

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Serial No.: 88156711
Filing Date: October 16, 2018
Applicant: Nova Biomedical Corporation
Mark: 24/7 CGM
Ref. No. NOVA.TM.15
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AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

In response to the Office Action mailed January 28, 2019, rejecting the above-identified Trademark Application, Applicant respectfully requests that the following remarks and amendments to the Application be entered:

Amendment to Identification of Goods/Services as recited on page 2 of this response.

Disclaimer as recited on page 2 of this response.

Remarks and Arguments begin on page 3 of this response.

AMENDMENT TO IDENTIFICATION OF GOODS AND SERVICES

Currently the Identification of Goods and Services recites:

Class 010: Devices for monitoring blood glucose for medical purposes

Please amend the Identification of Goods and Services to recite:

Class 010: Devices for subcutaneous monitoring of blood glucose for
medical purposes

AMENDMENT TO DISCLAIMERS ASSOCIATED WITH MARK

Currently, there are no disclaimers associated with the Mark of the present Application. Applicant respectfully submits the following disclaimer, and asks that the Application now reflect the same:

**No claim is made to the exclusive right to use “CGM”
apart from the mark as shown.**

Summary of Proposed Amendments

Applicant has amended the description of goods in accordance with Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), by amending the application to “clarify or limit, but not to broaden, the identification of goods and/or services.” This amendment further narrows the description to more clearly describe Applicant’s goods, and thus is believed to be proper.

REMARKS

Summary of Pending Refusals

The Office has refused registration of the present application under Trademark Act Section 2(d), 15 U.S.C. §1052(d) for perceived likelihood of confusion with the marks in U.S. Registration Nos. 5319645 and 5304012; and under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) because the applied-for mark allegedly merely describes a feature, use and purpose of applicant's goods and/or services. Applicant respectfully traverses.

Significance of the terms

The Office has requested that the Applicant respond to three questions which are repeated below and answered accordingly. See 37 C.F.R. §2.61(b); TMEP §814.

1. Do the goods provide continuous glucose monitoring? The goods in question relate to subcutaneous glucose monitoring. The term "continuous glucose monitoring" is somewhat of a misnomer as it is not employed entirely consistently across all platforms, and thus does not have a universal definition even within the 'diabetes' community. At times the terminology is employed to refer to any insulin and/or glucose related platform and technology regardless of consistent, continuous, interval, and/or scheduled monitoring over an extended period of time.

2. What does 'cgm' stand for in the diabetes/glucose monitoring industry? As the Office may have noted in the examples the Office provided, there is also no one set definition for CGM in the diabetes/glucose monitoring industry. For example, some use

the abbreviation for the goods, “continuous glucose monitor”, while others use the abbreviation for the methodology, “continuous glucose monitoring.” Less commonly, but still present in the community, the abbreviation is used to refer to “central glucose monitoring” as performed by Glucose transporters (GLUTs) as part of the metabolic pathway.

3. Do applicant’s devices provide results all the time/continuously? Applicant’s devices are subcutaneous sensors which provide metabolic information, specifically regarding glucose levels, to consumers and physicians at determined intervals throughout the night and day while implanted accordingly. The benefit of the Applicant’s implanted subcutaneous devices over the known prior art is that repeated injections are not necessary to access updated metabolic data as with finger-sticks or venous draws.

Disclaimer Amendment

In order to further prosecution, Applicant has accepted the Disclaimer proposed by the Office.

Suggestive terminology does not rise to the level of ‘Merely Descriptive’

The Applicant thanks the Office for recognizing that even in the diabetes industry, the letters “CGM” stands for at least two meanings “continuous glucose monitor” and “continuous glucose monitoring.” As Applicant noted, this abbreviation is not only used even for just these two meanings within the diabetes community, and indeed, Applicant notes that the Office’s own abbreviation search returned twenty-nine different results, interpretations, and meanings. Applicant believes that this evidence

illustrates that even this portion of the mark is incongruous, indefinite or susceptible to multiple connotations, or requires imagination, cogitation or gathering of further information in order for the relevant public to perceive any significance of the term as it relates to a significant aspect of applicant's goods.

The degree to which the mark is incongruous, indefinite or susceptible to multiple connotations, only increases when the composite mark is considered as a whole. For instance, in commerce and industry, "24/7" or "24-7" generally refers to the open times of business, or another type of service, that is available any time and, usually, every day of the week. The term is not commonly applied to goods or physical products as most consumers assume that if they own something, they own it, regardless of the time of day.

Thus, when initially considering the mark, a consumer (even in the diabetes industry) could imagine that the goods being offered are actually services such as those offered by hospitals or laboratories, which would require round-the-clock input and a particular skill level. In other words, this imagined service could be the technicians and laboratory assistants available for blood work analysis and hemolysis. On the other hand, if one expands the industry considerations, one could imagine that the services being offered are telecom technical support services available day or night for addressing consumer complaints. As the above indicates, more information is needed to be gathered for the relevant public to perceive any significance of the Mark as it relates to a significant aspect of Applicant's goods.

In light of the possible meanings discussed above, an exercise of imagination, cogitation, mental processing or gathering of further information is required in order for consumers of applicant's services, to readily perceive the significance of the mark 24/7 CGM. Applicant believes that such an exercise of imagination, thought or perception to reach a conclusion as to the goods indicates that the term is suggestive, not descriptive. Relying upon *In re Nobile Co.*, 225 USPQ 749, 750 (TTAB 1985) (NOBURST held suggestive as opposed to merely descriptive for a product that reduces the likelihood that pipes of a water system in which it is used will burst since the Board did not "believe this conclusion is readily arrived at by merely observing the mark on the goods but that it requires interpretation by the viewer.").

