

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

In re Trademark Application of

Applicant: Checkpoint Surgical, Inc.

Appl. Ser. No: 88/650,936

Filed: October 11, 2019

IC: 010

Mark: BEST

RESPONSE TO OFFICE ACTION

Examining Attorney: Yocheved Bechhofer

Trademark Law Office 114

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**RESPONSE TO OFFICE ACTION**

Applicant, Checkpoint Surgical, Inc. (“Applicant”), by and through its undersigned counsel, submits the following remarks in response to the Examining Attorney’s January 17, 2020 Office Action.

**I. STATEMENT OF FACTS.**

On October 11, 2019, Applicant filed U.S. Application Serial No. 88/650,936 (the “Application”) for the above-captioned BEST mark (“Applicant’s Mark” or “Applied-For Mark”). The Application was filed on a 1(b) “intent-to-use” basis pursuant to 15 U.S.C. §1051(b) for the following goods in International Class 021, and on a 1(a) “actual-use” basis pursuant to 15 U.S.C. §1051(b) for the following goods in International Class 010, as amended herewith, (the “Applied-For Goods”):

- Class 010: *electrical* stimulator ~~for applying that applies~~ electrical pulses directly to tissue *for the purpose of peripheral nerve regeneration*.

On January 17, 2020, Examining Attorney Yocheved Bechhofer (the “Examining Attorney”), issued an office action (the “Office Action”) refusing registration of Applicant’s Mark on the basis that the Mark, for use in connection with the above goods: (1) so resembles

the mark in U.S. Ser. No. 5,765,972<sup>1</sup> (the “Cited Mark” and the “Cited Application” respectively) that it would make confusion likely under the Trademark Act Section 2(d), 15 U.S.C. § 1052(d); (2) is merely descriptive as defined under the Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1); and (3) requiring an amendment to the identification of goods.

As further set forth herein, Applicant asserts that consumers are not likely to be confused as to the source of the Applied-For Mark, the Applied-For Mark is suggestive in nature and is not merely descriptive, and that the Applied-For Mark should be allowed for registration.

Accordingly, Applicant respectfully requests that the Examining Attorney reverse his refusals and allow the Application for registration on the USPTO Principal Register.

**II. LAW & ARGUMENT: THE 2(D) REFUSAL OF APPLICANT’S APPLICATION TO REGISTER BEST SHOULD BE REVERSED BECAUSE THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE APPLIED-FOR MARK AND THE CITED MARK.**

The Board and the courts look to a number of factors when determining whether there is a likelihood of confusion between allegedly conflicting trademarks. These factors include, without limitation, the following:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, meaning, and commercial impression;
2. The similarity or dissimilarity of the goods and/or services as identified in the application or registration;
3. The similarity or dissimilarity of established, likely-to-continue trade channels used to distribute the goods and/or services offered under the two marks;
4. The degree of care that purchasers of the goods and/or services offered under the two marks are likely to exercise, i.e., “impulse” versus careful, sophisticated purchasing;
5. The number and nature of similar marks in use on similar goods and/or services;
6. The intent of the junior user in selecting its mark; and

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<sup>1</sup> U.S. Reg. No. 5,765,972 identifies the mark BEST, for use in connection with “Electronic stimulation devices for nerves, skin, and muscles for medical use,” in International Class 010.

7. The nature and extent of any actual confusion, or the length of time during which there has been concurrent use without evidence of actual confusion.

*See, e.g., In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (1973) (cited in numerous Federal Circuit Court and Board decisions to provide the “likelihood of confusion” standard). *See also Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539 (6th Cir. 2005) (citing similar factors); *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 421-22 (6th Cir. 1999) (citing similar factors).

As demonstrated below, a preponderance of these factors, weigh against a likelihood of confusion. These factors tilt the balance heavily in favor of a finding of no likelihood of confusion. For these reasons, Applicant respectfully requests that the Examining Attorney reconsider and reverse her 2(d) refusal and allow the Application for registration.

*A. Applicant’s Applied-For Goods And the Goods Recited In The Cited Registration Are Dissimilar And Unrelated And Travel Through Different Channels of Trade; As Such, This Factor Weighs Against A Finding Of Likelihood Of Confusion.*

Courts consistently state that one cannot justify a finding that goods and services are related simply because they are sold or used within the same industry. *See PC Club v. Primex Techs., Inc.*, 32 Fed. Appx. 576, 578 (Fed. Cir. 2002) (unpublished) (“Goods are not related because they coexist in the same broad industry”); *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991) (“services are ‘related’ not because they coexist in the same broad industry”).

