

OFFICE ACTION RESPONSE: ITURN (and Design)
(Ser. No. 88/315,324)

The application filed by KAP Medical (the “Applicant”) to register the mark, ITURN (and Design) (the “Mark”), for various goods in International Class 10 and 20 (the “Applicant’s Goods”), was refused based upon a (i) request for a revised description of the Mark; and (ii) perceived likelihood of confusion with the pending application for the mark ITURN TECHNOLOGY (App. Ser. No. 87/794,088) (the “Cited Mark”), for use in connection with “*electrically powered vehicles, namely, scooters and power chairs, for use by handicapped, infirm or disabled persons; drive control mechanism that controls the turn radius for scooters or power chairs; repair and replacement parts for scooters or power chairs*” in Class 12 (the “Cited Goods”).

I. PRELIMINARY AMENDMENT TO APPLICANT’S GOODS.

As a preliminary matter, Applicant submits the following revision to the recitation of Applicant’s Goods in order to clarify the nature of Applicant’s Goods as compared to the Cited Goods:

Int. Cl. 10: “*Specialty support surfaces, namely, supports for general medical use in the form of mattresses, mats, pads, and therapeutic overlays for use in the prevention of decubitus ulcers and to provide pulmonary therapy*”

Int. Cl. 20: “*Bed frames for use in the prevention of decubitus ulcers and to provide pulmonary therapy*”

II. REVISED DESCRIPTION OF THE MARK.

Per the requests outlined in the Office Action, Applicant revises the description of the Mark as follows:

The mark consists of the stylized wording "ITURN" with the letter "i" appearing in larger font to the left of the smaller letters "TURN", which appear below a human silhouette figure laying on a bed formed by the letters “TURN”.

III. THE MARK AND THE CITED MARK ARE NOT LIKELY TO BE CONFUSED.

Likelihood of confusion is synonymous with “probable” confusion—it is not sufficient if confusion is merely “possible.” *Brennan's, Inc. v. Brennan's Restaurant, L.L.C.*, 360 F.3d 125, 135, 69 U.S.P.Q.2d 1939 (2d Cir. 2004). The test for a likelihood of confusion entails thirteen separate factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (C.C.P.A. 1973). While no single factor is dispositive, the significance of a particular factor may differ from case to case, and any one factor may control a particular case. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). It follows that the

likelihood of confusion analysis does not end with a review of the similarities between the Mark and Cited Mark.

In considering Applicant's Mark, and particularly following the revisions to Applicant's Goods as outlined in this response, the second *du Pont* factor ("the similarity or dissimilarity and nature of the goods and services"), the third *du Pont* factor ("similarity or dissimilarity of established, likely to-continue trade channels"), and the fourth *du Pont* factor ("conditions under which and buyers to whom sales are made") are most relevant.

While the Office Action does not include any specific justification, one can infer that the Cited Mark was identified as a potentially conflicting earlier filed application because of the attendant goods sold thereunder. However, particularly after considering the revisions to Applicant's Goods made along with this response, the parties' goods 1.) are *not* similar or commercially related, and 2.) do *not* travel in the same trade channels. Therefore, they do not give rise to a mistaken belief that the goods emanate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); TMEP § 1207.01(a)(i). Furthermore, the inference that no consumer confusion would result from coexistence of the parties and their respective trademarks is reinforced by the fact that these products are expensive and that neither is an "impulse purchase."

1.) The Applicant's Goods are Not Commercially Related to the Cited Goods.

There are notable differences between Applicant's Goods and the Cited Goods. On the one hand, Applicant's Goods are stationary, highly specialized medical beds and the component elements thereof (*i.e.* mattresses, mats, pads and overlays). Applicant's Goods are sold to medical care providers for reducing instances of decubitus ulcers amongst patients and to provide pulmonary therapy. On the other hand, the Cited Goods are "*electrically powered vehicles*" in the form of scooters and power chairs sold to handicapped, infirm or disabled persons, and the component drive control mechanisms and replacement parts therefor. Consumers are unlikely to associate a producer of mobile vehicles with that of stationary beds and component products. Each serves a different purpose and there is no relationship or competitive proximity between them. Absent some significant relationship or competitive proximity between the goods provided in connection with each mark that suggests there is a commercial relationship, a likelihood of confusion will *not* exist. *See, Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004).

In *Shen*, the Federal Circuit made clear that no significant relationship or competitive proximity can be established where products are designed for distinct purposes. Examples provided in *Shen* include: (i) a barbecue mitt and gloves (not competitive though each is a type of hand covering and technically a "glove"), and (ii) hard hats and fedoras (not competitive though each is a head covering and technically a "hat"). *Id.* Though each of the foregoing share definitional commonalities, they are designed for different purposes, such as keeping hands or heads warm, as opposed to protection. The same is true in the instant case.

