Mailed: October 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paragon 28, Inc.

Serial No. 88692159

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

Anthony Rinker, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Goodman, English and Allard,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Paragon 28, Inc. ("Applicant") seeks registration on the Principal Register of the mark APEX 3D (in standard characters) for

> Medical devices, namely, ankle joint implants comprised of artificial materials and associated surgical instruments used exclusively with total ankle implants in International Class 10.[1]

[1] Application Serial No. 88692159 was filed on Nov. 14, 2019 based upon Applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the following Principal Register marks, owned by two different entities, for goods in International Class 10 as to be likely, when used in connection with these goods, to cause confusion, to cause mistake, or to deceive:[2]

APEX IP FUSION DEVICE (IP FUSION DEVICE disclaimed)[3] and

(IP FUSION DEVICE disclaimed)[4]

both for "Medical devices, namely, intramedullary fusion devices for fusion of the interphalangeal joints of the hand"; and

APEX (typed drawing) for "bone pins and screws."[5]

Page references to the application record refer to the online database pages of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Applicant's brief is at 6 TTABVUE and its reply brief is at 9 TTABVUE. The Examining Attorney's brief is at 8 TTABVUE.

[2] In the appeal brief, the Examining Attorney confirmed withdrawal of the refusal as to cited Registration No. 1922866 APEX (typed drawing) for "medical and surgical instruments; namely, arthroscopic devices and parts and accessories therefor." 6 TTABVUE 3-4; 8 TTABVUE.

[3] Registration No. 4660373 issued Dec. 23, 2014; Section 8 and 15 accepted and acknowledged.

[4] Registration No. 4660372 issued Jul. 26, 2021; Section 8 and 15 accepted and acknowledged. The provided description of the mark states: "The mark consists of 'APEX' where the 'X' is represented as a stylized person with a semi-circle above the stylized person and the words 'IP FUSION DEVICE' underneath." Color is not claimed as a feature of the mark.

[5] Registration No. 2065134 issued May 27, 1994; second renewal.

A typed drawing mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) ("until 2003, 'standard character' marks formerly were known as 'typed' marks.").

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of 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 every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). These factors, and the others, are discussed below.

As explained below, because Applicant's proposed mark is likely to cause confusion with the cited Registration No. 2065134 for the mark APEX, we need not address likelihood of confusion based on the other cited registrations owned by a different

entity. A finding of likelihood of confusion between Applicant's mark and this mark suffices by itself to bar registration of Applicant's mark under Section 2(d); we need not find likelihood of confusion as to the other registrations cited by the Examining Attorney. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). We therefore refer to Registration No. 2065134 as the cited registration and APEX as the cited mark in this decision.

A. Similarity or Dissimilarity of the Marks

We turn to the first *DuPont* factor which requires us to determine the similarity or dissimilarity of the marks in terms of appearance, sound, connotation, and overall commercial impression. *Palm Bay Imps. Inc. 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." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The test under the first *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Our analysis cannot be predicated on dissecting the marks into their various components; the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.,* 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). It is nevertheless appropriate, for rational reasons, to regard certain features of the marks as being more dominant or otherwise significant, and therefore to give those features greater weight in the analysis. *See In re Nat'l Data Corp.*, 224 USPQ at 751-52. Disclaimed matter in a mark is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.,* 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Applicant's mark is APEX 3D (3D disclaimed). Registrant's mark is APEX. Applicant's mark is in standard characters and Registrant's mark is a typed drawing. Neither mark is limited to any particular font style, size, or color. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1353 (Fed. Cir. 2011) (citing Trademark Rule 2.52, 37 C.F.R. § 2.52).

Applicant argues that its mark is distinguishable from the cited mark because the addition of the term 3D creates significant differences and results in different connotations between the marks. 6 TTABVUE 14-15.

The term APEX is the entirety of Registrant's mark, and the first word in Applicant's mark. While there is no rule that likelihood of confusion automatically

applies where one mark encompasses another, likelihood of confusion has often been found where the entirety of one mark is incorporated within another. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (finding ML similar to ML MARK LEES).

