

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT : A.M.G. Medical Inc.

MARK : PROACTIVE

SERIAL NO. : 88/237,809

CLASS: : 10

Applicant seeks to register the trademark PROACTIVE (“Applicant’s Mark”) in connection with “Hot compresses; cold compresses; hot and cold compresses; Trans Cutaneous Electrical Stimulators; Muscle Stimulators; Electrical Muscle Stimulators; Electro Massagers,” in Class 10.

Applicant has carefully reviewed the Office Action, dated March 18, 2019, in which the Examining Attorney has refused to register Applicant’s Mark based upon: (1) a likelihood of confusion with certain registered marks, and (2) the specimen “does not show the applied-for mark in actual use in commerce.” The Examiner has also required certain amendments with respect to the identification of goods within the application, information about the specimen. For the reasons set forth below, Applicant respectfully requests that the Examiner withdraw the refusal of registration and approve Application Serial No. 88/237,809 for publication.

**I. AMENDMENT TO IDENTIFICATION OF GOODS**

Applicant hereby amends the identification of goods in its application as follows:

Class 10: Chemically activated hot and cold compresses; therapeutic hot and cold compression wraps; thermal energy transfer activated hold and cold compresses; chemically activated hot compresses; therapeutic hot compression wraps; thermal energy transfer activated hot compresses; chemically activated cold compresses; therapeutic cold compression wraps; thermal energy transfer activated cold compresses; electromedical rehabilitative and pain management products for

clinical and home use, namely, trans cutaneous electrical stimulators, muscle stimulators and electrical muscle stimulators; electric massage apparatus

(“Applicant’s Goods”).


## II. EXAMINER’S REFUSAL TO REGISTER APPLICANT’S MARK BASED ON LIKELIHOOD OF CONFUSION

### A. Introduction

The Examining Attorney has refused to register Applicant's Mark under the Trademark Act § 2(d), claiming that Applicant’s Mark is likely to be confused with the following registrations in International Class 10, listed below:

- PROACTIVE, U.S. Reg. No. 4,623,489, registered in connection with “Medical products, namely, patient monitoring chair and bed alarms; weight-sensitive pressure redistribution mattress pads for patient bed monitor and chair monitor use; Patient monitoring sensor mats; patient monitoring seat belts for medical use; nebulizers for administering medication in the form of a mist inhaled into the lungs for treatment of respiratory disorders; medical equipment accessories, namely, bag to secure patient monitoring alarm to chair, splitter for use with patient monitoring alarms, nurse call cord, nurse call connector plug; Non-contact infrared thermometer for medical use,” in Class 10, owned by Proactive Medical Products LLC (“Registrant”); and



- , U.S. Reg. No. 4,817,028, registered in connection with “Medical products, namely, patient monitoring chair and bed alarms; Weight-sensitive pressure redistribution mattress pads for patient bed monitor and chair monitor use; Patient monitoring sensor mats; Patient monitoring seat belts for medical use; Nebulizers for administering medication in the form of a mist inhaled into the lungs for treatment of respiratory disorders; Medical equipment accessories, namely, bags to secure patient monitoring alarm to chair, splitters for use with patient monitoring alarms, nurse call cords, nurse call connector plugs; Non-contact infrared thermometers for medical use; Invalid lifts; Slings for medical use; Air mattresses for medical purposes; Pressure management medical products, namely, therapeutic mattresses, beds, seats, cushions and arm and foot rests; Pressure management products, namely, low air loss mattresses; Foam mattresses for medical purposes,” in Class 10, also owned by Registrant (the “Design Mark”),

(collectively, the “Cited Marks”). Applicant respectfully submits that Applicant’s Mark is not likely to be confused with the Cited Marks and requests that the Examiner withdraw the refusal of registration on likelihood of confusion grounds.

**B. The Applicant’s Mark Is Not Likely To Be Confused With The Cited Marks Because The Marks Are Used In Connection With Vastly Different Goods.**

Applicant’s Goods include reusable short term pain management products, used by individual consumers to reduce muscle and abdominal pain, reduce spasms, help sprains and inflammation, back injuries and similar issues. *See* Declaration of Lori J. Shyavitz (“Shyavitz Dec.”), Exs. A (excerpts from Applicant’s website) and B (excerpts from Amazon.com). Among Applicant’s Goods are reusable compresses that are comprised of gel beads or clay that can be heated for use as a warm compress, or frozen for use as a cold compress. *See id.* Applicant’s Goods do not in any way provide patient monitoring functionality and do not include alarms or sensors of any kind as do the goods associated with the cited registrations.

