . as set forth in the . . . registration under consideration," *Country Oven*, 2019 USPQ2d 443903, at *9, we find that the phrase "surgical needles" encompasses the "microneedles" that are "an accessory for an electrosurgical device through which electrical energy is directed to a surgical site to perform functionality similar to the functionality described above with respect to electrosurgical devices." 16 TTABVUE 13. Accordingly, we deem the "surgical needles" identified in the cited registration to encompass "microneedles," which Applicant's catalog states are accessories to the electrosurgical devices and apparatus sold by Applicant.[34]

[32] *Id.* at TSDR 2.

[33] Many of Applicant's arguments, including its ones under the second *DuPont* factor, are based on the registrant's website, Cirino Decl. ¶ 13, Exs. 4-6 (12 TTABVUE 20, 39-49), but "[w]e must look to the goods as identified in the involved application[ ] and cited registration, not to any extrinsic evidence of actual use." *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014)). Applicant may not "'restrict the scope of the goods covered in [the] cited registration by argument or extrinsic evidence.'" *Id.* at 1739 (quoting *In re Midwest Gaming & Ent. LLC,* 106 USPQ2d 1163, 1165 (TTAB 2013)).

[34] December 7, 2021 Final Office Action at TSDR 2-3.

As noted above, the Examining Attorney also made of record Internet webpages showing that electrosurgical devices, and needles and sutures, are sold under the same mark. Applicant sells an electrosurgical generator and a smoke evacuation unit, as well as microneedles and sutures.[35] The mfimedical.com website offers both an electrosurgical generator package, which includes a smoke evacuator, and a reusable tungsten needle, which falls within the broad identification of "surgical needles" in the cited registration.[36] The ethicon.com website offers an electrosurgical generator and a smoke evacuator, as well as a polyester suture, which falls within the broad identification of "surgical . . . sutures" in the cited registration.[37]

The appliedmedical.com website offers an electrosurgical generator and an insufflation needle, which falls within the broad identification of "surgical needles" in the cited registration.[38] The avantehs.com website offers an electrosurgical generator and a dix needle, which falls within the broad identification of "surgical needles" in the cited registration.[39] The coopersurgical.com website offers an electrosurgical device, which includes a smoke evacuator. and suturing needles, which fall within

[35] February 7, 2019 Office Action at TSDR 7-10; December 7, 2021 Final Office Action at TSDR 2-3.

[36] February 7, 2019 Office Action at TSDR 11-13.

[37] *Id.* at TSDR 14-16.

[38] August 4, 2020 Final Office Action at TSDR 2-3.

[39] *Id.* at TSDR 4-5.

the broad identification of "surgical needles" in the cited registration.[40] The integralife.com website offers an electrosurgical system and surgeon's needles.[41]

The Medtronic.com website offers smoke evacuation systems as well as sutures.[42] The medical.olympusamerica.com website offers an electrosurgical generator and a needle for laparoscopic surgery, which falls within the broad identification of "surgical needles" in the cited registration.[43] The utahmed.com website displays an electrosurgical generator and various needles.[44]

In its reply brief, Applicant does not dispute that the Examining Attorney's Internet evidence shows that the involved goods "are advertised together or sold by the same manufacturer or dealer," *Embiid*, 2021 USPQ2d 577, at *22-23, but argues that the goods "should not be deemed related simply because they may be sold in or by the same kind of establishments," or "because the same entity may sell and market" them. 19 TTABVUE 8. The cases cited by Applicant, however, do not support its arguments or undermine the Examining Attorney's relatedness evidence.[45]

Applicant cites *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000) in support of its first argument. This citation is unavailing, and the case

[40] *Id.* at TSDR 7-9.

[41] *Id.* at TSDR 10-11.

[42] *Id.* at TSDR 15-16.

[43] *Id.* at TSDR 19-20.

[44] December 7, 2021 Final Office Action at TSDR 4.

