

APPLICANT'S RESPONSE TO OFFICE ACTION

The Applicant is responding to the Office Action dated May 10, 2019 (the "Office Action"). Pursuant to 37 C.F.R. §2.62(a) and TMEP § 711, the Applicant, Biorez, Inc. ("Applicant") respectfully submits this Response to Office Action (the "Response") in regards to Application Serial No. 88322262 (the "Application") for the mark BIOBRACE ("Applicant's Mark").

The Applicant hereby responds to each of the issues identified in the Office Action as follows:

I. Identification of Goods

In order to respond to and resolve the issues raised in the Office Action, and clarify its goods in light of the Section 2(d) refusal, The Applicant respectfully requests that the goods in the Application be amended as follows ("Applicant's Goods"):

Class 10: Bioresorbable *tissue-engineered scaffold* implant that facilitates the regeneration of new tissue, *namely a tissue-engineered scaffold implant implanted internally by a surgeon in a patient's body that is fully bioresorbable and remodels into functional tissue that enables the patient's body to heal itself without the pain and risks associated with traditional surgical implants.*

II. No Likelihood of Confusion Exists between the Applicant's Mark and the Cited Marks

The Examining Attorney has issued a refusal to register the Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that it could likely be confused with Registration No. 5232413 (the "Cited Mark"). The Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register based on the identification amendment above and the following arguments.

The standard for determining whether two marks are likely to be confused is set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01. The *DuPont* case establishes a number of factors to be considered in the analysis of whether two marks are likely to be confused under Trademark Act Section 2(d). Each factor may play a more dominant or diminished role, depending on the facts of each case. *DuPont*, 177 USPQ at 567. No single factor is dispositive. *Id.* The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. *See In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985).

In this case the most relevant *DuPont* factors are: (1) the dissimilarities in the goods identified by Applicant's Mark and the Cited Mark; (2) the dissimilarity of the established, likely-to-continue trade channels; and (3) the sophistication of the relevant consumers.

Under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not just possible. As the Second Circuit has

stated, “likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely ‘possible.’” *Estee Lauder, Inc. v. Gap, Inc.*, 42 USPQ2d 1228, 1232 (2nd Cir. 1997) (internal quotations omitted) quoting 3 J. McCarthy, *Trademarks and Unfair Competition*, § 23:2 (1996) (now at 4 *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2017)). When the relevant *DuPont* factors are considered in relation to Applicant’s Mark, each factor weighs in favor of allowing Applicant’s Mark to register.

A. The Applicant’s Goods Are Sufficiently Different From the Cited Goods to Eliminate Any Potential For Confusion.

The Examining Attorney states that Applicant’s Goods and Registrant’s Goods “are similar or complementary in terms of purpose or function” and, therefore, a likelihood of confusion exists. The Applicant respectfully disagrees.

1. The Goods Are Different

First, the goods themselves are so different that they cannot be considered similar or complementary in terms of purpose or function. Goods should not be considered related or similar or complementary merely because both are related to the medical industry. It has been clearly established that the medical industry “is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties’ respective products.” *Astra Pharm. Prod., Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 791 (1st Cir. 1983) (finding no confusion between ASTRA for pharmaceuticals and ASTRA for medical products marketed to hospitals). *See also, Hewlett Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1395 (T.T.A.B. 1991). “[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.” *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029, 1034 (S.D.N.Y. 199) (“while [both parties] furnish products related to the broad field of finance, [they] are completely unrelated as night and day.”); *Munters Corp. v. Matsui Am., Inc.*, 730 F. Supp. 790, 798 (N.D. Ill. 1989) (“In some, *albeit non-meaningful*, sense, all products are related” (emphasis supplied)).

The description of goods in a registration is indicative only of “the registrant’s exclusive right to use the mark in commerce on or in connection with the goods or services specified in the certificate.” 15 U.S.C. §1057(b). Trademark rights extend only as far as necessary to prevent consumer confusion. *See et al., T.M.E.P. 1207.01(a)(iii); Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360 (7th Cir. 1995); *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42, 45 (1st Cir. 1991) (“The trademark statute does not give the appellants any ‘property right’ in their mark *except* ‘the right to prevent confusion’”). There can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *T.M.E.P.* § 1207.01(a)(iv).