In contrast, the Registrant sells “pressure redistribution support solutions,” such as mattresses, chair and bed cushions, “seating and positioning” products, “safe patient handling” and transfer products,” and products intended for “fall and wandering prevention,” such as alarms and sensors. *See* Shyavitz Dec., Exhibit C (Registrant’s product catalogue). Registrant’s products are intended for use by medical professionals and healthcare institutions and are not intended to treat existing pain, muscle discomfort, sprains or inflammation. Rather, Registrant’s products are intended for patient support and positioning, as well as patient safety.

Therefore, Registrant’s goods, which are for maintaining the positioning, support and safety of patients, do not, in and of themselves, provide a treatment (as is the case with Applicant’s Goods) and are therefore used for purposes completely different from the purposes

for which Applicant's Goods would be used, namely, to reduce pain or swelling after an injury or illness. Registrant's goods are used in hospitals, nursing homes, and assisted care facilities, while Applicant's Goods are generally not used by institutions, but rather are used by individuals at home. Registrant's goods and Applicant's goods do not serve even remotely related purposes. Thus, the Registrant's goods are not related to the Applicant's Goods.

The sole fact that the goods covered by the Applicant's Mark and the Cited Mark may relate in some general manner to medical products of some kind is insufficient for a finding of likelihood of confusion. *See, e.g., Havens Capital Management, Inc. v. Havens Advisors, L.L.C.*, 965 F.Supp. 528 (S.D.N.Y. 1997) (finding HAVEN mark was not likely to be confused with HAVENS mark even though both marks were used with investment-related services). This conclusion is supported by the fact that the Applicant's Goods and Registrant's goods are used in two entirely different contexts, for unrelated purposes. Because the goods at issue here are different, Applicant's Goods are not likely to be confused with the goods covered by the Cited Marks.

**C. The Applicant's Mark Is Not Likely To Be Confused With The Cited Marks Because The Goods Covered By The Marks Are Purchased By Different Purchasers.**

The Registrant's goods are marketed and sold to hospitals, nursing homes, assisted living and other healthcare facilities. *See Shyavitz Dec., Ex. C.* In contrast, Applicant does not sell or market its goods to hospitals or healthcare facilities. Rather, Applicant's customers are individual consumers seeking temporary relief from pain and discomfort due to a minor injury, such as a sprain or pulled muscle. Accordingly, the customers seeking the Registrant's goods are not the same customers as the customers that purchase the goods covered by the Applicant's

Mark, as evidenced by the fact that Registrant's goods require a purchaser to view Registrant's catalogue and then contact Registrant by telephone to purchase the goods. *See id.* Applicant's Goods, in contrast, are sold via Amazon.com and are the type of products one would purchase in a big box store, a grocery store, or pharmacy. Plainly, consumers seeking to purchase the Applicant's Goods would not encounter the goods covered by the Cited Marks, and vice versa. Where goods and services do not travel in the same channels of trade, confusion is not likely. *See Local Trademarks Inc. v. The Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156, 1157-58 (TTAB 1990) (no likelihood of confusion where LITTLE PLUMBER for advertising services is marketed to plumbing contractors and LITTLE PLUMBER drain opener is marketed to the general public).

The Federal Circuit has noted that "the inquiry [into likelihood of confusion] generally will turn on whether actual or potential 'purchasers' are confused. The essential inquiry . . . is whether there is likely to be sufficient overlap of the respective purchasers of the parties' goods and services to confuse actual and potential purchasers." *Electronic Design & Sales v. Electronic Systems*, 954 F.2d 713, 716 (Fed. Cir. 1992). There is no such overlap here. Accordingly, there is not likely to be confusion between these marks. *See* 3 McCarthy on Trademark and Unfair Competition ("McCarthy"), § 23:3 and cases cited therein (standard is not mere possibility of overlap, but instead a probability of confusion).

