

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paragon 28, Inc.

Serial Nos. 88283057 & 88283073

Christina Brule and John Boger of Heslin Rothenberg Farley & Mesiti P.C.,
for Paragon 28, Inc.

Kaelie Kung, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.¹

Before Pologeorgis, Johnson, and Lavache,
Administrative Trademark Judges.

Opinion by Lavache, Administrative Trademark Judge:²

¹ Both applications were reassigned from the original examining attorney to the above-named examining attorney during the underlying examination of the applications.

² As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, citations in this opinion are in the form recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For opinions of the Board, this opinion uses citations to the Lexis legal database and cites only precedential decisions. Practitioners should also adhere to the practice set forth in TBMP § 101.03. Precedential decisions of the Board, and precedential decisions of the Federal Circuit involving Board decisions that issued January 1, 2008, or after, may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading

Serial Nos. 88283057 & 88283073

Paragon 28, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark **SILVERBACK**³ and the composite mark displayed below.⁴



Both applications identify the following goods in International Class 10:

Surgical implants, namely, bone plates and bone fasteners made from artificial material for use in the foot and ankle; all the foregoing not containing silver material.

The Trademark Examining Attorney refused registration of Applicant’s marks under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground of likelihood of confusion, citing the standard character mark **SILVERBAC**, which is registered on the Principal Register for goods in International Classes 1, 5, 10, 20, 22, 23, and 24, and for services in International Class 40.⁵ For purposes of the Section 2(d) refusal, the Examining Attorney focused on the following goods and services listed in the registration: “surgical apparatus and instruments for medical, dental and veterinary

Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

³ Application Serial No. 88283057, filed on January 30, 2019, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an allegation of a bona fide intention to use the mark in commerce.

⁴ Application Serial No. 88283073, filed on January 30, 2019, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an allegation of a bona fide intention to use the mark in commerce. The application includes the following description of the mark: “The mark consists of a left-facing gorilla with the ‘P’ and the offset number ‘28’ on the gorilla's left shoulder facing outward. To the right of the gorilla is the word SILVERBACK in stylized font.” Color is not claimed as a feature of the mark.

⁵ Registration No. 6709165 issued on April 26, 2022.

use; artificial limbs, eyes and teeth; suture materials . . . all of the foregoing containing sufficient natural silver ions to meet the standard for use of the term for antimicrobial benefits in the relevant industries,” in International Class 10, and “Custom manufacturing of surgical apparatus, equipment, and instruments, clothing and packaging featuring silver for use in the medical, healthcare, food, veterinary, textile, horticultural and agricultural industries,” in International Class 40.

After the Examining Attorney issued final refusals in both applications, Applicant appealed and requested reconsideration in each. The Examining Attorney denied the requests for reconsideration. The appeals then resumed and were fully briefed.

I. Appeals Consolidated

When an applicant has filed *ex parte* appeals to the Board in two co-pending applications, and where, as here, the cases involve common issues of law or fact and have highly similar records, the Board upon its own initiative may order the consolidation of the appeals for purposes of briefing, oral hearing, or final decision. *See, e.g., In re S. Malhotra & Co.*, Ser. No. 79194076, 2018 TTAB LEXIS 344, at *3 (TTAB 2018) (consolidating two appeals sua sponte); *In re Anderson*, Ser. No. 76511652, 2012 TTAB LEXIS 42, at *9 (TTAB 2012) (consolidating two appeals sua sponte); *see also* TBMP § 1214.

Accordingly, in the interest of judicial economy, we have consolidated these appeals sua sponte and decided them in this single opinion. In doing so, we have considered all arguments and evidence filed in each case.⁶ Where appropriate, we

⁶ All TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations in this

have taken into account any relevant factual differences.

We affirm the refusal to register as to each application for the reasons explained below.

II. Likelihood of Confusion

Trademark Act Section 2(d), in relevant part, prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion.” 15 U.S.C. § 1052(d). To determine whether confusion is likely, we analyze all probative evidence relevant to the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003).

