

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Trademark Application of: Life Spine, Inc.
Serial No.: 85/318,013
Filed: May 11, 2011
Mark: Nautilus
Law Office: 105
Examining Attorney: Evelyn Bradley
Atty Docket #: LSP087

RESPONSE TO OFFICE ACTION OF AUGUST 18, 2011

I. OVERVIEW

This is a Response to the Office Action of August 18, 2011 (the Office Action) having a six (6) month period of response ending February 18, 2012.

In the Office Action:

1. The mark was refused registration under Section 2(d) because of a likelihood of confusion with the mark of U.S. Registration No. 4009750; and
2. The description of goods was indicated as being indefinite.

II. REFUSAL OF REGISTRATION UNDER SECTION 2(d)

The Trademark Examining Attorney refused registration under Section 2(d) alleging a likelihood of confusion of the applied-for-mark (Applicant's mark) with Registration No. 4009750 for the mark "Nautilus." As presented below, applicant submits that there is no likelihood of confusion between Applicant's mark and Registration No. 4009750.

In the August 18, 2011 Office Action the Trademark Examining Attorney

alleged that the *du Pont* factors most relevant to the likelihood of confusion determination of Applicant's mark are: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. Applicant would also add that the conditions under which and buyers to whom sales are made (i.e. impulse versus careful sophisticated purchasing) is also most relevant to the likelihood of confusion determination of Applicant's mark with Registration No. 4009750. Applicant submits that these factors (and other factors detailed below) indicate there is no likelihood of confusion.

A. Comparison of the Marks

In the August 18, 2011 Office Action the Trademark Examining Attorney noted that the mark of U.S. Registration No. 4009750 (i.e. Nautilus) and Applicant's mark (i.e. Nautilus) are identical. In view of this alone, the Trademark Examining Attorney came to the conclusion that the marks are confusingly similar.

However, the mere fact that the marks are identical does not in and of itself result in the determination that the marks are confusingly similar. Identical marks can and do co-exist without being confusingly similar. A search of the U.S. Trademark Office's database reveals that there are forty-seven (47) registered and live NAUTILUS word marks (with no design element) for various goods and/or services. They are: 0641273; 0859667; 0991897; 1061003; 1067621; 1084853; 1086063; 1172257; 1173140; 1218622; 1233303; 1371189; 1391673; 1418401; 1453931; 1696840; 1760759; 1905785; 1937409; 2009770; 2074928; 2580931; 2709560; 2732794; 2777323; 2806513; 2845117; 2856651; 2970870; 3047389; 3122558; 3145803; 3146115; 3200718; 3223920; 3228745; 3236551; 3356564; 3390136; 3382256; 3513477; 3544822; 3667391; 3711774; 3750070; 3809988; and 3924057. Therefore, if the mere fact that the marks are identical creates a confusingly similar mark, then no marks would issue past the first registration. Clearly, from the above, this is not true.

In view of the above, applicant submits that a mere comparison of the marks is not sufficient to establish that Applicant's mark and the mark of U.S. Registration No. 4009750 are confusingly similar.

B. Comparison of the Goods

In a comparison of applicant's goods and the goods of U.S. Registration No. 4009750 (registrant's goods), the Trademark Examining Attorney indicated that it was "sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or service would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with the same source." The Trademark Examining Attorney then goes on to allege that Applicant's goods, namely, "spinal implants and associated components used in surgical implant procedures involving the spine and application tools and surgical instruments for such uses" and registrant's goods, namely a "surgical device ... a tip for use in phacoemulsification procedures; surgical device used in ophthalmic surgery" are used for related purposes, and so accordingly, "the goods would be available to the same class of purchasers and would be encountered under circumstances leading one to mistakenly believe that they originate from the same source."

Applicant disagrees that the applicant's goods and the registrant's goods are used for related purposes. Applicant's goods are for the spine while registrant's goods are for the eyes (phacoemulsification is a cataract surgical procedure). While both the spine and the eye are parts of the body, it is unclear how goods for the spine are related to goods for the eye and vice versa. Spinal implants and surgical instruments for spinal implant procedures cannot be used for the eye. Likewise, a surgical tip for use in phacoemulsification procedures and a surgical device for ophthalmic surgery cannot be used in spinal implant procedures. Orthopedic surgeons would use applicant's goods while ophthalmologists would use registrant's

goods. While both orthopedic surgeons and ophthalmologists are doctors, these consumers would not encounter the same goods since their fields are vastly different. They would therefore not be confused as to their source.