[45] In its appeal brief, Applicant argues that the goods cannot be considered related simply because both are "medical devices." 16 TTABVUE 8 (citing *Edwards Lifesciences* and *Harvey Hubbell Inc. v. Tokyo Seimitsu Co.*, 188 USPQ 517 (1975)). The Examining Attorney makes no such argument, and there was no evidence in either *Edwards Lifesciences* or *Harvey Hubbell* of the sale of the goods at issue in those cases by the same companies.

actually belies Applicant's second argument. *Recot* involved an opposition under Section 2(d) by the owner of the FRITO-LAY mark for human snack foods to an application to register FIDO LAY for edible dog treats. On the issue of the relatedness of the goods, the Federal Circuit held that it was not enough that they were "sold in like channels of trade, such as supermarkets," because "the law is that products should not be deemed related simply because they are sold in the same kind of establishments." *Recot*, 54 USPQ2d at 1899. The court's holding does not aid Applicant here because the Examining Attorney does not argue that the goods are related simply because they are sold in the sorts of channels of trade, such as supermarkets or big-box retailers, that carry all manners of goods. On the second *DuPont* factor, however, the *Recot* court held that the "Board erred when it refused to consider the lay evidence that several large companies produce and sell both pet and human food in deciding whether a consumer would reasonably believe that FIDO LAY dog treats originated from the same source as FRITO-LAY human snacks," evidence which the court held "seem[ed] extremely pertinent to the question of whether, absent any evidence of current use of the FRITO-LAY marks for pet food, a consumer would likely think that FRITO-LAY produced, sponsored, or licensed its mark for use for pet snack products." *Id.* at 1898. Here, we have evidence that multiple companies, including Applicant itself, sell both electrosurgical devices and apparatus, and surgical needles or sutures, and that evidence is pertinent to the question of whether the relevant consumers would likely think that the involved

goods originate from the same source when they are sold under the marks UNIFY and CONMED UNIFY, which we have found above to be similar.

Applicant cites two cases in support of its second argument, *Elec. Designs & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), and *In re Bentley Motors Ltd.*, Serial No. 85325994 (TTAB Dec. 3, 2013), a non-precedential decision.[46] 19 TTABVUE 8. Both of these cases focused on channels of trade under the third *DuPont* factor and neither held that evidence of the sale of the involved goods by the same companies did not establish the relatedness of those goods.

In *Elec. Designs & Sales*, the Federal Circuit found that there was no likelihood of confusion between the applicant's mark E.D.S. and design for power supplies and battery chargers, and the opposer's mark EDS for computer programming services, because "although the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers." *Elec. Designs & Sales*, 21 USPQ2d at 1391. The case did not deal with the relatedness of one type of good to another, and there was no evidence that the involved goods and services were sold by the same companies under the same mark.

[46] "Non-precedential decisions are not binding on the Board," *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *3 n.23 (TTAB 2020) (citing *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120-21 (TTAB 2012)), but as discussed below, *Bentley Motors* is inapposite in any event.

Applicant cites *Bentley Motors* for the proposition that the Board "has previously held in a similar situation that an applicant's goods were not related and did not travel through the same channels of trade where the applicant sold and marketed its goods exclusively through dealers and service outlets" and "the record was devoid of any evidence suggesting that the Cited Goods normally moved through those same restricted channels of trade, even though the identification of goods did not contain any restrictions as to the channels of trade." 19 TTABVUE 8. There was no discussion in *Bentley Motors* of the second *DuPont* factor, however, and no evidence of relatedness of the sort present here. The Board reversed the refusal to register based on the applicant's amendment to restrict its channels of trade, which the Board found made it unnecessary to "consider the other *du Pont* factors discussed by the examining attorney and applicant." 19 TTABVUE 9 (Serial No. 85325994).

