

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
May 18, 2006

Mailed: September 28, 2006
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

S.S. White Burs, Inc.
v.
S.S. White Technologies, Inc.

Opposition No. 91124302
to application Serial No. 76026164
filed on April 17, 2000

Charles R. Mandly, Jr. of Wildman, Harrold, Allen & Dixon
for S.S. White Burs, Inc.

Arthur L. Lessler of Lessler & Lessler for S.S. White
Technologies, Inc.

Before Hairston, Walters and Kuhlke, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

S.S. White Technologies, Inc. (applicant) has filed an application to register the mark S.S. WHITE in standard character form for "hand 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

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custom designed tools: bone and stem inspectors, femoral head extractors, bone taps, reamers, drill bits, spinal fixation tools, cutting blocks, and bone screws.”¹

S.S. White Burs, Inc. (opposer) filed a notice of opposition wherein it alleges that it and its predecessors have used the mark S.S. WHITE since the early 1890’s for dental and medical products, including burs and gloves used for dental and other medical procedures; that opposer is the owner of Registration No. 138,523 for the mark S.S. WHITE in standard character form for “dental burs,”² Registration No. 1,658,139 for the mark SS WHITE, as reproduced below,



for “dental diamond point burs, bur holders, bur cleaning brushes, and dental and surgical gloves,”³ and Registration No. 2,001,176 for the mark SS WHITE in standard character form for “dental burs, namely dental diamond points and carbide burs, bur holder blocks, bur cleaning brushes,

¹ Serial No. 76026164, filed April 17, 2000, which alleges July 1, 1999 as the date of first anywhere and the date of first use in commerce.

² Issued December 28, 1920; fourth renewal; Section 15 affidavit filed.

³ Issued September 24, 1991; renewed; Section 15 affidavit filed.

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dental gloves and rubber dams;"⁴ that opposer and its predecessors have expended considerable effort and expense in promoting the S.S. WHITE mark; that for over a hundred years, opposer's S.S. WHITE mark has been famous; and that applicant's mark, when used in connection with the identified goods, so resembles opposer's previously used and registered marks, as to be likely to cause confusion or mistake or to deceive. Further, opposer alleges that applicant's use of its mark is likely to cause dilution.

Applicant, in its answer, denied the salient allegations in the notice of opposition and asserted as an affirmative defense that the opposition is barred by res judicata and/or collateral estoppel.

History of the Parties and Background of the Proceeding

Before turning to the record and the merits of the case, we believe it is helpful to briefly discuss the relevant history of the parties and the background of this proceeding.

In 1965 Pennwalt Corporation purchased the S.S. White Dental Manufacturing Company, which had a Dental Division and an Industrial Division. The Dental Division manufactured dental burs and various other items of dental equipment. The Industrial Division manufactured, inter alia, flexible shafts and flexible shaft assemblies custom

⁴ Issued September 17, 1996; renewed; Section 15 affidavit filed.

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designed for use in medical equipment and air abrasion equipment, some of which was sold to dental laboratories for use in shaping crowns and the like. Pennwalt sold the product line of the Dental Division and the S.S. WHITE mark associated therewith to opposer in 1986. Pennwalt sold the entire Industrial Division business and the S.S. WHITE mark associated therewith to Applicant in 1988. In March 1999 applicant formed OzDental, Inc., a wholly owned subsidiary, for the purpose of marketing to dentists air abrasion equipment which applicant and the predecessor Industrial Division had sold to various industrial and commercial customers including dental laboratories for many years. In the spring of 1999 applicant formed S.S. White Medical Products Inc., a wholly owned subsidiary, which acquired most of the assets of Snap-On Medical Products Company, a business engaged in manufacturing and selling tools for use in orthopedic surgery, particularly hip and knee surgery.

