

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed: 9/5/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Invivo Corporation

Serial No. 78670679

Virginia R. Richard and Sanjana Chopra of Winston & Strawn
for Invivo Corporation.

W. Wendy Jun, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Drost and Bergsman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Invivo Corporation to
register the mark TELEPAK for "wireless telemetry
transmitter for monitoring vital signs" in International
Class 10.¹

Registration was refused by the trademark examining
attorney under Section 2(d) of the Trademark Act on the

¹ Application Serial No. 78670679, filed July 14, 2005, based on
an allegation of a bona fide intention to use the mark in
commerce.

ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark TELEPAC for "containers for use in sterilizing medical equipment; containers for use in sterilizing operating telescopes; arthroscopes; [and] laparoscopes" in International Class 10.²

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.³

Applicant argues that the goods offered under the involved marks, while broadly characterized as medical products, are distinctly different in nature, purpose and function, and that the respective purchasers of the goods are sophisticated consumers in the medical field. Applicant asserts that, in stark contrast to registrant's goods which are intended for use during interventional medical procedures, its goods are intended to be used to assist medical personnel in measuring and monitoring the

² Registration No. 3026696, issued December 13, 2005.

³ Applicant's appeal brief and reply brief are both accompanied by exhibits. The examining attorney, in her brief, made no mention of the exhibits attached to applicant's appeal brief. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. Exhibits attached to a brief that were not made of record during the examination are untimely, and generally will not be considered. TBMP § 1203.02(e) (2d ed. rev. 2004). The exhibits attached to applicant's appeal brief and reply brief are untimely and, accordingly, this evidence has not been considered.

vital signs of ambulatory patients in a hospital, nursing home or home-care setting. According to applicant, registrant's goods are purchased by surgeons or hospital purchasing agents assigned to the supply of goods used during surgery, while applicant's monitors would be purchased by primary care physicians for post-surgical and non-surgical patients, as well as for patients in nursing homes and in-home care environments. According to applicant, the goods would not be used during the same medical procedure because applicant's monitor is intended for use on mobile patients whereas registrant's goods are intended for use on immobilized patients in an operating room environment. Applicant has submitted literature about its goods.⁴

The examining attorney maintains that the marks are phonetic equivalents, sounding the same and looking similar. As to the goods, the examining attorney contends that "they are closely related because they are both medical devices that are commonly manufactured by the same company and thus emanate from the same source." (Brief, p.

⁴ Applicant, in its reply brief, also asserts that the cited mark "appears to have been discontinued from use" based on its search of registrant's website. This allegation constitutes an impermissible collateral attack on the cited registration. Thus, we have given no consideration to the allegation. See *In re Jump Designs LLC*, 80 USPQ2d 1370, 1376 (TTAB 2006).

3). The examining attorney has relied upon third-party registrations that purportedly show that the same companies sell both medical monitoring devices as well as arthroscopes and laparoscopes. The examining attorney also submitted articles retrieved from the Internet to show that a patient's vital signs must be monitored after laparoscopic surgery, and that hospitals and doctors using arthroscopes and laparoscopes are also using monitors to check on patients' vital signs post-operation. In further support of the refusal, the examining attorney introduced excerpts of four third-party websites of online medical supply retailers/distributors.⁵

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods

⁵ All of the examining attorney's evidence goes to the relatedness between applicant's goods and registrant's arthroscopes and laparoscopes; none of the evidence mentions containers for use in sterilizing medical or operating equipment.

and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). One other key factor in this case concerns the conditions under which and buyers to whom sales of the goods at issue are made.

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the goods offered under the respective marks is likely to result.

The marks TELEPAC and TELEPAK differ by only their last letter. The marks are phonetically equivalent and, thus, identical in sound. The difference of one letter in the marks, especially because it is the last letter and the letters "C" and "K" happen to be phonetically interchangeable, has essentially no effect on the appearances of the marks. Simply put, the marks are virtually identical in appearance. As to meaning, the

marks could convey somewhat different connotations, but there is no evidence one way or the other. For example, it would appear that the "TELE" portion of applicant's mark refers to the telemetry function of applicant's transmitter, whereas the "TELE" portion of registrant's mark might refer to the telescopic function of arthroscopes and laparoscopes. We are less sure, however, as to the meaning of "PAC" and "PAK" in the respective marks. Given the lack of evidence on the issue, our analysis as to the connotation of the marks is somewhat speculative. Nevertheless, in view of the significant similarities between the marks in sound and appearance, we find that they would engender virtually identical overall commercial impressions.

The factor of the similarities between the marks weighs in favor of finding a likelihood of confusion.

