Please consider the following in response to the June 7, 2021 Office Action herein.

In the Office Action, the Examining Attorney has refused registration under Trademark Act Section 2(d), alleging Applicant's mark, when used with the identified goods, is likely to be confused with the mark MOBI PATIENT MOBILITY, subject of U.S. Reg. No. 6342169. Applicant respectfully traverses this refusal of registration and offers the following information and argument in support of its position.

Applicant agrees with the Examining Attorney that likelihood of confusion is to be determined in accordance with the well-known *duPont* factors,[1] as applicable in a given situation. Applicant respectfully submits that when a *duPont* analysis is conducted in the instant matter, the refusal must be withdrawn.

The Respective Goods are Unrelated – In the Office Action, the Examining Attorney alleges Applicant's identified goods and the cited registrant's goods are related based on screenshots from three medical supply houses which, she alleges, manufacture and offer both Applicant's injection devices and the cited registrant's medical instrument organizers under the same mark.[2] In addition, the Examining Attorney alleges the respective goods are complementary because "it is likely the same medical personnel will use applicant's medical infusion and injection devices as well as the registrant's medical instruments organizer used to hold these devices." Applicant respectfully disagrees with the foregoing assessment and submits that once the nature of its goods is fully understood, it becomes clear the respective goods at issue are wholly unrelated for likelihood of confusion purposes.

Applicant's Goods -- Applicant intends to use the applied-for mark in connection with an insulin pump similar to its T:SLIM X2 pump, which appears below:

[1] *In re E. I. duPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973).

[2] With due respect, Applicant submits this characterization of the record evidence is misleading: Contrary to the Examining Attorney's assertion, none of the record evidence suggests the referenced medical supply houses manufacture and offer both injection devices and medical instrument organizers under the same mark. To the contrary, the Henry Schein site offers a medical instrument organizer under the brand HSI and syringes under the PRECISIONGLIDE brand. The Cardinal Health site offers syringes under the MAGELLAN and MONOJECT brands, while the phlebotomy organizer shown is unbranded. Finally, while the referenced Sklar website offers syringes and needles, the screenshots do *not* show medical instrument organizers (or any other goods covered by the cited registration) offered for sale.

Insulin pumps such as Applicant's are small, computerized devices about the size of a cell phone worn by a user that deliver doses of insulin to regulate the user's blood sugar.[3]

Registrant's Goods – The cited registration claims "furniture especially made for medical purposes," as well as mobile organizers and stands for holding and transporting a variety of medical equipment, medical instruments, pharmaceuticals, etc.[4] As demonstrated by the cited registration's specimens of record, the cited registrant offers medical furniture intended to facilitate patient mobility used in hospitals and medical care facilities such as assisted living centers,[5] *viz*.,

In light of the Examining Attorney's refusal to register herein, Applicant appreciates the claim "infusion and injection devices for administering drugs and other medicaments" in the application as filed encompasses both syringes of the sort shown in the medical supply screenshots of record as well as certain infusion pumps capable of mounting on the cited registrant's equipment stands and organizers.[6] To eliminate this unintended overlap, Applicant has amended Class 10 to identify its insulin pumps with greater specificity, as follows,

> Medical devices, namely, ambulatory infusion pumps for delivering insulin; replacement parts for the aforesaid goods.

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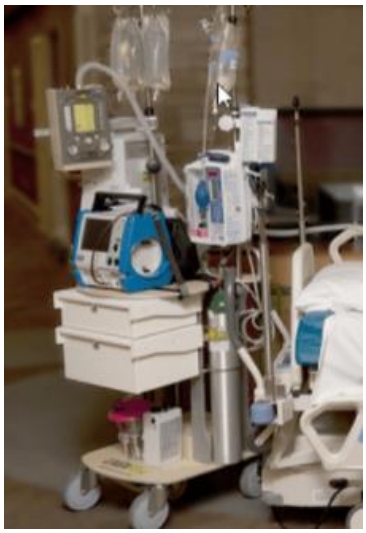
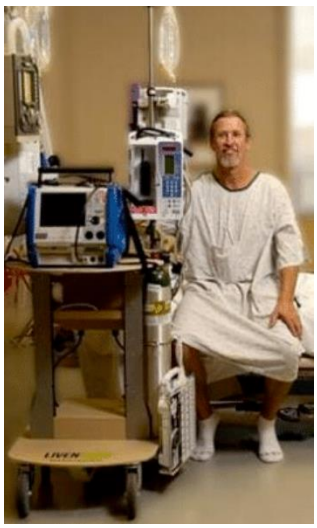
[3] See screenshot titled "Insulin Pump What Is It" attached within Exhibit A.
[4] The cited registration's full identification reads,

