IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Alma Lasers Ltd.

Serial No. 88/783,752

Filed: February 3, 2020

Mark: OPUS

James Blake Lovelace
Examining Attorney
Law Office 119

RESPONSE

To the Director of the Patent and Trademark Office

Sir:

In response to the Office Action dated March 17, 2020:

Kindly amend the listing of goods as follows:

-- Medical apparatus and instruments for treating face, body, tissue and skin, **namely, high-frequency unipolar radio-frequency energy emitting apparatus sold to medical professionals for skin resurfacing**; Medical devices, **namely, radio-frequency skin treatment devices for skin resurfacing**; ~~medical lasers; lasers for medical use~~ skin treatment apparatus for applying **high-frequency unipolar** radio-frequency energy ~~or ultrasound~~ for aesthetic and medical purposes; radio-frequency electromagnetic energy emitting apparatus ~~and ultrasound emitting apparatus~~ for aesthetic skin treatment and

medical use, **sold to medical professionals**; medical apparatus for aesthetic and therapeutic applications for the skin and its subcutaneous structures, namely, devices for delivering energy to the skin and its underlying tissues **for skin resurfacing, sold to medical professionals**; parts and fittings specifically adapted for the aforesaid goods, in International Class 10. --

No likelihood of confusion exists between the Applicant's mark and the cited mark because the goods as amended are unrelated and marketed in different channels of trade to unique and sophisticated consumers and the cited mark is diluted by third party registrations and therefore entitled to only a narrow scope of protection

REMARKS

No likelihood of confusion exists between Applicant's mark, OPUS, and the cited mark because the goods as amended are unrelated and marketed in different channels of trade to unique and sophisticated consumers and the cited mark is diluted by third party registrations and therefore entitled to only a narrow scope of protection.

The key element of the test of likelihood of confusion is whether consumers are likely to be confused as to the source of the goods or services. In this case, there is no chance for consumer confusion as to the source of the goods or services, because the goods as amended are unrelated and marketed in different channels of trade to unique and sophisticated consumers and the cited mark is diluted by third party registrations and use and therefore entitled to only a narrow scope of protection. *See In re E.I. DuPont de Nernours & Co.,* 476 F. 2d 1357, 1361 (C.C.P.A. 1973).

The Applicant's mark is not confusingly similar to the cited registration.

A. The Goods of the Applicant and the Cited Registration are Dissimilar and Unrelated

One crucial prong of the DuPont test is to compare the similarity or dissimilarity and nature of goods or services as described in an application or registration in connection with which a prior mark is in use. Analyzing the following amended goods, it is clear that this prong weighs in favor of registration for Applicant's mark, as the cited registration lists services unrelated to those of the Applicant.

Applicant's Mark: *Medical apparatus and instruments for treating face, body, tissue and skin, namely, high-frequency unipolar radio-frequency energy emitting apparatus sold to medical professionals for skin resurfacing; Medical devices, namely, radio-frequency skin*

treatment devices for skin resurfacing; skin treatment apparatus for applying high-frequency unipolar radio-frequency energy for aesthetic and medical purposes; radio-frequency electromagnetic energy emitting apparatus for aesthetic skin treatment and medical use, sold to medical professionals; medical apparatus for aesthetic and therapeutic applications for the skin and its subcutaneous structures, namely, devices for delivering energy to the skin and its underlying tissues for skin resurfacing, sold to medical professionals; parts and fittings specifically adapted for the aforesaid goods in International Class 10 –

Cited Registration: *Massage apparatus; facial massager; equipment for aesthetic skin treatments, namely, handheld toning massagers and cleanser brushes* in International Class 10 --

Analyzing the amended goods of the Applicant makes it apparent that they are distinct and unrelated to those listed in the cited registration. The cited mark lists handheld facial massagers and cleaning brushes. Applicant lists medical devices only- particularly high-tech, high-frequency unipolar radio frequency energy emitting machines which are sold to medical professionals and used for medical procedures, particularly skin resurfacing. These products have no relation at all to the massage devices listed for the cited mark. These goods are separate and unrelated to one another. As noted in TMEP 1201.01(a)(i): "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. (emphasis added) *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim,

noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by)."