In every Section 2(d) case, two key *DuPont* factors are the similarity or dissimilarity of the marks and the relatedness of the respective goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976). Here, we have considered each *DuPont* factor that is relevant or for which there is evidence and argument of record. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*,

opinion refer to the docket and electronic file database for Application Serial No. 88283057, unless otherwise indicated.

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637 F.3d 1344, 1356 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1205 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). Ultimately, however, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973).

A. Relatedness of the Goods

We begin our analysis with the second *DuPont* factor, the similarity or dissimilarity and nature of the respective goods. *DuPont*, 476 F.2d at 1361. In determining the relatedness of the goods, we must look to the goods as identified in Applicant’s application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)).

It is sufficient that the goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1396 (Fed. Cir. 2012); *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 28, at *18 (TTAB 2007).

Registration may be refused if Applicant's mark for any of its identified goods is likely to cause confusion with the Registrant's mark for any of the goods listed in the cited registration. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981) (indicating that likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Accordingly, for our analysis, it is not necessary to address all of Registrant's goods and services that were specified in the Examining Attorney's refusal. Instead, we confine our discussion to a comparison of Applicant's goods with Registrant's "surgical apparatus and instruments for medical, dental and veterinary use," because these goods are the most closely related.

In the present case, Applicant's goods, as ultimately identified in both applications, are "Surgical implants, namely, bone plates and bone fasteners made from artificial material for use in the foot and ankle; all the foregoing not containing silver material," in International Class 10.

Registrant's relevant goods are "surgical apparatus and instruments for medical, dental and veterinary use . . . all of the foregoing containing sufficient natural silver ions to meet the standard for use of the term for antimicrobial benefits in the relevant industries," in International Class 10.

The wording "surgical apparatus and instruments for medical, dental and

veterinary use,” which is used to identify Registrant’s goods, is very broad, given that the term “apparatus” refers to “[a]n appliance or device for a particular purpose.”⁷ Thus, Registrant’s goods could encompass any surgical device for a medical purpose, including Applicant’s surgical implants in the nature of bone plates and bone fasteners made from artificial material for use in the foot and ankle. In other words, Applicant’s goods would otherwise be deemed legally identical to Registrant’s goods in part, except that both Applicant’s goods and Registrant’s goods are explicitly limited in terms of their material composition. Specifically, Registrant’s surgical apparatus contain “natural silver ions,” whereas Applicant’s surgical implants do not contain “silver material.”

Applicant argues that the “relevant consumers—medical professionals (e.g., podiatrists and/or orthopedic surgeons) and/or medical entities (e.g., hospitals and/or surgical centers)—would absolutely know the difference in material composition because it is literally part of their job to know the details of the medical device being purchased to ensure that the correct medical device is obtained based on the patient’s needs.”⁸ Applicant further asserts that its goods, which do not contain silver, and Registrant’s goods, which contain silver ions, are “distinguishable and not related,” because “integrating silver into the Applicant’s goods may weaken the goods and

⁷ See THE AMERICAN HERITAGE DICTIONARY, <https://www.ahdictionary.com/word/search.html?q=apparatus> (accessed on July 17, 2024). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, Opp. No. 91061847, 1982 TTAB LEXIS 146, at *7 (TTAB 1982), *aff’d*, 703 F.2d 1372 (Fed. Cir. 1983); *In re Red Bull GmbH*, Ser. No. 75788830, 2006 TTAB LEXIS 136, at *7 (TTAB 2006); TBMP § 1208.04.

⁸ Appeal Brief, 6 TTABVUE 5.

render them insufficient for the purpose for which they were made.”⁹ However, the issue is not whether consumers would confuse Applicant’s goods with Registrant’s goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at *16 (TTAB 2012); *In re Rexel Inc.*, Ser. No. 241423, 1984 TTAB LEXIS 57, at *2 (TTAB 1984).