**D. Confusion Is Not Likely Because The Applicant's Goods And Registrant's Goods Are Purchased Only After Careful Consideration By Prospective Purchasers.**

The "price level of the goods or services is an important factor in determining the amount of care the reasonably prudent buyer will use. If the goods or services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation." 3

McCarthy, §23:95 at 23-245. The test for “likelihood of confusion” is conducted with respect to the perception of “reasonably prudent purchasers,” except in the case of a product or service which is considered expensive, where the standard is raised to “discriminating purchasers.” *See id.* at §23:96, 23-247 (“[i]f the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. Thus, confusion is less likely than where the goods are cheap and bought casually”). The “discriminating purchasers” standard plainly applies here.

The goods covered by Applicant’s Mark and the Cited Marks are purchased only after deliberation and a sales cycle that is far from the impulse purchase. Registrant’s goods are likely to be expensive as they are used by healthcare professionals in institutional settings, which is a very narrow class of purchasers seeking highly specialized goods. *See Shyavitz Dec., Ex. C.* Customers purchasing Registrant’s goods are likely to engage in rigorous due diligence prior to purchasing Registrant’s goods given the various sizes, grades and configurations available for each of Registrant’s goods. *See id.* Thus, the sophisticated and discriminating purchasers seeking to purchase the Registrant’s goods would not likely be confused between the Applicant’s Mark and the Cited Marks.

Applicant’s Goods also are not inexpensive and are purchased to treat pain and injury. Given the nature of the use of Applicant’s Goods, consumers are also likely to conduct some investigation into the products prior to purchase and to exercise care as Applicant’s Goods are not “impulse purchase” products.

Where expensive goods or services are purchased by sophisticated buyers after careful consideration and a long buying cycle, the likelihood that purchasers will be confused is nil. *See In re Software Design, Inc.*, 220 U.S.P.Q. 662, 663 (TTAB 1983) (finding that “highly

sophisticated, technical, and relatively expensive” nature of the services at issue, which were likely to be purchased only with care and deliberation after investigation, weighed against finding of likelihood of confusion even though marks were phonetically similar); *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 U.S.P.Q.2d 1213 (TTAB 2011) (“[T]he sophisticated purchasers involved in these purchasing decisions would be aware of the practices of the industry, and recognize that such goods and services do not emanate from a single source.”); *American Optical Corp. v. Atwood Oceanics, Inc.*, 180 U.S.P.Q. 532, 539 (TTAB 1973) (finding “such factors as highly sophisticated, technical and expensive services purchased by highly placed and informed corporate personnel with care and determination after intensive investigation and research” were “determinative of the question of likelihood of confusion”); *Oreck Corp. v. U.S. Floor Systems, Inc.*, 803 F.2d 166 (5th Cir. 1986).

Confusion is not likely here because the Registrant’s goods are apparently expensive and purchased only after careful consideration. *Checkpoint Systems Inc. v. Check Point Software Technologies Inc.*, 60 U.S.P.Q.2d 1609, 1617 (3d Cir. 2001) (“Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar.”) (citing 3 McCarthy §23:101) (CHECKPOINT mark used in connection with electronic security control systems not likely to be confused with CHECK POINT mark used in connection with computer software that protects and manages access to information); *see also Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 128 (4<sup>th</sup> Cir. 1990). In addition, the parties’ respective goods are used for very specialized, different purposes, making confusion unlikely.

**E. Applicant's Mark Is Not Likely To Be Confused With The Design Mark Because The Overall Commercial Impressions Of The Marks Are Different.**

A comparison of Applicant's Mark and the Design Mark in their entireties demonstrates that such marks are overall visually and aurally distinct, have different meanings, and, thus, create different overall commercial impressions. Although the marks share the common term PROACTIVE, they include other features that are quite dissimilar. The Design Mark includes the additional terms MEDICAL PRODUCTS, together with a design element featuring a series of spiraling solid dots, with all terms depicted in a stylized font, and a highly stylized letter "v" that features an arrow extending upwards. Applicant's Mark, in contrast, does not include the terms MEDICAL PRODUCTS and does not include any design element. Consequently, confusion between Applicant's Mark and the Cited Mark is not likely.