In 1999 opposer filed a civil action against applicant and its subsidiaries S.S. White Medical Products Inc. and Oz Dental, Inc. in the U.S. District Court for the District of New Jersey alleging, inter alia, trademark infringement and unfair competition based upon applicant's use of the mark and trade name S.S. WHITE in connection with the sale of dental air abrasion equipment. The district court granted a preliminary injunction enjoining applicant from marketing

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dental air abrasion equipment under the mark or trade name S.S. WHITE, or otherwise representing that such dental air abrasion equipment products or the related business were affiliated with opposer. Thereafter, the parties reached a settlement which was embodied in a consent judgment entered January 5, 2000. The consent judgment permanently enjoined applicant from (1) using the S.S. WHITE mark or any variant thereof in the sale of or promotion of dental products or related services, or any other aspect of a dental product business, and (2) engaging in any activity likely to result in confusion as to the source of opposer's products vis-à-vis those of applicant. After entry of the consent judgment applicant used the S.S. WHITE mark on orthopedic tools, caulk guns and micro-ratchets. Opposer brought a civil contempt action against applicant for violation of the consent judgment. Applicant conceded its violation of the consent judgment with respect to its sale of caulk guns for use by dentists and micro-ratchets for use by oral surgeons, but denied that its use of the S.S. WHITE mark on orthopedic tools violated the consent judgment. The district court conducted a hearing and indicated in its Opinion and Order that the "principal issue to be determined by this court is whether there is a likelihood of confusion as to the source of the orthopedic tools sold by defendant vis-à-vis plaintiff's dental products." (Opinion and Order, p. 5).

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Further, the court stated that "[i]n order to establish that a respondent is in civil contempt, the moving party must prove the following elements by clear and convincing evidence: '(1) that a valid order of the court existed; (2) that the defendant had knowledge of the order; and (3) that the defendants disobeyed the order.'" (Opinion and Order, pp. 14-15). The district court declined to hold applicant in contempt for the sale of orthopedic tools, stating at pp. 25-26, "it is clear that there has been no clear and convincing proof of a likelihood of confusion between plaintiff's products and those of S.S. White Medical."

Opposer brought this opposition in 2001. In 2003 the parties filed cross-motions for summary judgment. Applicant moved for summary judgment on the ground that the opposition was barred by res judicata and/or collateral estoppel in view of the decision in the civil action. The Board found that the "transactional facts" in the civil action, which involved trademark infringement and unfair competition and the subsequent civil contempt claim, are not the same as those in an opposition proceeding which involves the right to register. Second, the Board found that the district court in the civil contempt action, in determining likelihood of confusion, applied a more stringent evidentiary standard (clear and convincing evidence) than applied in Board proceedings (preponderance of the

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evidence). The Board therefore denied applicant's summary judgment motion.

Opposer cross-moved for summary judgment on the ground that there were no genuine issues of material fact for trial. The Board denied opposer's summary judgment motion finding that at the very least there was a genuine issue of material fact with respect to the relatedness of the goods.

The Record

The parties have submitted a stipulation to use the materials which were submitted in connection with their summary judgment motions as testimony. The majority of these materials are from the civil action and civil contempt proceeding involving the parties. Neither party took additional testimony or submitted other evidence during the testimony periods. Thus, the record consists of the following: certified copies of opposer's pleaded registrations; the consent judgment entered in the civil action; the stipulation of facts in the civil contempt proceeding (hereinafter "Stip."); the district court's opinion in the civil contempt proceeding; dictionary definitions; the declaration, report, and testimony of opposer's expert witness Robert M. Ronkin, D.M.D, M.D.; the declaration, supplemental declaration, and testimony of opposer's president Robert Hansen; the declaration and testimony of opposer's director of business development Tom

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Gallop; the testimony of opposer's vice-president Brian Parlato; the declaration, supplemental declaration, and testimony of applicant's president and CEO Rahul Shukla; the declaration and testimony of the general manager of applicant's subsidiary S.S. White Medical Products Glenn Rupp; the declaration and report of applicant's expert witness John Englehardt, Chief Executive Officer of Knowledge Enterprises, Inc.; copies of third-party trademark registrations; Internet printouts from applicant's website and third-party websites; and the catalogs of two distributors of opposer's products.

Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

Preliminary matter

Before turning to the merits of the case, we must address one additional matter. In its brief on the case, applicant argues that the Board erred in denying applicant's summary judgment motion on the basis that the transactional facts in the district court for trademark infringement and unfair competition are different from those in this opposition. In addition, applicant now contends that the doctrine of issue preclusion should apply to certain "sub-issues" that were determined by the district court in the civil action. Applicant argues that "[t]here is no reason the principles applicable to preclusion as to 'issues'

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should not apply to sub-issues as well - so long as the burden of proof as to each sub-issue in the prior action on Opposer was no greater than its burden in the present proceeding." (Applicant's brief, p. 12).

Opposer, in its reply brief, argues that the Board's denial of applicant's summary judgment motion was proper.