Here, the goods and services as recited in the Cited Registration differ from the Applicant’s Applied-For Goods. The Registrant’s goods are “electronic stimulation devices for nerves, skin, and muscles for medical use.” The purpose of Registrant’s goods are to provide its user with temporary pain relief. See Exhibit A attached hereto, for the substitute specimen filed by the Registrant on March 7, 2019 in support of the registration of the Cited Mark. Notably, the

Registrant describes its goods to consumers as a device that aids in the treatment for chronic pain as a substitute for surgery. *Id.* On the other hand, Applicant's Applied-For Goods, as amended herewith, are "electrical stimulator that applies electrical pulses directly to tissue for the purpose of peripheral nerve regeneration". The purpose of Applicant's Applied-For Goods are to promote permanent nerve regeneration to accelerate and improve patient recovery. See Exhibit B attached hereto, which includes an excerpt about Applicant's Applied-For Goods. Contrary to the purpose of the goods under the Cited Registration, Applicant's goods are meant to be used as a supplement to surgery to stimulate the recovery of a patient's nerves post-operation. *Id.* As such, Applicant's consumers and Registrant's consumers would not be confused as to the source of the goods, since they are intending to purchase vastly different goods that have different applications.

The Examining Attorney cannot justify, without additional evidence, that these types of goods are similar simply because they may be used within the medical industry. *See Kibler v. Hall*, 843 F.3d 1068, 1076–77 (6th Cir. 2016) ("Products belonging to the same industry are not necessarily related"). Given the differences between Applicant's Applied-For Goods and the goods and services identified in the Cited Registrations, it is apparent that there is, and will be, no likelihood of confusion. As such, this factor weighs against a finding of a likelihood of confusion.

*B. Purchasers Of Applicant's Applied-For Goods, And Presumably, Of Registrants' Goods, Exercise A High Degree of Care In Selecting Such Goods And Services; Accordingly, Such Purchasers Are Unlikely To Be Confused As To Source.*

Another Dupont factor to be considered in analyzing whether a likelihood of confusion exists is the status of the potential purchasers and the circumstances of the purchase. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. Consumers are likely to exercise greater care in purchases, and thus have a lower likelihood of confusion, where the conditions of the sale of

the goods or services require purchasers to do their due diligence. *See In Re Vision Wheel, Inc.*, No. 77498755, 2010 WL 3164749, at \*5 (2010) (finding that purchasing automobile parts involves a careful process wherein a consumer must identify the year, manufacturer and model of a specific vehicle – “we find that the conditions of sale minimize any potential confusion”). Courts have observed that “common sense dictates a finding that consumers approach health care decisions with a high degree of care.” *Unity Health Plans Ins. Co. v. Iowa Health System*, 995 F. Supp. 2d 874, 891 (W.D. Wis. 2014).

Indeed, in *In re Carefirst of Maryland, Inc., Firsthealth of the Carolinas, Inc.*, 2005 WL 2451671, 77 USPQ2d 1492,1504 (TTAB 2005), the Board held that no confusion was likely between the marks for competitive health care plans, in part because consumers who purchase a health care plan are making a “very important decision” and as such, are likely to exercise “greater care, and will know with whom they are dealing.” Here, both Applicant’s goods and the goods under the Cited Registration require a medical doctor’s prescription to obtain such goods. See Exhibit A, p. 9 for a snapshot of the goods under the Cited Registration on a website called “Click to Scripts”; Exhibit C for a description of “Click to Scripts” as a website offering goods that require a prescription. In this context, consumers will be very careful in their purchase of Applicant’s Applied-For Goods, and they will know “with whom they are dealing” and they will not be confused as to source.

Due to the context in which consumers are purchasing the Applied-For Goods and the goods under the Cited Registration, and the necessity to consult a doctor prior to purchasing the goods, consumers are carefully considering and becoming knowledgeable about the goods they are contemplating purchasing, and are thus unlikely to be confused as to the source of those goods.

Furthermore, it is well-established that where goods are high-cost, potential purchasers are likely to be (or to become) more knowledgeable about the goods that they purchase and, therefore, to exercise special care in such purchases. In this sense, the purchasers of key high-cost goods and services are “sophisticated” in that they are more knowledgeable about the goods or services that they seek, and therefore, they exercise special care in such purchases. These types of circumstances make consumer confusion less likely. See *PC Club v. Primex Technologies, Inc.*, 32 *Fed.Appx.* 576, 579 (Fed. Cir. 2002) (noting the difference between impulse versus careful, sophisticated purchasing). Here, the Applied-For Goods and the goods under the Cited Registration are fairly expensive, and are not routine purchases that consumers typically make on impulse. See Exhibit A, p. 9 for a snapshot of the goods under the Cited Registration listed at a price over \$1,000.

