RESPONSE TO NON-FINAL OFFICE ACTION

Applicant Metactive Medical, Inc. responds to the Office Action dated November 22, 2019, as follows:

REMARKS

I. Section 2(d) Refusal - Likelihood of Confusion

The Examiner initially has rejected Applicant's mark, ENDURA (the "Application"), on the basis that there may be a likelihood of confusion with the U.S. registered trademarks listed below:

U.S. Reg. No.	Mark	Goods/Services
3247924	**ENDURA**	International Class 10: Medical and surgical apparatus and instruments, namely, X-ray based apparatus and systems for diagnostic and interventional imaging applications.
4878280	**ENDURA MD**	International Class 10: Medical devices and instruments, namely, mass spectrometers; Medical devices and instruments, namely, mass spectrometers for small molecule analysis, including detection of protein levels in blood and human fluids; all the foregoing for medical in vitro diagnostic use.
5423627	**ENDURACOAT**	International Class 10: Surgical instruments and apparatus; medical apparatus and instruments for use in treating cardiovascular disease; drug coated angioplasty balloons; drug coated angioplasty balloon system, namely, surgical and medical apparatus and instruments for use in angioplasty surgery; surgical balloons for use in angioplasty surgery.
5795222	**SPRINT ENDURA**	International Class 10: Medical apparatus, namely, electrical stimulation systems including at least one electrode to be implanted in tissue for applying electrical stimulation to tissue.

Applicant's goods – as amended – and the cited applications' goods are not sufficiently related to cause confusion.

Applicant respectfully disagrees that the foregoing registrations will be confusingly similar to Applicant's Application, in the event it registers. Applicant is seeking to further clarify the nature of the goods.

The goods identified in the Application, as amended, clearly focus on specialized medical devices for the treatment of neurovascular diseases, specifically the medical devices are for the treatment of brain aneurysms and are embolization systems, including detachable balloon catheters and coils for use during brain aneurysm embolizations. In contrast, the cited registrations are also all highly-specialized medical devices but for different purposes and uses – i.e., X-ray imaging, mass spectrometers for small molecule analysis, drug-coated balloons for angioplasty surgery, and electrodes for stimulating tissue. The only arguable similarity between Applicant's goods (***prior to*** being amended) and the goods in the cited applications are that they all pertain to medical devices.

Further, Applicant's goods (as amended) and each of the goods listed in the cited registrations are very distinct, specific, highly specialized, and directed solely to highly sophisticated consumers. Overall, these respective goods are entirely different and are marketed and sold to an entirely different set of consumers through wholly distinct and separate trade channels.

In Electronic Data Systems Corp. v. EDSA Micro Corp., the TTAB acknowledged that while all computer software programs process data, not all computer programs are related. Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460 (TTAB 1992). The issue of relatedness does not revolve around the question of whether the goods can both be classified under the same general category. Id. The test is whether the goods are related in the mind of the consuming public as to their origin. See In re Coors Brewing Co., 343 F.3d 1340, 1346 (Fed. Cir. 2003), finding that while some restaurants may brew their own beer, that does not necessarily mean that consumers are likely to believe that beer and restaurant services with similar marks emanate from the same source, particularly where the evidence indicates that the degree of overlap between sources of beer and sources of restaurant services is *de minimis* and the very small number of dual use registrations does not counter the evidence. See also M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1381, 78 U.S.P.Q.2d 1994 (Fed. Cir. 2006) (where interactive multimedia CD-ROMs containing educational information in the pharmaceutical and medical product information industry were not found to be similar goods to computer software featuring business management applications for the film and music industries even though both fall in the same broad general category of informational software provided on the same media platform).

Similar to the Electronic Data Systems case and the M2 Software case, while Applicant and the Registrants may both touch on the broad category of medical devices, only highly sophisticated consumers in the medical and scientific research industry will utilize Applicant's goods for treating neurovascular diseases (namely, aneurysms), while an entirely different set of highly specialized consumers in the healthcare industry would utilize each of the goods listed in the cited registrations. These wholly distinct consumers would not overlap, the trade channels would be different, and it is very unlikely that any consumers would view Applicant's goods as associated with the goods and services listed in the cited registrations. As such, consumers are not likely to be confused, especially where the marks themselves create very distinct commercial impressions and, as discussed below, the goods/services of each entity are purchased after careful consideration by sophisticated consumers and are not impulse purchases.

When the extrinsic evidence regarding the nature of each of the Registrants' goods is examined, it is apparent that the Registrants' goods and the Applicant's goods are so dissimilar that there is no likelihood of confusion between Applicant's Mark and the Registrations. Applicant respectfully submits that the Trademark Act does not prevent registration of a mark on the possibility of consumer confusion, but requires that confusion be likely. Bongrain International (American) Corporation v. Delice de France Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1779; In re The Ridge Tahoe, 221 USPQ 839, 840 (T.T.A.B. 1983).

- According the ENDURA Registrant's website (usa.phillips.com), the Registrant's goods are stand-alone portable X-ray systems (i.e., compact X-ray machine having a flexible C-arm and installed software) for performing imagings during operations. However, the goods identified by the Applicant to be used in connection with the Applicant's Mark are not a

stand-alone portable X-ray system for use during surgeries, but an embolization system which includes a detachable balloon and coil for use during brain aneurysm embolizations. While the Registrant's goods are "X-ray based apparatus and systems", the goods identified by the Applicant's Mark are (i) devices for the treatment of brain aneurysms; and (ii) embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations. Thus, the Applicant's goods are sufficiently different from the goods covered in the Registration so as not to cause confusion among consumers.

