

AMENDMENT AND RESPONSE

Re: EVA NEXUS, Serial No. 79/292,807

This Amendment and Response is being filed in response to the Non-Final Office Action issued on October 15, 2020, and transmitted to the International Bureau on November 5, 2020. In the Office Action, the Examining Attorney has required Applicant to amend the identification of goods to make it more definite, to state whether the term "EVA" in the mark has any significance in the Applicant's trade or industry, to make a color claim on the record, and, the Examining Attorney identified three prior-filed applications that should those application mature into registrations, there is the potential that the marks could be found to be confusingly similar to the Applicant's mark, namely, Serial Nos. 792/292,287, 79/231,806, and 87/506,517.

I. AMENDMENT OF THE IDENTIFICATION OF GOODS

Applicant respectfully requests that the following amendments to the identification of goods and recitation of services be entered into the record:

Surgical and medical apparatus and instruments for use in ophthalmic surgery and anterior ophthalmic surgery in Class 10.

II. MEANING OF THE WORDING EVA

Applicant respectfully requests that the following statement be entered into the record:

The term EVA in the mark has no significance in the Applicant's trade or industry or as applied to Applicant's goods and/or services, and is not a "term of art" within Applicant's industry. 'The Applicant has adopted the word EVA to represent "Enhancing Visual Acuity"

III. COLOR STATEMENT

Applicant respectfully requests that the following amendments to the identification of goods and recitation of services be entered into the record:

The mark consists of the stylized wording EVA NEXUS in blue, with a red band across the term EVA.

IV. RESPONSE TO THE PROVISIONAL CONFUSING SIMILARITY REFUSAL

APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE PROVISIONALLY-CITED, PRIOR -FILED APPLICATIONS DUE TO DIFFERENCES IN THE MARKS, THE SIGNIFICANT WEAKNESS OF THE SHARED TERM, AND THE DIFFERENCES IN THE GOODS LISTED IN THE CITED REGISTRATON AND APPLICATIONS FROM THE AMENDED GOODS CONTAINED IN THE APPLICANT'S APPLICATION, AND THE SOHISTICATION OF THE LIKELY PURCHASERS.

The Applicant's mark is EVA NEXUS and Design. It is critical to note that **the Applicant is already the owner of a registration on the Principal Register for the corresponding word mark EVA NEXUS, namely, EVA NEXUS for "Multifunctional surgical equipment, namely, medical surgical apparatus and instruments for anterior and posterior ophthalmic surgery" bearing Reg. No. 6,087,883 (Exhibit B).** Clearly, none of the provisionally-cited prior-filed applications were seen as an issue during examination of the Applicant's registration, but just as important, none of the owners of the pending applications considered the mark to be confusingly similar as no party sought to oppose the registration of the mark.

Applicant believes that its mark is clearly not confusingly similar to any of the prior-filed applications for the reasons detailed below. The Applicant's mark is vastly different in sight, sound, and commercial impression from the provisionally-cited applications. Although

Applicant's mark admittedly shares the term EVA with each of the provisionally-cited prior-filed applications, the Applicant's mark also includes the term NEXUS which is unrelated to any of the goods listed in any of the prior-filed applications.

It should also be noted that the Principal Register contains many EVA marks, primarily in Class 10. The majority of those marks are directly related to the medical profession, but only the Applicant's marks are in the ophthalmic space. In fact, **Applicant is already the owner of two registrations EVA registrations, namely, EVA and Design** for "Multifunctional surgical system for anterior and posterior ophthalmic surgery composed primarily of surgical apparatus for use in ophthalmic and vitrectomy surgery" bearing Reg. No. 6,093,225 (Exhibit A) **and . EVA NEXUS** for "Multifunctional surgical equipment, namely, medical surgical apparatus and instruments for anterior and posterior ophthalmic surgery" bearing Reg. No. 6,087,883 (Exhibit B).

As detailed above, Applicants goods are all related specifically to **ophthalmic** surgery. The goods sold by the owners of the pending applications relate to medical diagnostic equipment and diagnostic devices, testing apparatuses, spectrometers, instruments for analyzing biological samples, analytical instruments, medical test kits, or tubes for samples, medical test kits and diagnostic apparatus for detection of cancer. colposcopes, cytology and cell-based testing, **None of the goods associated with the provisionally-cited applications have any relation to ophthalmic surgery**, and, conversely, none of Applicant's goods are remotely related diagnostic testing or any of the goods in the cited applications.

A testament to the vast differences in the goods is the fact that **none of the owners of the prior registered marks or the prior-filed application opposed registration of the Applicant's two applications that were permitted to mature into registration.** Clearly, each

of the Registrants and applicants recognized the vast differences in Applicant's goods from those sold by the other trademark owners. If those parties do not believe that confusion is likely, that is compelling evidence that a likelihood of confusion is not anticipated by those presumably who might have the greatest concern.

Both all of the cited applications and the following registrations had earlier filing dates than either of the Applicant's registrations, but, regardless, the owners of the registrations and the currently provisionally-cited applications did not find it necessary to oppose the Applicant's EVA marks that have now registered.