The Examiner has attached evidence in the form of internet screenshots of various websites, in order to show that the Applicants goods "are closely related to the registrant's massage devices because facial massagers frequently incorporate lasers, radio frequency, ultrasound, etc. and are used for the same purposes, namely, toning and firming the skin."

Applicant would first note that the Examining Attorney provides no basis for the conclusion that such similarities could amount to relatedness for trademark purposes. The Examining Attorney has presented no statute, case law, or rule to the effect that goods which may be used for overlapping purposes, or which share one or more technical features, are to be considered related in a likelihood of confusion analysis. Rather, the question is whether "the goods or services in question are … related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." Applicant submits that the evidence supplied is not sufficient to draw such a conclusion. And indeed, that any such conclusion would be incorrect, as Applicant's medical devices inherently would be encountered by very different purchasers and in very different situations than the goods listed in the cited registration, such that no one would believe the respective goods originate from the same source.

Furthermore, Applicant would note that the listed goods as amended recite medical devices emitting high-frequency unipolar radio-frequency energy and sold to medical professionals for medical procedures such as skin resurfacing. Massage apparatus do not have any of these features and are unrelated to Applicant's listed goods as amended.

"Numerous cases illustrate that even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion." *Harlem Wizards Entertainment Basketball v. NBA Properties*, 952 F. Supp. 1084, 1095 (D.N.J. 1997)(finding no likelihood of confusion for show basketball entertainment services and professional competitive basketball entertainment services both under the mark WIZARDS); *In re Shipp*, 4 USPQ2d 1174 (TTAB 1987) (PURITAN for laundry and dry cleaning services and PURITAN for dry cleaning machine filters and parts therefor "while

related in the sense that they are all in the laundry and dry cleaning industry, are not so related that they would come to the attention of the same kinds of purchasers and we believe that confusion as to source or sponsorship, while possible, is not likely"); *Reynolds & Reynolds Co. v. I.E. Systems Inc*., 5 USPQ2d 1749, 1751 (TTAB 1987)("there must be some similarity between the goods and services at issue herein beyond the fact that each involves the use of computer").

Although the goods and services of the Applicant and cited registration might be argued to both fall under the general umbrella of skincare, this industry is so broad and encompasses so many unique areas of focus that this is insufficient to prevent registration of the applied-for mark. As the goods and services offered by each party differ starkly from one another, there can be no likelihood of confusion between the two marks.

B. <u>The Established Trade Channels of the Applicant and of the Cited Mark are Dissimilar, the Goods are Specialized and Expensive, and Prospective Purchasers are Sophisticated and Unique.</u>

Another prong of the DuPont test focuses on the similarity or dissimilarity in the established trade channels. There is no likelihood of confusion as the goods of the Applicant and the cited registration travel in different trade channels and the prospective purchasers are sophisticated and distinct. The cited registration markets handheld facial massage and cleaning devices which are intended for the private use of general consumers and are sold directly to the public. The RF medical devices offered by the Applicant have no connection to facial massagers and, as indicated in the amended listing of goods, are not sold to the general public but instead to medical professionals. Such customers do not purchase or use massage apparatus as listed in the cited registration, as supported by the attached declaration. The Applicant’s goods do not travel

in the same channels as the goods listed in the cited registration. Whether a physical location or online marketplace, these disparate products cannot be found or purchased in the same space.

