IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Smith & Nephew, Inc.	)	
		)	Nicole Nguyen
MARK:	CONQUEST FN	)	Trademark
		)	Examining Attorney
SERIAL NO.:	86/448,071	)	Law Office 107

AMENDMENT AND RESPONSE TO OFFICE ACTION

Applicant has received the Office Action dated February 27, 2015 from examining attorney Nicole Nguyen, Law Office 107, and has carefully noted its contents. Applicant notes that the examining attorney has requested an amendment to clarify the identification of goods, has requested an explanation of the mark's significance, and has made a preliminary likelihood of confusion refusal. Applicant's response to the issues raised by the examining attorney is set forth below.

I. AMENDMENT

Applicant amends its description of goods as follows:

> Orthopaedic medical devices consisting of plates, screws and pins for use in treating traumatic femoral neck fractures, all of which are designed to avoid or prolong the need for hip replacement surgery.

II. EXPLANATION OF THE SIGNIFICANCE OF THE MARK

The examining attorney has asked whether the letters "FN" have any significance in the orthopaedic trade or industry or as applied to the goods described in the application, or if such

letters represent a "term of art" within Applicant's industry. Applicant responds that the letters "FN" are an acronym for "Femoral Neck".

III. RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL

Applicant respectfully requests that the examining attorney withdraw the likelihood of confusion refusal as to the CONQUEST mark shown in U.S. Registration No. 3,319,682 (the "Cited Registration") based on a prior registration for the CONQUEST FX mark owned by Applicant (U.S. Registration No. 2,478,392) for related goods.

Refusal of Applicant's CONQUEST FN is not warranted in light of Applicant's ownership of the CONQUEST FX mark registration ("Applicant's Registration"). Further information on Applicant's CONQUEST FN application and CONQUEST FX registration and the Cited Registration is set forth below:

Applicant's Application	**Applicant's Registration**	**Cited Registration**
CONQUEST FN Application No. 86/448,071 Amended goods: Class 10: orthopaedic medical devices consisting of plates, screws and pins for use in treating traumatic femoral neck fractures, all of which are designed to avoid or prolong the need for hip replacement surgery	**CONQUEST FX** Registration No. 2,478,392 Registration Date: August 14, 2001 Class 10: hip replacement system, namely, instruments for use in removing hip implants and sterilization cases for the instruments	**CONQUEST** Registration No. 3,319,682 Registration Date: October 23, 2007 Class 10: medical plates, medical rods, medical hooks, medical bolts, bone screws and associated components used in surgical implant procedures involving the spine and application tools and surgical instruments for such uses

As is demonstrated above, it is indisputable that Applicant's CONQUEST FN mark is far more similar in appearance and commercial impression to Applicant's prior registration for CONQUEST FX than to the Cited Registration. In addition, both Applicant's Registration and Applicant's Application as amended cover medical goods related to medical procedures performed relating directly or indirectly to the hip while the Cited Registration covers medical goods related to medical procedures performed relating to the spine.

Because Applicant's CONQUEST FN mark is far closer to Applicant's U.S. Registration No. 2,478,392 for CONQUEST FX in sound, sight and commercial impression (as well as in the goods covered), it cannot be deemed to be confusingly similar to a less similar registration, namely, the Cited Registration. If that were the case, the Cited Registration for the CONQUEST mark should have never issued as Registration No. 2,478,392 for CONQUEST FX was registered before the issuance of the Cited Registration.

Indeed, the existence of Applicant's Registration for CONQUEST FX effectively precludes a challenge by the owner of the Cited Registration to Applicant's mark under the well-established principle of Morehouse Mfg. v. J. Strickland & Co., 407 F.2d 881 (C.C.P.A. 1969) (an opposer cannot be damaged within the meaning of Lanham Act § 13 by registration of the mark for particular goods or services if the applicant owns an existing registration for the same or substantially identical goods); Place for Vision, Inc. v. Pearle Vision Center, Inc., 218 U.S.P.Q. 1022 (T.T.A.B. 1983) (opposer found to have suffered no damage by the issuance of a registration for PEARLE VISION CENTER where applicant already had two registrations for VISION CENTER for similar goods and services because opposer's challenge rested only upon

alleged prior use of the VISION CENTER portion of the mark, which was common to applicant's application and existing registrations); National Bakers Services, Inc. v. Hain Pure Food Co., 207 U.S.P.Q. 701 (T.T.A.B. 1980) (failure to object to registration of HOLLYWOOD HEALTH FOODS prevents damage from application for HOLLYWOOD. "Consequently, in our view, applicant's prior registered mark 'HOLLYWOOD HEALTH FOODS' is in essence the legal equivalent of the mark it now seeks to register, namely 'HOLLYWOOD' and since opposer is not damaged by the existence on the Register of applicant's mark 'HOLLYWOOD HEALTH FOODS' for mayonnaise, it cannot be damaged by the mark 'HOLLYWOOD' for the identical product on which applicant now seeks to register.").

When determining whether an applicant's mark creates a likelihood of confusion with a mark covered by a cited registration or application, "[a] showing of mere possibility of confusion is not enough; a substantial likelihood that the public will be confused must be shown." Omaha Nat'l Bank, 633 F. Supp. at 234. Applicant submits that the relevant factors set forth in In re E.I. Du Pont de Nemours & Co., 476 F.2d 1357,1361 (C.C.P.A. 1973) clearly support registration of Applicant's mark and do not raise a substantial likelihood of confusion. Under these circumstances, and absent "substantial doubt," In re Mars, 741 F.2d at 396 (Fed. Cir. 1984) (finding CANYON for candy bar not likely to be confused with CANYON for fruit), Applicant's application should be allowed.

IV. CONCLUSION

Having fully responded to the examining attorney's Office Action, Applicant respectfully requests that the examining attorney pass its mark to publication.

Dated: August 20, 2015

Respectfully submitted,

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