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

Proceeding	91124302
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

S.S. WHITE BURS, INC.,)	
)	
Opposer,)	Opposition No. 124,302
)	
vs.)	
)	
S.S. WHITE TECHNOLOGIES, INC.,)	
)	
Applicant.)	
_____)	

OPPOSER S.S. WHITE BURS' TRIAL BRIEF

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OPPOSER S.S. WHITE BURS' TRIAL BRIEF

I. STATEMENT

This matter comes before the Trademark Trial and Appeal Board on the opposition filed by opposer S.S. White Burs, Inc. ("S.S. White Burs") to Application Serial No. 76/026,164 filed by applicant S.S. White Technologies, Inc. ("Applicant") to register the mark S.S. WHITE for "[h]and operated medical tools and instruments used in orthopedics, namely pin pullers, hammers, mallets, ratchets and sockets, wrenches, quick disconnects, drill chucks, torque instruments, screwdrivers, universal nail and rod extraction sets, and the following custom designed tools-bone and stem impactors, femoral head extractors, bone taps, reamers, drill bits, spinal fixation tools, cutting blocks, and bone screws." As set forth below, Applicant's mark is confusingly similar to S.S. White Burs' various registered and common law S.S. WHITE trademarks for dental and medical products in violation of Section 2(d) of the United States Trademark Act of 1946, 15 U.S.C. § 1052(d). Furthermore, Applicant's mark dilutes or would likely dilute the distinctiveness of S.S. White Burs' S.S. WHITE marks in violation of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

II. DESCRIPTION OF THE RECORD

On April 22, 2004, the parties filed their Stipulation to Use Summary Judgment Materials as Testimony. On August 23, 2004 the Board approved the parties' stipulation. During their respective testimony periods, neither party chose to introduce evidence beyond what had already been submitted in connection with the summary judgment briefs. Accordingly, S.S. White Burs' record consists of:

- (a) Declaration of Nathan E. Ferguson ("Ferguson Decl.").
- (b) Ferguson Decl. Ex. 1, January 5, 2000 Consent Judgment entered in *S.S. White Burs, Inc. v. S.S. White Technologies Inc. and Oz Dental Inc.*, Civil Action No. 99-1288 (FSH) (D.N.J.) (hereafter, "District Court Action").
- (c) Ferguson Decl. Ex. 2, Certified copy of United States Trademark Registration Number 138,523
- (d) Ferguson Decl. Ex. 3, Certified copy of United States Trademark Registration Number 1,658,139.
- (e) Ferguson Decl. Ex. 4, Certified copy of United States Trademark Registration Number 2,001,176.
- (f) Ferguson Decl. Ex. 5, Stipulation of Facts Respecting Contempt Proceeding in District Court Action, Volumes 1, 2 and 3.
- (g) Ferguson Decl. Ex. 6, Opinion of Judge Barry entered April 7, 1999 in District Court Action.
- (h) Ferguson Decl. Ex. 7, Excerpt from *Webster's Third New International Dictionary*.
- (i) Ferguson Decl. Ex. 8, Excerpt from *The American Heritage Dictionary*.
- (j) Ferguson Decl. Ex. 9, Excerpt from *Dorland's Illustrated Medical Dictionary*.

- (k) Ferguson Decl. Ex. 10, Excerpt from *Stedman's Medical Dictionary*.
- (l) Ferguson Decl. Ex. 11, Expert Report of Robert B. Ronkin, D.M.D., M.D., entitled "Analysis of Product Use in Surgical Subspecialty Application: Biological Hard Tissue Rotary Cutting Instruments," from District Court Action.
- (m) Ferguson Decl. Ex. 12, Supplemental Certification of Robert Hansen dated August 10, 2000, from District Court Action.
- (n) Ferguson Decl. Ex. 13, Excerpts from Transcript of Proceeding of August 17, 2000 proceeding from District Court Action.
- (o) Ferguson Decl. Ex. 14, Printouts of U.S.P.T.O. Trademark Electronic Search System status report, Volumes 1 and 2.
- (p) Ferguson Decl. Ex. 15, Materials printed from Internet websites.
- (q) Second Declaration of Nathan E. Ferguson ("Second Ferguson Decl.")
- (r) Second Ferguson Decl. Group Ex. 1, Printouts of U.S.P.T.O. Trademark Electronic Search System status reports.

III. FACTS

A. S.S. White Burs and Its S.S. WHITE Products

Since the 1860's, S.S. White Burs and its predecessors-in-interest have engaged in the business, *inter alia*, of manufacturing, promoting and selling a wide array of dental and other medical products under the name and mark S.S. WHITE. *S.S. White Burs, Inc. v. S.S. White Technologies Inc.*, Civil Action No. 99-1288 (D.N.J.) (Consent Judgment Jan. 5, 2000), at ¶ 3 (hereinafter "Consent Judgment") (a true copy of which has been submitted as Exhibit 1 to the Declaration of Nathan E. Ferguson ("Ferguson Decl.")); *compare* Notice of Opposition at ¶ 1,

with Answer to Notice of Opposition at ¶ 1.¹ S.S. White Burs is the owner of all right, title and interest to the name and mark S.S. WHITE for dental products and dental products businesses. Consent Judgment at 4. Among the dental products sold by S.S. White Burs are rotary cutting medical instruments (such as dental burs and dental diamond points and carbide burs), bur holder blocks, bur cleaning brushes, dental and surgical gloves, and rubber dams. *Compare* Notice of Opposition at ¶ 2, with Answer to Notice of Opposition at ¶ 2; *see also infra* (incontestable federal trademark registrations).

S.S. White Burs has registered multiple S.S. WHITE marks with the United States Patent and Trademark Office, including the following:

<u>Mark</u>	<u>Registration No.</u>	<u>Goods</u>
S.S. WHITE (Stylized)	138,523	Dental burs.
SS WHITE (Stylized)	1,658,139	Dental diamond point burs, bur holders, bur cleaning brushes, and dental and surgical gloves.
SS WHITE	2,001,176	Dental burs, namely dental diamond points and carbide burs, bur holder blocks, bur cleaning brushes, dental gloves and rubber dams.

Each of these registrations is valid and subsisting, and each is incontestable in accordance with the provisions of Section 8 and 15 of the United States Trademark Act of 1946, 15 U.S.C. §§ 1065 & 1115(b). (Ferguson Decl., ¶¶ 3-5, at Exhibits 2-4); *compare* Notice of Opposition at ¶ 3, with Answer to Notice of Opposition at ¶ 3.