In assessing likelihood of confusion, marks should be considered in their entireties as to appearance, sound and meaning. *Professional Art Distribution, Inc. v. Internationaler Zeichenverbank Fur Kunstdruckpapier, E.V.*, 11 U.S.P.Q. 2d 1735 (Fed. Cir. 1989). A mark should not be dissected and considered piecemeal; rather, it must be considered as a whole. *See Franklin Mint Corporation v. Master Manufacturing Company*, 667 F.2d 1005, 1007 (CCPA 1981). Accordingly, the Applicant's Mark should be considered in its entirety, and the overall commercial impression of the Design Mark is greatly different from the overall commercial impression of the Applicant's Mark. When viewed as a whole, the overall commercial impressions of these marks are simply not similar.

The fact that the marks share a feature or term is not dispositive, as similarity is based on the total effect of the marks, rather than a comparison of any individual features. *See Trademark Manual of Examining Procedure*, April 2017 ed. ("TMEP"), §1207.01(c)(ii) ("fundamental rule"



when mark has words plus a design is that the marks must be considered in their entireties); *Red Carpet Corp. v. Johnstown Am. Enters.*, 7 U.S.P.Q.2d 1404 (TTAB 1988) (holding mark consisting of stylized house design for use in connection with real estate property management, and mark consisting of stylized house design for use in connection with real estate brokerage services, not likely to cause confusion); *Standard Brands Inc. v. Peters*, 191 U.S.P.Q. 168, 172 (TTAB 1975) (addition of the word “corn” is sufficient to render the mark “CORN-ROYAL” as a whole distinguishable from and registrable over “ROYAL” for butter and margarine products, which are specifically different from shortening for volume deep fat frying); *Ocean Spray Cranberries, Inc. v. Ocean Garden Prods., Inc.*, 223 U.S.P.Q. 1027 (TTAB 1984) (holding mark consisting of a circle containing three curved lines with rounded ends, for seafood, and mark consisting of a stylized breaking wave within an oval, for various food items, not likely to cause confusion). Here, the effect of the entire mark, including differences, should be considered. *See In re Sweet Victory Inc.*, 228 U.S.P.Q. 959, 961 (TTAB 1986) (finding marks GLACE CONTINENTAL and GLACE LITE were not likely to be confused even though both marks were used in connection with sherbet, because “the overall differences in the marks are sufficient so that while source confusion may be possible, it is not likely”); *New England Fish Co. v. The Herwin Co.*, 179 U.S.P.Q. 743 (TTAB 1973).

Applicant’s Mark, which consists of the term PROACTIVE standing alone, has an appearance, meaning and sound that differs from that of the Design Mark, which consists of the terms PROACTIVE MEDICAL PRODUCTS. The term “proactive” is defined to mean “serving to prepare for, intervene in, or control an expected occurrence or situation, especially a negative or difficult one; anticipatory.” *See Shyavitz Dec., Ex. D.* Applicant’s Mark suggests that the

user of Applicant's Goods is him or herself proactive. The Design Mark, in contrast, suggests that Registrant's products, rather than the users of those products, are proactive.

In view of the differences in appearance, sound and meaning between Applicant's Mark and the Design Mark, Applicant's Mark and the Design Mark create different commercial impressions. Thus, there will be no likelihood of confusion as to source. *See, e.g., In re Park Lane Shoes Ltd.*, 2011 TTAB LEXIS 282, at \*6-8 (TTAB 2011) (different meanings and commercial impressions of PARK LANE versus PARK AVENUE sufficiently distinguished the marks and made likelihood of confusion unlikely, even though both marks shared the same first word and were both used in connection with footwear); *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear because of the different commercial impressions created by the marks, despite the fact that the marks are identical and the goods are related); *Conde Nast Publ'ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (C.C.P.A. 1975) (VOGUE and COUNTRY VOGUE convey different commercial impressions).

**F. The Examining Attorney Should Allow The Applicant's Mark To Proceed To Registration Because There Are Other Registered Marks And Published Applications That Include The Term PROACTIVE.**

Applicant's Mark should be permitted to coexist with the Cited Marks. Notably, there are other federally registered marks that include the term PROACTIVE in connection with products in Class 10, all owned by entities other than the Registrant. In particular, we draw the Examiner's attention to the following marks:

- PROACTIVE, Registration No. 4,668,309, registered in connection with "nerve location system comprised of an electrical signal generator with configured software, stimulation instruments and electrodes for providing audio

and visual feedback of the location of human motor nerves, to monitor nerves during surgery,” in Class 10, owned by Neurovision Medical Products, Inc.;

The foregoing mark is actually closer to the Cited Marks in that the goods covered by this mark (like those associated with the Cited Marks):

- perform a monitoring function; and
- are likely to be purchased by institutions such as hospitals.