We next turn to a consideration of the goods. It is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under

circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

Applicant's product is a patient-worn telemetry transmitter that is used in monitoring the ECG (electrocardiogram) and SpO2 (saturation of peripheral oxygen) levels of ambulatory patients. Applicant's product literature states the following:

Tired of running back and forth from your patient's bedside to the central monitoring station just to see if the telemetry transmitter is functioning properly? The new lightweight TelePak ECG/SpO2 transmitter with its unique "Quick View" display window, allows you to visualize and verify proper electrode placement and waveform transmission with "Just One Look" - without ever leaving the patient's bedside.

Providing vital clinical information at the patient bedside - saving the clinician's time and unnecessary steps to and from the central monitoring station.

In the event of electrode/lead failure Telepak will "Automatically" select an alternative monitoring lead.

Optional SpO2 feature incorporates the convenience of monitoring two clinical parameters with one patient device.

Innovative ambulatory telemetry to meet your needs for maximum patient care and efficiency.

With respect to the types of goods listed in the cited registration, arthroscopes and laparoscopes are highly specialized, pencil-sized surgical instruments that contain a small lens and a lighting system. Arthroscopes are used in connection with joints (e.g., knees), while laparoscopes are used to repair/remove internal organs. These instruments allow surgeons to conduct diagnostic and surgical procedures on patients by making only small incisions. There is no information in the record relating to containers for use in sterilizing medical equipment and operating telescopes.

The burden is on the examining attorney to show that applicant's and registrant's goods are related. In determining the issue of likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Thus, although extrinsic evidence reveals certain characteristics of applicant's goods (e.g., that they are patient-worn or are for ambulatory patients), the goods are not so limited. Although we have considered the evidence to better understand the nature of applicant's

product, we have compared the goods on the basis of the respective identifications. *Cf. In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990).

The goods, on the face of the respective identification of goods, are distinctly different in terms of nature, use and function. Both are highly specialized medical instruments and devices for different purposes. Nonetheless, the examining attorney is correct in stating that applicant's and registrant's goods fall under the broad category of medical equipment, and that the goods are purchased and used by the same classes of consumers, including doctors, hospitals and out-patient surgical centers. The examining attorney has attempted to solidify her finding of a connection between the goods by introducing third-party registrations and information retrieved from the Internet.

The examining attorney has relied upon seven third-party registrations of marks registered by the same entity for both arthroscopes and laparoscopes on the one hand, and various types of medical monitors on the other. Third-party registrations which individually cover a number of different items (and/or services) **and which are based on use in commerce** serve to suggest that the listed goods and/or services are of a type that may emanate from a

single source. *In re Albert Trostel & Sons Co.*, 29 USPQ 1783 (TTAB 1993). The problem with the examining attorney's evidence herein is that six of the registrations are based not on use, but rather on a foreign filing.⁶ The seventh registration is a house mark, as evidenced by the identification of goods, with the prefatory language "house mark," followed by a listing of a wide range of medical products. Generally, registrations of house marks are given little probative value in terms of showing that the various goods listed therein are related because they cover such a disparate range of goods. *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Further, while the registrations list "monitors," none would appear to be of the type made by applicant. Consequently, the third-party registrations of record are insufficient to show that the goods at issue are commercially or otherwise closely related in that they are of a type that may emanate from a single source. *See, e.g., In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

The examining attorney further has submitted excerpts

⁶ We also note that none of the registrations indicates that the registrant has filed a Section 8 affidavit showing that there has been use in commerce in the United States.

from the websites of four online medical supply retailers/distributors showing that these entities sell both types of goods, that is, vital signs monitors and laparoscopes and arthroscopes. This evidence likewise is not persuasive to show a connection between these distinctly different products. The websites show that these four online retailers/distributors have assembled a wide range of medical equipment for sale, including monitors, operating lights, weight scales, exam tables and defibrillators. The monitors and arthroscopes and laparoscopes offered for sale are manufactured by a variety of entities under various different marks; there is not one instance of such goods emanating from the same manufacturer, let alone from the same manufacturer under the same mark. The fact that medical supply retailers/distributors sell all of these goods does not necessarily mean that they are commercially related. What this evidence does show for purposes of our analysis, however, is that monitors and arthroscopes and laparoscopes can cost several thousands of dollars; this cost further contributes to the sophisticated nature of any purchasing decision.

The examining attorney also points to an article that includes reference to the fact that "vital signs must be

monitored after laparoscopic surgery, as with any types of surgery." Therefore, the examining attorney asserts, "it is very likely that hospitals and doctors performing surgery using arthroscopes and laparoscopes are also using applicant's products to monitor the patients after arthroscopic or laparoscopic surgeries." (Brief, p. 5).