Applicant has not refuted the Examining Attorney's showing of relatedness based on the undisputed evidence that medical supply and equipment companies, including Applicant, commonly sell and advertise both electrosurgical equipment, and various forms of surgical needles and sutures. This evidence shows that the involved goods are related. *Cf. Cynosure*, 90 USPQ2d at 1647 (evidence that facilities, spas, and clinics offered both microdermabrasion and laser procedures supported a finding that "medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners" and "medical devices used for microdermabrasion" were related goods). We find that the second *DuPont* factor supports a finding of a likelihood of confusion.

### 2. Similarity or Dissimilarity of the Channels of Trade and Classes of Purchasers

The third *DuPont* factor considers "'the similarity or dissimilarity of established, likely-to-continue trade channels.'" *Detroit Athletic Co.*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USPQ at 567). "The third *DuPont* factor—like the second factor—must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world." *Id.* The fourth *DuPont* factor includes identification of "'the buyers to whom sales are made.'" *Sabhnani*, 2021 USPQ2d 1241, at *19 (quoting *DuPont*, 177 USPQ at 567).

There are no limitations on the channels of trade for the "surgical needles and sutures" identified in the cited registration. The record shows that the channels of trade for surgical needles and sutures, including the "microneedles" that are encompassed by the unrestricted term "surgical needles," include the websites of medical supply and equipment companies such as Applicant, some of which allow purchasers to order the goods online.[47] We can infer from the websites that the goods are also available in the brick-and-mortar world outlets of such companies.

The record similarly shows that the channels of trade for electrosurgical equipment include the websites of medical supply and equipment companies, some of which allow purchasers to order the goods, or request quotes, online.[48] We can again

[47] February 7, 2019 Office Action at TSDR 13, 16; August 4, 2020 Final Office Action at TSDR 3, 5, 9, 11, 13, 16, 20; December 7, 2021 Final Office Action at TSDR 2, 5.

[48] February 7, 2019 Office Action at TSDR 11-12, 14-15; August 4, 2020 Final Office Action at TSDR 2, 4, 7-8, 10, 12, 14-15, 18-19; December 7, 2021 Final Office Action at TSDR 4.

infer from the websites that the goods are also available in the brick-and-mortar world outlets of these companies.

The identification of goods in Applicant's application, however, limits Applicant's electrosurgical devices to ones "sold only by authorized and exclusive sales representatives who do not also sell suture needles and sutures." We read this express limitation to restrict the channels of trade for the goods identified in the application to direct contacts between Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures" and prospective purchasers. *See Cynosure*, 90 USPQ2d at 1647 (applicant's identification of goods, "medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners," created a restricted trade channel). The record shows that the prospective purchasers of Applicant's goods include hospitals and medical facilities that provide electrosurgical procedures. Nami Decl. ¶ 2 (6 TTABVUE 8); Cirino Decl. ¶ 2 (12 TTABVUE 15). Consistent with the restriction in its identification of goods, Applicant's declarants testified that the identified goods "are only sold and marketed through Applicant's authorized exclusive sales force (which does not market and sell the cited registrations [sic] goods), as detailed in the amended goods description," Nami Decl. ¶ 8 (6 TTABVUE 11);[49] that Applicant's "authorized and exclusive sales force for

[49] We note, however, that Applicant's electrosurgical equipment and other goods are marketed through their display and description on Applicant's website and in its catalog, both of which are accessible to any prospective purchaser. Applicant's website also allows access to videos and documents regarding Applicant's goods. February 7, 2019 Office Action at TSDR 7-10; December 7, 2021 Final Office Action at TSDR 2-3.

advanced surgical capital equipment sells such products through a hospital's or surgical facility's capital acquisition process," Cirino Decl. ¶ 6 (12 TTABVUE 16); and that Applicant's "exclusive sales force has access to the target hospital accounts and surgeon purchasers via Group Purchasing Organization contracts which generally do not include sole practitioners or small purchasers such as the registrant for the cited registration." Cirino Decl. ¶ 7 (12 TTABVUE 16).