Accordingly, Applicant requests that the Examining attorney withdraw this ground for refusal to register. See *In re Disc Jockeys, Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992), citing *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (holding that when the mark is suggestive, not descriptive, the refusal should be withdrawn). See also, *In re Atavio, Inc.*, 25 USPQ2d 1361, 1362 (TTAB 1992) ("One which is only suggestive requires some imagination, thought or perception to determine its meaning in relation to the goods."); *In re WSI Corporation*, 1 USPQ2d 1570, 1572 (TTAB 1986) ("Where such imagination or forethought is required to reach a conclusion as to the nature of a key characteristic of goods or services, a mark must be determined to be suggestive and not descriptive."); *The Institut National Des Appellations D'Origine v. Vintners International Co, Inc.*, 22 USPQ 1190 (Fed. Cir. 1992).

Lack of Confusion

The Applicant thanks the Office for recognizing that the Marks in question are not identical. Applicant likewise recognizes that likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017).

Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Applicant believes the following du Pont Factors are relevant to the present case: dissimilarity of the Marks, dissimilarity of the Goods, conceptual weakness of the shared portion of the marks; dilution due to third-party use; and the highly sophisticated nature of the consumers.

Dissimilarity of The Marks

Under *du Pont*, the marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, meaning, and commercial impression. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

The marks differ in sound and appearance. Applicant's 24/7 CGM mark ends with the unshared term "CGM." As a result, Applicant's mark sounds different from the 24/7 EEG word portion of the cited mark, and when considered as a whole with the design element of the cited mark, considerably different in appearance.

The marks also differ in meaning and connotation. Applicant's mark includes the term CGM which, although provided with many possible meanings, does not have any possible interpretation which is comparable to or confusable with any of the possible meanings or interpretations for "EEG". While Applicant would argue that "24/7" is not necessarily the dominant element of either mark, Applicant also notes that this is not dispositive as "no element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone". See *In re Electrolyte Labs, Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Additionally, the overall impression is different because Applicant's mark is always seen in its entirety by the relevant public.

Thus, consideration of this du Pont factor would indicate that, when viewed in its entirety and giving appropriate weight to all of the elements in Applicant's mark, Applicant's mark is not likely to be confused with the cited marks.

Dissimilarity of The Goods

There is no per se rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood

of confusion cancellation of LLOYD'S for barbecued meats based on LLOYD's for restaurant services).

Here, the relevant goods are neither identical nor overlapping. Although both identifications of goods relate to the broad product category of medical equipment, Applicant's identified "devices for subcutaneous monitoring of blood glucose for medical purposes" goods do not overlap with the cited mark's "Surgical, medical and diagnostic apparatus and instruments, namely, devices for invasive and non-invasive EEG (Electroencephalography) monitoring and warning of abnormal blood glucose levels."

The overriding concern is not to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). In view of the wide disparity between the nature of the goods, there is no likelihood of adverse commercial impact to the owner of the cited marks. Thus, when considering the dissimilarity of the goods, this du Pont factor would tend towards evidence for registration of the applicant's mark.

Conceptual Weakness

Applicant notes that "Where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks." *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295,297 (CCPA 1958).

Applicant believes that the term shared between the marks, 24/7, has little or no source identifying significance because it is, at least, very highly suggestive. As discussed above, in commerce and industry, “24/7” or “24-7” generally refers to the open times of business, or another type of service, that is available any time and, usually, every day of the week. The term “24/7” is conceptually weak and very highly suggestive with respect to the goods as discussed above.

Thus, this du Pont factor also provides evidence in support of registration of the applicant’s mark.

Dilution Due to Third-Party Use

Third-party use of a term in the marketplace may be offered as evidence of a term’s weakness and dilution with respect to a particular field and weighs in favor of narrowing the scope of its protection against subsequent applications. *See Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant submits that there are at least 224 third-party marks on the trademark register that include the term “24-7” or “24/7”; and 97 of those third-party marks on the trademark register are live. These third-party registrations serve as compelling evidence that the shared term “24/7” is extremely weak and diluted, such that it creates little source identifying significance that could contribute to any likelihood of confusion apart from the cited marks as a whole.

Highly Sophisticated Consumers

Du Pont factor 4 looks at the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing. This is a consideration for determining consumer confusion where the term “sophistication” is shorthand for “conditions under which and buyers to whom sales are made.” Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

Applicant respectfully submits that the nature of the goods themselves indicates that the purchasers of the respective goods would likely include high-level physicians, medical personnel, and/or highly trained professionals responsible for decisions related to a patient’s well-being and medical status. Such individuals would certainly “exercise heightened care in evaluating” such goods/services before entrusting them to a third-party.

Therefore, this factor weighs against a likelihood of confusion because the respective relevant consumers are highly sophisticated and would exercise heightened care before purchasing the goods of Applicant or those in the cited cases.

Conclusion

Applicant respectfully submits that the amendments and arguments presented herein successfully address each of the pending requests and traverse the grounds for refusal to register. Applicant believes that the pending mark is now in condition for publication. Early and favorable action to that end is respectfully requested. If any further action is deemed necessary, the Applicant invites the Examiner to contact the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Best Regards,



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