

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Trademark Application of: Life Spine, Inc.
Serial No.: 86/632,576
Filed: May 18, 2015
Mark: SImpact
Law Office: 116
Examining Attorney: Barbara Brown
Atty Docket No.: LSP116

**ARGUMENTS IN SUPPORT OF REGISTRATION AFTER A §2(d)
REFUSAL IN THE OFFICE ACTION OF SEPTEMBER 3, 2015****I. OVERVIEW**

This is a Response to the §2 (d) refusal in the Office Action of September 3, 2015 (the Office Action) to register Applicant's mark SImpact.

Particularly, in the Office Action the mark was refused registration under Section 2(d) because of a likelihood of confusion with the mark of U.S. Registration Nos. 3797518 and 3797519.

II. REFUSAL OF REGISTRATION UNDER SECTION 2(d)

The Trademark Examining Attorney refused registration under Section 2(d) alleging a likelihood of confusion of applicant's mark "SImpact" with Registration No. 3797518 for the mark "Simpact and design" and Registration No. 3797519 for the mark "Simpact". As presented below, applicant submits that there is no likelihood of confusion between applicant's mark and the marks of Registration Nos. 3797518 and 3797519.

In the September 3, 2015 Office Action the Trademark Examining Attorney

said that two key considerations of the *du Pont* factors are similarity of the marks and, similarity or relatedness of the goods. While these two considerations are factors in determining likelihood of confusion under Section 2(d), they are not the only considerations and, in the present case, Applicant submits that other *du Pont* factors are more determinative of whether there is a likelihood of confusion.

In particular, Applicant submits that the channels of trade for the goods and the consumers of the goods are also quite relevant factors in the likelihood of confusion determination of applicant's mark with Registration Nos. 3797518 and 3797519. Applicant concludes that all of these factors indicate there is no likelihood of confusion.

Comparison of the Marks

In the September 3, 2015 Office Action the Trademark Examining Attorney noted that applicant's mark "SImpact" is identical in sound, appearance and meaning to the marks of U.S. Registration Nos. 3797518 and 3797519 (i.e. Simpact and design, and Simpact). While applicant's mark, in a strict sense, is not identical to the registered marks since applicant's mark capitalizes the "i" in its mark, applicant does not disagree that applicant's mark is generally identical in sound, appearance and commercial impression.

However, applicant submits that a mere comparison of the marks is not sufficient to establish that applicant's mark and the marks of U.S. Registration Nos. 3797518 and 3797519 are confusingly similar.

Comparison of the Goods

In a comparison of applicant's goods and the goods of U.S. Registration Nos. 3797518 and 3797519 ("registrant's goods"), the Trademark Examining Attorney indicated that "the goods of the parties need not be identical or even competitive to find a likelihood of confusion" and that "the respective goods need only be related in some manner and/or if the circumstances surrounding their marketing [is] such that

they could give rise to the mistaken belief that [the goods] emanate from the same source.” The Examining Trademark Attorney concludes that “both applicant and registrant use their marks in connection with surgical implants and instruments” and therefore, “the goods of the parties are closely related, if not the same.”

Applicant submits that while applicant’s goods and registrant’s goods can both be generally termed surgical implants and instruments, applicant’s goods are for the medical field of orthopedics (particularly the spine), while registrant’s goods are for the medical field of dentistry. These medical fields are completely separate. Orthopedic spine surgeons do not practice dentistry, while dentists do not practice orthopedic spine surgery. As such, the goods are likewise not related.

Comparison of the Consumers for the Goods

Because of the type of applicant’s and registrant’s goods, the consumers for both goods are doctors and other medical professionals within their field of expertise - not the medical field in general or the general public. In particular, the consumers for applicant’s goods are spine surgeons/doctors and related medical professionals, while the consumers for registrant’s goods are dentists and related dental professionals. These consumers have a high level of sophistication when it comes to distinguishing between goods and services especially within the varied medical fields of spine/orthopedics and dentistry. Moreover, consumers for applicant’s goods will most likely not be aware of registrant’s goods. As well, the consumers for registrant’s goods will most likely not be aware of applicant’s goods. Therefore, given the level of sophistication of the typical consumer of applicant’s goods and registrant’s goods, there would be no confusion in the marketplace as to the source or origin of applicant’s goods and registrant’s goods.

Comparison of Channels of Trade

Given the difference in medical fields of applicant’s goods and registrant’s goods, they are not so related to one another so as to cause consumer confusion

because the channels of trade of applicant's goods and of registrant's goods are not the same.

The channels of trade for applicant's goods and registrant's goods are such that those purchasing applicant's goods and those purchasing registrant's goods would not be confused as to the origin of the goods and services. Orthopedic/spine implants and instruments are marketed exclusively and directly to orthopedic/spine surgeons, medical professionals, and to the hospitals and/or clinics in which those doctors practice. Registrant's goods would likewise be marketed exclusively and directly to dentists, dental professionals and to the offices and/or clinics in which those dentists practice. The two fields are not intermixed. Also, trade publications are quite specific and thus applicant's goods and registrant's goods would not be advertised in the same trade publications. Given the above, it is thus unlikely that consumers would be familiar with both applicant's goods and registrant's goods.

Thus, the channels of trade for applicant's goods and those of registrant's goods are such that the consumers of applicant's goods and registrant's goods, and vice versa, will not be confused as to their source.

There is No Evidence of Actual Confusion

Applicant's goods are now in the marketplace. Applicant knows of no consumer confusion between its goods and registrant's goods. Therefore, there is no evidence of actual confusion.

III. CONCLUSION

Given the above, applicant submits that while applicant's and registrant's marks are essentially identical, there is no likelihood of confusion by consumers as to the origin of goods under applicant's "SImpact" mark and of goods under registrant's "SImpact" and "SImpact and design" marks under Section 2(d). Applicant thus respectfully submits that applicant's mark is registrable, and registration is therefore requested.

In the event that there are any questions related to this response or to the application in general, the undersigned would appreciate the opportunity to address those questions directly by telephone to expedite the prosecution of the application for all concerned. Therefore, if the Trademark Examining Attorney has any questions relating to the instant application, she is respectfully request to contact applicant's undersigned attorney.

Respectfully Submitted,
Life Spine, Inc., Applicant
By:

February 26, 2016
Date

/Bruce J. Bowman/
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