The prospective purchasers of the Applicant's products, namely, medical clinics and medical spas and the healthcare professional employees of such businesses, are highly knowledgeable and discerning purchasers. Additionally, the Applicant's RF medical devices are highly complex and very expensive machines that require a significant amount of research on the part of the purchaser prior to purchase. The sophisticated nature and expense of these products ensures that any confusion as to the source of these goods on the purchaser's end is virtually impossible. There is simply no likelihood of a consumer who intends to purchase a massager (as listed in the cited registration) mistakenly purchasing one of the Applicant's RF medical devices or thinking there was some connection between them. The fact that the goods listed by the Applicant and in the cited registration travel in different channels of trade and are marketed towards sophisticated and distinct clientele heavily favors registration.

C. The Cited Mark is Weak and Diluted by Third Party Registrations

Another prong of the DuPont test is to examine the number and nature of similar marks in use on similar goods. TMEP 1207.01(d)(iii) states that: "If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it 'is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.'" *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (emphasis added). It has also been shown that the weaker an earlier mark is, the closer a second-comer's mark can come without causing a likelihood of confusion. As the U. S. Court of Appeals found in *Juice Generation, Inc. v. GS*

Enterprises LLC, 115 USPQ2d 1671 (Fed. Cir. 2015) [precedential]: “[S]ufficient evidence of third-party use of similar marks can ‘show that customers have been educated to distinguish between different marks on the basis of minute distinctions.’”

In this case the cited mark, OPUS, is clearly diluted and therefore only entitled to a narrow scope of protection. A search for marks containing the word “OPUS” in the USPTO database returns 171 active registrations and applications from a multitude of owners, a number of which also feature goods in Class 10. An Internet search for third-party businesses incorporating “OPUS” in their names also turns up extensive results. A number of these registrations/applications and third-party businesses have been attached here in order to be counted as evidence on the record.

Thus, the record shows that there is a crowded field of OPUS marks, rendering each individual such mark relatively weak. *See Miss World (U.K.) Ltd. v. Mrs. America Pageants*, 856 F.2d 1445, 1449 (9th Cir. 1988) ("In a 'crowded' field of similar marks, each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd.") (quotations omitted).

If such a large number of active registrations and applications as well as businesses including the term “OPUS” are already able to co-exist in the same class of goods and in connection with various medical goods and services, this indicates that consumers are used to seeing this term on various products from various companies, and will not necessarily associate two products just because they are marketed in connection with this or similar elements. This weighs heavily in favor of registration for the Applicant.

D. The DuPont Factors as a Whole Favor Registration

After applying the relevant factors of the DuPont test, it is evident that Applicant's mark, OPUS, when viewed in its entirety and in relation to the goods or services it represents, cannot create any likelihood of confusion with the cited mark.

The analysis is similar in nature to that of California Fruit Growers. *California Fruit Growers Exchange v. Sunkist Baking Co.*, 76 USPQ 85 (7th Cir. 1947). In that case, the court found no likelihood of confusion between plaintiffs use of SUNKIST for fruits and vegetables and defendant's use of SUNKIST for bread. The court stated, “[u]nless 'Sunkist' covers everything edible under the sun, we cannot believe that anyone whose I.Q. is high enough to be regarded by the law would ever be confused or would be likely to be confused in the purchase of a loaf of bread branded as 'Sun-kist' because someone else sold fruits and vegetables under that name. The purchaser is buying bread, not a name. If the plaintiffs sold bread under the name 'Sunkist', that would present a different question; but the plaintiffs do not, and there is no finding that the plaintiffs ever applied the word 'Sunkist' to bakery products." *California Fruit Growers Exchange v. Sunkist Baking Co.*, 76 USPQ 85, 87 (7th Cir. 1947); see also *General Motors Corp. v. Cadillac Marine & Boat Co.*, 140 USPQ 447, 456 (W.D. MI 1964).

CONCLUSION

The Applicant's mark and the cited registration are used in connection with unrelated goods and services marketed in different channels of trade to unique and sophisticated consumers and the cited mark is weak and diluted by third party registrations. There is no likelihood of confusion between the two marks. Allowance and publication of the mark are respectfully requested.

Respectfully,

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Date: April 22, 2020