Applicant's arguments essentially amount to a request for reconsideration of the Board's denial of its summary judgment motion. The time for filing such a request has passed (See Trademark Rule 2.127(b)), and therefore we will give no consideration to applicant's arguments. For the reasons stated in the summary judgment decision, we remain of the view that issue preclusion is not applicable in the circumstances of this case.

Opposer

Opposer's primary products are burs used in dentistry. (Stip. 45). Generally, a dental bur is used by attaching it to a rotatable portion of an instrument. (Stip. 51). Dental burs are discarded after use in only a few clinical procedures. (Stip. 30 and 31). Opposer's product line also includes dental rubber dams and latex gloves for use by medical and dental professionals. (Gallop dep. at 11-12, Stip. 48). Dental rubber dams and latex gloves are single-use products. (Stip. 49). Opposer's products are priced from \$3 to \$5.00. (Gallop dep. at 11-12). Opposer sells

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essentially all of its products to distributors (also referred to as dealers) who in turn sell them to end users. (Hansen dep. at 13, and 16-17; Stip. 35 and 97). These distributors are "broad-based dental dealers, dental/medical dealers, and some are specialized dealers" (Hansen dep. at 25) who sell opposer's products primarily to individual dental practices, large dental clinics, individual oral and maxillofacial surgical practices, dental schools and hospitals. (Gallop supplemental declaration at 3; Stip. 75 and 76). Opposer's products are used "by dentists and that's all of the specialties within the dental profession." (Hansen dep. at 25).

Opposer has marketed its products by direct mail to "endodontists, to oral surgeons, to general practice doctors, to dental dealers, to dealer dental representatives, to opposer's own sales force, to dental schools and dental school personnel." (Gallop dep. at 51). Opposer advertises in professional magazines directed to dentists and attends trade shows. (Gallop dep. at 52). Opposer uses the S.S. WHITE mark in its advertisements, on the packaging of its products, and on its sample packages. (Stip. 6).

Applicant

Applicant sells custom-designed orthopedic tools used primarily in knee and hip surgery. These products

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(excluding replacement parts for them) are priced in the range of \$45 to \$6000 with the average unit price being above \$150. (Rupp and Shukla declarations). All sales of applicant's products are made to medical equipment manufacturers and one distributor of orthopedic products. The end purchasers of applicant's products repackage the products for resale as their own goods. The S.S. WHITE mark does not appear on the packaging of any of applicant's resold products. (Rupp and Shukla declarations). Applicant currently uses the S.S. WHITE mark in communications with customers, at trade shows, and on its Internet website. (Rupp and Shukla declarations). Applicant markets its products solely to existing customers. Applicant has attempted to expand its business by obtaining additional business from those customers, since it is primarily a manufacturer of orthopedic tools designed to meet a customer's requirements. (Rupp and Shukla Declarations). Applicant attends industry trade shows for "image purposes," only. It does not attend such shows to attract new customers. (Rupp and Shukla declarations).

Opposer's Expert

Opposer submitted a report prepared by Robert B. Ronkin, D.M.D., M.D. entitled "Analysis of Product Use in Surgical Specialty Applications: Biological Hard Tissue Rotary Cutting Instruments." Mr. Ronkin is the Medical

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Director of Surgical Services at Central DuPage Hospital in Winfield, Illinois. In his report, Dr. Ronkin states, in relevant part, that:

...the instruments used in cutting, shaping, contouring or creating a hole in biological hard tissue such as bone, cartilage and tooth structure are referred to as burs and drill bits.

...[opposer's dental burs] may also be used by plastic surgeons, otolaryngologists and orthopaedic surgeons to perform operations on small bones of the hands, feet, and facial structures. These burs are manufactured with multiple shank options to accommodate different rotary power sources used in these surgical disciplines and in fact are used for multiple small bone applications.

As a practicing surgeon and medical director of surgery at a busy Midwestern hospital, I have a wide range of responsibilities for delivery of surgical services at our institution. I function as an advisor in the strategic development of our surgical business and supervise the operational aspects of our surgical services. This includes overseeing the acquisition of surgical supplies and equipment. Our hospital is a founding member of a large nationwide buying consortium and I often meet with surgical supply and equipment vendors to discuss their product lines.

