

SERIAL NO.: 79/255719
MARK: MULTIX IMPACT

ARGUMENTS

The Examining Attorney has refused registration of the Applicant's Mark MULTIX IMPACT for x-ray apparatus for medical use based on an alleged likelihood of confusion with the registered mark IMPACT for respiratory care equipment, namely, ventilators, automatic resuscitators, aspirators, vacuum pumps, suction devices, rails and mounting brackets. Applicant submits that in the significant differences in the marks in their entireties, the differences in the goods covered, and the differences in the consumers to whom the goods will be sold preclude a likelihood of confusion between these marks. This is particularly true in view of the highly educated, professional consumers who will be purchasing the goods in question and the weakness of the mark IMPACT in the medical field. These factors are discussed in detail below.

A. DIFFERENCES IN THE MARKS



It is well settled that marks must be considered in their entireties when determining whether there is a likelihood of confusion. *Colgate-Palmolive Company v. Carter Wallace Inc.* 167 USPQ 529 (CCPA 1970). *Massey Junior College, Inc. v. Fashion Institute of Tech.*, 181 USPQ 272 (CCPA 1974); *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233 (CCPA 1981). Although the Applicant's and Registrant's Marks both contain the word IMPACT, the Applicant's Mark also contains the dominant, distinguishing word MULTIX which has a strong impact on the appearance sound and meaning of the mark as a whole. As a result, the marks in their entireties are dissimilar.


The fact that MULTIX is the first word in the Applicant's Mark reinforces that this is the dominant part of the Applicant's Mark. The Board has recognized that the first portion of a

trademark is the most likely to be noticed and remembered by consumers and, as a result, generally plays the dominant role in the mark. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (noting that the dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *Presto Prods. Inc. v. NicePak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Even greater weight should be afforded to the word MULTIX in Applicant’s Mark because this is a strong arbitrary term, while the word IMPACT is weak and suggestive. In view of the strength of the additional word MULTIX in the Applicant’s Mark, consumers are highly unlikely to associate this mark with the Registrant’s weak one-word mark IMPACT.

B. WEAKNESS OF THE REGISTRANT’S MARK

Moreover, the Applicant submits that the Examining Attorney has afforded the Registrant’s weak mark, IMPACT, with an overly broad scope of protection considering the numerous coexisting marks which include this term and widespread use of this word in the medical field. As shown by the attached search of the word IMPACT in Class 10 (Exhibit A), there are numerous marks consisting or comprised of the word IMPACT which are registered in association with medical goods in Class 10. Some examples of coexisting marks are:

MARK	REG. NO.	OWNER	GOODS IN CLASS 10
IMPACT And 	5779882 5142350	Impact Products LLC	Disposable gloves for medical use, ear plugs for medical purposes; ear plugs for noise reduction; back support for medical purposes
IMPACT CRYOTHERAPY And 	5595948 5586681	Impact Cryotherapy Inc.	Therapeutic apparatus, namely, a therapeutic chamber for whole body cryotherapy treatment for therapeutic purposes; therapeutic units, namely, a therapeutic chamber for whole body cryotherapy treatment for therapeutic purposes; etc.
IMPACT	3146331	Skeletal Kinetics LLC	Surgical implant compositions of artificial material, namely, calcium phosphate compositions for use as implantable materials.
SImpact	5429320	Life Spine, Inc.	Neurosurgical implants consisting of artificial materials and neurosurgical instruments for use in orthopedic surgery
BLUE IMPACT	4971859	Shimadzo Corporation	Lasers for medical purposes; lasers for medical use; lasers for surgical use; blue direct diode laser for medical purposes
MICRO IMPACT PLATFORM	4938561	Regenerative Technologies	Physical exercise apparatus for medical purposes. . .micro-impact to help improve bone health, etc.
IMPACT BEYOND	4671166	Shockwave Medical	catheters

THE BALLOON		Inc.	
I.M.P.A.C.T. SYSTEM	3989195	Hemolife Medical, Inc.	Medical device for blood plasma purification
	3828460	Medacta International S.A.,	Orthopaedic prostheses and implants consisting of artificial materials for the femur, knees and acetabular cups
IMPACT	3294800	Allied Healthcare Products	Digital medical gas alarm system for use in hospitals for dispensing medical gas to patients
LIGASURE IMPACT	3687532	Covidien AG	Surgical devices, namely, vessel sealing and tissue fusion systems with controlled energy monopolar mode, comprised of electrosurgical generators and accessories
IMPAK HEALTH	4176440	Meridian Health System, Inc.	Medical devices, namely, portable electronic patient monitors and patient sensors with automated alert and monitoring capacity for monitoring and measuring patient reported symptoms, heart rate, blood pressure, body temperature, pain, blood glucose levels, the oxygen saturation of the blood and other vital sign and diagnostic parameters

