I. Argument

A. Applicant's Goods And Registrant's Goods Are Not Related

In its office action, the Trademark Office has refused registration of Applicant's trademark PHENOM on the ground that there is a likelihood of confusion with Registration No. 5,413,155 for the trademark PHENOM. In large part, the Trademark Office rests its likelihood of confusion conclusion on a finding that Applicant's goods and Registrant's goods are closely related.

Registrant's goods, as identified in its registration, are "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 the foregoing." In its application, Applicant identified its goods as "Medical and surgical implants, apparatus and instruments for use in surgery, including spinal and orthopedic products and related accessories." Herein, however, Applicant has refined and narrowed its identification of goods to be "Spinal implants comprised of synthetic material and surgical instruments for use in spinal correction surgery."

Notwithstanding whether or not the goods Applicant initially identified in its application are related to the goods in Registrant's registration, the narrower category of goods Applicant has now identified in its revised identification of goods are not related to Registrant's goods. "[T]he [Trademark] Office permits applicants to limit identification of goods that are by themselves acceptable." *In re Truth Hardware Corporation*, 2008 TTAB

LEXIS 437 at *11-12 (2006). "With this limitation, applicant has changed the likelihood of confusion analysis." *Id.* at *12.

Spinal implants and surgical instruments used in spinal correction surgery is a very narrow type of goods. Unlike the broader category of medical and surgical implants in Applicant's initial identification of goods, this new identification of goods does not include and is not in any way related to the catheters identified in Registrant's identification of goods. Indeed, a catheter is "[a] tube passed into the body for evacuating or injecting fluids. It may be made of elastic, elastic web, rubber, glass, metal, or plastic." (Exh. A); see e.g. *In re Johnson & Johnson*, 2002 TTAB LEXIS 68 at *5 (2002) ("Moreover, even without applicant's extrinsic evidence explaining the description of goods set forth in the cited registration, it is obvious that both endoscopes (applicant's goods) and computer and work stations for use in electrophysiology imaging event recording and catheter positioning are distinctly different types of medical devices.")

B. Consumers of Applicant's Goods And Registrant's Goods Are Highly Sophisticated Medical Professionals

Even assuming *arguendo* that the goods Applicant now identifies are in some way related to Registrant's goods, such relatedness cannot lead to a finding by the Trademark Office that there is a likelihood of confusion, because the consumers of both Applicant's and Registrant's goods, who are physicians and surgeons in particular, are highly sophisticated. Indeed, on its website, Applicant explicitly explains that all its products are for surgeons. (Exh. B) ("Curiteva is dedicated to providing surgeons with the highest quality of products to enhance patient outcomes.")

As the Federal Circuit explained in *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*,

> Even assuming, *arguendo*, that the Board was correct in finding sufficient relatedness of the goods and services, the relevant persons – potential and actual purchasers – are nevertheless mostly different and in an any event are sophisticated enough that the likelihood of confusion remains remote.
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> . . . .
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> Just from the record description of goods and services here one would expect that nearly all of opposer's and applicant's purchasers would be highly sophisticated. Nothing in the record is to the contrary. Indeed, the record confirms that opposer's services are expensive and are purchased *only* by experienced corporate officials after significant study and contractual negotiation.

Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 717 (Fed. Cir. 1992).

Moreover, in *In re Invivo Corporation*, the Trademark Trial & Appeal Board explained

> Against the backdrop of this minimal evidence bearing on the relatedness of the goods is the fact that, even assuming that applicant's and registrant's goods would be purchased by the same doctors, hospitals, out-patient surgical centers and other medical institutions, it is readily apparent that the purchasing decisions for such goods would be made by highly sophisticated and knowledgeable buyers under conditions of sale which would further minimize any likelihood of confusion as to source or affiliation. As *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983) makes clear, for a likelihood of confusion to exist, "it must be based on confusion of some relevant person, i.e., a customer or user, and there is always less likelihood of confusion where goods are expensive and purchased and used by highly specialized individuals after careful consideration." It has long been recognized that purchasers of medical equipment, whether hospital personnel or physicians, are highly sophisticated and, as such, are more likely to distinguish between marks and goods than is the general consuming public. *In re N.A.D.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985); and *Pfizer Inc. v. Astra Pharmaceutical Products Inc.*, 858 F.Supp. 1305, 33 USPQ2d 1545, 1562 (S.D.N.Y. 1994) ["[t]he consumers here are doctors, as sophisticated a group as one could imagine"].
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> The evidence indicates that laparoscopes and arthroscopes are used by a variety of doctors, including general surgeons and orthopedic surgeons, gynecologists, and urologists. These are specialists who are highly trained in their field and who, by necessity, must be very sophisticated about the selection and use of specific instruments during a medical procedure. *See, e.g., Warner-Hudnut, Inc. v. Wander Co.*,