It is not unusual in today's marketplace to encounter surgical companies with disparate product lines housed under the same corporate roof with a common branding. This would suggest that S.S. White Burs, Inc. and S.S. White Technologies, Inc. could easily be misconstrued to represent one branded company with different product lines serving the surgical community. This would also provide a common pathway for entrance into the marketplace for both companies.

Applicant's Expert

Applicant submitted a report prepared by John Englehardt entitled "Orthopaedic, Dental and Oral Surgery

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Industries: A Comparison of Market Dynamics". As noted, Mr. Englehardt is the Chief Executive Officer of Knowledge Enterprises, Inc., a consulting firm which provides market research in the orthopedic field and other services. Based on his research, Mr. Englehardt reached the following conclusions:

Orthopaedic and dental products are targeted at specifically separate practitioners who are trained differently, practice in distinctly different venues, keep separate professional affiliations and possess bodies of knowledge so highly specialized that much of the professional terminology by either group would be poorly understood by the other.

Because of these fundamental differences, separate marketing and sales channels are utilized for each of the specific markets.

Even the most experienced and accomplished orthopaedic sales rep would be nearly useless as a dental rep. He would possess none of the relationships or knowledge of the specialty required to even be remotely successful. To the author's knowledge, no company utilizes the same sales force to sell general dental or oral surgery products to the dental or oral maxillofacial physician and implants or instruments to the orthopaedic surgeon.

Orthopaedic products purchases are specified by the orthopaedic surgeon performing the procedures. In most cases, the purchases are actually made by the hospital.

The products of S.S. White Medical Products Inc. are instruments used by the orthopaedic surgeon in performing implantation or extraction of implants made by the orthopaedic implant manufacturer. The sale of these orthopaedic implants is restricted by law to be by or on the order of a physician, and is the result of personal contact between the surgeon and a representative of the manufacturer of the implant. Re-order occurs through a representative of the manufacturer of the implant. In the case of the dental markets, the vast majority of purchases of general dental products

are not subject to this restriction and can therefore be made by anyone through a catalog or internet shopping site.

In summary, the statement that the dental and orthopaedic markets are not distinctly different because there is a minute chance that practitioners of each might see a similar product is very much like saying that a taxidermist and veterinarian are the same because they both give your animal back.

Third-party registrations and other evidence

In connection with its argument that the respective goods are related, opposer submitted eighteen third-party registrations for marks which cover dental products, on the one hand, and orthopedic products, on the other hand. In addition, opposer submitted over seventy registrations for marks which cover surgical, medical and dental products generally. Opposer also submitted printouts from the Internet websites of eighteen companies that sell both medical products and dental products, and two of the companies sell both orthopedic products and dental products, in particular.

In support of its position that the respective goods are not related, applicant submitted what it characterizes as "19 'pairs' of registrations (i.e. 38 registrations) of identical word trademarks to different owners, wherein one trademark was registered for dental products and the other trademark was registered for orthopedic products" and "101 additional 'pairs' of registrations of identical word trademarks to different owners, wherein one trademark was

registered for dental products and the other trademark was registered for medical products." (Brief at 50).

Arguments of the parties

Opposer argues that at least one of its medical instruments, i.e., burs, is legally identical to one of applicant's medical instruments, i.e., drill bits. Opposer argues that drill bits and burs are legally identical products as both are rotary cutting instruments attached to a drill and used to cut organ tissue. Opposer argues that its types of burs may be used by orthopedic surgeon and applicant's types of drill bits may be used by oral surgeons in maxillofacial surgery. Further, opposer argues that its remaining medical instruments are otherwise related to applicant's goods in that such instruments are used in maxillofacial surgery which is a specialized field of orthopedic surgery. Lastly, opposer argues that its surgical gloves are for use by surgeons in all medical specialties, including orthopedic surgery, and therefore such gloves are related to applicant's tools and instruments used in orthopedics. In sum, it is opposer's position that the goods are identical in part and otherwise related. Opposer also argues that the parties' employ the same sales methods, that is, their respective goods are sold through distributors or dealers. Also, with respect to the relatedness of the goods, opposer argues that it is common

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for dental products and orthopedic instruments to emanate from a single company under a single mark. Opposer maintains that its S.S. WHITE mark is a famous, well-known mark in the dental products field.