(See attached TSDR printouts of listed registrations, Exhibit B). The coexistence of these registrations, is evidence that the word IMPACT is “weak” in a trademark sense should be afforded a narrow range of protection. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*

Maison Fondée en 1772, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *In re America's Best Chocolate, Inc.*, 169 USPQ 53 (TTAB 1971). These marks coexist because the remaining wording in the marks or differences in the goods have been deemed sufficient to preclude a likelihood of confusion. Thus, it is notable that the registration for IMPACT with respiratory devices cited by the Examiner coexists with registrations for the identical mark IMPACT for digital medical gas alarm systems used in hospitals for dispensing medical gas to patients, IMPACT for surgical implant compositions and IMPACT for disposable gloves, ear plugs and back supports for medical purposes as well as a host of additional IMPACT formative marks for medical goods. Just as these numerous marks can coexist without a likelihood of confusion, so too can the Applicant's and Registrant's readily distinguishable marks as applied to their unrelated goods.

C. DIFFERENCES IN THE GOODS, CHANNELS OF TRADE AND CONSUMERS

The goods covered by the instant application are x-ray apparatus for medical use. These goods differ significantly in form and function from the respiratory care equipment covered by the cited registration. While the Applicant's goods would be sold to radiology clinics and radiology departments of hospitals, the respiratory equipment covered by the Registrant's Mark would be sold to medical units and hospital divisions professionals concerned with emergency care of patients with breathing difficulties. While the Applicant's goods are used in diagnostics, the Registrant's goods are used for patient emergency and intensive care. Even assuming that both the Applicant's Goods and Registrant's goods could be sold to the same large medical institutions, in view of the difference in the goods, they would not be sold to or used by the same medical professionals in these institutions. As recognized by the Circuit Court in *Astra Pharm. Prod. Inc. v. Beckman Instruments, Inc.*, 220 USPQ 790 (1st Cir. 1983), the hospital community

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. *Id.* at 791

Moreover, the Internet evidence and the prior Siemens registration referenced by the Examining Attorney are not sufficient to show that the Applicant's and Registrant's goods are related in such a manner than likelihood of confusion is possible. Although the registration for the house mark SIEMENS, referenced by the Examining Attorney may cover a wide range of medical goods and services, this does not support a finding that the goods involved in this case are related. The USPTO database is full of registrations which cover disparate goods and services. This is particularly true with regard to house mark registrations which can cover disparate goods sold through by different divisions of large companies to diverse groups of consumers. Attempting to create a *per se* rule of relatedness based on these types of registrations is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 152 (CCPA 1978); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977). It is further noteworthy that while only one party owns marks comprised of the word SIEMENS, marks containing the word IMPACT are owned by dozens of different entities. The excerpts from the Philips and GE websites are similarly unconvincing to show that consumers will believe that the Applicant's and Registrant's goods are related. First, these excerpts do not show that these two companies sell respirators and imaging equipment under the same marks, or that these goods are sold to the same consumers. In addition, the goods do not appear to be sold in the same section of the Philips or GE website and therefore the excerpts also do not show sale or promotion in the same channels of trade.

D. SOPHISTICATION OF CONSUMERS

The Board has recognized that purchasers of medical equipment are better able to distinguish between marks and goods than the general consuming public because these individuals are educated professionals who will purchase the goods with care and deliberation. *Astra Pharm. Prod. Inc. v. Beckman Instruments, Inc.*, supra, 220 USPQ at 791-92 This sophistication combined with the high cost of x-ray devices such as those sold under Applicant's Mark virtually ensures that the consumers for Applicant's goods will be well aware of the source of those goods and are not likely to be confused. The same holds true for respiratory equipment. In both instances the purchasers for the goods will buy them with great care and unquestionably will know the source of the goods they are purchasing. *See, In re N.A. D.*, 224 USPQ 969(Fed. Cir. 1985.)

E. CONCLUSION

For the reasons above, the Applicant submits that the mark MULTISTIX IMPACT for x-ray apparatus can coexist without a likelihood of confusion with the registered mark IMPACT for respiratory equipment. A likelihood of confusion is obviated not only by the significant differences in the marks in their entireties, but also the differences in the goods with which they are used and the sophistication of the purchasers. The numerous coexisting IMPACT registrations in the medical field is further evidence that the scope of protection afforded to the Registrant's Mark should not preclude registration of the Applicant's Mark.