Similarity in one, generalized aspect is not sufficient if otherwise the goods or services are “plainly different things, different in size, shape, concept, purpose, appearance, and price.” *Safeguard Business Systems, Inc. v. New England Business Systems*, 696 F. Supp. 1041, 9 U.S.P.Q.2d 1051,

1055 (E.D. Pa. 1988) (emphasis supplied). *See also, Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176 (11th Cir. 1985) (holding no likelihood of confusion between FREEDOM realty services and FREEDOM savings and loan services despite a close proximity of services in home procurement).

As a matter of law, no trademark owner enjoys a monopoly in its mark with respect to *all* goods or services, and even similar marks often co-exist with no danger of consumer confusion when they are used with sufficiently different goods or services, especially in the healthcare arena. *See Quality Inns Int'l v. McDonald's Corp.*, 8 U.S.P.Q.2d 1633 (D. Md. 1988). In fact, in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.* 718 F.2d 1201 (1st Cir 1983), the First Circuit stated that a “registered mark does not allow [the registrant] to pre-empt the whole broad field of health care products, especially as to other goods in that field that are totally dissimilar to its products.”

As in the foregoing cases, Applicant's Goods and the Cited Mark's goods are not similar, complementary or related, despite the fact that one includes the term *brace* and the other *implant*. By the plain language of the Cited Mark's goods and Applicant's Goods, as amended, these goods simply do not overlap. The Cited Mark goods are “braces for limbs and joints, for medical use.” A review of the specimen submitted by the Registrant for the Registration reveals that the brace marketed under the Cited Mark is a healthcare product consisting of a fabric arm brace to be placed by the individual consumer on the exterior of the arm. *See Exhibit A*. A review of the Registrant's website at www.biobrace.com further establishes that the fabric exterior brace with acupuncture pressure point beads within the fabric brace are to be placed by the individual consumer externally over the consumer elbow on a temporary basis to relieve elbow pain from the discomfort created by repetitive motion or sports related injuries such as tendinitis or tennis elbow and that consumers can order the product on the Registrant's website for \$79.95. *See Exhibit B*.

In contrast, Applicant's Goods are a “bioresorbable tissue-engineered scaffold implant that facilitates the regeneration of new tissue, namely a tissue-engineered scaffold implant implanted internally by a surgeon in a patient's body that is fully bioresorbable and remodels into functional tissue that enables the patient's body to heal itself without the pain and risks associated with traditional surgical implants.” Due to the nature of Applicant's Goods, none of the externally placed temporary fabric elbow brace products identified in the Registrant's goods and shown in the Registrant's submitted specimen (or Registrant's website) would be included in the Applicant's Application nor would the Applicant's Goods be available to be purchased online directly by the individual consumer for a nominal fee. In fact, the Applicant submits that Applicant's Goods and the Cited Marks' goods are mutually exclusive and intended to be used by wholly separate consumers.

Offering a temporary use externally placed fabric arm brace on a website for an individual consumer with tennis elbow to purchase is a completely different type of good from a tissue-engineered scaffold implant implanted by a surgeon in the patient's body that requires the patient to seek the services of physician or an orthopedic surgeon at a significant cost to the consumer or its insurer to schedule a medical procedure in a hospital or surgical center in order to implant the Applicant's Goods. In contrast to the Registrant's consumer, the consumer of Applicant's Goods is likely to be the orthopedic surgeon performing the surgery or the hospital or surgical center where the procedure is performed.

Individual consumers looking for a surgical solution for a serious orthopedic problem would not go to a website that sells temporary use externally placed fabric braces for \$79.95. They would instead seek medical advice from an orthopedic surgeon who would provide the medical diagnosis to implant Applicant's Goods internally in the patient in a hospital or surgical center setting and the hospital or surgical center or the orthopedic surgeon would make the purchase of Applicant's Goods. Given this, the audiences and consumers are completely different. The Applicant's audience is clinicians, hospitals and surgical centers, namely orthopedic surgeons that regularly perform expensive, complex orthopedic surgery implanting bioresorbable tissue-engineered scaffold implants internally in their patients in order to provide permanent relief for an orthopedic health issue. In contrast, the Registrant's audience are primarily individual consumers looking for an inexpensive temporary solution to wear externally on their elbow to provide temporary relief from the pain of tennis elbow.

Finally, to block any trademark registration that might someday be used with any type of external fabric brace would grant Registrant an effective monopoly to use the Cited Mark across the entire orthopedic industry. Most, if not all, goods in the orthopedic field treat joint conditions in some regard. Thus, the mere fact that a good may treat a joint condition cannot mean that it is related to all other orthopedic related goods used in the orthopedic industry.