In fact, the Applicant's Goods and Cited Goods are even less related than those exemplified in *Shen* – as one party makes medical beds sold to caregivers that are designed to address

particular medical issues suffered by bedridden patients (*see Exhibit A*) while the other makes “*electrically powered vehicles*” for purposes of “personal mobility.” *See Exhibit B*, showing use of the Cited Mark in promotion of the Cited Goods and touting its maneuverability. The products of the parties are designed for divergent purposes and unrelated, and thus share no significant relationship or competitive proximity. Thus, the *Shen* standard dictates that there cannot be a likelihood of confusion between the Mark and Cited Mark (particularly when considering that the marks are not even identical – as they were in *Shen*).

In fact, use of identical marks on far more related goods have been found unlikely to cause consumer confusion. *See e.g., United Foods Inc. v. United Air Lines Inc.*, 41 U.S.P.Q.2d 1653 (TTAB 1995) (“UNITED EXPRESS” marks used by the parties in connection with transportation services deemed not to be confusingly similar); *Lenox Inc. v. Ranmaru U.S.A. Corp.*, 17 U.S.P.Q.2d 1696 (S.D.N.Y. 1990) (“TUXEDO” was used by each party on dinner plate designs, however no likelihood of confusion found); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (“BOTTOMS UP” for men's suits, coats and trousers not confusingly similar with ladies' and children's underwear); and *In re Dominion Auto Accessories Ltd.*, 200 U.S.P.Q. 389 (TTAB 1978) (“SHOCK-FREE” for vehicle lamps not confusingly similar with the same mark for motor vehicles). In each of the foregoing examples, the marks at issue were identical and the relevant goods and services fall into such similar categories that they would likely be used and encountered by the same target audiences and used for the same purposes. In the instant case, the marks are *not* identical and are used in connection with *divergent* goods (medical beds vs. electrically powered vehicles) that inherently serve divergent purposes (prevention of decubitus ulcers and administration of pulmonary therapy vs. personal mobility for disabled persons). As such, consistency requires that the Mark and Cited Mark also be deemed *not* confusingly similar.

All of the foregoing strongly weighs in favor of a finding that the Mark and Cited Mark are not confusingly similar.

2.) *Applicant’s Goods Do Not Travel in the Same Channels of Trade as the Cited Goods.*

Goods that are “non-competitive, differ completely in utility, have nothing in common with respect to their essential characteristics or sales appeals, and, . . . are expensive” suggest that the associated channels of trade are different. *See, In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1550 (TTAB 2015). *Even identical trademarks*, when presented through different trade channels in different markets, can co-exist without a likelihood of confusion. *Id.* at 1551 (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade) (emphasis added). The foregoing is true in the instant case, particularly where the marks at issue are not identical.

Applicant’s Goods do not compete with the Cited Goods because Applicant does not use the Mark to promote personal mobility products of any kind. Indeed, use of Applicant’s Goods inherently results in the patient remaining in bed (as opposed to traveling around in electrically powered vehicles). Further, the parties’ products differ completely in utility and have nothing in common with regard to their essential sales appeals because the Applicant’s Goods are provided for the purpose of reducing instances of decubitus ulcers amongst patients and to provide

pulmonary therapy, while the Cited Goods are provided for the purpose of improving mobility for handicapped, infirm or disabled persons. *See Exhibit A.*

Finally, the parties' products are expensive. Indeed, Applicant's Goods and the Cited Goods are typically very expensive. The Cited Goods cost at least \$1,699. *See Exhibit C.* Applicant's Goods can cost as much as \$10,000. *See Exhibit D.*

All the foregoing strongly weighs in favor of a finding that the Mark and Cited Mark are not confusingly similar.

3.) Consumer Confusion is NOT Likely Because Neither Party's Goods are Purchased on Impulse.

It is well established that circumstances suggesting care and sophistication in purchasing tend to minimize any 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). Neither Applicant's Goods nor the Cited Goods are purchased on impulse. Indeed, Applicant's Goods and the Cited Goods are typically very expensive. The Cited Goods cost at least \$1,699. *See Exhibit C.* Applicant's Goods can cost as much as \$10,000. *See Exhibit D.* Further, neither product is a fungible good that is replaced or "used up" with frequency. The expensive nature of the parties' goods and the longevity thereof suggests that purchases are reviewed and considered very thoughtfully prior to sale, wholly unlike a point-of-sale purchase or other "impulse" purchase. This naturally results in a high level of care and review in purchasing and minimizes the potential for a likelihood of confusion; further suggesting that no likelihood of confusion would result from registration and continued use of the Mark.

IV. CONCLUSION

For all the reasons set forth above, Applicant respectfully requests that the Office approve the Mark and its application for publication.