

### **Comments**

Applicant has essentially adopted the suggested goods and services. Applicant has revised “medicinal catheters” to “medical catheters”, as the catheters are designed for use without a drug coating. Applicant has also clarified that the introducer sheaths/catheters can include “support catheters”. A support catheter is a specific form of an introducer catheter/sheath and, thus, the goods description in Class 10 has not been broadened. Acceptance of the amendments is respectfully requested

### **Likelihood of Confusion Rejection**

The Office Action has cited Trademark Registration Nos. 2,524,137 (“OSCOR and Design”); 3,855,508 (“OSCAR”); and 5,479,532 (“OSCAR THERAPY”) against Applicant’s mark alleging that there may be a likelihood of confusion under § 2(d) of the Trademark Act.

Applicant respectfully traverses the Office Action’s rejection for at least the following reasons.

In determining whether there is a likelihood of confusion under § 2(d) of the Trademark Act, the various factors listed in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973) should be considered. A comparison of the goods and/or services must also be made to determine if they are related or if their marketing activities are such that confusion is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983). Importantly, likelihood of confusion requires that confusion be probable, not simply a possibility. *HMH Publishing Co. v. Brincat*, 504 F.2d 713, 717, 183 USPQ 141, 144 (9th Cir. 1974); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 804, 167 USPQ 713, 720 (9th Cir. 1970). The possibility that two goods or

services may interact in the same field with one another does not presume a likelihood of confusion. *Freedom Savings & Loan Association v. Way*, 757 F.2d 1176, 226 USPQ 123 (11th Cir. 1985), *cert. denied*, 474 U.S. 845 (1985) (FREEDOM for savings and loan services not confusingly similar to FREEDOM for real estate brokerage services); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F.Supp. 1029, 17 USPQ2d 1599 (SDNY 1990) (electronic financial information service and investment counseling unrelated); *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F.Supp. 445, 213 USPQ 1091 (SDNY 1982) (BENEFICIAL for consumer loans not confusingly similar to BENEFICIAL for business loans).

Applicant submits that its mark “OSCAR” when used on or in connection with the recited goods and services is sufficiently different from the cited marks “OSCOR and Design”, “OSCAR” and “OSCAR THERAPY” when used on or in connection with their respective goods and/or services, such that there is no likelihood of confusion.

**U.S. Reg. No. 2,524,137 - “OSCOR and Design”**

The Office Action takes the position that the design element in “OSCAR and Design” is a relatively minor design element that would not be focused on by consumers. The Office Action also takes the position that “OSCAR” and “OSCOR” are nearly identical and thus indistinguishable by consumers. Applicant respectfully disagrees.

The perceived relatively minor difference in spelling, along with the design element, actually creates a very distinct and different commercial impression. The design element in the cited mark is a stylistic representation of a heart. The meaning of “cor” in Latin means heart. Accordingly, the unique spelling of “OSCOR”, using “COR”, is intentional to provide a strong

association with the heart. Couple this with the heart design that is very prominent and constitutes the first portion of the cited mark, and consumers will readily associate the cited mark with the heart and that goods/services sold thereunder are specifically designed for the heart.

In contrast, Applicant’s mark is “OSCAR”. This term has a very different association, as it is a common name and also a movie award. Thus, the perceived relatively minor difference in spelling is, in reality, a very big difference in that it creates a big impact on the commercial impression of each mark and its association.

This difference has an even bigger impact since consumers of such products will be highly sophisticated medical personnel who will purchase such products only after careful and deliberate consideration. Medical personnel purchasing products designed for insertion or implantation into the human body are certainly not impulse purchasers. They will make such decisions only after long deliberations and discussions with the company providing such goods. This further points against any likelihood of confusion, as sophisticated medical product purchasers are readily able to distinguish between the marks and the source of the goods.

Accordingly, Applicant submits that there is no likelihood of confusion between Applicant’s mark “OSCAR” and the cited mark “OSCOR and Design” when the marks are used in connection with the parties’ respective goods and/or services.

**U.S. Reg. No. 3,855,508 - “OSCAR”**

The goods recited under the cited mark are:

- Medical and surgical instruments, namely, ultrasonically vibratable tools for **removing cement during joint-prosthesis revision and ultrasonically vibratable osteotomes.** (*Emphasis added*).