We agree with Applicant that the relevant consumers here would want or need to know the material composition of the goods they are purchasing or using. However, we do not see how this difference in material composition would preclude source confusion when the respective goods are otherwise the same. For instance, a doctor might, for medical reasons, choose a surgical implant that does not contain silver over one that does, but it is not clear why, nor does the record establish that, the same doctor would assume that a surgical implant containing silver ions would necessarily originate from a different source as one not containing silver ions. *See, e.g., Carlisle Chem. Works, Inc. v. Hardman & Holden, Ltd.*, 434 F.2d 1403, 1406 (CCPA 1970) (noting that confusion would be likely, even for sophisticated purchasers, where the marks were similar and the only difference between the respective goods was that one contained cobalt and the other did not).

In sum, but for the difference in material composition, Applicant’s goods here would be encompassed by the broad wording used to identify Registrant’s goods.

⁹ Reply Brief, 9 TTABVUE 6. Applicant provided no evidence to support its contention that silver weakens surgical implants. Even assuming this were true, it might affect the relevant consumers’ purchasing decisions, but it would not render the respective goods unrelated.


Thus, Applicant's goods and Registrant's goods are legally identical in part, virtually identical in terms of their nature and purpose. We are not persuaded that the difference in material composition renders them so dissimilar or unrelated as to preclude source confusion.

Accordingly, the second *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

B. Comparison of the Marks

We now turn to the first *DuPont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005) (quoting *DuPont*, 476 F.2d at 1361). Similarity as to any one of these elements may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 732 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018).

"The proper test 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." *In re i.am.symbolic*, 866 F.3d 1315, 1324 (Fed. Cir. 2017) (quoting *Coach Servs.*, 668 F.3d at 1368 (internal quotation marks omitted)).

Here, Applicant's marks are the standard character mark **SILVERBACK** and the composite mark  **SILVERBACK**. The registered mark is **SILVERBAC**.

We note preliminarily that, where a mark, such as Applicant's composite mark, consists of both words and a design, "the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 TTAB LEXIS 108, at *6 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)); see also *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties."). Thus, with regard to Applicant's composite mark, we find that **SILVERBACK** is the dominant element for purposes of our comparison.¹⁰

¹⁰ We acknowledge that Applicant's composite mark also includes the letter "P" and the number "28" on the left shoulder of the gorilla depicted in the design. Applicant indicates that this refers to the Applicant's name, Paragon 28, Inc. See Appeal Brief for Ser. No. 88283073, 6 TTABVUE 17. While "P" and "28" are a part of the literal element of the mark, they are less prominent because they are displayed in relatively small font and integrated into the design element of the mark. Thus, we consider **SILVERBACK** to be the primary literal element, and the dominant element, of the composite mark overall, because it is far more prominent in the mark and it is a recognized and pronounceable word. See *In re Electrolyte Labs, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) ("The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur."); *Toro Co. v. ToroHead, Inc.*, Opp. No. 114061, 2001 TTAB LEXIS 823, at *5-6 (TTAB 2001) (finding **TORO** to be the dominant element of applicant's mark, **ToroMR** (with bull design), where, inter alia, it was prominently featured and was the only pronounceable word in the mark); *In re Strathmore Prods., Inc.*, 1971 TTAB LEXIS 210, at *3 (TTAB 1971) ("[M]arks must be considered in their entireties but where a mark is a composite mark including a design and a word then which of the two features dominates the mark is usually controlling in the determination of likelihood of confusion.").

The term SILVERBACK in Applicant's two marks is virtually identical to the term SILVERBAC in the cited mark. The only difference is that the cited mark does not have the concluding "K" that appears in Applicant's marks. Thus, the literal elements of the respective marks are almost identical in appearance. *See In re Peace Love World Live, LLC*, Ser. No. 86705287, 2018 TTAB LEXIS 220, at *23 (TTAB 2018) ("Slight differences in marks do not normally create dissimilar marks.").