¹ “[A] ‘dental product’ means any product or device used in connection with providing dental care or hygiene. . . . A ‘dental products business’ is a business engaged in the design, manufacture, promotion, advertisement, sale or distribution of one or more dental products.” Consent Judgment at ¶ 2.

B. Applicant and Its Medical Products

On April 17, 2000, Applicant filed an application (Serial Number 76/026,164) for the mark S.S. WHITE for “[h]and operated medical tools and instruments used in orthopedics, namely pin pullers, hammers, mallets, ratchets and sockets, wrenches, quick disconnects, drill chucks, torque instruments, screwdrivers, universal nail and rod extraction sets, and the following custom designed tools-bone and stem impactors, femoral head extractors, bone taps, reamers, drill bits, spinal fixation tools, cutting blocks, and bone screws” in International Trademark Class 10. 1246 Off. Gaz. Pat. Office TM 158 (May 1, 2001). Applicant made no use of the mark S.S. WHITE for the named goods prior to its claimed date of first use of July 1, 1999. *Compare* Notice of Opposition at ¶ 7, *with* Answer to Notice of Opposition at ¶ 7. Further, Applicant sold no medical instruments of any kind under the S.S. WHITE name or mark (excluding only an air abrasion unit for dental use which resulted in the grant of a preliminary injunction and subsequent consent judgment) until subsequent to June 30, 1999 when it first acquired certain assets of Snap-On Medical Products Company. *See* Stipulation of Facts Respecting Contempt Proceedings from *S.S. White Burs, Inc. v. S.S. White Technologies Inc.*, Civil Action No. 99-1288 (D.N.J.) at ¶¶ 5 & 85 (a true copy of which is contained in Ferguson Decl. at Exhibit 5) (hereinafter “Stipulated Facts”); *see also* Consent Judgment; *see also* Opinion (4/7/99) from *S.S. White Burs, Inc. v. S.S. White Technologies Inc. and Oz Dental, Inc.*, Civil Action No. 99-1288 (D.N.J.), at 2 (Barry, J.) (a true copy of which is contained in Ferguson Decl. at Exhibit 6) (hereinafter “Opinion (4/7/99)”).

IV. ISSUES

Applicant seeks to register the opposed mark, S.S. WHITE, for a variety of products that are identical or related to S.S. White Burs’ goods. S.S. White Burs submits that Applicant’s use of the opposed mark in connection with Applicant’s goods would create a likelihood of

confusion within the meaning of § 2(d) of the Federal Trademark Act, in view of S.S. White Burs' prior use and registration of its S.S. WHITE marks, as well as the substantial fame of the mark S.S. WHITE. S.S. White Burs also submits that Applicant's use of the opposed mark in connection with Applicant's goods dilutes or would likely dilute the distinctiveness of S.S. White Burs' S.S. WHITE marks.

V. ARGUMENT

A. Likelihood of Confusion Under § 2(d)

To prevail upon its Section 2(d) claim, S.S. White Burs must establish by a preponderance of the evidence that it is the owner of valid trade identity rights in its S.S. WHITE marks and that Applicant's use of the S.S. WHITE mark for the aforesaid goods would likely cause confusion with one or more of S.S. White Burs' S.S. WHITE marks. *See, e.g., Calvin Klein Indus., Inc. v. Calvins Pharm., Inc.*, 8 U.S.P.Q.2d 1269, 1270 (T.T.A.B. 1988). There can be no doubt that the cumulative weight of the evidence greatly favors the rejection of Applicant's application.

1. S.S. White Burs' Ownership of the S.S. WHITE Mark

S.S. White Burs owns three (3) incontestable federal trademark registrations for its S.S. WHITE mark. *See supra* at 2. Such registrations constitute conclusive evidence of the validity of the mark and of the registrant's exclusive right to use the mark on the goods specified in the registration. *See* 15 U.S.C. §§ 1057(b) & 1115(a). Moreover, under the terms of a previously entered consent judgment to which both S.S. White Burs and Applicant are parties, it is conclusively established that S.S. White Burs owns all right, title and interest to the trade name and trademark S.S. WHITE for dental products and dental products businesses. *See* Consent Judgment at ¶ 4. Accordingly, S.S. White Burs has easily established that it owns the S.S. WHITE mark for the goods recited in its incontestable registrations.

2. Likelihood of Confusion

Whether or not there is a likelihood of confusion is a legal question determined by evaluating multiple factual factors, the so-called *Dupont* factors,² which may include, but are not necessarily limited to, the following:

(1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether *de minimis* or substantial; and (13) any other established fact probative of the effect of use.

See, e.g., Recot, Inc. v. Becton, 214 F.3d 1322, 1326-27, 54 U.S.P.Q.2d 894, 1897 (Fed. Cir. 2000) (citation omitted). “Each case of likelihood of confusion is decided upon the particular facts of the case, . . . recognizing that the various evidentiary factors may play more or less weighty roles in a particular determination.” *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q.2d 1687, 1688 (Fed. Cir. 1993) (citation omitted). In appropriate cases (including the instant matter), the similarity of the respective marks and the relatedness of the respective products may be deemed dispositive of the likelihood of confusion analysis. *See Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 U.S.P.Q.2d 1557, 1559 (Fed. Cir. 2001),

²*In re Dupont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

related proc'gs sub nom., Alberto-Culver Co. v. Trevive, Inc., 199 F. Supp. 2d 1004 (C.D. Cal. 2002). The similarity of the respective marks and the relatedness of the respective goods, as discussed in more detail below, weigh heavily in S.S. White Burs' favor and these two factors alone could be the basis for judgment in S.S. White Burs' favor.

In weighing the *Dupont* factors to determine the existence of likelihood of confusion, the Board is to resolve any doubt against Applicant because “. . . the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so.” *See, e.g., In re Shell Oil Co.*, 992 F.2d at 1209, 26 U.S.P.Q.2d at 1691 (citation omitted). Moreover, where, as here, a proceeding involves use of similar marks on medical products, it is well established that, in light of potential risks to patients, the likelihood of confusion analysis is even more conservative than usual, with a lower quantum of proof to establish the existence of a likelihood of confusion. *See Glenwood Labs., Inc. v. American Home Prod.*, 455 F.2d 1384, 1386, 173 U.S.P.Q. 19, 21 (C.C.P.A. 1972) (pharmaceuticals); *Ethicon, Inc. v. American Cyanamid Co.*, 192 U.S.P.Q. 647, 651-52 (T.T.A.B. 1976) (surgical sutures).

