

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : ConMed Corporation  
Serial No. : 90/042,313  
Mark : INFINITY  
Class : 010  
Filed : July 8, 2020

Examining Attorney:  
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Law Office:  
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### **RESPONSE TO OFFICE ACTION**

Applicant ConMed Corporation (“Applicant”) hereby responds to the United States Patent and Trademark Office’s Office Action dated October 23, 2020. In the Office Action, the Trademark Office refused registration of the application for the INFINITY mark (the “applied-for mark”) under Section 2(d). In view of the arguments and information supplied herein, Applicant respectfully requests that the refusal be withdrawn.

### **Section 2(d) Refusal – Likelihood of Confusion**

The Trademark Office asserts that there is a likelihood of confusion between the applied-for mark (INFINITY) and U.S. Trademark Reg. No. 4,444,100 for INFINITY and earlier-filed pending applications. Applicant respectfully submits that there is no likelihood of confusion between any of the registered mark and the earlier-filed pending applications and Applicant’s applied-for mark.

In evaluating the likelihood of confusion between two marks, one must compare the entirety of the marks. *Estate of P.D. Beckwith, Inc., v. Commissioner*, 252 U.S. 538 (1920). A likelihood of confusion determination is based on the factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973). One of the factors is the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973); TMEP § 1207.01. Here, when properly evaluated in their entireties, Applicant’s applied-for mark and the registered mark and earlier-filed pending applications apply to dissimilar goods.

## **There Is No Similarity of The Nature Of The Goods**

Applicant's amended list of goods is as follows:

- IC 010 – Medical and surgical products and instruments, namely, drill guides, guide arms, guide sleeves, guide bodies, guide pins, implants consisting of artificial materials, drills, reamers, and accessories, namely, titanium alloy buttons for ligament reconstruction, suspensory graft fixation devices, locking suture, suture shuttles, tunnel dilators and instrument trays for use in Orthopedic knee surgery, reconstruction, repair, and preservation sold exclusively through an authorized sales force, excluding ankle prostheses and shoulder implants

Registrant's INFITY mark is registered in connection with the following goods:

- IC 010 – Medical devices, namely, internally implanted orthopedic ankle prostheses

The earlier-filed pending applications are applied-for in connection with the following goods:

- Medical devices, namely, ankle prostheses; Surgical instruments for implanting ankle prostheses
- Surgical implants comprising artificial material, namely, permanent implantable device comprised of tape and a titanium alloy button for ligament reconstruction to treat shoulder injuries; medical needle guides, reamers and cutting devices, all for medical use, namely, for use in implanting a surgical implant for ligament reconstruction to treat shoulder injuries; all of the foregoing excluding surgical and medical apparatus and instruments for use in spinal implant surgery, excluding surgical instruments relating to ankle prostheses, and excluding ankle prostheses
- Medical apparatus and instruments for use with medical analysis for identification, planning as well as implementing of treatment against cancer, benign diseases or neurological disorders using radiation; radiosurgery and radiotherapy equipment, apparatus and instruments; image guided radiation therapy device for use in medicine and recorded computer software and hardware for operation thereof sold as a unit therewith; radiology apparatus for medical purposes; collimators for medical purposes in providing radiation therapy; medical fixation apparatus for fixing limbs in a specified position during measuring and treatment; medical and radiographic linear accelerators for medical use;

radiation beam collimation apparatus for radiotherapy; magnetoencephalography imaging equipment for medical use; radiographic and X-ray equipment for medical use; X-ray tubes for medical purposes; X-ray imaging tubes for X-ray radiation therapy purposes; radiation delivery devices for medical purposes; X-ray image intensifiers for medical purposes; accelerators for charged particles for therapeutic cancer treatment purposes; medical imaging apparatus for the creation or transmission of images, video or data relating to a medical treatment for diagnostic or clinical use; furniture specially made for medical purposes, namely, surgery, therapy, medical treatment and operating tables, beds and couches, excluding furniture for transporting or incubating patients; medical tools, equipment and apparatus for manipulating and positioning of patients, namely, instruments that hold patients in a specified position to allow for precise delivery of oncology treatments; patient safety restraints; medical imaging apparatus for treatment planning; X-ray radiographic and fluoroscopic imaging systems for medical purposes; structural parts and fittings for all the aforesaid goods; all of the aforesaid goods being for use in radiation therapy

The amendment to Applicant's listing of goods avoids any likelihood of confusion between Applicant's mark and the registered mark and earlier-filed pending applications. Applicant's list of goods now excludes ankle prostheses and shoulder implants. Registrant's goods and the goods of one of the earlier-filed pending applications include only implanted orthopedic ankle prostheses. Goods of another of the earlier-filed pending applications are limited to surgical implants to treat shoulder injuries. Applicant's amended list of goods specifically excludes ankle prostheses and shoulder implants.

Regarding the final earlier-filed pending application, the list of goods is specific to the treatment of cancer, benign diseases, or neurological disorders using radiation (and radiation imaging). Applicant's goods include products and instruments for orthopedic knee surgeries. Orthopedic surgery and radiation therapy are very separate and specialized medical fields. Surgeons specializing in orthopedic surgery do not practice radiation therapy and vice versa. Furthermore, instruments used in orthopedic knee surgery are specific to the anatomy of the knee and instruments used in radiation therapy are specific to radiographic or fluoroscopic imaging. In *In re TriVascular, Inc.*, the TTAB identified a difference in vascular stents and hip prostheses. *In re TriVascular, Inc.*, TTAB, Serial No. 77941535 (Nov. 27, 2012). To support a finding of a

significant difference in the goods, the TTAB cited the technological distinction of the goods, the process for manufacturing the goods, and the inability to substitute the goods for each other or use the goods together in a single medical procedure. *Id.* Applicant's products and instruments for orthopedic knee surgeries are technologically distinct, manufactured differently, and cannot be substituted with the products and instruments used in radiation therapy and imaging.

Accordingly, Applicant respectfully asserts that the applied-for mark and the registered marks and earlier-filed pending applications are not likely to be confused due to the dissimilarity among the nature of the goods.

### **Identification of Goods**

Applicant amended the list of goods to recite the following:

- Medical and surgical products and instruments, namely, drill guides, guide arms, guide sleeves, guide bodies, guide pins, implants consisting of artificial materials, drills, reamers, and accessories, namely, titanium alloy buttons for ligament reconstruction, suspensory graft fixation devices, locking suture, suture shuttles, tunnel dilators and instrument trays for use in Orthopedic knee surgery, reconstruction, repair, and preservation sold exclusively through an authorized sales force, excluding ankle prostheses and shoulder implants

### **Conclusion**

For the reasons set forth above, Applicant respectfully requests the Examiner withdraw the refusal under Section 2(d) of the Trademark Act. Accordingly, Applicant respectfully submits that the applied-for mark is not likely to be confused with the registered mark or any of the earlier-filed pending applications because the goods associated therewith are dissimilar.

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance. If the Examining Attorney believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned.

Dated: April 23, 2021

Respectfully submitted,

BY: /Erin S. Phillips/

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