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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SYNTHES AG Chur

Serial No. 78/035,255

Stephen A. Hill of Rankin, Hill, Porter & Clark for SYNTHES AG Chur.

John D. Rodriguez, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hohein, Walters and Rogers, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

SYNTHES AG Chur has filed an application to register the mark "AO" for the following goods and services:¹

"prerecorded computer discs, videotapes and CD-ROMS with computer programs for teaching surgical techniques, sorters for sorting photographic pictures, X-ray pictures, slide transparencies and videos featuring medical information, exposed X-ray films and slides; computer software for use in database management and spreadsheets in the fields of science and technology; blank magnetic data carriers for computers; integrated computer software for use in database management and spreadsheets in the fields of science, technology and education" in International Class 9;

¹ Ser. No. 78/035,255, filed on November 14, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce.

"surgical, medical, dental, and veterinary implants of biodegradable and non-biodegradable materials, in particular for osteosynthesis, musculoskeletal surgery, maxillofacial and spine surgery; artificial limbs, artificial teeth, bone pins, bone nails, bone screws and bone plates, angulated plates, compression plates, hip screws and hip plates, pedicle screws and pedicle hooks, intramedullary nails, splints, cerclage wires, bone clamps and bone staples; endoprosthesis, in particular endo-joint-prosthesis, intramedullary plugs; prostheses and reinforcements for ligaments and tendons; apparatus and instruments for stereo-tactical and computer-aided surgery, in particular, gastroscopes, laryngoscopes, probes and surgical knives; bone drills, rasps and saws, distractors, bone forceps, elevators, retractors, chisels, impactors, internal and external fixators, pelvic clamps, surgical drills, drill guides, aiming devices; trays and cases for instruments and implants of the aforesaid kind; surgical sutures; artificial bones and limbs for medical insertion purposes" in International Class 10;

"printed matter, in particular newspapers, magazines and books featuring medical information; teaching material, in particular workbooks featuring medical information" in International Class 16;

"copyright management" in International Class 35;

"publication of books and magazines; electronic publication services, in particular publication of text and graphic works of others on CD-ROMS featuring medical information; library services, production of educational video tapes; organizing and conducting fairs, classes, exhibitions, and seminars in the field of medicine" in International Class 41; and

"medical research, organizing and conducting medical clinical trials, medical laboratory services, medical services, providing medical information, leasing computer facilities, language translations, and medical photography" in International Class 42.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its goods and services, so resembles the mark "AO" and design, as shown below,



which is registered for "surgery and medical services, namely, ear, nose and throat as well as plastic and cosmetic surgery" in International Class 42,² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. Inasmuch as registration must be refused if use of a mark for any item in an application is likely to cause confusion with a mark for any item in a prior registration, see, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981), and because we find a likelihood of confusion solely with respect to applicant's use of its mark for "medical services" in International Class 42 and registrant's use of its mark for its services, we affirm the refusal to register as to International Class 42, but reverse the refusal to register as to International Classes 9, 10, 16, 35 and 41.

² Reg. No. 2,332,480, issued on March 21, 2000, which sets forth a date of first use anywhere of September 30, 1996 and a date of first use in commerce of February 5, 1997. The term "P.A." is disclaimed.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods and services, applicant argues that (*italics in original*):

It is very apparent from a review of the goods and services of applicant that its goods and services are intended for physicians, medical personnel and others in the medical profession. The services in the cited registration, on the other hand, are being offered *by physicians, not to physicians*. The services in the cited registration are being offered to patients. Medical patients ordinarily would have no cause to be exposed to a mark applied to, for example, surgical instruments and supplies, since such goods would be marketed to the physicians [and] not to the patients. As such, the two marks ... are not intended to be seen by the same class of customers, so there would be no likelihood of confusion.

However, as the Examining Attorney has pointed out (both in his brief and in the final refusal), applicant's goods and services include "medical services" in International Class 42. Such services plainly encompass, and hence are identical to, registrant's "medical services, namely ear, nose and throat"

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

services, and are clearly related to registrant's "surgery" services with respect to the ear, nose and throat, including "plastic and cosmetic surgery." The provision of applicant's "medical services" and registrant's "surgery and medical services, namely, ear, nose and throat as well as plastic and cosmetic surgery" services to the general public under the same or similar marks would consequently be likely to cause confusion as to source or sponsorship.