2. The Goods Are Not Complementary

The Examining Attorney states that that the Applicant's goods are similar or complementary to Registrant's goods. The Applicant asserts that the term 'complementary' is analogous to "used together". The Federal Circuit has stated that "used together" is not alone determinative, but must be considered in the overall mosaic of evidence: "[T]he test is not that the goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue . . . can be related in the mind of the consuming public as to the origin of the goods." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000) (emphasis added); *see also* MCCARTHY, *supra*, § 24:26.

Thus, a mere fact, let alone possibility, that two goods are used together for a similar purpose or function does not, in and of itself, demand a finding that confusion is likely. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) ("That two goods are used together, however, does not, in itself, justify a finding of relatedness." No likelihood of confusion was found between RITZ for kitchen towels and aprons and RITZ for cooking classes.); *see also* MCCARTHY, *supra*, § 24:26.

As the *Packard Press* and *Shen Mfg.* courts require, the likelihood of confusion determination must be made from the viewpoint of the consumers of the relevant services – here, orthopedic surgeons dealing with surgical implantation of tissue-engineered scaffold implants and hospital purchasing personnel vs. individual consumers looking to purchase an inexpensive external fabric elbow brace to provide temporary relief from tennis elbow. The fact that both the goods might be used to provide relief for joint pain, as to Registrant's: inexpensive, temporary and external, vs. as to the Applicant's: expensive, permanent, surgically implanted and orthopedic surgery, is not enough to find that confusion is likely.

The goods are simply not related. Consumers understand that the vast differences in an externally placed fabric brace for temporary relief of a sore elbow on the one hand and a surgically implanted tissue-engineered scaffold implant on the other makes it unlikely that these goods emanate from the same source. Consumers are not likely to become confused that these goods are likely to emanate from the same source just because both relate in some way to joint pain relief or repair. Indeed, nearly every exterior brace or surgical implant good or product available in the orthopedic field today relates to joint pain relief or repair of some kind.

In cases where the goods are dissimilar, as in this case, no likelihood of confusion will be found even if the marks are arguably alike. See *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 73 USPQ2d 1350 (Fed Cir. 2004) (cooking classes and kitchen textiles not related under RITZ marks); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1931 n.16 (TTAB 1993) (computer programs sold under KNOWLEDGE FINDER not similar to computer programs sold under INFORMATION FINDER); *Flow Technology, Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991) (OMNITRAX for computer programs not likely to be confused with OMNITRAK for flowmeter calibrator); *Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990) (confusion not likely between LITTLE PLUMBERS for liquid drain opener and the identical mark for advertising services marketed to plumbing contractors); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g. lamps, tubes) relating to the photocopying field).

Based on the above, the Applicant respectfully submits that the goods involved are too different, target much different consumers, and are not similar or complementary such that there is no likelihood of confusion.

B. Applicant's and Registrant's Goods Will Be Marketed and Offered in Distinct Channels of Trade and to Sophisticated Consumers.

As a result of the considerable differences in the respective goods and their fields of use, the conditions and activities surrounding their marketing, distribution, and use will be such that they will not be encountered by the same class of consumers or under the same circumstances that could give rise to the mistaken belief that they originate from the same source. *See* 1207.01(a)(i); *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark). In order to support a likelihood of confusion, the circumstances must be such that consumers will be confused as to source. TMEP §1207.01(a)(i). In this case, the respective goods are so distinct and are offered in different channels of trade such that confusion is unlikely.

The Applicant's market for its cited goods consists of orthopedic doctors and orthopedic surgeons in orthopedic surgery centers and hospitals. The Applicant's Mark is used in connection with orthopedic surgeries provided by highly trained orthopedic surgeons for their patients. On the other hand, the Cited Mark's goods are directed to the individual consumer market on the Registrant's website to provide an inexpensive temporary fabric brace solution to be placed and worn by an individual consumer externally for temporary relief from elbow pain and will not be

marketed in the same channels as Applicant's Goods. These goods have very different uses (permanent vs. temporary, external vs. internal, expensive vs. inexpensive; individual consumer vs. orthopedic surgeon or hospital or surgery center) and travel in distinct and different channels of trade. Similar to the Trademark Trial and Appeal Board's reasoning in *In re Orphan Pharmaceuticals, U.S.A., Inc.*, while both goods are generally marketed in the health field, the purpose and use of the goods are so distinct that the trade channels and classes of purchasers are distinct.