Moreover, applicant submits that while the same or similar goods may come from a single source it does not de facto indicate that the consumer is aware of the fact.

In view of the above applicant submits that the goods are not related and thus would not be confused as coming from the same source and thus are not confusingly similar.

C. Comparison of Channels of Trade

Applicant would like to note that the channels of trade for applicant's goods and registrant's goods are such that those purchasing applicant's goods and those purchasing registrant's goods would not be confused as to the origin of the goods. Spinal implants and instrumentation for spinal implant procedures are marketed exclusively and directly to orthopedic surgeons and neurosurgeons. They are not marketed to the hospitals and/or clinics in which those doctors practice. Orthopedic surgeons and neurosurgeons do not practice in ophthalmology. Therefore they will not be aware of registrant's goods.

Registrant's goods are marketed to ophthalmologists, phacoemulsification instrument makers and/or ophthalmologist/phacoemulsification clinics. Ophthalmologists do not practice in orthopedics or neurosurgery. Therefore, they will not be aware of applicant's goods.

Thus the channels of trade for applicant's goods and those of registrant's goods are such that the consumers of those goods will not be confused as to their source.

D. Impulse Versus Careful Sophisticated Purchasing.

As pointed out above, the buyers of applicant's goods and registrant's goods are typically doctors and/or other medical professionals. Doctors and other medical professionals have a high level of sophistication when it comes to distinguishing between goods. Therefore, given the level of sophistication of the typical buyer of the goods, and given the difference in the channels of trade of the goods, there would be no confusion in the marketplace.

E. There is No Evidence of Actual Confusion

Applicant's goods are now in the marketplace. To date, fourteen (14) cases have used the NAUTILUS system. Applicant knows of no consumer confusion between its goods and registrant's goods. Therefore, there is no evidence of actual confusion.

F. Additional Considerations

Applicant also notes the following.

Medtronic, Inc. filed a trademark application for the mark NAUTILUS for a "nucleus replacement implant for use in spinal surgery" in International Class 010 on April 21, 2003 (the Medtronic NAUTILUS application). The Medtronic NAUTILUS application was allowed October 23, 2007 (Medtronic eventually abandoned the application November 22, 2010 and does not make a NAUTILUS product). Registrant's NAUTILUS trademark application was filed September 23, 2007 - after the filing date of the Medtronic NAUTILUS application. The Trademark Office allowed registrant's application while the Medtronic NAUTILUS application was pending. The *du Pont* factors were also the standard for likelihood of confusion at that time.

The Trademark Office thus concluded that there was no likelihood of confusion between the Medtronic NAUTILUS application and registrant's application. Since applicant's goods and the goods for Medtronic's NAUTILUS application are spinal implants, there cannot now be confusion between registrant's mark and applicant's mark.

G. Conclusion

Given the above, applicant submits that while applicant's and registrant's marks are identical, there is no likelihood of confusion between applicant's NAUTILUS mark and registrant's NAUTILUS mark under Section 2(d).

III. DESCRIPTION OF GOODS

Applicant is amending the description of goods to be similar with the Examining Attorney's suggestion in the Office Action. Particularly, applicant is amending the description of goods to:

“Spinal implants composed of artificial material, namely, spinal rods, spinal screws, spinal hooks, spinal plates, vertebral interbody spacers, vertebral intrabody spacers, spinal cross-connectors and spinal screw assemblies; surgical instruments for use in spinal surgery, in International Class 10.”

IV. CONCLUSION

Applicant submits, in view of the above, that there is no likelihood of confusion between the present mark and Registration No. 4009750. Applicant thus respectfully submits that the mark is registrable, and registration is therefore requested.

In the event that there are any questions related to this response or to the application in general, the undersigned would appreciate the opportunity to address

those questions directly in a telephone interview to expedite the prosecution of the application for all concerned. Therefore, if the Trademark Examining Attorney has any questions relating to the instant application, she is respectfully request to contact applicant's undersigned attorney.

Respectfully Submitted,
Life Spine, Inc., Applicant
By:

September 22, 2011
Date

/bjb/
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