An evaluation of the evidence submitted to the Board, particularly in light of the above identified evidentiary standards, demonstrates by *at least* a preponderance of the evidence that Applicant's proposed mark will likely lead to confusion.

a. Similarity of the Marks

Perhaps the single most important factor in analyzing likelihood of confusion is the similarity or dissimilarity of marks at issue. *See, e.g., Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 293, 18 U.S.P.Q.2d 1417, 1430 (3d Cir. 1991), *cert. denied sub nom., Altran Corp. v. Ford Motor Co.*, 502 U.S. 939 (1991). As conceded by Applicant, Applicant's mark is identical to, and legally indistinguishable from, S.S. White Burs' mark. *See* Applicant's Memorandum in Opposition to S.S. White Burs' Motion for Summary Judgment and in Support

of Applicant's Cross-Motion for Summary Judgment at 33 ("App. SJ Memo"). Consequently, this factor strongly favors a finding of likelihood of confusion.

b. Similarity of the Goods

The evidence clearly demonstrates that Applicant has attempted to register the S.S. WHITE mark for at least one medical instrument (*i.e.*, drill bits) that is identical to one of S.S. White Burs' medical instruments³ (*i.e.*, burs). As discussed in more detail below, "burs" and "drill bits" are legally identical products as both are a rotating cutting instrument attached to a drill and used to cut organic tissue. *See, e.g., Dorland's Illustrated Medical Dictionary* at 253 (bur) & 544 (drill) (29th ed. 2000) (Ferguson Decl.; Exh. 9); *Stedman's Medical Dictionary* at 258 (bur) & 541 (drill) (27th ed. 2000) (Ferguson Decl., Exh.10). However, even if the parties goods were not identical, it is well established that:

goods . . . do not need to be identical or even competitive in order to determine that there is a likelihood of confusion. It is sufficient that the goods . . . of the applicant and the registrant are related in some manner or the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.

TMEP § 1207.01(a)(i). Furthermore, where "the applicant's mark is identical to a registrant's mark, as it is in this case, there need be only *a viable relationship* between the respective goods . . . in order to find that a likelihood of confusion exist." *In re Opus One, Inc.*, 60 U.S.P.Q.2d

³ The evidence submitted to the Board also supports the conclusion that dental instruments, such as S.S. White Burs' burs, are medical instruments because dentistry is but a specialized area of medical practice. *See* excerpts from *Webster's Third New Int'l Dictionary* (a true and correct copy of which has been submitted as Exhibit 7 to Ferguson Decl.), and excerpts from *American Heritage Dictionary of the English Language*, (a true and correct copy of which has been submitted as Exhibit 8 to Ferguson Decl.) As discussed in greater detail *infra* at 10-11, this fact is also established because Applicant has stipulated that S.S. White Burs' burs are used in performing oral and maxillo-facial surgery.

1812, 1815 (T.T.A.B. 2001) (emphasis added); *see also In re Concordia Int'l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983). There is no doubt that the evidence submitted by S.S. White Burs meets this low evidentiary threshold.

i) The Rotary Cutting Medical Instruments Sold by the Parties Under the S.S. WHITE Mark Are Identical.

Each party markets rotary cutting medical instruments under the S.S. WHITE mark to hospitals and medical professionals in connection with medical procedures undertaken on the human body. *See* Stipulation of Facts Respecting Contempt Proceedings at ¶¶ 14 & 15 (Ferguson Decl. (5/2/03) at Ex. 5 (hereinafter “Stipulated Facts”). For example, S.S. White Burs’ rotary cutting medical instruments are used to cut bone, cartilage and tooth structure in oral and maxillo-facial surgery. Stipulated Facts at ¶ 76. These S.S. WHITE branded surgical burs sold by S.S. White Burs are also useable by orthopedic surgeons for small bone applications, such as in the hand, as well as for other surgical applications. *See* Robert B. Ronkin, D.M.D., M.D., Analysis of Product Use in Surgical Subspecialty Applications: Biological Hard Tissue Rotary Cutting Instruments (8/10/00), (a true copy of which is contained in Ferguson Decl. at Exhibit 11), (“Ronkin Report”). For years, and long prior to Applicant’s application, acquisition of a medical products company, and subsequent use of the mark, S.S. White Burs’ S.S. WHITE branded burs have been marketed and sold by S.S. White Burs’ distributors for small-bone orthopedic and other surgical applications. *See* Supplemental Certification of Roger Hansen (8/10/00) at ¶¶ 5-7 from *S.S. White Burs, Inc. v. S.S. White Technologies Inc. and Oz Dental, Inc.*, Civil Action No. 99-1288 (D.N.J.), (hereinafter “Hansen Supp. Cert. (8/10/00)”), (a true copy of which is contained in Ferguson Decl. at Exhibit 12).

Applicant’s rotary cutting medical instruments (*i.e.*, drill bits) are used in a similar fashion on bone and other tissues, and can be used in maxillofacial surgery. Additionally,

Applicant's other instruments, such as drills, screw drivers and bone screws, are used for maxillofacial surgery in the United States. Stipulated Facts at ¶¶ 94-97. Therefore, S.S. White Burs' burs and Applicant's surgical drill bits are legally identical products.⁴ *See also Endo Labs., Inc. v. Fredericks*, 199 U.S.P.Q. 824, 828-30 (T.T.A.B. 1978) (ENDOSTIK for medical instruments confusingly similar to ENDO for medicinal and pharmaceutical preparations); *Smith Kline Instruments, Inc. v. Mars Mfg. Co.*, 172 U.S.P.Q. 190, 191 (T.T.A.B. 1971) (LIFE-GUARD for disposable sterile surgical packs containing gowns, sheets, drapes, towels, and table and stand covers confusingly similar to LIFEGUARD for cardiac monitoring medical instruments and cardiac monitoring systems); *In re Tee-Pak, Inc.*, 164 U.S.P.Q. 88, 89 (T.T.A.B. 1969) (HOSP-PAK for thin-walled tubing of regenerated cellulose for use as sterilization tubes confusingly similar to HOSPAC for hypodermic needles, hypodermic syringes, surgical blades, catheters, rectal tubes, hospital thermometer racks and surgical tubular drains); *American Optical Co. v. Synthes AG*, 156 U.S.P.Q. 344, 345 (T.T.A.B. 1967) (AOI (stylized) for surgical instruments and apparatus for bone surgery, namely screws, plates and intramedullary nails confusingly similar to AO (stylized) for line of ophthalmic equipment, apparatus and supplies including machinery and tools used in the optical or ophthalmic trade); *In re Cross Country Paper Prods., Inc.*, 2000 TTAB LEXIS 871, *3 (T.T.A.B. 2000), *request for reconsideration denied*, 2001 TTAB LEXIS 84, *2 (T.T.A.B. 2001) (EXCEL for plastic gloves to be used once by and thereafter disposed of by dentists confusingly similar to EXCEL and EXCEL DR used for

