

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eko Devices, Inc.)	<u>TRADEMARK APPLICATION</u>
)	
US Serial No.:	88276906)	Docket No. 1072T0004US
)	
Filed:	January 25, 2019)	Examining Attorney: Alison F. Pollack
)	
Mark:	DUO)	Law Office 106
)	

RESPONSE TO OFFICE ACTION

This is intended as a complete response to the Office Action sent April 9, 2019.

I. Section 2(d) Refusal

The Examining Attorney has refused registration under Section 2(d) in view of U.S. Registration Nos. 4,929,587 and 4,792,730. This rejection is respectfully traversed as follows.

The standards for determining whether there is a likelihood of confusion are set forth in *Application of E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

Likelihood of confusion is said to be synonymous with "probable confusion" - it is not sufficient if confusion is merely "possible." *See Rodeo Collection Ltd. v. West Seventh*, 812 F.2d 1215 (9th Cir. 1987) ("likelihood of confusion requires that confusion be probable, not simply a possibility").

Although many factors are relevant to the likelihood of confusion analysis, one factor can be so compelling that it alone can be dispositive of the issue of likelihood of confusion. *See Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 330 (Fed. Cir. 1991). In this case, Applicant respectfully submits that the dissimilarity of the marks, the dissimilarity of the goods in question

and the sophistication of the relevant consumers compel the conclusion that there would be no likelihood of confusion.

A. U.S. Registration 4,929,587 for CLICKLINE DUO

The cited CLICKLINE DUO mark in Registration No. 4,929,587 (“the ‘587 registration”) and Applicant’s mark have several significant distinctions that create different commercial impressions. The cited mark, CLICKLINE DUO, consists of two words whereas Applicant’s mark is just one word. The initial and most prominent word in the cited mark is not present in Applicant’s mark; Applicant’s mark has nothing even remotely resembling the word “CLICKLINE.” Moreover, “CLICKLINE” is a compound word that is much longer than “DUO” and appears to be a coined term; CLICKLINE is therefore the dominant word in the cited mark. The cited mark consists of 12 letters whereas Applicant’s mark has just three letters. The cited mark contains four syllables to only two in Applicant’s mark. Applicant respectfully submits that a consumer would notice all these distinctions as he or she peruses the cited mark and likely would focus more on the first word “CLICKLINE” because it is longer and appears to be a coined term. Accordingly, the cited mark and Applicant’s mark generate very different commercial impressions, militating against likelihood of confusion.

The dominance of the term CLICKLINE in the ‘587 Registrant’s mark is evident considering by how the ‘587 Registrant actually uses its mark (or rather, fails to use its mark). The ‘587 Registrant’s primary brand is CLICKLINE, without the term DUO. (*See, e.g.*, Exhibit A (CLICKLINE brochure available at https://www.karlstorz.com/cps/rde/xbcr/karlstorz_assets/ASSETS/3403645.pdf, omitting any reference to CLICKLINE DUO.) After extensive searching of the ‘587 registrant’s website as well as general Internet searching, Applicant has identified use of the family mark CLICKLINE,

but no commercial use at all of the mark CLICKLINE DUO (despite Applicant's registration of CLICKLINE DUO 3½ years ago for use on approximately 375 different goods). Even as to the family mark CLICKLINE, it appears to be used in connection with a limited range of laparoscopy surgical tools and not stethoscopes or anything remotely related thereto. Clearly, CLICKLINE is the '587 Registrant's dominant mark, with the term DUO serving a subservient role (to the extent it is used at all). Applicant's registration and use of DUO certainly would not cause a likelihood of confusion in the marketplace with the CLICKLINE DUO variation of the registrant's CLICKLINE brand.

Lack of likelihood of confusion is further attributable to a very high level of sophistication of the target consumers and the degree of care in purchasing the goods. The goods recited in the CLICKLINE DUO registration relate to surgery and other devices used by trained medical professionals with special skills. These professionals are sophisticated consumers who know the instruments they need to perform their duties, know the companies and brands that provide those instruments, and are very careful in selecting the right instruments for surgery and other medical care. They would be very unlikely to confuse brands for such critical equipment. Accordingly, it is respectfully submitted that the level of sophistication of the physician consumers and high degree of care in purchasing medical instruments militate against likelihood of confusion.

