

**Application Serial No. 88356618 for the Mark HALO  
Response to Office Action dated June 18, 2019**

**RESPONSE**

In the Office Action, the examining attorney refuses registration of Applicant's mark under Section 2(d) on the basis of U.S. Registration Nos. 3577648, 4289289, and 5059918 ("Cited Registrations"). Applicant respectfully requests the refusal be withdrawn in all cases in view of the arguments presented herein.

Under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods or services be likely, not merely possible. As the Second Circuit has stated, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" *Estee Lauder, Inc. v. The Gap, Inc.*, 42 USPQ2d 1228 (2nd Cir. 1997) (internal quotations omitted) quoting 2 J. McCarthy, *Trademarks and Unfair Competition*, Section 23:3. The Federal Circuit and the Board have consistently held that one DuPont factor may be dispositive in the likelihood-of-confusion analysis.

In the present case, there are several factors that weigh in favor of registration. The state of the register and the marketplace show that consumers can readily differentiate between like marks. Moreover, the type of goods in question dictate careful consideration on the part of the consumer, who is sure to be a sophisticated purchaser in this case. Accordingly, despite the fact that the marks are identical and the goods are all in the general category of medical devices, they can peacefully co-exist without creating confusion.

**I. The mark HALO is Diluted for Medical Devices**

It is not uncommon for the USPTO to allow similar and identical marks in the same International Class to coexist on the Principal Register. This is certainly the case in the present situation for the mark HALO in Class 10 for medical goods, where multiple HALO marks are coexisting in a crowded field. For example, the following registrations are all peacefully co-existing (copies of the TESS print outs for these records are attached as Exhibit A):

<b>Mark</b>	<b>Reg. No.</b>	<b>Full Goods/Services</b>	<b>Owner Information</b>
<b>HALO</b>	RN: 4289289 SN: 77746572	(Int'l Class: 10) electrosurgical instruments, namely, cutting forceps for use in laparoscopic surgery in the fields of gynecology and urology	Gyrus Acmi, Inc. (Delaware Corp.) 136 Turnpike Road Southborough Massachusetts 01772
<b>HALO</b>	RN: 4588733 SN: 86173700	(Int'l Class: 10) non-invasive electronic neuromodulator device for medical use by healthy and impaired persons to enhance performance on cognitive tasks	Halo Neuro Inc., Dba Halo Neuroscience 4th Floor 735 Market Street San Francisco California 94103
<b>HALO</b>	RN: 5729483 SN: 87830779	(Int'l Class: 10) Medical devices, namely, tourniquets	Halo Tactical Products, LLC 13728 Statesville Road Huntersville North Carolina 28078
<b>HALO</b>	RN: 5834972 SN: 85830295	(Int'l Class: 10) Bassinets used for medical purposes, namely, bassinets for use in hospitals and designed to promote safe sleep for infants <i>inter alia</i>	Halo Innovations, Inc. (Minnesota Corp.) 111 Cheshire Lane, Suite 100 Minnetonka Minnesota 553052325
<b>HALO</b>	RN: 5830798 SN: 85830309	(Int'l Class: 10) medical wearing apparel, namely, infant hospital garments; infant hip positioning garment to protect against hip dysplasia for medical use <i>inter alia</i>	Halo Innovations, Inc. (Minnesota Corp.) 111 Cheshire Lane, Suite 100 Minnetonka Minnesota 553052325
<b>HALO</b>	RN: 4874994 SN: 86189191	(Int'l Class: 10) medical apparatus, namely, connectors for facilitating transfer of substances from a fluid source to a delivery device	Corvida Medical, Inc. 2261 Crosspark Road Coralville Iowa 52241
<b>HALO</b>	RN: 5059918 SN: 86240898	(Int'l Class: 10) biomedical apparatus, namely, hearing aids and structural parts therefor	Starkey Laboratories, Inc. 6700 Washington Avenue South Eden Prairie Minnesota 55344
<b>HALO</b>	RN: 5894386 SN: 88086862	(Int'l Class: 10) Medical laser delivery apparatus, namely, lasers for medical use	Sciton, Inc. 845 Commercial Street Palo Alto California 94303
<b>HALO</b>	RN: 4387238 SN: 85789384	(Int'l Class: 10) medical device for the treatment of sleep disorders, namely, headgear designed for non-infants to support the lower chin	Jarma, Inc. 8430 Washington Place Ne Albuquerque New Mexico 87113