⁴ Because there are no limitations on the scope of drill bits in the Applicant's description of goods, the application's broad description of goods necessarily overlaps with S.S. White Burs' burs. Purported differences between the parties' rotary cutting medical instruments based upon price, size or even disposability ultimately are irrelevant because the Applicant's goods as described in the application cover all variations. *See CBS Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 U.S.P.Q. 198, 199-200 (Fed. Cir. 1983) (giving no weight to applicant's contention that its

surgical instruments, namely, forceps, graspers, scissors, dissectors, clamps, needles, needle holders, probes, suction and irrigation instruments, trocars, cannulae, and cutting instruments).⁵ The Applicant's and S.S. White Burs' goods are so similar that this factor strongly favors a finding of likelihood of confusion.

ii) Applicant's Other Medical Products Have at Least a Viable Relationship to S.S. White Burs'.

As to Applicant's remaining orthopedic instruments, it is clear that there is at least a "viable relationship"⁶ between those goods and S.S. White Burs' rotary cutting medial instruments and the surgical gloves that are used in maxillofacial surgery. *See Stipulated Facts ¶¶ 76 & 79; see also Ronkin Report.* The record establishes that maxillofacial surgery is a specialized form of orthopedic surgery. *See Transcript of 8/17/00 proceeding from S.S. White Burs, Inc. v. S.S. White Technologies Inc. and Oz Dental, Inc., Civil Action No. 99-1288 (D.N.J.) at 87 (Ronkin testimony) (a true copy of which is contained in Ferguson Decl. (5/2/03) at Ex. 13;*

goods were distinguishable due to high sales price, differing channels of trade, and sophistication of consumer because these distinctions were not articulated in application).

⁵ Although not designated by the Board as citable precedent, S.S. White Burs notes *In re Cross Country Paper Products, Inc.* because it bears upon goods and issues virtually identical to those in the instant opposition:

[S]ome of registrant's surgical instruments, as identified in the cited registrations, might also be used in the dental field by oral surgeons. Registrant's goods, therefore, would be encountered by the same class of purchasers/users of applicant's goods. Although we find it reasonable for applicant to assert that medical professionals are likely to be somewhat sophisticated purchasers of medical supplies, that sophistication would not ensure against confusion here given the closeness between the involved marks.

Id. at *5.

⁶ *See In re Opus, Inc.*, 60 U.S.P.Q.2d at 1815.

App. Memo. Ex. B) (hereinafter “Trans. (8/17/00)”)⁷ Both non-maxillofacial orthopedic surgery and maxillofacial surgery are performed in hospitals, as is more traditional dental treatment. *See* Stipulated Facts at ¶¶ 18-19 & 80-82. In testimony undisputed by any licensed medical professional, S.S. White Burs’ expert Dr. Ronkin stated that the respective goods were clearly related in the eyes of the end users, at least some of whom are direct purchasers of the respective goods. *See* Transcript of (8/17/00) at 88, 93-97, 111-12 (Ronkin testimony); *see also* Ronkin Report. For instance, the S.S. WHITE branded latex gloves sold by S.S. White Burs are usable by surgeons in any surgical application, including orthopedic surgery. *See* Transcript of 8/17/00 proceeding from *S.S. White Burs, Inc. v. S.S. White Technologies Inc.*, Civil Action No. 99-1288 (D.N.J.) at 106-07 (Ronkin Testimony) (a true copy of which is contained in Ferguson Decl. at Exhibit 13) (hereinafter “Trans. (8/17/00)”). The Board may take judicial notice of the fact that surgical gloves, such as those sold by S.S. White Burs under the S.S. WHITE mark, are routinely used by medical professionals performing virtually any medical procedure (including those performed by a medical professional using any of Applicant’s proposed goods). This fact alone requires a finding that the respective goods are related.

The Board is to construe an applicant’s description of its goods in the manner most favorable to the opposer. *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 U.S.P.Q. 198, 199-200 (Fed. Cir. 1983) (giving no weight to applicant’s contention that its goods were distinguishable

⁷ Applicant has previously challenged the qualifications of S.S. White Burs’ expert witness, Dr. Ronkin. *See* App. SJ Memo. at 13-15. Applicant asserts that Dr. Ronkin, a respected trauma surgeon who is head of surgery at a major Illinois hospital, *see* Opp. Ex. 11 (Ronkin CV), is atypical and unrepresentative of surgeons. The record contains no evidence from a medical professional that rebuts Dr. Ronkin’s qualifications and Applicant’s challenge should be wholly disregarded. Dr. Ronkin’s testimony, coming from both a practicing surgeon and a hospital administrator with supply purchasing responsibilities, is the only evidence from a medical professional as to the relatedness of the respective goods and the overlap of distribution chains, as well as the only evidence from an actual purchaser of medical instruments.

due to high sales price, differing channels of trade, and sophistication of consumer because these distinctions were not articulated in application); *see also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1337, 209 U.S.P.Q. 986, 988 (C.C.P.A. 1981). Furthermore, the relatedness of goods must be determined on the basis of the description of goods set forth in the application opposed. Accordingly,

[t]he issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein. 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 sales of the goods are directed.

Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 942, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (citations omitted); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 950, 55 U.S.P.Q.2d 1842, 1846 (Fed. Cir. 2000); *Penguin Books, Ltd. v. Rainer Eberhard*, 48 U.S.P.Q.2d 1280, 1286 (T.T.A.B. 1998). Based on the evidence submitted, the Applicant's description of goods, and the legal standards by which the Board is to evaluate the application at issue, there can be no finding other than that the parties' goods are related and that this factor strongly favors S.S. White Burs.

c. Marketing Channels and Methods

Manufacturers of medical and surgical products commonly sell their products to customers (*e.g.*, individual clinicians and hospitals) through sales representatives. Stipulated Facts ¶ 14. Similarly, sales representatives of distributors commonly sell to traditional dental channels of trade, such as individual dental practices, and to hospitals where oral surgery is performed. Stipulated Facts ¶ 15. Given the methods by which Applicant's and S.S. White Burs' respective goods are sold, substantial overlap is inevitable.