In comparing the sound of the respective marks, the Examining Attorney argues that the "K" in SILVERBACK is essentially silent when the term is pronounced.¹¹ Based on the dictionary evidence the Examining Attorney provided, however, it may be more accurate to say that both "c" and "ck" can make the hard "k" sound.¹² Regardless, we agree with the Examining Attorney that both SILVERBACK and SILVERBAC are phonetic equivalents and will sound the same when spoken. *See, e.g., In re Great Lakes Canning, Inc.*, Ser. No. 73365360, 1985 TTAB LEXIS 75, at *5-6 (TTAB 1985) (finding CAYNA similar to CANA); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 1980 TTAB LEXIS, at *12 (TTAB 1980) (finding REMACS and RE/MAX "indistinguishable in sound" and confusingly similar); *In re Cresco Mfg. Co.*, 1963 TTAB LEXIS 84, at *2 (TTAB 1963) (finding CRESCO and KRESSCO "phonetically indistinguishable" such that there would be a likelihood of confusion); *see also In re 1st USA Realty Prof'ls, Inc.*, Ser. No. 78553715, 2007 TTAB LEXIS 73, at *16 (TTAB

¹¹ *See* Examining Attorney's Brief, 8 TTABVUE 6.

¹² *See* February 24, 2023 Final Office Action at TSDR 51.

2007) (“Similarity in sound alone may be sufficient for a finding of likelihood of confusion.”) (citing *Krim-Ko*, 390 F.2d at 732).

Because SILVERBACK and SILVERBAC are identical in sound and nearly so in appearance, the Examining Attorney argues that they also share the same connotation and commercial impression.¹³ Applicant asserts, however, that the difference in spelling between SILVERBACK and SILVERBAC creates “drastically different meanings” when considered in connection with the respective goods.¹⁴

Specifically, Applicant provided dictionary evidence indicating that the term SILVERBACK commonly refers to “a mature male mountain gorilla” and argues that, when the term is applied to Applicant’s surgical implants, it connotes attributes generally associated with gorillas, i.e., strength and durability.¹⁵ We agree with Applicant that consumers are likely to associate SILVERBACK with its common meaning, especially when it appears alongside the depiction of a gorilla, as it does in Applicant’s composite mark. *See, e.g., In re Ox Paperboard, LLC*, Ser. No. 87847482, 2020 TTAB LEXIS 266, at *13 (TTAB 2020) (“The stylized depiction of an ox [in a mark also containing the word OX] serves to reinforce the dominance of the literal element, not to detract from it.”) (citing *Herbko Int’l v. Kappa Books*, 308 F.3d 1156, 1165 (Fed. Cir. 2002)); *In re Wilson*, Ser. No. 75285881, 2001 TTAB LEXIS 53, at *4

¹³ Examining Attorney’s Brief, 8 TTABVUE 7.

¹⁴ Appeal Brief, 6 TTABVUE 15.

¹⁵ *Id.* at 16.

(TTAB 2001) (“[T]he illustration of pine cones merely reinforces the dominance of the arbitrary designation PINE CONE.”).

However, Applicant asserts that this same gorilla connotation would not apply to SILVERBAC, because, on the Registrant’s website, that term “is used to describe a technology that ‘releases silver ions even when dry which disrupt metabolic processes across organism cell walls, ultimately leading to the demise of bacteria and other organisms.’”¹⁶ Thus, according to Applicant, when SILVERBAC is used in connection with Registrant’s goods, the term “gives the impression of goods containing SILVER with anti-BACterial benefits.”¹⁷

To the extent that Applicant is arguing that the commercial impression of a mark must be determined in relation to the goods at issue, we agree. *In re Box Sols. Corp.*, Ser. No. 76267086, 2006 TTAB LEXIS 176, at *15 (TTAB 2006) (citing *In re Sears, Roebuck and Co.*, Ser. No. 73502919, 1987 TTAB LEXIS 84 (TTAB 1987); *In re British Bulldog, Ltd.*, Ser. No. 73354851, 1984 TTAB LEXIS 15 (TTAB 1984)). And, as we have noted, Registrant’s goods are limited to those “containing sufficient natural silver ions to meet the standard for use of the term for antimicrobial benefits in the relevant industries.” But we must confine our analysis to that limitation, regardless of what extrinsic evidence of Registrant’s actual use of the mark might show. *See i.am.symbolic, llc*, 866 F.3d at 1323 (confirming that “extrinsic evidence concerning