<b>Mark</b>	<b>Reg. No.</b>	<b>Full Goods/Services</b>	<b>Owner Information</b>
<b>HALO</b>	RN: 3577648 SN: 77371096	(Int'l Class: 10) medical devices for use in surgery, namely, orthopedic implants, fixation plates, screws, targeting systems for screw placement, instruments for accessing a surgical target site, instruments for the preparation, distraction, and sizing a surgical target site, instruments for insertion of implants into a surgical target site, instruments for securing the implants to bone structures within a surgical target site, and containers for holding, transporting, and sterilizing such implants, plates, screws, and instruments	Nuvasive, Inc. (Delaware Corp.) 7475 Lusk Boulevard San Diego California 92121
<b>HALO</b>	RN: 3122063 SN: 78582723	(Int'l Class: 10) gloves for medical and dental use	Dash Medical Gloves, Inc. 9635 South Franklin Drive Franklin Wisconsin 53132
<b>HALO</b>	RN: 1853021 SN: 74350651	(Int'l Class: 10) electrode catheters	Biosense Webster, Inc. 3333 Diamond Canyon Road Diamond Bar California 91765

Additionally, the following pending applications have been approved to co-exist as well (copies of the TESS print outs for these records are attached as Exhibit B):

<b>Mark</b>	<b>App. Ser. No.</b>	<b>Full Goods/Services</b>	<b>Owner Information</b>
<b>HALO</b>	SN: 87944840	(Int'l Class: 10) Insulin pen module utilizing wireless technology, namely, dose detection and data transmission apparatus utilizing wireless technology adapted for insulin injection pens, sold empty <i>inter alia</i>	Eli Lilly and Company (Indiana Corp.) Lilly Corporate Center Indianapolis Indiana 46285
<b>HALO</b>	SN: 87956844	(Int'l Class: 10) Dental instruments for use in restoring posterior interproximal tooth surfaces; dental matrices; dental matrix rings; dental matrix bands; dental wedges; dental forceps; sectional matrix systems for use in restoring posterior	Ultradent Products, Inc. (Utah Corp.) 505 West 10200 South South Jordan Utah 84095

Mark	App. Ser. No.	Full Goods/Services	Owner Information
		interproximal tooth surfaces comprised of matrix rings, matrix bands, and wedges	
HALO	SN: 88509509	(Int'l Class: 10) Air mattresses for medical purposes; Medical apparatus comprising an inflatable general medical use support for conveying supine human bodies between horizontal surfaces	Cega Innovations, Inc. (Delaware Corp.) 251 Little Falls Drive Wilmington Delaware 19808

A likelihood of confusion analysis requires consideration of “the number and nature of similar marks in use on similar goods [or services].” In re E.I. DuPont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973). The Board has repeatedly concluded that consumer confusion is unlikely between two marks allegedly sharing one or more terms where the record shows extensive use by third parties of marks incorporating these terms in the marketplace. See e.g., In re Hartz Hotel Services, Inc., Serial No. 102 USPQ2d 1150 (TTAB 2012) (precedential) (reversing the Examining Attorney and finding applied-for mark GRAND HOTEL NYC unlikely to be confused with registered mark GRAND HOTEL, both for hotel services, due to evidence of extensive third-party use of GRAND HOTEL with hotel services).

From the evidence above, it is clear that the USPTO has taken the position that identical HALO marks may coexist on the Principal Register when the goods are sufficiently different or sufficiently discernable to trained medical professionals, such that the distinct sources of those goods are easily identifiable, despite the fact that the goods exist in the same field or category. Applicant respectfully asks for the same consideration that has been given to the other registered HALO marks currently on the Principal Register.