> 280 F.2d 435, 47 C.C.P.A. 1172, 1960 Dec. Comm'r Pat. 510, 126 USPQ 411, 412 (CCPA 1960) [physicians constitute "a highly intelligent and discriminating public"]. Because the products at issue are all used for patient care, we can safely assume that the doctors and hospital personnel responsible for the selection and purchase of those products will exercise a high degree of care in purchasing decisions to ensure that the products come from a reputable source, thereby further minimizing a likelihood of confusion. Their "sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'" *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), quoting from *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 212 USPQ 246, 252 (1st Cir. 1981). While, in this case, it is possible for the same doctor, medical practice or hospital to purchase both applicant and registrant's goods, the Federal Circuit has cautioned that it is error to deny registration simply because an applicant markets and sells its goods in the same general field as those promoted and sold by the registrant (*e.g.*, the medical field). *See Electronic Design & Sales,* 21 USPQ2d at 1391.

In re Invivo Corporation, 2007 TTAB LEXIS 306 at *15-16 (2007); see also *In re Itec Manufacturing, Ltd.*, 2008 TTAB LEXIS 225 at *21-23 (2008).

The cases are legion in which the Trademark Trial & Appeal Board declined to find a likelihood of confusion, because the purchasers of the goods were sophisticated medical professionals. See e.g. *In re Itec Manufacturing, Ltd.*, 2008 TTAB LEXIS 225 at *24 (2008) ("In sum, the types of products involved in this appeal would be bought by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation. Further, the goods are distinctly different. Given the knowledge, care and deliberation required of doctors, hospitals and other medical facilities in making the purchasing decisions with respect to applicant's and registrants' goods, it is unlikely that they would be confused."); *In re Inspired Technologies, Inc.*, 2011 TTAB LEXIS 15 at *13 (2011) ("In sum, both types of products involved in this appeal would be bought by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberations. Further, as identified, the goods are distinctly different. Given the knowledge, care and deliberation

required of doctors, hospitals and other medical institutions in making the purchasing decisions with respect to applicant's and registrant's goods, it is unlikely that they would be confused."); *In re Wright Medical Technology, Inc.*, 1998 TTAB LEXIS 392 at *8 (1998) ("The Board is convinced that orthopedic hip implantation is a highly specialized medical area. The applicant and the Trademark Examining Attorney agree that the purchaser for the purposes of trademark analysis comprises a most sophisticated market. There may be nuances of difference in their conclusions as to which professional on the hospital team chooses among competing vendors of this type of medical apparatus. In any event, a small and select group of medical professionals – the orthopedic surgeon, operating room nurse supervisors and hospital administrators or purchasing agents or committees – decides which firm or firms will be supplying the implants. As applicant has pointed out, ultimately the critical recommendation, if not the final decision, is made by the surgeon."); *In re TriVascular, Inc.*, 2012 TTAB LEXIS 456 at *18 (2012) ("Considering the highly specialized and technological nature of the goods in this case before us, we expect that any reasonable decision to purchase goods of applicant or registrant would in all likelihood involve the advice of a person having specialized expertise in orthopedics or vascular medicine, as appropriate, even if the formalities of purchase are ultimately undertaken by a business administrator or purchasing agent. A decision made without consideration of the technical needs and preferences of the surgeons who will ultimately use the products would not, in our view, be a reasonable one. . . . In sum, these are two separate classes of highly informed, careful, and sophisticated purchasers whose selection of the goods would be based on very many factors of critical importance. Even if such a purchaser were to know