Thus, each set of consumers in this case would not make decisions lightly with regard to their purchasing of either Applicant’s Applied-For Goods on the one hand, or Registrant’s goods on the other. Consumers of both parties’ goods would make purchases only after careful consideration. Accordingly, this factor weighs against a likelihood of confusion.

*C. Applicant Had A Good-Faith Intent In Selection Of Its Applied-For BEST Mark.*

Another Dupont factor to be considered in analyzing whether a likelihood of confusion exists is the intent of the applicant in registering the mark. See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. A finding of bad intent on behalf of an applicant in registering a mark weighs in favor of a finding of likelihood of confusion. See, e.g., *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1385 (Fed. Cir. 2006) (noting that a finding of bad faith intent weighs in favor of the registrant).

Here, there is no dispute that Applicant's selection of the Applied-For BEST Mark was made in good faith. There is nothing to suggest that Applicant had a bad faith motive in adopting and seeking to register its Applied-For Mark, or is seeking to trade on Registrants' goodwill. Accordingly, this Dupont factor also weighs in favor of a finding of no likelihood of confusion.

**III. LAW & ARGUMENT: THE 2(E)(1) REFUSAL OF THE APPLICATION TO REGISTER BEST SHOULD BE REVERSED BECAUSE THE APPLIED-FOR MARK IS NOT MERELY DESCRIPTIVE.**

The threshold test to determine whether a mark is merely descriptive under 15 USC § 1052(e)(1) is whether the mark "consists *merely* of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark." *In re TriVita, Inc.*, 783 F.3d 872, 874 (Fed.Cir.2015). A descriptive mark will directly convey "some knowledge of the characteristic of a product or service," to a potential consumer. 2 McCarthy on Trademarks and Unfair Competition § 11:51 (5th ed.). The Trademark Trial and Appeal Board (the "Board") has consistently held that "the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace." *In Re Apotex Techs. Inc.*, No. 78429952, 2007 WL 411948, at \*2 (Jan. 29, 2007).

On the other hand, a suggestive mark requires imagination, thought and perception to ascertain the nature of the goods or services. *See DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 103 USPQ2d at 1755 (citing *In re Abcor Dev. Corp.*, 200 USPQ at 218); *In Re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 2018 WL 2277123 (TTAB 2018). If one must "exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than

merely descriptive.” *In Re Mueller Sports Medicine, Inc.*, 126 U.S.P.Q.2d 1584, 2018 WL 2277503, at \*3-4 (TTAB 2018).

For the reasons set forth herein, the Applicant Asserts that the Applied-For Mark is not merely descriptive.

*A. The Examining Attorney Has Not Provided Sufficient Evidence To Show That The Term “BEST” Is In Fact Descriptive.*

An Examining Attorney has the burden of substantially showing that the term is in fact descriptive, based on clear evidence, for a descriptiveness refusal to the registration of a mark to stand. *See In re Am. Fertility Soc'y.*, 188 F.3d 1341, 1346 (Fed.Cir.1999). Here, the Examining Attorney relies on articles from *Best Viva*, *Gadget Reviews*, and *Top Best Pro Review*. *See the Office Action, Section 2(e)(1) Refusal.*

The articles that the Examiner provided are for “muscle stimulators.” As identified according to the amendment of goods submitted herewith, the Applied-For Goods relate to the stimulation of nerves, not muscles. Further, evidence from four internet sources cannot serve as clear evidence that a term is descriptive. Accordingly, the Examining Attorney has provided no evidence whatsoever that the Applied-For Mark is descriptive as applied to the Applied-For Goods. In other words, the Examining Attorney has failed to show that the average purchaser encountering the Applied-For Mark, in relation to the Applied-For Goods, in the marketplace would immediately think that the Applied-For-Mark describes the quality or purpose of the Applied-For Goods.

#### **IV. CONCLUSION**

For the foregoing reasons, it is clear that there is no likelihood of confusion, and the Applicant’s Applied-For Mark is not merely descriptive. Thus, Applicant respectfully requests that the Examining Attorney withdraw her 2(d) and 2(e)(1) objections contained in the above-



captioned Office Action and permit the Application, Serial No. 88/650,936, for the BEST Mark, for registration on the Principal Register without further refusal.

Respectfully submitted,

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