APEX, as the first word of Applicant's mark, "is likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay Imps.* 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark). The disclaimed term 3D in Applicant's mark is less significant because it is at least descriptive of a feature of Applicant's goods. *See In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression.").

APEX in each mark is identical in appearance and sound. As to connotation, APEX is defined as "the tip, point, or vertex; summit" and "climax; peak; acme."[6] APEX in each mark has a similar connotation and commercial impression. *See In re Dare Foods Inc.,* 2022 USPQ2d 291, at *10-11 (TTAB 2022) (nothing in the record to suggest the term RAINCOAST would have one meaning in the mark RAINCOAST TRADING for seafood meals, snacks and appetizers and a second different meaning

[6] RANDOM HOUSE UNABRIDGED DICTIONARY, dictionary.com (accessed September 30, 2022) https://www.dictionary.com/browse/apex. The Board may take judicial notice of dictionary definitions including online dictionaries that exist in printed format or have regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*,213 USPQ 594 (TTAB 1982), *aff'd*,703 F.2d 1372,217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*,78 USPQ2d 1375, 1377 (TTAB 2006).

in the mark RAINCOAST DIP for snack food dips; "both suggest goods emanating from an unspecified 'rain coast.'"); *In re Joel Embiid,* 2021 USPQ2d 577, at *21 (TTAB 2021) ("there is no evidence here, or other reason to find, that the mark TRUST THE PROCESS has one meaning when used with shoes, and a second and different meaning when used with shirts and sweatshirts, based on the nature of the respective goods").

In considering the marks in their entireties, we are not persuaded that the addition of the disclaimed term 3D in Applicant's mark creates a different commercial impression. We find that overall the marks are similar in sound and appearance and have very similar connotations and commercial impressions such that the addition of the term 3D does not distinguish the marks. *See In re Code Consultants, Inc.*, 60 USPQ2d at1702 (disclaimed matter is often "less significant in creating the mark's commercial impression."). Consumers who are familiar with Registrant's mark APEX for bone screws may view Applicant's APEX 3D mark as a variation of Registrant's APEX mark, and ascribe a common source to the products sold under both marks.

We find the first *DuPont* factor supports a finding of likelihood of confusion.

B. Similarity or Dissimilarity of the Goods

We next consider the second *DuPont* factor, "[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration." *DuPont*, 177 USPQ at 567. Our comparison is based on the goods as identified in Applicant's application and the cited registration. *See Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *M2 Software, Inc. v. M2*

Commc'ns, Inc., 450 F.3d 1378, 8 USPQ2d 1944, 1947 (Fed. Cir. 2006)) (In reviewing the second *DuPont* factor, "we consider the applicant's goods as set forth in its application, and the opposer's goods as set forth in its registration.").

It is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified goods within that class in the application or cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.,* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Evidence of relatedness may include copies of prior use-based registrations of the same mark for both Applicant's goods and the goods listed in the cited registration. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020) (citing *In re Davia*, 110 USPQ2d at 1817).

Applicant's goods are "medical devices, namely, ankle joint implants comprised of artificial materials and associated surgical instruments used exclusively with total ankle implants." Registrant's goods are "bone pins and screws."

The Examining Attorney submitted third-party registrations showing that the same entity has registered a single mark identifying goods in both Applicant's application and Registrant's registration.[7] "As a general proposition, third-party registrations that cover goods from both the cited registration and an Applicant's application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark." *In re Country Oven, Inc.*, 2019

[7] Dec. 17, 2019 Office Action at TSDR 14-113. The Examining Attorney submitted 33 third-party registrations. Seven of these registrations are based on Section 44, and at the time of submission by the Examining Attorney six have been registered for less than five years, with one registered for more than five years, so we have not considered them. *Made in Nature, LLC v. Pharmavite, LLC,* 2022 USPQ2d 557, at *25-26 (TTAB 2022). Six registrants of use-based registrations own two or more registrations.