A small sampling of the many EVA marks on the Principal Register for medical applications and devices primarily in Class 10 are shown in Exhibits K-R.

EVA, Reg. No. 5,461,743, for suctioning products Exhibit K

EVA, Reg. No. 5,093,564, for treatment of patients who cannot breathe on their own
Exhibit L

EVACARE, Reg. No. 5,580,439, for gynecological and urological products Exhibit M

EVACORE, Reg. No. 5,114,120, for breast biopsies Exhibit N

EVACUP, Reg. No. 4,801,137, for collection of menses Exhibit O

EVAKIT, Reg. No. 5,209,739, for vascular products Exhibit P

EVA MEDICAL, Reg. No. 4,566,485, for orthopedic, general health monitoring, and patient care products Exhibit Q.

Applicant respectfully asserts that the term EVA for medically-related goods and services is somewhat weak. Weak marks are afforded a much narrower scope of protection than that afforded to “strong” marks. See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (C.C.P.A. 1958). See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d

1400, 182 USPQ 108 (C.C.P.A. 1974) (confusion is unlikely if it is a weak mark); *J. B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 186 USPQ 317, 189 USPQ 10 (9th Cir. 1975), cert. denied, 424 U.S. 913, 47 L. Ed. 2d 317, 96 S. Ct. 1110, 188 USPQ 720 (1976) (strong mark entitled to a greater degree of protection); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 194 USPQ 128 (D. Kan. 1977) (“famous and strong mark” is entitled to “broad protection”); *Waples-Platter Cos. v. General Foods Corp.*, 439 F. Supp. 551, 196 USPQ 50 (N.D. Tex. 1977) (“The relative strength of a trademark is but a legal shorthand for the breadth of protection to be afforded the mark.”); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 207 USPQ 897 (8th Cir. 1980) (“a strong and distinctive trademark is entitled to greater protection than a weak or commonplace one”); *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 1 USPQ2d 1861 (6th Cir. 1987) (the stronger a trademark, the greater the protection afforded); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 53 USPQ.2d 1652 (9th Cir. 2000) (the stronger the mark “the greater protection the mark is accorded by trademark laws.”).

Use of such a weak term by the owners of the prior-filed applications, and the prior Registrants places the Applicant's mark in a crowd of similar marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. **Even a slight difference** in marks in a crowded field can be sufficient to differentiate it from other similar marks.

As Professor McCarthy notes, a mark that is hemmed in on all sides by similar marks on similar goods or services cannot be very “distinctive.” It is merely one of a crowd of similar marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.

2 McCarthy on Trademarks and Unfair Competition § 11:85 (5th ed.)

When numerous sellers in a product or service line use similar marks, there may be little if any individual distinctiveness and consumers may have difficulty telling one seller from another. “[I]f consumers don't have a clear sense of what plaintiff's mark represents, they are unlikely to purchase defendant's product or service thinking it is plaintiff's.”³

In a “crowded” field of look-alike marks, each member of the crowd is relatively “weak” in its ability to prevent use by others in the crowd. See *Standard Brands Incorporated v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385, 1976 WL 21135 (T.T.A.B. 1976) (no proof that the public had been educated by exposure to many uses of ROYAL marks to distinguish between different ROYAL marks “on the basis of minute distinctions”); *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988) (quoting treatise with approval); *Source Services Corp. v. Chicagoland JobSource, Inc.*, 643 F. Supp. 1523, 1531, 1 U.S.P.Q.2d 1048 (N.D. Ill. 1986) (“Where numerous producers or providers use similar marks for similar products or services, consumers may not be at all sure whose mark they are dealing with. ... [P]aradoxically, that sort of real confusion militates against finding a ‘likelihood of confusion’ in the Lanham Act infringement sense.”). In *re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1996 WL 253841 (T.T.A.B. 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.”).

Applicant’s mark is EVA NEXUS. None of the provisionally-cited applications contain the term NEXUS. Applicant acknowledges that its mark does share the term EVA with the prior-filed applications. However, **based upon the fact that the Applicant already owns a registration for the identical word elements for the same goods, the color and design aspect does not, it is submitted, make confusion with the prior-filed applications more likely.** The sheer number of highly similar marks that are permitted to co-exist on the Federal Register, all of which contain the element EVA for medical devices, it is clear that the USPTO, and the owners of those similar marks, believe that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field and that

confusion is not likely. The law is clear that even slight differences are sufficient to differentiate marks from one another in a crowded field, especially where the cited marks are descriptive in nature. As Professor McCarthy has noted, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. The public is protected here.

Applicant strongly contends that its marks are not likely to cause confusion in with the cited registrations and provisionally-cited applications due to differences in the marks as shown above.

V. CONCLUSION

In light of all of the above arguments and evidence, Applicant strongly asserts that its mark, is not likely to cause confusion with the registered marks or the provisionally-cited marks,.

By this response, Applicant has addressed the issues raised by the Examining Attorney and respectfully requests that the application be approved for publication at an early date.

If the Examining Attorney has any questions or comments, Applicant respectfully requests that the Examining Attorney contact the undersigned Attorney of record.

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