## II. The Goods are Sufficiently Different

In the present case, Applicant’s goods are just as different from the goods of the Cited Registrations as are the goods of the records discussed above. In the case of Registration No. 5059918, the goods are significantly different in that Applicant’s goods are surgical instruments and the goods covered by Reg. No. 5059918 are not. Those goods are a “biomedical apparatus” commonly known as a hearing aid. These goods are not related to surgery, medical procedures, or hospitals and would travel through completely different channels of trade than Applicant’s

goods.

In the case of Registration Nos. 3577648 and 4289289, these items are related to surgery, but are no more similar to Applicant's goods than they are to each other's goods. Registration No. 4289289 specifically states that the instruments are for use for laproscopic surgeries, which would not be the type of procedure performed for procedures involving the ear, nose or throat. Further, the registration specifies that the goods are in the field of gynecology and urology, which is clearly a different field from that of Applicant's goods, which is specified in the application as ear, nose and throat.

The goods of Registration No. 3577648 are also devices used in surgery, but they are used in the field of orthopedics, specifically, for orthopedic implants. Again, the purpose and field of use is very different from that of Applicant's goods.

In the cases of Registration Nos. 3577648 and 4289289, Applicant's goods are used for a different purpose and in a different field than those of the cited registration. As is the case with Registration No. 5059918, the goods would travel through different channels of trade and the chance of consumer confusion is thus obviated. To the extent there is any overlap in channels of trade between Applicant's goods and those of any of the Cited Registrations, the cost of the goods and the sophistication of the consumer would ensure that consumer confusion did not arise.

### **III. The Goods Are Marketed and Sold to Sophisticated Consumers.**

In the improbable event that the goods of Registrant and Applicant were encountered by the same pool of customers, the potential for confusion remains unlikely. As the Trademark Manual of Examining Procedure (TMEP) makes clear, the Examining Attorney must determine whether the goods on which the marks are used are of such a nature that they would likely be encountered by the same persons who could mistakenly believe that they originate from the same source. In rendering this assessment, the Examining Attorney should consider a number of factors, including, to whom the goods in question are marketed and the level of sophistication of the intended customers. TMEP Section 1207.01(a)(i). See also, *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cables held not confusingly similar to QR for lamps, tubes, and other products related to the photocopying field.)

The Board has consistently held that purchasers of expensive goods and services are expected to be more careful in making purchasing decisions, thus decreasing the likelihood of

confusion. *Hewlett-Packard v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1396 (TTAB 1991) (given sophisticated purchasers and deliberation in determining suitability of product, confusion held unlikely).

A high degree of sophistication is present in the potential consumers of both Applicant's and Registrant's goods. Decisions on the purchase of surgical instruments and related goods are made by doctors and medical specialists who have years of professional training in their respective fields. See *American Council of Certified Podiatric Physicians and Surgeons v. American Board of Podiatric Surgery, Inc.*, 185 F.3d 606 (6th Cir. 1999) (finding regarding sophistication of purchasers in the medical field). Additionally, the significant cost of the respective goods would lead those same potential consumers to carefully consider the source and content of the goods before making a purchase decision. See *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550 (10th Cir. 1998). Even a cursory look at the goods would reveal their source, nature, intended purpose and proper field of use. Therefore, it is inconceivable that these sophisticated consumers (doctors and medical specialists) would confuse the source Applicant's goods with those of the registrations cited in the Office Action.

#### **IV. Conclusion**

The many HALO marks currently co-existing in the field of medical devices, including two for surgical instruments, is evidence that consumers can easily differentiate between the source of goods sold under the HALO mark in this category, provided the goods are different. In the present case, there are sufficient differences between Applicant's goods and the goods of the cited registrations such that no confusion would arise. In all cases, either the goods themselves and/or the fields of use are distinct and the channels of trade would be different. Moreover, the price of the goods in question and the sophistication of consumers provides insurance against confusion in the unlikely event the goods are sold to the same consumer. Accordingly, Applicant requests that the 2(d) refusals be withdrawn and the application be approved for publication.