that the same trademark appears on different products used in a different medical field, it would not likely have an untoward impact on the decision to purchase or not purchase the goods."); *In re Optical Sensors Inc.*, 2007 TTAB LEXIS 391 at *34-35 (2007) ("It is therefore clear that doctors, including cardiologists and endocrinologists, would constitute the persons who would make, or be primarily responsible for making, the purchasing decisions with respect [to] non-invasive hemodynamic monitoring systems like those sold by applicant. Doctors would be the individuals most familiar with the equipment available for measuring and tracking such variables. Doctors, therefore, have been held to be highly discriminating and sophisticated purchasers. As such, they would be expected to exercise a high degree of care of deliberation in decisions involving the purchasing of medical equipment to deal with their patients' needs, including the selection of non-invasive hemodynamic monitoring systems."); *In re Digirad Corporation*, 1998 TTAB LEXIS 2 at *8 (1998) ("Although applicant states that the purchase of such equipment may be 'routine' and made by an institution's purchasing agent 'off the shelf or from catalogs,' we assume that such equipment is substantial in both size and technical complexity and, thus, is not inexpensive and that, as these products are marketed to Radiology specialists, the purchasing decision is made by knowledgeable individuals after careful consideration."); *In re AccuraScience LLC*, 2015 TTAB LEXIS 193 at *22-23 (2015) ("By contrast, the record shows that the primary purchasers of both of the recited services involved herein are pharmaceutical companies. The record shows that the primary purchasers of both of the recited services involved herein are companies involved in the pharmaceutical and biotech industries. By definition, all of these customers would be quite sophisticated. We acknowledge the line of cases supporting that

even if customers are knowledgeable in a particular field that does not necessarily mean that they are immune from source confusion. In this case, however, given the highly technical and sophisticated nature of the involved services, we find that purchasers of these services would exercise a high degree of care and be likely to notice the difference between Applicant's marks and the mark in the cited registration.")

Indeed, when the consumers of a good are highly sophisticated medical professionals, the Trademark Trial & Appeal Board has refused to find a likelihood of confusion even when it has expressly found that the applicant's and registrant's products are related.

In *In re Genzyme Corp.*, the Board found that

> We are therefore constrained to agree with the Examining Attorney that, as identified in the respective application and registration, applicant's "coated mesh for surgical procedures including hernia repair" encompasses products which are identical and closely related to registrant's "nylon in mesh form used as an implant in plastic surgery," and vice versa, such as coated mesh for use as an implant in plastic surgery and a nylon mesh implant for surface abdominal hernia repair.

In re Genzyme Corp., 2002 TTAB LEXIS 362 at *7-8 (2002).

Notwithstanding this conclusion, however, the Board reversed the Trademark Examiner's refusal to register the applicant's trademark due to the likelihood of confusion, explaining

> Surgeons, in their capacity as buyers of applicant's and registrant's goods, are clearly sophisticated purchasers. As such, their "sophistication is important and often dispositive because sophisticated endusers may be expected to exercise greater care. Moreover, even if purchased for surgeons at their direction by members of a hospital administrative staff, it is still the case that, as asserted by applicant in its initial brief, the goods at issue "are important patient care-related products such that purchasers and users are certain to exercise a high degree of care and consideration in making the purchasing or use decision" and such decision plainly will not be made on impulse.
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> In consequence thereof, we conclude that the sophisticated purchasers of applicant's and registrant's goods can be expected to be highly cognizant of the substantial differences in connotation and overall commercial impression between

> applicant's "SEPRAMESH" mark for its coated mesh for surgical procedures including hernia repair and registrant's "SUPRAMESH" mark for its nylon in mesh form used as an implant in plastic surgery. Inasmuch as such careful and discriminating purchasers will thus readily distinguish the marks, confusion as to the source or sponsorship of the respective goods is not likely.

Id. at *20-21.

II. Conclusion

For all the foregoing reasons, the Trademark Office should allow registration of Applicant's PHENOM trademark.