We are not persuaded. Most, if not all, surgeries require that the patient's vital signs be monitored. This fact, however, should not lead to the conclusion that vital signs monitors are commercially related to all other specialized instruments that are being used during or after surgery.

Against the backdrop of this minimal evidence bearing on the relatedness of the goods is the fact that, even assuming that applicant's and registrant's goods would be purchased by the same doctors, hospitals, out-patient surgical centers and other medical institutions, it is readily apparent that the purchasing decisions for such goods would be made by highly sophisticated and knowledgeable buyers under conditions of sale which would further minimize any likelihood of confusion as to source or affiliation. As *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983) makes clear, for a likelihood of confusion to exist, "it must be based on confusion of some relevant

person, i.e., a customer or user, and there is always less likelihood of confusion where goods are expensive and purchased and used by highly specialized individuals after careful consideration." It has long been recognized that purchasers of medical equipment, whether hospital personnel or physicians, are highly sophisticated and, as such, are more likely to distinguish between marks and goods than is the general consuming public. *In re N.A.D.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985); and *Pfizer Inc. v. Astra Pharmaceutical Products Inc.*, 858 F.Supp. 1305, 33 USPQ2d 1545, 1562 (S.D.N.Y. 1994) ["[t]he consumers here are doctors, as sophisticated a group as one could imagine"].

The evidence indicates that laparoscopes and arthroscopes are used by a variety of doctors, including general surgeons and orthopedic surgeons, gynecologists, and urologists. These are specialists who are highly trained in their field and who, by necessity, must be very sophisticated about the selection and use of specific instruments during a medical procedure. *See, e.g., Warner-Hudnut, Inc. v. Wander Co.*, 280 F.2d 435, 126 USPQ 411, 412 (CCPA 1960) [physicians constitute "a highly intelligent and discriminating public"]. Because the products at issue are all used for patient care, we can safely assume that

the doctors and hospital personnel responsible for the selection and purchase of those products will exercise a high degree of care in purchasing decisions to ensure that the products come from a reputable source, thereby further minimizing a likelihood of confusion. Their "sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'" *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), quoting from *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 212 USPQ 246, 252 (1st Cir. 1981). While, in this case, it is possible for the same doctor, medical practice or hospital to purchase both applicant and registrant's goods, the Federal Circuit has cautioned that it is error to deny registration simply because an applicant markets and sells its goods in the same general field as those promoted and sold by the registrant (e.g., the medical field). See *Electronic Design & Sales*, 21 USPQ2d at 1391.

When consumers exercise heightened care in evaluating products before making purchasing decisions, there is not a strong likelihood of confusion. *Electronic Design & Sales Inc.*, 21 USPQ2d at 1392 ["there is always less likelihood of confusion where goods are...purchased after careful

consideration."]. As Professor McCarthy notes, "the price level of the goods...is an important factor in determining the amount of care the reasonably prudent buyer will use. If the goods...are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation." 3 McCarthy on Trademarks and Unfair Competition, § 23:95 (4th ed. 1998). Similarly, "[w]here the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers." *Id.* at § 23:101.

In sum, both types of products involved in this appeal would be bought by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation. Further, the goods are distinctly different and relatively expensive. Given the knowledge, care and deliberation required of doctors, hospitals and other medical institutions in making the purchasing decisions with respect to applicant and registrant's goods, it is unlikely that they would be confused.

The connection between applicant's wireless telemetry transmitters for monitoring vital signs and registrant's containers for use in sterilizing medical equipment; containers for use in sterilizing operating telescopes;

arthroscopes; and laparoscopes is so tenuous that the public would not view the goods as having a common source, even when sold under virtually identical marks. In sum, the examining attorney has not met her burden of showing that applicant and registrant's goods are related. With scant evidence that the goods are related, the fact that the marks used in connection therewith are virtually the same is not sufficient to demonstrate a likelihood of confusion. Based on the record before us, we see the likelihood of confusion between the marks as amounting to only a speculative, theoretical possibility. See *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998) [no likelihood of confusion between the mark DIGIRAD for gamma radiation sensors, signal processors and display apparatus for use in medical isotopic tracing and nuclear imaging and mark DIGIRAY and design for electronic digital xray system comprised of an x-ray scanning beam tube and detector for medical use]. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Ser No. 78670679

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d at 1391, citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

In sum, the differences between the goods and the sophistication of the purchasers for such goods outweigh the similarities between the marks.

Decision: The refusal to register is reversed.