Applicant argues that

> [i]n analyzing this *DuPont* Factor, a court must recognize that "although the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. The likelihood of confusion must be shown to exist not in a purchasing *institution*, but in 'a customer or purchaser.'"

16 TTABVUE 17 (quoting *Elec. Design & Sales*, 21 USPQ2d at 1391).

Applicant cites *Elec. Design & Sales* for the proposition that even if goods are sold to the same institutional customers, confusion is unlikely where the actual and potential purchasers for each party would not be the same due to specialization among the corporate departments of the common customers. *Id.* at 18 (citing *Elec. Design & Sales*, 21 USPQ2d at 1391).

Applicant cites *Bentley Motors* for the proposition that

> the Board found it unlikely that any likelihood of confusion would result not just because the applicant marketed and sold its goods through an exclusive and niche trade channel, but also because the record was devoid of any evidence suggesting that the cited registrations' goods regularly moved in the channels of trade in which Applicant marketed.

*Id.* at 19.

Applicant argues that "[m]uch like in *Bentley*, Applicant's Goods will be marketed and sold through an exclusive and distinct trade channel" and "Applicant will sell and market the goods exclusively through its sales force for advanced surgical capital equipment." *Id.* According to Applicant, "[t]his authorized and exclusive sales force for advanced surgical capital equipment does not sell the commodity disposable goods (surgical needles and sutures) of the Cited Mark; those products are sold in separate channels via separate sales mechanisms outside of the instant application's exclusive trade channel." *Id.* Applicant argues that the "sales force will also be targeting a different group of purchasers: surgeons and members of surgical clinician teams within specialty electrosurgical practice areas at a targeted hospital/surgical facility, as compared to general purchasing office of a hospital or surgical facility, and sole practitioners or small purchasers such as the Registrant for the Cited Mark." *Id.* at 19-20. Applicant concludes that "[u]tilizing the exclusive sales force allows the Applicant to market and sell Applicant's Goods in a niche and distinct trade channel, wholly separate from the trade channel in which Cited Mark's Goods are marketed and sold. Therefore, any alleged likelihood of confusion is eliminated." *Id.* at 20.

The Examining Attorney distinguishes *Bentley Motors* on the grounds that in that case "there was no evidence of record to suggest that the ordinary trade channels for registrant's goods included authorized vehicle dealers and authorized vehicle service outlets," 18 TTABVUE 14, while here "the evidence of record suggests that the ordinary trade channels for registrant's goods overlap with applicant's limited trade

channel" because "the ordinary trade channels for registrant's goods include medical device companies, similar to applicant, who sell electrosurgical medical devices as well as surgical needles and sutures to consumers in the same industry." *Id.* According to the Examining Attorney, the "restriction to the identification of goods does not obviate the relatedness of the goods because the registered goods are not restricted to any specific trade channel or class of purchaser and the ordinary trade channels for registrant's goods overlap with applicant's limited trade channel." *Id.*

In its reply brief, Applicant argues that

> Applicant has highly specialized departments and individuals exclusively involved in the marketing and selling process for Applicant's Goods. Similar to *Bentley*, Applicant's Goods will be marketed and sold only by and through a specific and exclusive sales force of Applicant, i.e., Applicant's authorized and exclusive sales force/representatives for advanced surgical capital equipment, which does not also sell surgical needles and sutures. . . . The sales team for Applicant's Goods targets identified surgeon purchasers within the highly specialized electrosurgical practice areas. . . . The surgeon clinician team then evaluates and, ultimately, approves whether the facility or surgeon team should purchase the Applicant's Goods. . . . The Cited Mark's Goods, on the other hand, are not sold via the same sales cycle or in the same manner as Applicant's Goods, and are not sold to the same purchasers within hospitals and surgical facilities. There is no opportunity for a surgeon team to provide its input during a formal evaluation and review process, like there is for Applicant's Goods. . . . Instead, Cited Mark's Goods are merely sold to a general purchasing office for the hospital or surgical facility as part of a larger group of commodity products for the facility which may include other facility and office supplies. Therefore, contrary to Examining Attorney's assertion, the Cited Goods' ordinary trade channels do not overlap with Applicant's highly specialized and restrictive trade channels and there is nothing in the record which shows or even suggests otherwise.