> Furniture especially made for medical purposes; medical instrument organizer specially adapted for holding medical instruments; medical supply organizer specially adapted for holding medical instruments and pharmaceuticals; medical stands for holding and transporting medical apparatus and devices; mobile equipment consolidator for holding and transporting medical equipment, gasses, medicines, and patient supplies; mobile medical device stands with power outlets, and IV poles, in Class 10.

[5] See screenshot titled "Mobility Protocols" attached within Exhibit A.
[6] See screenshot titled "What is an Infusion Pump?" attached within Exhibit A

Applicant specifically notes its amended identification *excludes* "injection devices" such as syringes. In addition, the amended identification clarifies that Applicant's device is an *ambulatory* insulin pump, distinguishing it from stationary bedside infusion pumps such as those shown below in connection with one of the cited registrant's mobile equipment stands:[7]





Based on Applicant's amended identification and the foregoing information, Applicant respectfully submits its insulin pumps are entirely distinguishable from and unrelated to the cited registrant's medical facility furniture. The respective goods are not identical, do not perform the same, similar, or inter-related functions, are not used together in a complementary fashion, and do not compete in the marketplace. A finding that the goods in an application are not closely related to those in a cited registration can be sufficient, even in the face of *identical* marks, to give rise to the conclusion that there is no likelihood of confusion.[8]

In addition to the differences between the goods at issue, the conditions surrounding the purchase of Applicant's insulin pumps and the cited registrant's medical furnishings eliminate any likelihood of consumer confusion. Applicant's insulin pumps are sold to diabetes patients seeking the advantages offered by its devices. Like all insulin pumps, Applicant's pumps are available by prescription only following consultation with and evaluation by a licensed physician. In contrast, the cited registrant's medical facility furnishings are offered to and purchased by professional hospital purchasing agents to meet specific, pre-defined needs (*e.g.*, increasing patient mobility, meeting surge capacity).

Due to their nature, sales of Applicant's insulin pumps and the cited registrant's medical furniture simply cannot take place based on impulse or trademarks alone, in contrast to the "off the shelf" nature of typical consumer goods. Further, as noted above, Applicant's insulin pumps and the cited registrant's medical furniture are distributed in different trade channels, targeting different

[7] See screenshot titled "Surge Capacity Solutions" attached within Exhibit A.
[8] *See In re Fesco*, 219 USPQ 437, 438 (TTAB 1983) (explaining that "the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other").

consumers acquiring the respective goods for entirely unrelated purposes, all mitigating any potential for confusion. Finally, of course, the fact that the purchasers of the cited registrant's medical furniture are sophisticated professionals weighs against the likelihood of consumer confusion.[9] In this situation, the TMEP indicates no confusion is likely:

> [I]f 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.[10]

The MOBI Element of the Cited Mark is Weak – Evidence of third-party use of a mark or constituent components thereof falls under the sixth *du Pont* factor – the "number and nature of similar marks in use on similar goods."[11] In this instance, Applicant respectfully submits widespread third-party use and registration of marks consisting of or incorporating MOBI with medical goods in Class 10 demonstrates that the MOBI element of the cited mark is commercially weak and entitled to a relatively narrow scope of protection, as follows.[12]

Third-Party Uses Weaken MOBI as an Indication of Origin -- Applicant has attached illustrative examples demonstrating common third-party use of marks consisting of or incorporating MOBI for medical goods, including the following:[13]

[9] *See* J. Thomas McCarthy, Trademarks and Unfair Competition §23:101 ("Where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar").
[10] TMEP §1207.01(a)(I).
[11] *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).
[12] *See Information Resources, Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1039 (TTAB 1988) (holding that widespread use of a term in the relevant industry is an indication that the term is weak); *see also In re Hamilton Bank*, 222 USPQ 174, 178 (TTAB 1984) (noting that evidence of use of a common term by a number of different parties indicates that the common term is weak).
[13] Evidence in the form of third-party website screenshots documenting the above as well as additional screenshot evidence is attached within Exhibit B.