Applicant argues that its products are strictly orthopedic products and that opposer's products are strictly dental products, that the markets for orthopedic products and dental products are distinct and do not overlap, and that the respective products are targeted to different medical practitioners. Further, applicant maintains that purchasers of the parties' respective goods are sophisticated purchasers. Applicant maintains that it has used its mark since 1999 and there have been no instances of confusion. Lastly, applicant argues it is common for different companies to use the same or similar marks on dental products, on the one hand, and other types of medical products on the other hand.⁵

Priority

Priority is not in issue in this proceeding because opposer has properly made of record certified status and title copies of its three pleaded registrations. King Candy

⁵ Applicant has also made a number of arguments with respect to the dissimilarity between its flexible shaft assemblies and opposer's goods. However, applicant's flexible shaft assemblies are not the subject of applicant's application and therefore we have not considered these arguments.

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Co. v. Eunice Kings's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).⁶ See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Marks

It is readily apparent that applicant's applied-for mark S.S. WHITE is identical to opposer's mark S.S. WHITE,

⁶ We note that applicant, in its brief, argues that the likelihood of confusion analysis herein is governed by *Scott Paper Company v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 200 USPQ 421 (3d Cir. 1978) and *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 31 USPQ2d 1592 (3d Cir. 1994). While certain of the likelihood of confusion factors set forth in these cases are the same likelihood of confusion factors set forth in *du Pont*, these cases involved trademark infringement and unfair competition claims. In short, these cases do not govern the Board's likelihood of confusion analysis.

and applicant's applied-for mark is extremely similar to opposer's marks SS WHITE and SS WHITE in stylized letters.
Goods/Trade Channels/Purchasers

We turn next to the similarity/dissimilarity of the parties' goods, and the trade channels and the classes of purchasers to whom they are marketed. At the outset, we note that it is not necessary that the respective goods be identical or even competitive in order to support a likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Further, where as here, the marks are identical/ extremely similar, "it is only necessary that there be a viable relationship between the goods or services in order to support a finding of likelihood of confusion." *In re*

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Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983). See also 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Section 23:20.50 ["[T]he greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likely confusion"].

With respect to the goods, as often stated, Board proceedings are concerned with registrability and not use of marks and, thus, the identification of goods in the registrations and application herein frames the issue. Opposer's goods, as identified in its three registrations, are: "dental burs" (Registration No. 138,523); "dental diamond point burs, bur holders, bur cleaning brushes, and dental and surgical gloves" (Registration No. 1,658,139); and "dental burs, namely dental diamond points and carbide burs, bur holder blocks, bur cleaning brushes, dental gloves and rubber dams" (Registration No. 2,001,176). Applicant's goods, as identified in its application are: "hand 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 inspectors, femoral head extractors, bone taps,

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reamers, drill bits, spinal fixation tools, cutting blocks, and bone screws."

With the exception of the "surgical gloves," the other goods in opposer's registrations are identified as dental products. Nonetheless, the expert testimony of opposer's witness establishes that dental burs, in particular, are used by oral surgeons. Further, the record shows that applicant's orthopedic tools and instruments are used by orthopedic surgeons. Both opposer's dental burs and applicant's orthopedic tools and instruments are the types of goods that may be used in a hospital operating room. We recognize that the decision as to what dental bur to purchase would likely be made by the oral surgeon and the decision as to what orthopedic tool or instrument to purchase would likely be made by the orthopedic surgeon. However, in the hospital environment, once the decision to use a particular dental bur, or orthopedic instrument or tool is made, the hospital must maintain an inventory of such dental burs, and orthopedic instruments and tools. Additional purchases of opposer's dental burs and applicant's orthopedic tools and instruments are likely to be made by the hospital purchasing office or other personnel in charge of maintaining the inventory. Thus, opposer's dental burs and applicant's orthopedic tools and instruments may both be used by the operating room of the hospital and

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may be purchased by the hospital's purchasing office. Under the circumstances, we find that opposer's dental burs and applicant's orthopedic tools and instruments are sufficiently related that when sold under identical and extremely similar marks, confusion is likely.

In finding that opposer's dental burs and applicant's orthopedic tools and instruments are related, we have given little weight to the third-party registrations submitted by opposer. None of these registrations covers both of the specific types of dental products and orthopedic tools and instruments involved in this case. With respect to the third-party registrations submitted by applicant, the fact that the USPTO has issued some registrations for identical marks to different entities for dental products, on the one hand, and orthopedic products, on the other hand, does not establish that the specific dental products and orthopedic tools and instruments involved in this case are not related.