19 TTABVUE 9 (record citations omitted).

As noted above, we are not bound by the non-precedential *Bentley Motors* decision, but it provides, at most, only marginal support for Applicant's trade channel argument. The trade channel restriction in *Bentley Motors* provided that the applicant's goods were sold only in its own automobile dealerships and service outlets, which the applicant stated were "devoted to the distribution and sale of luxury vehicles such as Rolls Royce® and Bentley® brand automobiles and related parts and accessories . . . ." 19 TTABVUE 7 (Serial No. 85325994). The Board noted that the cited registrations contained no restrictions regarding channels of trade, but found that there was nothing in the record to "suggest that the ordinary trade channels for registrants' goods include 'authorized' vehicle dealers and vehicle service outlets" and that the applicant's "goods are marketed solely and exclusively through dealers and service outlets for Bentley and Rolls Royce," and the "record does not support the proposition that the goods identified in the cited registrations normally move in these channels of trade, notwithstanding that they do not recite any trade channel limitations." *Id.* at 8. The Board concluded that "the trade channels, as now identified in applicant's application, are distinct and do not overlap with the ordinary channels of trade for the identified goods," *id.*, and that "the amendment to restrict applicant's channel of trade means 'there is virtually no opportunity for confusion to arise.'" *Id.* at 9 (quoting *In re Herbal Sci. Grp. LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010)).

Here, as in *Bentley Motors*, the cited registration does not contain any restrictions on the channels of trade (or classes of purchasers) for the broadly-identified "surgical

needles," and it is true, as in *Bentley Motors*, that the channels of trade for the goods identified in the cited registration would not include Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures." But unlike the class of purchasers of the applicant's goods in *Bentley Motors*, which was limited to prospective purchasers of the applicant's Rolls Royce and Bentley vehicles, the prospective purchasers of the "surgical needles" identified in the cited registration, which we must deem to encompass "microneedles" that are an accessory to electrosurgical equipment, logically overlap with the purchasers of the electrosurgical equipment itself.[50] Thus, we must assume that the cited UNIFY mark for "surgical needles," which encompasses "microneedles," would be exposed to purchasers of electrosurgical equipment even if that exposure occurred through a different channel of trade than Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures."[51]

Accordingly, although the third *DuPont* factor supports a finding of no likelihood of confusion because, by definition, the "surgical needles and sutures" identified in the cited registration would never be sold by Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures," we must

[50] Applicant's argument that the "surgical needles and sutures" identified in the cited registration "are not sold via the same sales cycle or in the same manner as capital equipment and are not sold to the same purchasers within hospitals and surgical facilities," 16 TTABVUE 15, is based on extrinsic evidence of the registrant's actual use and a reading of the term "surgical needles" in the cited registration that does not give that unrestricted identification its full scope.

[51] As discussed above, the other channels include the websites of medical supply and equipment companies, including Applicant itself, whose catalog offers both sets of goods to the same purchasers.

assume that the buyers to whom sales of electrosurgical equipment and microneedles are made overlap, such that that portion of the fourth *DuPont* factor either supports a finding of a likelihood of confusion or is, at most, neutral.