Rotary cutting medical instruments are used to perform oral and maxillofacial surgery or to provide dental patient care provided through, *inter alia*, hospitals in the United States. Stipulated Facts at ¶¶ 79, 80, 82. S.S. White Burs markets and sells its burs and other medical products to dentists and oral and maxillofacial surgeons, at least some of whom provide patient care through hospitals. In fact, S.S. White Burs' S.S. WHITE branded products have been sold to, and used in, hospitals for years. *See* Hansen Supp. Cert. (8/10/00) ¶¶ 2-10; *see also* Ronkin Report at 1-2. Likewise, the rotary cutting medical instruments and other medical products marketed and sold by Applicant are used in performing surgery or providing patient care provided through, *inter alia*, hospitals in the United States. Stipulated Facts at ¶¶ 78, 81. Thus, the evidence demonstrates that the respective parties' products pass through similar, if not identical, channels of trade.

The overlap in trade channels, and inevitable confusion, is further evidenced by other aspects of medical instruments marketing. Multiple companies sell both medical and surgical instruments and dental instruments in the United States.⁸ Stipulated Facts at ¶¶ 10, 82, 83.

In fact, medical professionals are likely to encounter both Applicant's and S.S. White Burs' advertising and goods. Surgeons, even specialists, operate across surgical disciplines, and often work in surgical teams composed of surgical specialists outside their own specialties. *See* Trans. (8/17/00) at 94-97 (Ronkin testimony). Doctors encountering Applicant's S.S. WHITE branded surgical products are likely to associate such goods with S.S. White Burs' S.S. WHITE branded products. *See* Trans. (8/17/00) at 111-14 (Ronkin Testimony); *see also* Ronkin Report at 2.

⁸ Furthermore, there are companies that own federal trademark registrations for the same mark for both surgical instruments and dental instruments in the United States. Stipulated Facts ¶ 12 & Exh. 6 thereto.

Finally, both S.S. White Burs and Applicant promote their respective products via the Internet. *See* Stipulated Facts at ¶¶ 6-9. Use of such overlapping advertising contributes to the preponderance of evidence before the Board favoring a finding of likelihood of confusion.

The evidence before the Board – much of it stipulated – leads to no other conclusion but that the respective parties market and sell products in overlapping channels of trade to overlapping customer bases. Based upon this record, this factor strongly favors a finding of likelihood of confusion.

d. Consumer Perceptions of Relatedness of Goods

S.S. White Burs submits that the best evidence that consumers will perceive the respective parties' goods to be related is that both parties sell rotary cutting medical instruments and other related medical products. Indeed, as discussed *supra*, with respect to the rotary cutting medical instruments marketed and sold by both parties, S.S. White Burs and Applicant are selling legally identical goods.

Although S.S. White Burs believes that the Board could virtually take judicial notice that consumers will perceive the respective party's goods are related, S.S. White Burs has introduced substantial additional evidence of the likelihood of such perception. S.S. White Burs has introduced evidence of at least eighteen (18) companies that market and sell both dental products and other medical products, including, in many instances, orthopedic and other surgical products. (*See* Ferguson Decl. at ¶15 & Group Exh.14). For example, Sklar Instruments uses its website (<http://www.sklarcorp.com/ProductsUS.aspx>) to market in the United States both dental instruments, such as dental rongeurs, pliers, and forceps (<http://www.sklarcorp.com/CategoriesUS.aspx?DepartmentID=6>), and orthopedic instruments, such as bone saws, chisels, drills and mallets (<http://www.sklarcorp.com/CategoriesUS.aspx?DepartmentID=35>). (*See also* Ferguson Decl. at ¶15 & Group Exh.14.) Similarly, Gulmag Surgical Company uses its website

(<http://www.gulmag.com/aboutus.html>) to market in the United States dental instruments, such as dental picks and tweezers (http://www.gulmag.com/dental_pics_tweezers1.html), as well as orthopedic instruments, such as bone cutters, bone rasps and bone holding clamps (http://www.gulmag.com/bone_surgery10.html). *See also* Ferguson Decl. at ¶15 & Group Exh.14.

Further, S.S. White Burs has introduced evidence of more than one hundred (100) federal trademark registrations establishing registration of marks for both dental and orthopedic-related medical products. *See* Ferguson Decl. at ¶16 & Group Exh.15. Such third party registrations constitute evidence that consumers encountering the respective goods sold under the same or similar marks would attribute the goods to the same producer. *See In re Great Lakes Canning, Inc.*, 227 U.S.P.Q. 483, 484 (T.T.A.B. 1985) (“soft drinks” related to “fruit juice”). For example, the following marks have been registered to cover both distinctly dental and distinctly orthopedic goods, including the goods listed in Table 1:

TABLE 1:

Mark	Reg. #	Dental Goods	Orthopedic Goods
PRICK FILM	2,636,138	Dental apparatus and instruments, namely, dental inlays, dental onlays and dental picks, bite trays, dental bridges, dental burrs, dental examination chairs, dental crowns, dental impression trays, gum massaging instruments, dental mirror, artificial teeth	Bone implants, bone screws, surgical clips, surgical cutlery, knives for surgical purposes, surgical scissors, surgical skin staplers, stethoscopes, surgical saws, transfusion sets, suture, surgical threads
design only	2,583,067	Dental bridges, dental crowns, dental instruments for reconstruction and rehabilitation, namely, picks, burrs, drill bits, and mirrors; and artificial teeth	Orthopedic articles, namely orthopedic joint implants
LM and design	2,632,090	Dental instruments, namely,	Orthopedic implants and

Mark	Reg. #	Dental Goods	Orthopedic Goods
		picks, burrs and mirrors	knee braces;
ENDOSTEPPER	2,337,297	Medical apparatus, namely, drive gears and electric motors for tooth drills; dental cutting, grinding and polishing tools	Drilling and sawing tools and screwdrivers for use in the orthopedic and plastic surgery fields
LIQUIDMETAL and design	2,468,132	Dental instruments, namely, picks, burrs and mirrors	Medical devices, namely, hip joint orthopedic implants and knee braces
DIVYSIO	2,432,533	Dental instruments, namely, picks, burrs and mirrors;	Orthopedic splints and braces; surgical instruments, namely, scalpels, blades, and sutures
BIODIVYSIO	2,339,578	Dental instruments, namely, picks, burrs and mirrors	Surgical instruments, namely, scalpels, blades and sutures; skin and vascular grafts
SULZER MEDICA	2,303,255	Dental instruments for contouring and polishing of teeth and dentures; cutting and grinding discs for dental use	Orthopedic instruments, namely, fixators, fixation plates, bone screws, bone nail and bone pins, pedicle screws, expansion screws, rasps, reamers, drilling guides, impactors, marking guides and medullary plugs
IDELIO	2,236,475	Dental instruments	Orthopedic instruments
2 BOND 2	2,215,733	Cements for dental prosthetics, etching and sealing substances for the surface treatment of the teeth,	Bone cements for surgical and orthopedic purposes
DREVE	2,439,733	Silicone materials for taking dental impressions, medical and dental instruments and apparatus for clinical use, medical and dental laboratory devices and apparatus for use by dental technicians; dentures	Silicone materials used in the treatment of orthopedic foot disorders; artificial limbs and materials for artificial limbs, namely, steel rods, molded limb components, components used to connect artificial limbs to the human body
ATOM Stylized Letters	2,521,445	Dental filling instruments, planing and drilling instruments and gum cutting and tooth	Bone planes, bone saws, bone drills, orthopedic instruments in the nature of