USPQ2d 443903, at *8 (TTAB 2019) (citations omitted). In particular, we find eleven of these registrations, issued based on use in commerce under Section 1(a) of the Trademark Act, relevant to show that bone screws and surgical implants comprising artificial material are offered under the same mark and thus related. *Id.* at *10 ("just as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, we must consider the full scope of the goods and services described in a third-party registration. … a registration that describes goods broadly is presumed to encompass all goods or services of the type described.") (citations omitted).

These registrations are as follows (emphasis supplied):

Registration No. 3702736 PARCUS for **Goods of metal for medical use, namely**, **screws**, plates, pins and pivots; Knives for surgical purposes; Medical and surgical knives and cutters for cutting human or animal tissue and organs; Medical implants of artificial material in particular for anchoring joint capsule components and ligament tendon structures; Substitutes for bones, cartilage, ligaments and tendons; Surgical and medical apparatus and instruments for use in general surgery; Surgical devices and instruments; **Surgical implants comprising artificial material and associated surgical instrument sets**; Surgical instruments for use in arthroscopic surgery; Surgical instruments, namely, suture passers and suture anchoring equipment and tools; Surgical sutures; Suture materials; Suture needles; Sutures;

Registration No. 5553365 PEGA MEDICAL for **Medical, surgical and orthopedic implants made of artificial materials**; Medical and surgical apparatus and instruments, namely, orthopedic fixation devices for use in orthopedic implant surgery, namely, metal screws and plates; Orthopedic bone implants made of artificial materials; **orthopedic bone screws**; surgical instruments for use in orthopedic and spinal surgery; templates for orthopedic purposes; Orthopedic implants made of artificial materials, namely, orthopedic hip prostheses; intramedullary nails, surgical nails; Medical and surgical apparatus, namely, self-extending rods for use in fixation of long bone fractures;

Registration No. 5394395 MATRIXMIDFACE for **Surgical and medical implants composed of non-living material** and associated surgical instruments

and apparatus, namely, **bone screws**, bone plates, drill bits, surgical gauges for drilling, drill guides, screwdrivers, screwdriver blades, calipers, forceps, splint drivers, mallets, pliers, plate holders, plate and rod benders; Graphic cases composed primarily of metal, namely, cases specially adapted for holding the aforesaid surgical and medical implants comprised of non-living materials, instruments, and apparatus;

Registration No. 5168317 MARINER for Implantable medical devices, namely, pedicle screws, spinal rods, and connectors; Medical apparatus for use in spinal surgeries; Surgical apparatus; **Surgical implants comprising artificial materials;** Spinal implants composed of artificial material; Spinal devices, namely, pedicle screws, spinal rods, and connectors; **Bone screws**, namely, pedicle screws; Medical devices, namely, connecting rods for spinal surgery; Medical devices, namely, cross connectors for spinal surgery; Locking bone screws; Bone implants comprised of artificial materials;

Registration No. 5643905 MD VUE for **Medical and surgical apparatus and instruments, namely, orthopedic implants composed of artificial materials**; spinal implants composed of artificial materials; **implants composed of artificial materials**; surgical instruments used in orthopedic surgery; **bone screws**; and pedicle screws;

Registration No. 5745932 RE-INVENTING HEALTH for Medical devices, namely, depth gauges, electromagnetic medical diagnostic imaging apparatus, anastomosis devices, bone drills, bone plates, bone setting machines and instruments, **bone screws**, bone implants composed of artificial material, bone substitutes for surgical use, electric bone operating machines, devices for measuring bone thickness, disposable syringes, hypodermic needles, hypodermic syringes, implants consisting of artificial materials, injection device for pharmaceuticals, injection instruments without needles, injection instruments with needles, injection needles, injection syringes, orthopedic fixation device used in orthopedic transplant and/or implant surgery, medical apparatus for facilitating the inhalation of pharmaceutical preparations, medical electrodes, needles for injection, needles for medical use, needle-based and needle-free injection systems, orthodontic machines and instruments, stents, surgical and medical apparatus and instruments for use in general surgery, **surgical implants comprising artificial material**, surgical instruments in the nature of scalpels, blades and staplers, surgical instruments for use in spine surgery, synthetic stent grafts, ultrasound diagnostic apparatus, ultrasonic medical diagnostic apparatus;