Furthermore, it must be borne in mind that even "a tiny percentage" of crossover business "is a very weak evidentiary basis for a finding of relatedness." *In re Coors Brewing Co.*, 68 USPQ2d 1059 (Fed. Cir. 2003) (degree of overlap in the sources of BLUE MOON for beer and BLUE MOON for restaurant was de minimis, no likelihood of confusion). Given the unique markets in which the parties' goods move, it is highly doubtful the offerings of the respective parties will even be encountered together by prospective purchasers at all, let alone in a context-giving rise to confusion by each product's likely consumer. Thus, even if there were some overlap, confusion is nonetheless unlikely to occur among consumers. *See Fruit of the Loom Inc. v. Fruit of the Earth Inc.*, 3 USPQ2d 1531, 1533 (TTAB 1987).

Additionally, the Applicant's and the Registrant's consumers will exercise a high degree of care in selecting the appropriate offerings necessary to provide temporary vs. permanent relief from their orthopedic pain or repair. The respective customers are making a selection taking into consideration potentially requiring a significant monetary investment for a specific medical purpose and potentially going through surgery and the requisite recovery and will take care in selecting the source for their purchase. *Checkpoint Systems Inc. v. Check Point Software Technologies Inc.*, 60 USPQ2d 1609, 1618 (3d Cir. 2001). Where consumers exercise a higher degree of care any possibility of confusion is substantially mitigated. *See In re Vision Wheel, Inc.*, Serial Nos. 77498758 and 77498755 (TTAB, July 28, 2010) (the Board found that there was no likelihood of confusion between V-TEC for custom wheels and V-TEC for car engines; conditions of sale lead to a high degree of care when making purchases). Further, a purchaser who has a "reasonably focused need" or "specific purpose" or plan for the product, will exercise a high degree of care in selecting the product that meets his or her needs. *See e.g. Haydon Switch & Instr., Inc. v. Rexnord, Inc.*, 4 USPQ2d 1510, 1517 (D. Conn. 1987) (specific products for specific industrial purpose); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295 (Fed. Cir. 1990) ("focused need" for champagne); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publi'g Group, Inc.*, 886 F.2d 490, 496 (2d Cir. 1989) (reader of Cliffs Notes probably has specific book in mind).

It is clear from the foregoing that the respective offerings move in distinct channels of trade, and are marketed to distinct classes of sophisticated consumers with very specific concerns. In view of the differences in the respective goods and fields of use, the consumers who seek Applicant's Goods will not seek or encounter the goods marketed by Registrant under the Cited Mark, and vice versa. Since any connection between the respective consumers and resulting channels of trade is unlikely, confusion as to the source of the respective goods is not probable.

C. Summary

In view of the foregoing, the Applicant respectfully asserts that the refusal under Trademark Act

Section 2(d) based on the Cited Mark is inappropriate because the threshold of a probability of confusion has not been met. The differences between the respective goods, the respective consumers, and the respective channels of trade compel the conclusion that a likelihood of confusion is remote.

It should be noted that the Examining Attorney has no duty to proactively extend the Registrant's protection to market areas in which trademark confusion does not exist. The registration process is designed to provide to the Registrant the ability to prove and defend the scope of protection in an opposition proceeding, due to the realistic limits of the Examining Attorney's knowledge of the relevant products and marketplace factors. The Registrant is rightfully entitled to oppose Applicant's Mark and make a showing of facts to challenge Applicant's Mark, even if the Examining Attorney agrees that the Applicant's Mark is not likely to confuse any segment of the public as found in the marketplace. In this case, sufficient evidence exists to shift the Examining Attorney's burden to the Registrant to prove why Applicant's Mark is likely to cause confusion in the marketplace at the opposition stage of the process.

The Applicant therefore respectfully requests that the Examining Attorney withdraw the refusal under Section 2(d) based on the Cited Mark.

III. Conclusion

The Applicant submits that with the responses and arguments above, all of the issues raised by the Examining Attorney in the Office Action have been resolved. The Applicant therefore respectfully requests that the Application be approved for publication.

The Examining Attorney is invited to contact the undersigned with any remaining questions or concerns.

Respectfully submitted,

Catherine Intravia, Esq.
Attorney for the Applicant

Exhibit A



ForeArmed

Active Implant Device

 BioBrace | www.biobrace.com

Exhibit B



Developers of Active Pressure Point Therapy products including the **ForeArmed** elbow brace

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