Mobi-Lift® handle facilitates the sit to stand procedures during mobilization.

mobimedical Supply.com

Trolley MOBI CT100-G™
mobimedical Supply.com

MOBI CT100-G™

Applicant respectfully submits the foregoing evidence of marketplace use is "*powerful on its face*" as used to demonstrate the weakness of MOBI element of the cited mark.[14] As such, this evidence demonstrates the cited mark is "relatively weak and entitled to only a narrow scope of protection."[15]

Third-Party Use and Registration Weaken MOBI as an Indicator of Origin -- In addition to the above, Applicant submits widespread third-party use and registration of marks consisting of or incorporating MOBI with Class 10 medical goods demonstrates the inherent weakness of MOBI as used with the cited registrant's goods, as illustrated by, *inter alia*, the following third-party registrations in which proof of use has been filed with the Office:

Mark	**Reg. No.**
MOBI	5544569
MOBI	6100897
MOBI	3365795
MOBIS	3486729
MOBIS	3250450
MOBIES	5413301
MOBI-C	3197424
MOBI M6	4994106
MOBI-LIFT	3520829
MOBIO	5829749
MOBIUS	6239405
MOBILATE	6309721
MOBISKINS	6264011
MOBILEGS	6100890
MOBIPACS	5706750
MOBI BODYWORK	5462036
BIOMOBIE	5868626
MOBICUFF	5047875
MOBICT	4538070
MOBICATH	4529792
MOBIUSHD	4548128
MOBILASER	4129302
MOBIUS	2895358

[14] *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (emphasis added).

[15] *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondee en 1772*, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (finding the "smoking hot" element in the marks I'M SMOKING HOT and SMOKIN' HOT SHOW TIME "somewhat weak" based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses "tend to show consumer exposure to third-party use of the term on similar goods"); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting evidence third parties had adopted marks identical or similar to opposer's mark "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak").

MOBIUS IMAGING	4347023
MOBILETT	1685185
	6435730
	6357049
	6144542
	4962244

TSDR printouts showing details for the above are attached. While none of the above references identify goods similar to Applicant's in a manner likely to cause confusion or mistake, their sheer number suggests the Office has been willing to register many marks incorporating MOBI on a continuing basis for use with medical goods in Class 10; in this regard, Applicant notes over *two dozen* of the above registrations have filing dates prior to the cited registration's March 18, 2019 filing date.

Applicant recognizes the existence of third-party registrations cannot, *per se*, justify registration of what may otherwise be a confusingly similar mark;[16] however, "third party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services."[17] As explained in the *Juice Generation* case,

> Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.[18]

[16] *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).
[17] TMEP §1207.01(d) (iii). *See also, Jerrold Electronics Corp. v. The Magnavox Company*, 199 USPQ 751, 758 (TTAB 1978) (third- party registrations "reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various 'STAR' marks can coexist provided that there is a difference.")
[18] *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) citing 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015). *See also, Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ 693, 694-95 (CCPA 1976) (even if "there is no evidence of actual use" of "third-party registrations," such registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used").

Similarly, in *Jack Wolfskin*, the Federal Circuit held evidence demonstrating common adoption of a particular trademark element by multiple registrants can indicate the element has a non-source identifying significance that undermines its conceptual strength as an indicator of a single source.[19] The TMEP also indicates consideration of the descriptive significance of individual elements comprising a multi-term mark is appropriate in evaluating the mark's relative strength as a whole.[20]

In this instance, the widespread use of MOBI in connection with Class 10 medical goods entitles the cited mark to protection only against *substantially identical marks* for *substantially identical goods*.[21] As a result, Applicant respectfully asserts the commonality of MOBI to the marks at issue is not a sufficient basis upon which to find a likelihood of confusion.[22] The Office clearly took this view in allowing the cited mark for registration amongst a crowded field of similar registered marks such as those identified above.