Mark	Reg. #	Dental Goods	Orthopedic Goods
		excavating instruments	scalpels, forceps and bone saws, bone setting instruments
FRIAGON	2,166,809	Etching and sandblasting machines for dental laboratory use; dental vacuum casting units, dental vacuum stirrers and mixers, and dental vibrators for use in the manufacture of dental prostheses; dental apparatus and instruments, namely, dental pliers, dental scissors, dental tweezers, dental forceps, dental aspirators, dental polishing motors, dental drives and handpieces, dental cutting and abrading wheels and disks, dental burs made of metal, diamond dental burs	Surgical and orthopedic apparatus and instruments, namely, arthroscopy, endoscopy, and laparoscopy units, including motor drive units, monitors, hand instruments, and shavers for surgical intervention and diagnostic purposes, parts and fittings for the aforesaid goods, pliers, scissors, tweezers, forceps, aspirators
QUADMED, INC. Q QUALITY INNOVATION VALUE SERVICE and Design	2,009,884	Dental burs	Orthopedic support and elastic bandages, orthopedic and abdominal belts, orthopedic braces, knives for surgical purposes, orthopedic and surgical/medical splints
BIOLAND	1,822,154	Teeth filling and dental impression materials; Cements, restrictors, adhesives, greases, gums, lacquers, mastics, porcelains and ceramics for surgical and dental use	Chemical preparations and chemicals used during surgery in relation to orthopedic prosthesis and implants; dextran, casein, calcium phosphates, hydroxylapatite and alumina for coating orthopedic prosthesis and implants and for use in filling bones
SPEEDO and design	1,657,288	Dental floss; dentures; gum massaging instruments; dental burs	Orthopedic belts, saws for surgical purposes, surgical cutlery
CANON	1,375,686	Dental instruments, namely, dental, cutting and excavating instruments, filling instruments,	Bone drills, bone planes, bone saws, bone setting

Mark	Reg. #	Dental Goods	Orthopedic Goods
		drilling instruments	instruments;
HEALTHCO H and Design	1,196,155	Surgical instruments and appliances, namely, carbide burs for dental drilling, dental hand instruments;	Surgical forceps, surgical scissors; orthopedic appliances, namely, belts and braces

Some marks, including the goods listed in Table 2, are registered for both dental and orthopedic goods that are so inextricably linked or mingled that it is difficult to discern which of the claimed goods, if any, are distinctly dental or distinctly orthopedic.

TABLE 2:

Mark	Reg. #	Dental/Orthopedic Goods
MIM PLUS (stylized letters)	2,673,829	Surgical, medical, dental and veterinary instruments
SEDECAL EASY MOVING and Design	2,542,477	Surgical, medical, dental and veterinary apparatus and instruments, namely, scalpels, clips, cutlery, lamps, surgical gowns
FRIADENT and design	2,575,002	Apparatus, instruments and tools, namely impression posts, dowel pins, insertion instruments, finishers, waxing sleeves, drills, burs, ratchets, placement instruments, searing instruments, screwdrivers, depth gauges, surgical trays, implantology surgical units, tranfixation posts, apical points, root canal points, reamers, facing tools, laparoscopes, cannulas, trocars, probes, forceps, scissors, dissecting hooks, and arthroscopy hand pieces, cutters, resectors, and burs for surgical, orthopedic, medical and dental purposes and for use in dental laboratories.
05682776 design only	2,647,697	Surgical, medical, dental and veterinary apparatus and instruments and orthopedic articles
D LOGISTICS and design	2,675,836	Full line of medical, dental, surgical, and veterinary instruments
X15TN	2,389,078	Surgical, medical and dental apparatus and instruments
FRIOS	2,262,470	Apparatus, instruments and tools, namely, impression posts, dowel pins, insertion instruments, finishers, waxing sleeves, drills, burs, ratchets, placement instruments, seating instruments, screwdrivers, depth gauges, surgical trays, implantology surgical units, transfixation posts, apical points,

Mark	Reg. #	Dental/Orthopedic Goods
		root canal points, reamers, facing tools, laparoscopes, cannulas, trocars, probes, forceps, scissors, dissecting hooks and arthroscopy handpieces, cutters, resectors and burrs for surgical, orthopedic, medical and dental purposes for use in dental laboratories
AMARCO	2,077,052	Surgical, medical, dental and veterinary devices, namely, mechanical instruments for use in surgery and dentistry
ALTATED	2,358,940	Instrument sets for oral, maxillofacial and orthopedic surgery; electrical and mechanical machines to perform oral, maxillofacial and orthopedic surgery
BASS	2,103,722	Orthodontic and orthopedic appliances, apparatus and instruments, namely construction parts for use in making orthodontic and orthopedic appliances
BERCHTOLD	1,818,607	Full line of surgical, medical, dental and veterinary apparatus and instruments; namely, scalpels, forceps, scissors, pincers, pliers
PROCERA	1,789,085	Surgical, medical, dental and orthopedic implants, instruments and apparatus for reconstruction and rehabilitation of tissue-anchored non-biological prostheses, and artificial limbs, joints, eyes, and teeth used in such reconstruction and rehabilitation
KYOCERA	1,411,056	Ceramics for use in dental surgery and in orthopedic prosthetic surgery, namely, dental implants and artificial bones; hand tools for dental surgery and orthopedic prosthetic surgery
AUSTENAL Stylized letters	595,629	Surgical, dental and veterinary instruments, tools, and accessories, appliances and accessories used by surgeons, dentists, veterinarians and medical and dental technicians- namely, implants used in dentistry, appliances for orthopedic and general surgery, wires for dental and surgical uses

Furthermore, Dr. Robert B. Ronkin has provided expert testimony that purchasers of the kinds of goods sold by the respective parties could reasonably understand that they derive from the same source. *See* Ronkin Report at 2. Accordingly, the consumer perception factor strongly favors S.S. White Burs.

e. Consumer Care

The respective parties' products are sold to medical professionals who presumably are sophisticated consumers, and, therefore, arguably less susceptible to confusion. Nevertheless, the relative sophistication of purchasers does not foreclose a finding of a likelihood of confusion because the Board repeatedly has recognized that even consumers who deal in the most expensive and sophisticated marketplace can be confused. *See, e.g., Smith Kline Instruments, Inc.*, 172 U.S.P.Q. at 192 (“[W]hile purchasers of hospital supplies and equipment may be expected to exercise more discretion than the average member of the general public, we cannot assume that they are immune to error or mistake.”); *American Optical Co.*, 156 U.S.P.Q. at 345 (“While applicant’s goods may only be purchased or used by orthopedic surgeons, these persons may also use or otherwise be familiar with some of opposer’s products, and there is no reason to suppose that merely because they are careful in their selection of surgical instruments or apparatus, that they might not confuse trademarks used in the same general field.”).