For at least the above-stated reasons, Applicant respectfully submits that the dissimilarity of the marks, and the sophistication and high degree of care of the relevant consumers compel the conclusion that there would be no likelihood of confusion.

B. U.S. Registration 4,792,730 for TESLA DUO

The cited stylized design mark in Registration No. 4,792,730 (“the ‘730 registration”) and Applicant’s mark also have significant distinctions that create different commercial impressions. The cited mark, TESLA DUO, consists of two words having a distinctive stylized appearance as follows:

Tesla^{DUO}

In contrast, Applicant’s mark is just one word. Applicant’s mark has nothing like the foundational “TESLA” element of the cited mark.

The cited mark has eight letters while Applicant’s mark has only three, and the cited mark contains four syllables to only two in Applicant’s mark. A consumer would notice these distinctions as he or she peruses the cited mark and likely would focus more on the first word “TESLA” because it is longer, prominently positioned and has some additional meaning as described above. The dominance of the term TESLA is strongly reinforced by the listing of DUO in a smaller, superscript font, clearly communicating to consumers its subservience as a source designator. By contrast, in Applicant’s mark, the term DUO is the primary (and indeed sole) source designator, creating a distinctly different overall commercial impression.

Significantly, “TESLA” is a well-recognized term due to the fame of the historic individual and the electric car company that uses his name as a brand. These factors further contribute to TESLA being the dominant word in the cited mark.

For at least these reasons, the cited mark and Applicant’s mark generate very different commercial impressions, which militate against likelihood of confusion.

There are also significant differences between the goods in the cited TESLA DUO ‘730 registration and those of the present application. The identification of goods in the ‘730 registration are primarily surgical instruments. By contrast, Applicant’s goods are stethoscopes, EKG machines, and other non-invasive medical apparatus and instruments. These distinctions result in different target consumers. The goods in the cited registration are used by surgeons in operating rooms of hospitals while the goods in the present application are used by primary care doctors and physician’s assistants in medical offices. In addition to being distinct customer segments, they use different product procurement processes. Due to the differences in goods and consumers, it is believed that there would be no likelihood of confusion between the cited mark and the present mark.

Applicant also notes that the level of sophistication of the target consumers and degree of care in purchasing the goods are very high. The goods in the TESLA DUO registration relate to surgery and other devices used by trained medical professionals with special skills. These professionals are sophisticated consumers who know the instruments they need to perform their duties, know the companies and brands that provide those instruments, and are very careful in selecting the right instruments for surgery and other medical care. They would be very unlikely to confuse brands for surgical instruments, on the one hand, with brands for non-invasive primary care medical instruments such as stethoscopes and EKG machines, on the other hand. Accordingly, it is respectfully submitted that the level of sophistication of the physician consumers and high degree of care in purchasing medical instruments militate against likelihood of confusion.

For at least the above-stated reasons, Applicant respectfully submits that the dissimilarity of the marks, the dissimilarity of the goods, and the sophistication and high degree of care of the relevant consumers compel the conclusion that there would be no likelihood of confusion.

C. Clarification of the Identification of Goods

The Examining Attorney has requested clarification of the identification of goods in Class 10. The identification of goods is amended herein in accordance with the Examining Attorney's suggestions, as follows:

- *International Class 10*: Stethoscopes; digital stethoscopes; EKG machines; non-invasive medical apparatus and instruments, namely, digital stethoscopes for auscultation; non-invasive medical apparatus and instruments, namely, digital stethoscopes and EKG machines, for monitoring, recording, reproducing and electronically transmitting information indicative of heart rate, heart sounds, and heart function; non-invasive medical apparatus and instruments, namely, digital stethoscopes and EKG machines, for recording and electronically transmitting cardiac measurements to remote computing devices for cardiac analysis using, namely, application of machine learning-based diagnostic and classification techniques; non-invasive heart monitors

It is believed all the issues in the Office Action have been addressed, such that the application is now in condition for registration. If the Examining Attorney believes further discussion would be helpful, a telephone call to the undersigned is invited.

Respectfully submitted,

Dated: 10/8/2019

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