The Marks Differ in Overall Appearance, Pronunciation, and Commercial Impression – In the Office Action, the Examining Attorney alleges Applicant's mark is confusingly similar to the cited mark because they share the identical term MOBI. Applicant does not dispute the presence of this common element; however, that alone does not mandate a finding of likely confusion.[23] In this instance, Applicant respectfully submits the weakness of MOBI as used with the cited registrant's medical facility furnishings must factor into assessing similarity between the marks. This weakness "is a significant factor which 'tip[s] the scales' in favor of a finding of no likelihood of confusion."[24]

With the above in mind, Applicant respectfully submits the TANDEM and PATIENT MOBILITY elements of the respective marks renders them *visually* distinguishable. Similarly, presence of the terms alters the *pronunciation* of the respective marks. Applicant submits these

[19] *Jack Wolfskin*, 116 USPQ2d at 1136 ("[E]vidence of third-party registrations is relevant to 'show the sense in which a mark is used in ordinary parlance,' … that is, some segment that is common to both parties' marks may have 'a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak'").
[20] *See* TMEP §1207.01(b)(viii) ("If the common element of two marks is 'weak' in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. ").
[21] *Plus Products v. Redken Laboratories, Inc.,* 199 USPQ 111, 116-17 (TTAB 1978). ("It is settled that highly suggestive terms, because of their connotation and possible frequent registration, *per se*, and as component of marks for the same or similar goods, have been considered to fall within the category of 'weak' marks, and the scope of protection afforded these marks has been limited to the substantially identical designation and/or to the subsequent use thereof on substantially similar goods.")
[22] *Juice Generation*, 115 USPQ2d 1671, 1674-75 (citing *Drackett Co. v. H. Kohnstamm & Co.*, 160 USPQ 407, 408 (CCPA 1969) ("The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.").
[23] *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.,* 167 USPQ 529, 530 (CCPA 1970) (explaining that the fact one mark includes the whole of another does "not *ipso facto* warrant a holding that the marks are confusingly similar").
[24] *In Re Dayco Products-Eaglemotive, Inc.*, 9 USPQ2d 1910 (TTAB 1988)) (reversing the Examiner's refusal to register "IMPERIAL" for automotive products based on a prior "IMPERIAL" registration for the same goods).

differences cannot be ignored in properly assessing similarity of the marks at issue *in their entireties*.[25]

In addition to the foregoing, Applicant respectfully submits "TANDEM is the dominant, distinguishing component of Applicant's mark. It is the first term in the applied-for mark—the part that is most prominently displayed, first encountered by purchasers, and most likely to be remembered by those purchasers.[26] Therefore, when considered in connection with Applicant's goods, the presence of Applicant's house mark TANDEM in the applied-for mark creates a commercial impression entirely dissimilar from that created by the cited mark.

Conclusion -- As the Board has stated, for confusion to be likely, it must be *probable*; not merely possible.[27] Applicant respectfully submits that while confusion is certainly possible in the present situation, it is by no means *probable*. Hence, Applicant respectfully requests withdrawal of the refusal of registration under Trademark Act Section 2(d) and allowance of the subject mark for publication.

[25] *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition LLC,* 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (noting that the visual distinctions in the marks at issue create "unquestionably different commercial impressions" that preclude a likelihood of confusion). *See also, In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n. 4 (TTAB 1987) (similarity as to one aspect of a mark does not automatically result in a likelihood of confusion).
[26] *See Palm Bay Imports*., 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America,* 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prod. Inc. v. Nice-Pak Products., 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").
[27] *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1465 (TTAB 1992); *Rodeo Collection, Ltd v. West Seventh*, 2 USPQ2d 1204, 1206 (9 Cir. 1987).