Moreover, the record shows that persons other than doctors are involved in purchasing medical products used in providing professional medical care to patients. *See, e.g., Ronkin Report* at 2. It is very well established that where products are sold both to a sophisticated purchasing class and a less sophisticated purchasing class, likelihood of confusion must be determined with reference to the less sophisticated class. *See, e.g., Ford Motor Co.*, 930 F.2d at 293.

f. S.S. White Burs’ S.S. WHITE Mark Is Strong

In a prior proceeding between the parties, Applicant explicitly acknowledged that it “is very mindful of the valuable trademark rights owned by [S.S. White Burs] inherent in the term ‘S.S. WHITE.’” *See Opinion* (4/7/99) at 10. Further, following a full preliminary injunction hearing, the Hon. M.A. Trump Barry, then of the District of New Jersey and now of the Third

Circuit Court of Appeals, expressly found that S.S. White Burs was “a ‘name’”, and therefore widely recognized, in the dental products field. *See id.* at 12-13; *see generally id.* at 2-6. In the instant proceeding, Applicant concedes that S.S. White Burs’ mark “is a strong one” for its products, which include, *inter alia*, rotary cutting medical instruments and dental and surgical gloves. *See App. SJ Memo* at 33. Such strength is not surprising in light of the more than one hundred years of continuous use of the S.S. WHITE name and mark by S.S. White Burs and its predecessors-in-interest within the dental field. *See supra* at 3. Where, as here, a mark has acquired a strong secondary meaning, it is entitled to a broad scope of protection. Accordingly:

The . . . fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. . . . Thus, a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. . . . [T]he Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls. . . . The driving designs and origins of the Lanham Act demand the standard consistently applied by this court - namely, more protection against confusion for famous marks.

Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1992). So where, as here, an opposer establishes the ownership of a famous or well-known mark, his or her corresponding need to establish either the similarity of the opposed mark or the relatedness of the respective goods or services in order to establish likelihood of confusion is correspondingly reduced. *See id.*; T.M.E.P. § 1207.01(a) (3d ed. May 2003) (citation omitted).

g. Applicant’s Wrongful Intent

It is well established that evidence of a defendant’s wrongful intent is not required to establish likelihood of confusion. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891, 7 U.S.P.Q.2d 1629, 1630 (Fed. Cir. 1988). Evidence of wrongful intent, however, is “persuasive evidence of likelihood of confusion.” *Id.* Where, as here, an applicant adopts a

mark similar to the trademark owner's mark, such conduct constitutes persuasive evidence of applicant's wrongful intent. *See Broadway Catering Corp. v. Carla Inc.*, 215 U.S.P.Q. 462, 465 (T.T.A.B. 1982). Applicant also has a history of attempting to trade on the massive goodwill established by S.S. White Burs in the dentistry field. For instance, the current version of Applicant's web site states the following:

S.S. WHITE® Technologies was founded in 1844 by Dr. Samuel Stockton White, a practicing dentist who saw a need for innovation. The company, known as S.S. White Dental Manufacturing at the time, rapidly became a pioneer in the field of dentistry with the introduction of its high speed flexible shaft dental drills.⁹

Furthermore, this is not the first time that Applicant has attempted to trade on S.S. White Burs' goodwill as is demonstrated by the April 7, 1999 opinion in *S.S. White Burs, Inc. v. S.S. White Technologies Inc. and Oz Dental, Inc.*, Civil Action No. 99-1288 (D.N.J.), at 2 (Barry, J.) (a true copy of which is contained in Ferguson Decl. at Exhibit 6. Applicant's continued attempts to trade on S.S. White Burs' goodwill strongly demonstrates Applicant's wrongful intent.

h. Applicant's and S.S. White Burs' Co-Existence Respecting Other Goods

Throughout this matter, Applicant has relied on irrelevant and misleading evidence (and argument) regarding the co-existence between it and S.S. White Burs related to Applicant's manufacture and sale of flexible shaft assemblies. Flexible shaft assemblies, however, are not at

⁹ An old version of Applicant's web site – with a placeholder for Company History – is attached as Exhibit 2 to the Stipulated Facts. However, the Board may take judicial notice of Applicant's current Company History displayed to the public on the www.sswhitemedical.com web site. *See Hendrickson v. EBay, Inc.*, 165 F. Supp. 2d 1082, 1084 n.2 (C.D. Cal. 2001) ("To the extent some of the descriptions about eBay's website are not in the record, the Court takes judicial notice of www.eBay.com and the information contained therein pursuant to Federal Rule of Evidence 201."); *see also* Stipulated Fact ¶ 10 (noting that an entity's web site is a reliable source of information concerning the public understanding of the entity).

issue in this proceeding. To the contrary, only those goods specified in Applicant's description of goods in the opposed application are relevant. Whether or not there has been confusion resulting from Applicant's sales of flexible shaft assemblies is wholly irrelevant to the registrability of Applicant's application, *see Hurst Performance, Inc. v. Hendrickson Manufacturing Co.*, 199 U.S.P.Q. 48, 56 (T.T.A.B. 1978), and the evidence submitted by Applicant supporting this position is similarly irrelevant.

i. Class of Consumers Targeted

Given the broad identification of goods in Applicant's application, the Board may presume that the identified goods would be purchased by all potential customers. *In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981). Although Applicant has argued throughout this matter that it markets its products exclusively to medical equipment manufacturers and distributors, it also concedes that some manufactures and distributors deal in dental equipment in addition to other medical equipment. Applicant has sought to minimize this overlap by suggesting that some distributors carry different lines of products and utilize separate divisions for dental products as opposed to other medical products. *See* App. SJ Memo. at 29 & 37; Stipulated Facts at ¶¶ 22, 23, 24, 25, 83 & 84. These subtle differences cannot negate the presumption that the goods will be purchased by all potential customers.