¹⁶ *Id.* We presume that Applicant is using the term “describe” in its general sense, rather than the trademark-specific legal sense, because the record otherwise contains no claims or evidence that SILVERBAC is merely descriptive.

¹⁷ *Id.*

the actual uses of the marks cannot be considered because the restrictions are not reflected in the four corners of the application and registrations”).

Here, we are not persuaded that a consumer would view SILVERBAC as solely connoting the silver content and antimicrobial properties of the goods. That is not to say that it is impossible or even improbable that a consumer who is familiar with the material composition of the goods might connect the literal components SILVER and BAC in the mark to a feature or purpose of the goods. But, given that the term SILVERBAC, as a whole, is the phonetic equivalent SILVERBACK, which Applicant acknowledges is “commonly known to refer to a gorilla,”¹⁸ it is just as likely, if not more so, that consumers will associate SILVERBAC with that connotation. Moreover, even consumers who do perceive SILVERBAC as potentially referring to the properties of Registrant’s goods are not precluded from assuming that the mark is a novel spelling of SILVERBACK, and thus also connotes silverback gorillas and whatever attributes they are commonly associated with.

In sum, we find that despite the slight difference in the spelling of the literal elements in the respective marks,¹⁹ and the potential alternative connotation of the registered mark, the marks in their entireties are more similar than dissimilar in sound, appearance, connotation, and overall commercial impression.²⁰

¹⁸ *Id.*

¹⁹ To support the contention that differences in spelling can affect meaning, Applicant included a chart in its appeal brief showing various words that sound the same, but are spelled differently and have different meanings (e.g., “doc” and “dock,” “pic” and “pick,” “new” and “knew”). *Id.* at 17-18.

²⁰ As to Applicant’s composite mark, we note that the gorilla design element does little to

The first *DuPont* factor thus weighs strongly in favor of a finding of likelihood of confusion.

C. Similarity of the Trade Channels

We next consider established, likely-to-continue channels of trade, the third *DuPont* factor. As discussed above, Registrant's goods in part essentially encompass Applicant's goods. So, the respective goods would otherwise be legally identical in part, except that the Registrant's goods contain "silver ions," while Applicant's do not. The record does not establish that this difference in material composition affects the relevant channels of trade or classes of customers, nor are Applicant's and Registrant's goods, as identified, restricted to that effect. Therefore, we must presume that these virtually identical in part goods travel in the same channels of trade to the same class of purchasers. *In re Viterra*, 671 F.3d 1358

Thus, the third *DuPont* factor also weighs strongly in favor of a finding of likelihood of confusion.

D. Purchasing Conditions and Sophistication of Purchasers

Under the fourth *DuPont* factor, we consider "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 476 F.2d at 1361. Applicant contends that, given the complex and involved process for purchasing its goods, impulse purchases are virtually impossible and,

differentiate it from the cited mark, because it merely reinforces the gorilla connotation of the wording SILVERBACK that it accompanies. *See, e.g., In re Ox Paperboard*, 2020 TTAB LEXIS 266, at *13 ("The stylized depiction of an ox [in a mark also containing the word OX] serves to reinforce the dominance of the literal element, not to detract from it.") (citing *Herbko Int'l*, 308 F.3d at 1165); *In re Wilson*, 2001 TTAB LEXIS 53, at *4 ("[T]he illustration of pine cones merely reinforces the dominance of the arbitrary designation PINE CONE.").

instead, sophisticated purchasers would take great care in learning about, selecting, and buying the goods.²¹

We agree that, in view of the inherent nature of the goods, Applicant's potential or actual consumers will exercise a relatively high degree of purchasing care. Generally, purchasers of medical equipment, whether hospital personnel or physicians, are highly sophisticated and thus are more likely to distinguish between marks and goods than is the general consuming public. *See, e.g., In re N.A.D.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985) ("The record shows the machines to be elaborate, sizeable, complex pieces of technical apparatus of the kind which would be purchased only in consultation with an anesthesiologist or someone with equivalent technical knowledge. In other words, only very sophisticated purchasers are here involved who would buy with great care and unquestionably know the source of the goods.").