Clearly, such goods are specifically meant for orthopedic medical field. The vibratable tools are meant for removing cement during joint-prosthesis revision; and osteotomes are tools specifically designed for cutting and preparing bone. Such tools find use specifically in the orthopedic medical field.

Conversely, Applicants goods and services are all catheters and related devices all designed specifically for use in the medical field of cardiology. The two travel in distinctly different channels of trade with no overlap. Orthopedic doctors are not concerned with cardiology-related instruments and services. Cardiologists are not concerned with removing joint cement and bone cutting tools and other orthopedic instruments. Orthopedic doctors do not use cardiology related medical instruments; and cardiologists do not use orthopedic related medical instruments. The two are far removed.

Of particular importance is that Applicant has limited its goods and services to **specifically exclude orthopedics**: Class 10 - all the above goods not in the field of orthopedics; Class 44 - all the above services not relating to orthopedics. Thus, Applicant's goods and services will not be in the channel of trade related to orthopedics; further significantly mitigating any possible likelihood of confusion.

Moreover, such doctors and medical personnel are highly sophisticated and intelligent and readily able to distinguish between products and services having the same or similar marks, and are especially able to distinguish between products and services having completely different medical fields of use, as is the case herein.

Accordingly, Applicant submits that there is no likelihood of confusion between Applicant’s mark “OSCAR” and the cited mark “OSCAR” when the marks are used in connection with the parties’ respective goods and/or services.

**U.S. Reg. No. 5,479,532 - “OSCAR THERAPY”**

The services recited under the cited mark are:

- **Cognitive therapy** services for humans and animals. (*Emphasis added*).

Cognitive therapy is a form of psychotherapy which is based on the concept that the way we think affects how we feel emotionally. It focuses on present thinking, behavior and communication rather than on past experiences and is oriented toward problem solving. (See “[https://www.medicinenet.com/cognitive\\_therapy/definition.htm](https://www.medicinenet.com/cognitive_therapy/definition.htm)baseIn contrast”).

Cognitive therapy has three main goals:

1. To relieve symptoms and resolve problems.
2. To help the client to acquire skills and coping strategies.
3. To help the client to modify underlying cognitive structures in order to prevent relapse.

(See “[http://www.cognitivetherapy.me.uk/cognitive\\_therapy.htm](http://www.cognitivetherapy.me.uk/cognitive_therapy.htm)”).

In short, cognitive therapy of a form of behavioral therapy, in that it aims to help people (and animals) in the way they think, feel and act.

In complete contrast, all of Applicant’s goods in Class 10 are related to the field of cardiology and include, for example, various catheters, introducers, balloons, stents, etc. Similarly, Applicant’s services in Class 44 include various medical services including medical and surgical therapies, vascular therapies, cardiovascular and peripheral therapies. None of

Applicant’s goods and services are remotely related to any form of behavioral therapy, let alone cognitive therapy for humans and animals.

The channels of trade are completely different and there is zero overlap. A consumer looking for cognitive therapy services would never look to cardiology-related medical instruments, such as catheters, introducers, balloons, stents, etc., and would never look for medical services such as medical and surgical therapies, vascular therapies, cardiovascular and peripheral therapies. And vice-versa. The goods and services are so unrelated and directed to completely different groups of people (and animals) that there is virtually no possibility of confusion.

Accordingly, Applicant submits that there is no likelihood of confusion between Applicant’s mark “OSCAR” and the cited mark “OSCAR THERAPY” when the marks are used in connection with the parties’ respective goods and/or services.

**Coexistence of Cited Marks**

The coexistence and co-registration of the cited marks is further evidence that Applicant’s mark should also be accepted. The cited marks are all OSCAR-formative marks used in connection with products and services in different medical fields. The differences in the marks and/or the goods/services distinguish between the marks and allow the marks to coexist. Applicant’s mark is similarly distinguishable over the cited marks for at least the same reasons and, thus, can coexist with the other marks and be co-registered.

**Conclusion**

For at least the above-mentioned reasons, Applicant submits that there is no likelihood of confusion between Applicant’s mark “OSCAR” and the cited marks “OSCOR and Design”, “OSCAR” and “OSCAR THERAPY” when the marks are used in connection with the parties’ respective goods and/or services.

Accordingly, it is respectfully requested that Applicant's mark “OSCAR” be approved for publication in International Classes 10 and 44. Early notification to that effect is respectfully requested.