Registration No. 5576705 CAYENNE for **Orthopedic articles, namely, orthopedic implants composed of artificial materials and surgical instruments used in associate therewith**; medical apparatus and instruments for use in orthopedic surgery; medical devices for use in surgical and orthopedic procedures, namely, suture anchors, suture anchor inserters, suture passers, bone

anchors, **bone screws**, arthroscopic instruments, surgical drills, surgical drill guides, cannulae, suture cutters, knot pushers, rasps, probes, suture materials, and bone screw insertion and positioning tools;

Registration No. 5852362 WILTROM for Medical devices and apparatus for surgical implantation; medical instruments for surgical implantation; surgical implants comprised of artificial materials; surgical apparatus and instruments for surgical implantation; pins for artificial teeth; dental apparatus and instruments; biodegradable bone fixation implants; Medical apparatus and instruments for treating osteotraumatic injuries, degenerative bone diseases and joint diseases; Medical apparatus and instruments for treating osteoarthritis, osteoporosis, osteotraumatic injuries, degenerative bone diseases and joint diseases; **medical and dental implants of artificial materials**; artificial human bone material for surgical implants; Medical and surgical apparatus and instruments, namely, orthopedic fixation device used in orthopedic transplant and/or implant surgery; Medical apparatus, namely, a spinal fusion device; Bone retractors; Bone forceps; Osseous implants made of artificial materials; Prosthetic and filling materials, namely, artificial materials for use in the placement of bones; Prosthetic and filling materials, namely, putty for use in the placement of bones; **Bone screws**; Synthetic bone grafts; Osseointegrated implants made of artificial matter; Artificial bone growth media; Synthetic bone substitute compound, namely, phosphocalcic granules; Medical devices for spinal disc repair in the nature of spinal disc implants made from artificial substances; Medical apparatus for spinal disc repair; Medical devices, namely, spinal cross connectors; Surgical and medical apparatus and instruments for use in spinal, general or orthopedic surgery;

Registration No. 5909254 REGENESORB for Suture anchors for use in soft tissue repair; **bone screws**; implants comprising artificial material for use in arthroscopic surgery; **implants comprising artificial material for use in joint repair**; implants comprising artificial material for use in soft tissue repair;

Registration No. 5841003 

for Medical lancing devices; Medical cutting devices; Medical device for correcting vertebral alignment; Medical devices, namely, spinal cross connectors; Medical apparatus, namely, a spinal fusion device; Therapeutic apparatus, namely, cervical neck supports for relief of neck muscle pain; Spinal column braces for medical purposes, namely, back braces and cervical neck braces; **Medical and surgical apparatus and instruments, namely, orthopedic implants composed of artificial materials and instruments used in orthopedic surgery**; **Bone screws**, namely, pedicle screws; Orthopedic supports for medical use, namely, braces, slings, ankle supports, elbow support, knee support, wrist supports, arthritic knee supports, calf supports, thigh supports, leg supports, back supports, neck supports, shoulder supports, hernia supports, abdominal

binders, support bandages for the arm, maternity support belts for medical use, patella straps for medical use, rib belts for medical use, wraps, bands, belts, splints, collars, and immobilizers; Maternity support belts for medical purposes; Orthopedic toe straighteners; Posture correction device, namely, an adjustable harness to correct one's posture for medical purposes; Massage balls; Foot pad for detoxifying an organism for medical purpose; Cervical pillows for medical use; Massage apparatus; Back supports for medical purposes; Medical Cervical and Lumbar Traction Devices; and

Registration No. 5802312 SUREMAX for Bone implants composed of artificial materials; **Bone screws**; Medical and surgical apparatus and instruments, namely, orthopedic fixation device used in orthopedic transplant and/or implant surgery; **Surgical implants comprising artificial material and associated surgical instrument sets**.