The issue in this proceeding is likelihood of confusion as to source, not confusion as to classes of goods. Whether or not a potential consumer would mistake a dental bur for an orthopedic drill bit is not the ultimate issue. Instead, the issue is whether a consumer encountering both products is likely to be confused as to the source of the two products (even if that consumer happens to recognize some differences in the products themselves). Applicant's use of an identical mark for identical or at least closely related goods is likely to cause confusion

and certainly will not assure an absence of probable confusion even among the purported expert purchasing class discussed by Applicant. *See* T.M.E.P. § 1207.01(d)(vii) (3d ed. May 2003); *Big Blue Prods., Inc. v. Int'l Business Machines Corp.*, 19 U.S.P.Q.2d 1072, 1075 (T.T.A.B. 1991).

Source confusion can occur at any point in the chain of distribution. If an end user maxillofacial surgeon long familiar with S.S. White Burs' S.S. WHITE branded burs is exposed to Applicant's S.S. WHITE orthopedic drill bits, that surgeon will not necessarily know that the respective products reached the hospital via different product lines or divisions of a distributor. In fact, the surgeon might not even know if the goods arrived at the hospital through the same or different distributors. Ronkin Report. The surgeon is likely to be confused as to the source of the goods because of the identity of the marks and the similarity of the goods. *Id.*

Based upon the foregoing facts, it is clear that S.S. White Burs is entitled to judgment on its Section 2(d) claim herein.

B. Dilution Claim Under § 2(f)

Concerning its Section 2(f) dilution claim, S.S. White Burs has established by a preponderance of the evidence that its S.S. WHITE mark is distinctive and famous and that use and registration of the Applicant's mark would lessen the capacity of the S.S. WHITE marks to identify and distinguish S.S. White Burs' goods. *The NASDAQ Stock Market, Inc. v. Antartica, S.r.l.*, 69 U.S.P.Q.2d 1718, 1734 (T.T.A.B. 2003). A mark is distinctive for dilution purposes if "the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods and services." *The NASDAQ Stock Market, Inc.*, 69 U.S.P.Q.2d at 1735 (citing *The Toro Company v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164, 1174 (T.T.A.B. 2001)). Also, the mark must have become famous prior to the filing date of the

Applicant's application. *The Toro Company*, 61 U.S.P.Q.2d at 1174. The following factors are considered in determining whether a mark is distinctive and famous:

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(1); *The Toro Company*, 61 U.S.P.Q.2d at 1176.

Incorporating by reference S.S. White Burs' factual analysis in the likelihood of confusion section, there can be no doubt that S.S. White Burs has established the fame and distinctiveness of its S.S. WHITE mark. Applicant concedes that S.S. White Burs' mark "is a strong one" for its products, which include, *inter alia*, rotary cutting medical instruments and dental and surgical gloves. *See* App. SJ Memo at 33. Furthermore, S.S. White Burs has more than one hundred years of continuous use of the S.S. WHITE name and mark by S.S. White Burs and its predecessors-in-interest. *See supra* at 3. Importantly, the Hon. M.A. Trump Barry,

U.S.D.J., then of the United States District Court For the District of New Jersey and now of the United States Court of Appeals for the Third Circuit, expressly found that S.S. White Burs was “a ‘name’” in the dental products field. *See* Opinion (4/7/99) at 12-13; *see generally id.* at 2-6. Finally, because the parties marketing channels, web sites, and trading fields completely overlap, the fame of the S.S. WHITE mark, at least in the dental products field, is conclusive. *The Toro Company*, 61 U.S.P.Q.2d at 1182 (concluding that if the parties’ trading fields overlap and the goods are competing, fame among a niche market, rather than the general population, may be proven for a dilution claim). Consequently, S.S. White Burs has established the fame of its mark S.S. WHITE for medical instruments by a clear preponderance of the evidence.

S.S. White Burs has also demonstrated that Applicant’s use of the mark causes or would likely cause dilution so as to lessen the capacity of S.S. White Burs’ mark to identify its goods. *See The NASDAQ Stock Market, Inc.*, 69 U.S.P.Q.2d at 1737. Three factors are considered in making this determination: the similarity of the marks; the renown of the opposing party; and “whether target customers are likely to associate two different products with the mark even if they are not confused as to the different origins of these products.” *Id.* “[W]hen identical marks are used on similar goods, dilution – the capacity of the famous mark to identify and distinguish the goods of the trademark holder – obviously occurs.” *Am. Honda Motor Co. v. Pro-Line Protoform*, 325 F. Supp. 2d 1081, 1085 (C.D. Cal. 2004). This Board has found that members of the public would inevitably associate the applicant’s goods with the opposer or its goods when the marks are essentially identical and do not consist of an otherwise common word or phrase. *The NASDAQ Stock Market, Inc.*, 69 U.S.P.Q.2d at 1737.

The first factor, the similarity of marks, is easily established because the marks are identical. The second factor, the renown of the opposing party is similarly easy to establish as

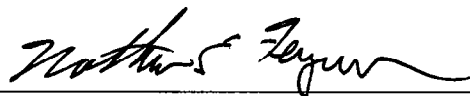
S.S. White Burs' has been a "name" in the dental products field for more than one hundred years. The third factor is also in S.S. White Burs' favor because when identical marks are used on similar goods, "dilution ... obviously occurs." *Am. Honda Motor Co.*, 325 F. Supp. 2d at 1085. Accordingly, Applicant's use of the S.S. WHITE mark on rotary cutting and other medical instruments dilutes and will likely continue to dilute S.S. White Burs' S.S. WHITE mark. *The NASDAQ Stock Market, Inc.*, 69 U.S.P.Q.2d at 1737 (concluding with "no difficulty" that dilution would occur, even in the absence of survey evidence, because the marks were "effectively identical"); *see also Pinehurst, Inc. v. Wick*, 256 F. Supp. 2d 424, 432 (M.D.N.C. 2003) (finding dilution "due to the identical or virtually identical character" of the marks); *see generally Am. Honda Motor Co.*, 325 F. Supp. 2d at 1085 (noting the same).

VI. CONCLUSION

For the aforesaid reasons, S.S. White Burs respectfully requests that judgment be entered against Applicant on S.S. White Burs' Section 2(d) claim and Section 2(f) claim, and that the subject application be denied.

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CERTIFICATE OF SERVICE

I, Heather E. Nolan, hereby certify that a copy of S.S. White Burs' Trial Brief was served on this 15th day of February, 2005, upon:

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