### C. Purchasing Conditions and Consumer Sophistication

The fourth *DuPont* factor also considers '[t]he conditions under which . . . sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing.'" *Embiid*, 2021 USPQ2d 577, at *31 (quoting *DuPont*, 177 USPQ at 567). On the basis of the testimony of its declarants, Applicant argues that

> [t]he conditions under which sales of Applicant's Goods and the Cited Mark's Goods are made are different. Where the initial marketing and outreach efforts are made to different prospective end users of the products, even if the same purchasing committee in a hospital ultimately makes the purchasing decisions for both products, the Trademark Trial and Appeal Board has found that there is no likelihood of confusion. *Edwards Lifesciences Corporation*, 94 U.S.P.Q.2d 1399 ([TTAB] 2010). This is particularly the case where "the purchasing process is so attenuated and lengthy" that it allows the vendors involved sufficient time to be unmistakable as to with whom they are dealing. *Id.* Here, the sales process for Applicant's Goods is extensive, time consuming, and complex.
>
> . . .
>
> The sales cycle for capital acquisition of such goods, from initial contact of the surgeon purchaser through the issuance of a purchase order for the capital equipment are targeted to an identified surgeon purchaser or group of surgeon purchasers within the specialty electrosurgical practice areas, are very involved (including several sales cycle phases such as a value analysis and a clinical evaluation of such goods, and approval and confirmation of sale of the goods) and time consuming (average sales cycle for such capital equipment being approximately nine (9) months).

16 TTABVUE 14-15.

Applicant also argues that both "the purchasers and/or end users of both Applicant's Goods (surgeons and members of surgical clinician teams within specialty electrosurgical practice areas at a targeted hospital/surgical facility)" and the purchasers of the goods identified in the cited registration, the "(general purchasing office of a hospital or surgical facility, and sole practitioners/smaller non-hospital purchasers) are highly sophisticated members of the medical community." *Id.* at 16. The record also shows that the electrosurgical devices and apparatus identified in Applicant's application are relatively expensive and may cost several thousand dollars per unit.[52]

The Examining Attorney argues that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion," 18 TTABVUE 14-15, and that "[i]n this case, applicant's and registrations [sic] 'highly sophisticated' purchasers are likely to be confused, despite their knowledge in the field, because the marks are identical in part and the goods of the parties are closely related." *Id.* at 15.

In its reply brief, Applicant argues that "[i]t is well-settled that purchasers of medical equipment are highly sophisticated individuals that are so familiar with the medical products in [sic] which they are purchasing and that they routinely

[52] Cirino Decl. ¶ 5 (12 TTABVUE 16) (stating that the anticipated list price for Applicant's goods is in the range of $10,000-$15,000 per unit); February 7, 2019 Office Action at TSDR 12 (displaying an electrosurgical generator package for $5,288.80).

undertake such a careful review process of such products, that source confusion is extremely unlikely." 19 TTABVUE 10. Applicant further argues that

> [w]ith Applicant's Goods, in particular, electrosurgical surgeons and members of the surgical clinician team, the same individuals that will be using the goods are highly involved in the evaluation and purchasing decisions. Specifically, the hospitals and other surgical facilities that wish to purchase Applicant's Goods must first obtain surgeon and surgical clinician team approval.

*Id.* Applicant concludes that the "Examining Attorney's arguments clearly fail to support a showing of a likelihood of confusion. The sophistication level of purchasers of Applicant's Goods and [the] Cited Goods eliminate any likelihood of confusion." *Id.* at 11.

The Board has found on multiple occasions, sometimes based solely on the nature of the identified goods, that purchasers of medical equipment are sophisticated buyers who exercise considerable care in the purchase decision. *See*, *e.g.*, *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1383 (TTAB 2012) (finding that "[g]iven the nature of ['medical devices, namely, guiding sheaths for use in conjunction with access needles, wire guides, and dilators for providing access for diagnostic and interventional devices in vascular and non-vascular procedures' and 'catheters'], . . . it is reasonable for us to assume that the relevant purchasers are likely to exercise some degree of care when it comes to buying and using [such goods] that would be used in performing medical procedures."); *Edwards Lifesciences*, 94 USPQ2d at 1413 (noting that "[j]ust based on the products involved in this proceeding ['near real-time computer monitoring system comprised of a software application and database that anticipates and detects possible adverse drug events, and alerts healthcare providers