Applicant argues that "[e]ven if the goods may potentially be used during the same surgery (which they are not)," the goods "themselves are significantly different and serve entirely different purposes." 6 TTABVUE 11-12. This argument is not persuasive. The goods need only be "related in some manner and/or … the circumstances surrounding their marketing be such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). The third-party registrations, although not evidence of actual use, are probative. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (21 third-party registrations probative of relatedness of subject goods).

Applicant further "submits that the relatedness presented is minimal and woefully insufficient to support a likelihood of confusion by a substantial number of reasonable consumers." 9 TTABVUE 8. We find, however, that the third-party "registrations are sufficient in both quality and quantity to provide a reasonable

predicate supporting the Examining Attorney's position on relatedness and shift the burden to Applicant to rebut the evidence with competent evidence of its own," which Applicant has not done. *Country Oven,* 2019 USPQ2d 443903, at *9-10.

In addition, Applicant argues that "the descriptions [in the identifications] alone are sufficient to establish that the medical devices are different, and thus the targeted consumers are different." 9 TTABVUE 10. But the cited registration is broad enough to include "bone pins and screws" used in ankle surgery. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). Accordingly, we find that the goods are related in such a manner that they would 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. We find the second *DuPont* factor supports a finding of likelihood of confusion.

C. Trade Channels

We now turn to the third *DuPont* factor which requires us to consider "the similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567.

The basis for our analysis of trade channels is the identification of goods set forth in the application and cited registration "regardless of what the record may reveal as to the particular nature of an applicant's [or registrant's] goods, [or] the particular channels of trade or the class of purchasers to which sales of the goods are directed."

Octocom Sys., Inc. v. Hous. Comput. Servs., Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Here, both Registrant's and Applicant's identifications are unrestricted as to trade channels. Moreover, in the absence of specific limitations in Applicant's and Registrant's respective identifications, we must assume that the products set forth in the identifications are sold in all normal channels of trade for goods of that type. *DeVivo v. Ortiz,* 2020 USPQ2d 10153, at *39-41 (TTAB 2020) ("[A]bsent an explicit restriction in the application, the identified goods in the application must be presumed to move in all channels of trade that would be normal for such goods and to all usual prospective purchasers for goods of that type.").

The Examining Attorney references website evidence as support for trade channel overlap.[8] However, this evidence consists of articles relating to surgical hardware, intermedullary nails and rods, and screws and plates used in connection with foot surgery, and titanium surgical devices generally, none of which shows the normal trade channels utilized to distribute bone screws and pins nor Applicant's identified goods.

As to Applicant's goods, implantable medical devices, Applicant's witness Frank S. Bono, Co-Founder and Chief Technology Officer of Applicant, states that the identified goods are sold directly from Applicant through sales representatives and are not sold in stores or available for resale.[9] Applicant's sales process requires the goods to be purchased directly from Applicant through these trained sales

[8] Jan. 14, 2021 Office Action at TSDR 5-20.

[9] Bono Declaration, ¶¶ 6, 8, 9, Jan. 26, 2022 Request for Reconsideration at TSDR 18.

representatives.[10] Applicant argues that "the unique sales process in the implantable medical device marketplace makes likelihood of confusion as to the source of the goods at issue improbable if not impossible" and that because of the way its goods are marketed confusion is unlikely. 6 TTABVUE 13; 9 TTABVUE 9.

We find the evidence of trade channel overlap is lacking, and therefore, the *DuPont* factor relating to channels of trade is neutral. *See Bond v. Taylor*, 119 USPQ2d 1049, 1054 (TTAB 2016) ("However, while the consumers may be identical, the evidence is not sufficient to establish an overlap in the channels of trade for the services.").