Insofar as the opposer's surgical gloves are concerned, applicant argues that opposer actually sells these gloves only to dentists. However, as noted, the surgical gloves are not restricted in this manner in opposer's registration. In the absence of any restrictions, we must assume that opposer's surgical gloves travel in all the normal channels of trade for goods of this type to all the usual purchasers. Thus, opposer's surgical gloves might also be used in the

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orthopedic field by orthopedic surgeons. Opposer's surgical gloves, therefore, would be encountered by the same class of purchasers/users of applicant's goods. Under the circumstances, we find that there is a sufficient relationship between opposer's surgical gloves, on the one hand, and applicant's orthopedic tools and instruments, on the other hand, that when sold under extremely similar marks, purchasers are likely to be confused.

The facts of this case are distinguishable from those in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983). In that case, the respective goods of the parties were used by different departments in the hospital, and the decision to purchase the respective products was made or influenced by those different departments.

While we have carefully reviewed the declarations, reports and testimony of both expert witnesses herein, it is well settled that the Board must reach its own conclusions on the ultimate issues before it, including whether the respective the goods are related.

In sum, we find that opposer's dental burs, in particular, and applicant's orthopedic instruments and tools are related insofar as they would be used in the same hospital environment and may be bought by the same hospital purchasing personnel. In addition, we find that opposer's

surgical gloves and applicant's orthopedic instruments and tools are related insofar as they are encountered and used by the same end users/purchasers, i.e., orthopedic surgeons.

Sophistication of Purchasers

Insofar as hospital purchasing personnel are concerned, there is no evidence that such personnel are particularly sophisticated. It is reasonable to expect that orthopedic surgeons are sophisticated and knowledgeable about the sources of tools and instruments they use and recommend for purchase. However, we are not persuaded that this sophistication would ensure against confusion here given the extreme similarity of the involved marks. In any event, it is settled that even sophisticated purchasers are not immune to source confusion which would otherwise result from the use of confusingly similar marks. See e.g., *American Optical Co. v. Synthes AG*, 156 USPQ 344 (TTAB 1967).

Fame

Citing *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), opposer contends in its brief that its S.S. WHITE mark is a famous, well-known mark in the dental products field which is therefore entitled to a broad scope of protection. Applicant, in its brief at 35, acknowledges that "[o]pposer's S.S. WHITE mark is a strong one in the market for the three products Opposer sells, namely dental burs,

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dental gloves, and dental dams." Moreover, there is no dispute in this case that opposer has used the S.S. WHITE mark in the dental products field for over 100 years.

The fame of a plaintiff's mark, when fame is shown in the record, is an important factor because a famous mark deserves a broad scope of protection. However, in this case, the fame of opposer's mark has not been established. Because fame plays a dominant role in the likelihood of confusion analysis and famous marks are entitled to a wide scope of protection, a plaintiff is obligated to clearly prove the fame of its mark. *Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005). Also, our primary reviewing court has stated that "the fame factor is based on underlying factfinding . . . [and] relevant evidence must be submitted in support of a request for treatment under the fame factor." *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ 1351, 1356 (Fed. Cir. 2000). In this case, opposer has offered no evidence with respect to its sales or marketing expenditures. Nor is there evidence as to opposer's market share in the dental products field. Thus, while there is no dispute that opposer's S.S. WHITE mark is a strong mark in the dental products field, there is insufficient evidence upon which to conclude that the mark is famous.

Actual Confusion

Applicant contends that the lack of evidence of actual confusion indicates that there is no likelihood of confusion. However, we do not believe that the lack of evidence of actual confusion is a significant factor in this case because it is clear that the parties have focused their efforts in different marketing and distribution channels and to different end users. Moreover, applicant's sales of its orthopedic tools and instruments have been to existing customers with no efforts to expand beyond such customers. In short, we cannot conclude from this record that there has been a meaningful opportunity for confusion to occur. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992); and *Chemtron Corp., v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979).

Conclusion

In view of the foregoing, we find that contemporaneous use of the parties' marks on their respective goods is likely to cause confusion.

Dilution

In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution. Also, we note that a plaintiff must meet more stringent requirements to establish that its mark is famous for

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dilution purposes. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Motion to Amend

Finally, we note that applicant filed a motion to amend the dates of use in its application. In view of our decision herein, applicant's motion to amend is considered moot.

Decision: The opposition is sustained on the ground of likelihood of confusion.