

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : ConMed Corporation
Serial No. : 88/315,554
Mark : RELAY
Class : 010
Filed : February 25, 2019

Examining Attorney:
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RESPONSE TO OFFICE ACTION

Applicant ConMed Corporation (“Applicant”) hereby responds to the United States Patent and Trademark Office’s Office Action dated November 13, 2019. In the Office Action, the Trademark Office refused registration of the application for the RELAY mark (the “applied-for mark”) under Section 2(d). In view of the arguments and information supplied herein, Applicant respectfully requests that the refusal be withdrawn.

Section 2(d) Refusal – Likelihood of Confusion

The Trademark Office asserts that there is a likelihood of confusion between the applied-for mark (RELAY) and U.S. Trademark Reg. No. 3,056,357 for RELAY. Applicant respectfully submits that there is no likelihood for confusion between the registered mark and Applicant’s applied-for mark.

In evaluating likelihood of confusion between two marks, one must compare the entirety of the marks. *Estate of P.D. Beckwith, Inc., v. Commissioner*, 252 U.S. 538 (1920). A likelihood of confusion determination is based on the factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973):

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;
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;
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 minimus or substantial; and
13. Any other established fact probative of the effect of use.

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (CCPA 1973); TMEP § 1207.01.

In the present case, when properly evaluated in their entirety, Applicant's applied-for mark and the registered RELAY mark apply to dissimilar goods, appear in different trade channels, and are marketed to sophisticated consumers.

A. There Is No Similarity Of The Nature Of The Goods

Applicant has amended its list of goods as follows:

- IC 010 – Medical devices for use in arthroscopic hip surgical and orthopedic procedures, namely, suture passers and excluding stents, vascular prostheses and thoracic stent grafts.

Registrant's RELAY mark is registered in connection with the following goods:

- IC 010 – Medical devices, namely, stents, vascular prostheses and thoracic stent grafts.

The amended goods offered under the Applicant's mark are dissimilar to the goods offered under the registered mark, and thus the marks are not likely to be confused. As amended, Applicant's listing of goods includes suture passers for use in arthroscopic hip procedures, specifically excluding Registrant's goods, stents, vascular prostheses and thoracic stent grafts.

Applicant's goods include a specialized suture passer for hip arthroscopy, while Registrant's goods include instruments only for cardiac surgery. As stated above, Applicant has specifically excluded stents, vascular prostheses and thoracic stent grafts to further distinguish Applicant's goods from Registrant's goods. Arthroscopic hip surgery and cardiac surgery are two very separate and specialized surgical fields. Surgeons specializing in hip surgery do not conduct cardiac surgeries and vice versa. Furthermore, the instruments used in cardiac surgery are specific to the anatomy of the heart and surrounding vessels and instruments used in arthroscopic surgeries of the hip are specific to the anatomy of the hip.

B. The Goods Travel in Dissimilar Trade Channels

The goods associated with Applicant's applied-for RELAY mark and the goods associated with the registered mark are found in dissimilar trade channels. Applicant is using the applied-for mark for arthroscopic procedures of the hip, where Registrant is using the registered mark for cardiac surgeries. Due to the nature of the goods and the specificity of the surgical procedures, Applicant's and Registrant's goods are sold through different trade channels.

The trade channels for Applicant's goods and Registrant's goods are different because both Applicant and Registrant rely on sale representatives to make sales to consumers. In the surgical device industry, sales representatives visit consumers to showcase each device and demonstrate how to use it. Applicant has its own sales representatives that showcase its instruments for arthroscopic hip procedures and make sales, while Registrant has its own sales representatives that do the same for instruments for cardiac surgery. It is typical for orthopedic doctors and surgeons (potential consumers) to focus their practice on one of the knee, hip, shoulder, or extremities, and never practice in another specialized field, such as cardiac surgery. Here, orthopedic hip surgery and cardiac surgery are separate focused practices and thus have separate trade channels with separate sales persons. Therefore, two separate trade channels exist for two distinct types of goods through Applicant's sales representatives and Registrant's sales representatives. Further, due to the personal nature in which sales are conducted through these trade channels, consumers are not likely to be confused as to the source of Applicant's goods and the source of Registrant's goods.

C. The Consumer is Highly Sophisticated

Applicant asserts that the relevant class of consumers do not lend themselves to the possibility of confusion. The Court of Customs and Patent Appeals stated that, “other things being equal, confusion is less likely where goods are expensive and are purchased after careful consideration than where they are purchased casually.” *Magnaflux Corp. v. Sonoflux Corp.*, 109 U.S.P.Q. 313, 315 (C.C.P.A. 1956). The customers for the goods offered by the Applicant and the Registrant are sophisticated. A relevant consumer or buyer of Registrant’s goods and Applicant’s goods may be a skilled surgeon or a purchasing hospital administrator, for example. Surgeons and hospital administrators are more sophisticated than an average consumer because determining the type of instrument to purchase for use in a live human body is a great responsibility that has effects on patient safety and healthcare provider (e.g., hospital) liability. As a result, the purchasing decisions, such as the source of goods, types of goods, quality of goods, and quantity of goods, are likely thoughtful and well researched.

Further, as stated in the previous section, Applicant’s device and Registrant’s devices are showcased and sold to consumers through distinct trade channels created by sales representatives. Unlike consumers of other goods and services who make quick purchases at a cash register, Applicant’s and Registrant’s consumers make careful and deliberate choices for instruments to use on their patients and discuss those choices with the sales representatives.

The diligence of the relevant class of consumer in combination with the nature of the goods and the sales process ensure that there is no likelihood of confusion between the Applicant’s and Registrant’s marks. *See Weiss Associates Inc. v. HRL Associates Inc.*, 14 U.S.P.Q.2d 1840, 1841 (Fed. Cir. 1990) (“In making purchasing decisions regarding ‘expensive’ goods, the reasonably prudent person standard is elevated to the standard of the ‘discriminating purchaser.’”); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489 (1st Cir. 1981) (holding that sophisticated consumers may be expected to exercise greater care.). Given the nature of the devices and the trade channels, consumers are ultra-conservative in the selection in the respective industries.

Conclusion

For the reasons set forth above, Applicant respectfully requests the Examiner withdraw the refusal under Section 2(d) of the Trademark Act. Accordingly, Applicant respectfully submits that

there is no likelihood of confusion between Applicant's mark and the Registered mark for the issues set forth in the Office Action.

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance. If the Examining Attorney believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned.

Dated: May 13, 2020

Respectfully submitted,

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