

This is in response to the Office Action issued March 19, 2019, related to Application No. 5413155 (the “Cited Mark”) for the mark PHENOM (“Applicant’s Mark”) Application No. 88230205 for the following amended goods:

*International Class 10: “Medical and surgical implants **comprising artificial material; medical apparatus and instruments for use in surgery, including spinal and orthopedic products and related accessories”***

In the Office Action, the Examining Attorney refused registration of Applicant’s Mark based on a likelihood of confusion with mark U.S. Reg. No. 5413155 (PHENOM) (the “Cited Mark”) owned by COVIDIEN LP for the following services:

International Class 10: Medical catheters; Surgical catheters; Catheters for intracranial use; Catheters for intravascular use; Catheters for endovascular use; Catheters for use in radiology and neuroradiology; Catheters for use in cardiology; Catheters for treating strokes; Catheters to retrieve clots and foreign bodies; Medical devices, namely, catheters for use in the vascular system; and parts and fittings for all of the foregoing.

For the following reasons, Applicant respectfully disagrees that there is a likelihood of confusion between Applicant’s Mark and the Cited Mark, and requests that the refusal be withdrawn.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Applicant’s products are marketed and sold directly to surgeons only (neurosurgeons and orthopedic spine surgeons, namely) who are solely responsible for selecting the implant hardware they will use in the specifically prescribed corrective spinal surgery.

The products described in the Cited Mark are disposable, bulk products purchased by the hospital administration for use by all staff.

The goods identified by the Cited Mark are different from the goods identified by Applicant’s Mark, and consumers purchasing these goods are highly educated, sophisticated consumers who conduct extensive research and make careful purchasing decisions. Purchasing decisions by medical professionals often involve significant cost and involve products that affect the well-being and sometimes even the lives of their patients. Surgeons, who will use the goods on their patients, will likely extensively research these goods and may even receive training on how to use the goods in patient care.

Thus, there is little chance of likelihood of confusion between Applicant’s Mark and the Cited Mark.

Comparison of the Goods

Applicant’s Goods are distinguishable from the goods offered under the Cited Mark.

Applicant’s products are sold in non-sterile, metal system trays containing implants (permanent single use) and accompanying instruments (reusable) for use in specifically prescribed corrective spinal

surgeries that need to be sterilized by the hospital prior to use.

The Internet evidence cited by the examiner to establish that the same entity manufactures both catheters and implants illustrates that these are commonly sold by the same entity when the prescribed surgical procedure requires BOTH of these items to work in conjunction with one another (i.e. arterial catheter and vascular stent). Applicant's products do not require the conjunctive use of catheters during surgery for the implant to achieve the intended use.

The products used in the Cited Mark are pre-packaged, sterile disposable, bulk products purchased by the hospital administration for use by all staff.

MULTIPLE-CLASS APPLICATION REQUIREMENTS (ADVISORY)

Applicant amended the description of goods/services to clarify and limit the international class to class 010.

Conclusion

Applicant's Mark and the Cited Mark must be considered in their entireties, and further consideration of the differences in the goods and the channels of trade, the sophistication of the consumers purchasing these goods, suggests that Applicant's Mark is readily distinguishable to the Cited Mark.

Therefore, Applicant respectfully requests that the Section 2(d) Likelihood of Confusion Refusal related to the Cited Mark be withdrawn to allow Applicant's Mark to proceed to publication.