D. Conditions of Sale

The fourth *DuPont* factor considers the "conditions under which and buyers to whom sales are made, i.e. 'impulse' vs careful, sophisticated purchasing," *DuPont,* 177 USPQ at 567. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps.,* 73 USPQ2d at 1695.

As indicated by Applicant's declaration, the classes of consumers for Applicant's and Registrant's goods, are foot and ankle surgeons, physicians, surgical nurses and technicians, as well as hospital administrative personnel.

In particular, Applicant's co-founder Mr. Bono averred that Applicant's goods are purchased by medical professionals (foot and ankle surgeons, surgical nurses, and

[10] *Id.* at ¶ 7.

technicians). Mr. Bono also stated that "it is common practice in the medical field for a hospital purchasing committee, comprised of multiple physicians, nurses, and hospital administrative personnel, to make the decision of which goods to purchase."[11] Therefore, we find the classes of consumers overlap.

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) ("Given 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 [goods] that would be used in performing medical procedures."); *Edward Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1413 (TTAB 2010) (noting that "[j]ust based on the products involved in this proceeding 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 [significant study and negotiations] by persons who are highly knowledgeable about the products."); *In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1273 (TTAB 2009) ("it seems beyond dispute that ultrasound and MRI imaging equipment is expensive and that the

[11] *Id.* at ¶ 9.

purchasers of these products would be sophisticated"); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1393 (TTAB 1991) (potential customers of medical instruments and medical equipment would be purchased by highly educated sophisticated purchasers who know their equipment needs and would be expected to exercise great care in their selection, "[g]iven the deliberation involved in determining the suitability of particular medical instruments for specific patient care applications, and since customers and prospective purchasers typically deal directly with the parties in making their purchasing decisions.").

Applicant argues that the sophistication of the buyers is a critical factor that mitigates against a finding of a likelihood of confusion because of the great care in purchasing Applicant's goods which minimizes and eliminates confusion. 6 TTABVUE 7. Specifically, Applicant argues that "an ordinary consumer of the Applicant's goods, and those associated with the Registered Marks, is a highly sophisticated medical professional, or entity with medical professional employees, who routinely makes thoughtful and careful decisions, including the purchase of medical goods and surgical implants." 6 TTABVUE 7. Applicant submits that even "the least sophisticated purchaser [of its goods] is a medical professional or medical entity, i.e., a highly sophisticated purchaser." 6 TTABVUE 6-7.

Applicant also argues that "impulse purchasing" is unlikely and "virtually impossible" because consumers must contact Applicant for the goods. Applicant, referencing the Bono declaration, explains that its sales representatives address the specific needs of the podiatric and foot and ankle medical professionals and provide

follow-up and technical support after purchase.[12] Applicant, further states that its sales representatives communicate extensively with the purchasers to determine their needs and specifications.[13]

Although the purchasing conditions for bone screws and pins is not supplied, Mr. Bono did state that in the medical field, medical goods may be purchased by a hospital purchasing committee, who make the decision of which goods to purchase after considerable time and deliberation.[14] We find that both Applicant's and Registrant's goods are purchased by medical personnel and the purchasing process requires some deliberation and care.

The fourth *DuPont* factor supports a finding of no likelihood of confusion.

II. Conclusion

We find the marks are similar and the goods related. However, the evidence of trade channel overlap is lacking, so this factor is neutral. Although we find the conditions of sale and buyers to whom sales are made weighs in Applicant's favor, we find this *DuPont* factor does not overcome similarity of the marks and relatedness of the goods supporting an ultimate finding that confusion is likely.

Decision: The refusal to register Applicant's mark APEX 3D is affirmed.

[12] Bono Declaration, ¶ 7, January 26, 2022 Request for Reconsideration at TSDR 18.

[13] *Id.* at ¶ 7.

[14] *Id.* at ¶ 9.