With respect to applicant's other goods and services, the Examining correctly notes that it is well settled that goods and/or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and/or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). One way, in particular, of demonstrating such a close relationship is by making of record copies of use-based third-party registrations of marks which, in each instance, are registered for the respective goods and/or services at issue. While such third-party registrations are admittedly not evidence

that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods and/or services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In this case, the Examining Attorney maintains that:

[I]t is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. TMEP Section 1207.01(a)(ii). It is common for parties that perform medical services to also use the same mark in relation to medical instruments, goods, products, equipment devices and software. As evidenced by third[-]party registrations taken from the X-Search database and attached to the Final Office Action dated August 24, 2001, it is common in the medical field for companies to use the same mark for medical instruments and devices along with medical services. As a result, the source of the goods and services is likely to be confused.

A review of the seven use-based third-party registrations made of record by the Examining Attorney reveals, however, that while such registrations, broadly speaking, cover on the one hand a variety of medical instruments and devices, various computer programs with application to the medical field, or medical training services, and list on the other hand certain medical services, none sets forth or encompasses both one or more of applicant's particular goods and/or services and registrant's specific "surgery and medical services, namely, ear, nose and throat as well as plastic and cosmetic surgery" services.

Thus, and aside from applicant's "medical services," there is simply no evidence that any of its diverse goods and services, which as applicant points out "share the common theme of medicine and surgery, but are otherwise quite different" on their face from registrant's particular services, are indeed sufficiently related to the latter as to be likely, if provided under the same or similar marks, to cause confusion as to the origin or affiliation of the goods and services at issue. As applicant stresses in its brief, there has been no showing by the Examining Attorney of any common channels of trade and classes of purchasers for the respective goods and services; instead, it is apparent that, in essence, applicant "is offering medical supplies and information to the medical community" while "[t]he owner of the cited registration is offering medical services to interested patients."

Turning, therefore, to consideration of whether applicant's "AO" mark for its "medical services" so resembles registrant's "AO" and design mark for its identical in part and otherwise closely related "surgery and medical services, namely, ear, nose and throat as well as plastic and cosmetic surgery" as to be likely to cause confusion, applicant argues that:

When considered in their entireties, the marks are quite different. Applicant's mark is the simple combination of letters AO. The mark in the cited registration is for the entire term AO P.A. and includes a dominating design feature.

While marks must be considered in their entireties, including any descriptive or generic matter, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion

on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

In the present case, when the respective marks are considered in their entireties, it is plain that they are substantially the same in appearance, sound, connotation and commercial impression. In particular, we concur with the Examining Attorney that the dominant and distinguishing portion of registrant's "AO" and design mark is the letters "AO," which are identical in all respects to applicant's "AO" mark. Clearly, because of their large size and bold stylization, the letters "AO" form the most prominent portion of registrant's mark,⁴ especially since, as noted by the Examining Attorney, the much smaller and disclaimed "letters 'P.A.[,]' like 'Co.,' 'Corp.,' and 'Inc.,' are merely generic entity designations" which provide very little in terms of functioning as a source identifier.

Moreover, while registrant's mark contains a design feature, consisting basically of an outline of a human head with

⁴ The cited registration, we observe, issued to and is owned by "Affiliated Otolaryngologists, P. A."

a representation of an ear, nose and throat, such feature is overshadowed by not only the visual prominence of the letters "AO" but the descriptiveness inherent in such a feature when used as part of a mark for surgical and medical services focused on treatment of the ear, nose and throat. The most prominent element in registrant's "AO" and design mark, and the element which would be utilized by patients in asking about and referring to registrant's services, consequently consists of the letters "AO," which form the dominant and distinguishing portion of registrant's mark when considered as a whole.

In addition, it must be kept in mind that because applicant seeks registration of its "AO" mark in typed form, the display thereof could include the same stylized manner of lettering as that utilized by registrant for the letters "AO" in its "AO" and design mark. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in typed format is not limited to the depiction thereof in any special form]; and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word] could be depicted"].

Accordingly, we find that patients and other members of the general public, who are familiar or acquainted with registrant's "AO" and design mark for its "surgery and medical services, namely, ear, nose and throat as well as plastic and

cosmetic surgery" services, would be likely to believe, upon encountering applicant's substantially identical "AO" mark for its "medical services" in International Class 42, that such identical in part and otherwise closely related services emanate from, or are sponsored by or associated with, the same source.

Decision: In view of our finding of a likelihood of confusion solely with respect to applicant's "medical services" in International Class 42, the refusal under Section 2(d) is affirmed as to International Class 42, but is reversed as to International Classes 9, 10, 16, 35 and 41.⁵

⁵ In consequence thereof, it is pointed out that unless on a possible appeal applicant ultimately prevails with respect to the finding of a likelihood of confusion as to its "medical services" in International Class 42, the application will in due course go forward to publication of applicant's "AO" mark for the goods and services in International Classes 9, 10, 16, 35 and 41, but will stand abandoned as to the services in International Class 42.