To the extent that the U.S. Patent and Trademark Office (the “PTO”) has determined that this mark can co-exist on the Register with the Cited Marks, it is difficult to explain why the Applicant’s Mark, which presents greater differences, would present any likelihood of confusion with the Registrant’s marks.

Given the co-existence of the Registrant’s PROACTIVE marks and the PROACTIVE mark aforesaid belonging to Neurovision Medical Products, Inc., both registered in connection with goods which perform a monitoring function, it is not surprising that the PTO has allowed a number of marks in the medical field to be registered where the distinctive portion thereof is the word PROACTIVE, accompanied with descriptive wording, such as:

- PROACTIVE MD, Registration No. 4,451,945, registered in connection with “Electronic medical devices for the treatment of acne,” in Class 10 (as well as other goods in other classes, owned by Guthy-Renker LLC, with the term “MD” disclaimed;
- PROACTIVE COUNTERPULSATION, Registration No. 3,332,225, registered in connection with “Medical devices, namely, intra-aortic balloon pumps,” in Class 10, owned by Arrow International, Inc., with the term “COUNTERPULSATION” disclaimed; and
- PROACTIVE WEAR, Registration No. 2,548,972, registered in connection with “wearable prosthetic [sic] and orthotic accessories for knees and joints to be used in conjunction with other prosthetic and orthotic devices,” in Class

10, owned by Cascade Orthopedic Supply, Inc., with the term “WEAR” disclaimed.

The fact that all these marks co-exist on the Register highlights the importance to be afforded to the nature of the goods associated with each mark when dealing with PROACTIVE marks. As such, the differences mentioned above, inherent in the Applicant’s mark, ensures that the Applicant’s mark can co-exist on the Register with the Registrant’s marks and the above marks. Applicant submits copies of the Certificates of Registration for the foregoing marks as Exhibit E to the Declaration of Lori J. Shyavitz, submitted herewith.

The USPTO has allowed the references above, as well as the Cited Marks all of which include the term PROACTIVE and cover goods in Class 10, to coexist on the federal registry. Accordingly, the Applicant’s Mark should be permitted to coexist with these registrations as well.

### **III. SPECIMEN REFUSAL AND INFORMATION CONCERNING SPECIMEN**

The Examining Attorney has rejected the specimen submitted by Applicant. The Applicant submits herewith a substitute specimen showing the Applicant’s Mark in use in commerce in connection with Applicant’s Goods in Class 10.

The Examining Attorney has requested additional information from Applicant regarding Applicant’s previously submitted specimen and that information is provided below.

- (1) Applicant’s Goods are sold online in the United States. *See* Shyavitz Dec., Ex. B.
- (2) A copy of an invoice to Amazon.com reflecting sale of Applicant’s Goods is attached as Exhibit F to the Declaration of Lori J. Shyavitz.

(3) The previously submitted specimen was not created for submission with this application. The image previously submitted as a specimen appeared on Applicant's website (Shyavitz Dec., Ex. A) and on Amazon.com (Shyavitz Dec., Ex. B).

(4) The previously submitted specimen shows Applicant's Goods as they are sold to consumers. See substitute specimen.

(5) Applicant refers the Examining Attorney to Exhibit B to the Declaration of Lori Shyavitz, which depicts the products as they are advertised and sold on Amazon.com.

(6) See response to (5) above.

## **V. FILING BASIS AND FOREIGN REGISTRATION**

The foreign registration for Applicant's Mark covering "hot compresses; cold compresses; hot and cold compresses" has not yet issued and Applicant requests that the application be suspended until such time as the foreign registration issues.

## **VI. CONCLUSION**

Based upon the foregoing, Applicant respectfully requests that the Examiner withdraw the refusal to register Applicant's Mark and allow Application Serial No. 88/237,809 to proceed to publication.