We find this factor weighs against a finding of likelihood of confusion.

E. Doctrine of Greater Care

Lastly, the Examining Attorney has invoked the "doctrine of greater care," arguing that "a stricter standard for determining likelihood of confusion for medicinal products is appropriate here due to the potential harm or serious consequences that could be caused by source confusion as these types of goods."²² We acknowledge that prior precedent has considered this principle in likelihood of confusion determinations when the goods at issue are pharmaceuticals or medical devices.

²¹ Appeal Brief, 6 TTABVUE 12-14.

²² Examining Attorney's Brief, 8 TTABVUE 20-21.

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See, e.g., In re Cook Med. Techs. LLC, Ser. No. 77882876, 2012 TTAB LEXIS 496, at *16 (TTAB 2012); *Ethicon, Inc. v. Am. Cyanamid Co.*, Ser. No. 72415792, 1976 TTAB LEXIS 101, at *16-18 (TTAB 1976). But each case must be decided on its own facts. *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973).

Applicant has suggested that some surgical patients may be allergic to silver²³ and that integrating silver into surgical implants may weaken them.²⁴ Thus, a potential for harm does appear to exist if, for example, a surgeon confused a SILVERBAC implant that contains silver ions with a SILVERBACK implant that does not. However, under the facts here and their application to the *DuPont* factors discussed above, we do not find it necessary to apply the “doctrine of greater care” to reach our decision.

III. Conclusion

Having carefully considered all of the arguments and evidence of record and all relevant *DuPont* factors, we find that (1) the marks at issue are highly similar, (2) Applicant’s goods and Registrant’s goods are virtually legally identical in part, and (3) Applicant’s and Registrant’s virtually legally identical in part goods are presumed to travel in the same trade channels and are offered to the identical classes of purchasers.

While we also find that the purchasers of surgical apparatus are highly sophisticated, here they are not necessarily immune from source confusion. Where

²³ *See* Appeal Brief, 6 TTABVUE 5.

²⁴ *See* Reply Brief, 9 TTABVUE 6.

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the only difference between the goods at issue is their material composition, skilled, discriminating purchasers who are relying on their own impressions and memories are not infallible and could reasonably assume that the respective goods are counterpart products from the same source (i.e., one containing silver and one silver-free). *See, e.g., Carlisle Chem. Works, Inc. v. Hardman & Holden, Ltd.*, 434 F.2d 1403, 1406 (CCPA 1970) (“Human memories even of discriminating purchasers . . . are not infallible. The only difference between the respective products is that COZIRC contains cobalt while ZIRCO does not. . . . We think it probable that even discriminating purchasers would be likely to assume that COZIRC is another product of appellant which may be used without the addition of a cobalt drier.”). Therefore, we find that the other factors discussed above outweigh any consumer sophistication or purchasing care. *See In re Rsch. & Trading Corp.*, 793 F.2d 1276, 1279 (Fed. Cir. 1986); *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, Opp. No. 91075632, 1989 TTAB LEXIS 33, at *13 (TTAB 1989) (finding likelihood of confusion in view of similarities of goods and marks, despite consumer sophistication and purchasing care), *aff’d*, 902 F.2d 1546 (Fed. Cir. 1990).

Accordingly, we conclude that confusion as to source is likely.

Decision: The refusals to register Applicant’s marks in Application Serial Nos. 88283057 and 88283073 under Section 2(d) of the Trademark Act are affirmed.