- According to the ENDURA MD Registrant's website (thermofisher.com), the Registrant's goods are mass spectrometers (i.e., a quantitative instrument for performing laboratory tests and analyses of samples) for in vitro diagnostics. However, the goods identified by the Applicant to be used in connection with the Applicant's Mark are not quantitative instruments for assessing samples and performing diagnostics, but an embolization system which includes a detachable balloon and coil for use during brain aneurysm embolizations. While the Registrant's goods are "mass spectrometers", the goods identified by the Applicant's Mark are (i) devices for the treatment of brain aneurysms; and (ii) embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations. Thus, the Applicant's goods are sufficiently different from the goods covered in the Registration so as not to cause confusion among consumers.

- According to the ENDURACOAT Registrant's website (stellarexdcb.com), the Registrant's goods specifically refer to a coating technology applied to the Registrant's angioplasty balloons. The angioplasty balloon is sold under the brand name "Stellarex", while the drug coating technology used with the Stellarex balloon is known as ENDURACOAT. However, the goods identified by the Applicant to be used in connection with the Applicant's Mark are not a specific coating technology, but an embolization system which includes a detachable balloon and coil for use during brain aneurysm embolizations. While the Registrant's goods are "drug coating technology", the goods identified by the Applicant's Mark are (i) devices for the treatment of brain aneurysms; and (ii) embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations. Thus, the Applicant's goods are sufficiently different from the goods covered in the Registration so as not to cause confusion among consumers.

- According to the SPRINT ENDURA Registrant's website (sprtherapeutics.com), the Registrant's goods specifically refer to a minimally-invasive 60-day single lead electrode implant designed to deliver pain relief. However, the goods identified by the Applicant to be used in connection with the Applicant's Mark are not an electrode implant for pain relief, but an embolization system which includes a detachable balloon and coil for use during brain aneurysm embolizations. While the Registrant's goods are "electrical stimulation systems", the goods identified by the Applicant's Mark are (i) devices for the treatment of brain aneurysms; and (ii) embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations. Thus, the Applicant's goods are sufficiently

different from the goods covered in the Registration so as not to cause confusion among consumers.

Individual consumers of Applicant's goods and the goods listed in the cited registrations make the decision to purchase after careful consideration, and such buyers are highly sophisticated.

Consumers of Applicant's goods and the goods of those of the cited registrations are careful, sophisticated, highly-specialized, and discriminating consumers and are therefore less likely to be confused as to the origin of those goods and services. There is always less likelihood of confusion where goods or services are purchased after careful consideration. Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 718, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (finding that both opposer's services and applicant's goods are usually purchased after careful consideration by persons who are highly knowledgeable and thereby lessening the likelihood of confusion between EDS for computer programming services and EDS for power supplies and battery chargers), citing Astra Pharmaceutical Prods. v. Beckman Instruments, 718 F.2d 1201, 1206 (1st Cir. 1983).

To that end, Applicant's and the cited registrations' respective consumers are highly sophisticated and do not make impulse purchases for use in highly specialized medical procedures; rather, they carefully evaluate the nature and quality of the goods being offered in light of their particular needs or specialty, and they are fully aware of the company when they select a provider of goods. Such respective consumers take great care in selecting such goods and services and make such decisions only after careful consideration. Consumers are much less likely to be confused that Applicant's goods originate from the same source as those of the cited registrations.

ENDURA marks coexist on the Register indicating a narrow scope of protection

Evidence of coexistence of marks containing the word ENDURA on the registrar indicates a narrow scope of protection. The Office action cites to four registrations discussed above, which all coexist and are used in reference to very different types of specialized medical devices.

As is plain from the registrations cited, the term ENDURA is very common for related goods to the cited registrations. This indicates a very narrow scope of protection for the cited marks. See Juice Generation, Inc. v. GS Enters LLC, 794 F.3d 1334, 1338-39 (Fed. Cir. 2015). For this reason, the Office should look at the rest of the distinguishing elements to determine if there is a likelihood of confusion. Applicant's ENDURA mark for its neurovascular medical devices for the treatment of brain aneurysms; embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations is sufficiently distinct from ENDURA for X-rays, ENDURA MD for mass spectrometers, ENDURACOAT for drug-coated balloons for angioplasties, and SPRINT ENDURA for implantable electrodes. Highly sophisticated physician and hospital personnel consumers regularly come across the term ENDURA in connection with medical devices and any distinguishing feature is sufficient to establish that there is no likelihood of confusion.

The application should proceed to publication because "[a]ny doubt in determining registrability of [a mark] is resolved in favor of an applicant…." In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987). The additional evidence of the weakness of the marks indicates an extremely narrow scope of protection. The differences in the marks, even slight,

indicate no likelihood of confusion. Applicant respectfully requests removal of the section 2(d) refusal and that the application proceed to publication.

II. Identification of Goods and Services (and Amendments Thereto)

Applicant notes that the Examining Attorney has initially rejected the application with respect to the identification of goods and services ("Identification") because the goods were classified incorrectly. As requested, Applicant hereby amends the classification as suggested by the Examining Attorney, and further provides a more specific description of the goods used in connection with Applicant's mark, which serves to clearly distinguish the goods from those referenced in the cited registrations:

> **International Class ~~9~~ 10: Medical devices for the treatment of ~~peripheral vascular,~~ neurovascular~~, and structural heart~~ diseases, namely devices for the treatment of brain aneurysms; embolization systems, namely, detachable balloon catheters and coils for use during brain aneurysm embolizations.**

III. Conclusion

For the foregoing reasons, there is no likelihood of confusion between Applicant's ENDURA mark – as amended - and the cited registrations in connection with their respective highly sophisticated goods and consumers. Should the Examining Attorney wish to discuss this Application further, a telephone call to the undersigned attorney is respectfully invited.

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