to adverse drug events' and 'heart monitors'], one would expect that all of the purchasers would exercise a high degree of care when making their purchasing decisions," and finding that those goods "are purchased and licensed only after careful consideration by persons who are highly knowledgeable about the products."); *Cynosure*, 90 USPQ2d at 1647 (finding that "medical lasers for the cosmetic and medical treatment of the face and skin, and vascular treatment, sold directly to licensed medical practitioners" and "medical devices used for microdermabrasion" are "relatively complex and expensive" and that "the potential purchasers are relatively sophisticated in their fields . . . ."); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1396 (TTAB 1991) (finding that "medical instruments for clinical measurement of human performance functions, e.g. manual dexterity, reaction time and memory" and "laboratory and medical instruments and equipment for physiological monitoring, measuring, recording, diagnostic and analysis purposes" such as electromyographs, cardiac telemetry systems and electrocardiogram machines, were "sophisticated medical equipment which would be selected with great care by purchasers familiar with the source or origin of the products.").

The record shows that the goods identified in Applicant's application are relatively expensive, complicated goods that are purchased after considerable interaction between Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures" and their institutional customers, and with the involvement of medical professionals. Cirino Decl. ¶¶ 5-8 (12 TTABVUE 15-18). The

portion of the fourth *DuPont* factor regarding "[t]he conditions under which . . . sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing," *DuPont*, 177 USPQ at 567, supports a finding of no likelihood of confusion.

### D. Balancing the *DuPont* Factors

The key first two *DuPont* factors support a finding of a likelihood of confusion. The standard-character marks UNIFY and CONMED UNIFY are similar, as each may be viewed simply as a variant of the other that either adds the CONMED house mark to the UNIFY mark (in a forward confusion scenario), or removes the CONMED house mark from the CONMED UNIFY mark (in a reverse confusion scenario). The goods identified in the application and the cited registration are commonly sold by the same medical equipment supply companies, and, on this record, when the term "surgical needles" in the cited registration is given its full scope, it must be deemed to encompass "microneedles," which are an accessory to electrosurgical equipment and are sold by Applicant and marketed in the same catalog in which Applicant offers its electrosurgical devices and apparatus.

The third *DuPont* factor and the portion of the fourth *DuPont* factor regarding the conditions of purchase and purchaser sophistication cut the other way. The channels of trade through which Applicant sells the CONMED UNIFY goods identified in its application are limited, on the face of the identification, to Applicant's "authorized and exclusive sales representatives who do not also sell suture needles and sutures," and, by definition, this is not a channel through which "surgical needles," including "microneedles," would be sold under the UNIFY mark to Applicant's institutional

customers for electrosurgical equipment. As discussed above, however, the purchasers of "microneedles" could be exposed to the UNIFY mark for those goods through other channels of trade. The goods identified in the application are complicated, relatively expensive pieces of medical equipment that are purchased with care by professional buyers through an elongated process.

In the final analysis, in weighing the relative importance of the conflicting *DuPont* factors, we must take into account that "even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and closely related goods," *Cook Med. Techs.*, 105 USPQ2d at 1383, and that there may be "'no reason to believe that medical expertise as to products will obviate confusion as to source or affiliation or other factors affecting goodwill.'" *Id.* (quoting *Kos Pharms. Inc. v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874, 1887-88 (3d Cir. 2004)). *See also HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1824 (TTAB 1989) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods), *aff'd*, *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). We find that confusion is likely because the first and second *DuPont* factors, and the portion of the fourth *DuPont* factor regarding the buyers to whom sales are made, outweigh the third *DuPont* factor and the portion of the fourth *DuPont* factor regarding the purchase conditions and sophistication of the purchasers. *Cook Med. Techs.*, 105 USPQ2d at 1384; *Cynosure*, 90 USPQ2d at 1647. We acknowledge that this is a close case, but to the extent that there is doubt about our conclusion that a likelihood of

confusion exists, we must resolve that doubt in favor of the cited registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290-91 (Fed. Cir. 1984).

**Decision**: The refusal to register is affirmed.