Hearing:
July 23, 2002

Paper No. 33
Bottorff

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cordis Corporation
v.
Anthony P. Furnary

Opposition No. 99,988
to application Serial No. 74/545,005
filed on June 30, 1994

Norm D. St. Landau of Drinker, Biddle & Reath LLP for Cordis Corporation

Charles D. McClung of Chernoff, Vilhauer, McClung & Stenzel, LLP for Anthony P. Furnary.

Before Seeherman, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark CORIS for goods identified in the application as

"computer database management program for cardiologic medical and surgical information."[1]

Opposer filed a notice of opposition to registration of applicant's mark. As grounds therefor, opposer alleged that it is the owner of the trademark and trade name CORDIS, previously used by opposer in connection with a wide variety of medical devices and systems for the cardiology, radiology and neuroscience markets and in connection with related computer hardware and software products, and that applicant's mark, as applied to applicant's recited goods, so resembles opposer's CORDIS mark and name as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d). Applicant filed an answer by which he denied the allegations of the notice of opposition which are essential to opposer's claim for relief.

The evidence of record consists of status and title copies of three CORDIS registrations owned by opposer (submitted by opposer under notice of reliance), each of which is shown to be extant and owned by opposer;[2] the

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[1] Serial No. 74/545005, filed June 30, 1994. The application was filed on the basis of intent-to-use, under Trademark Act Section 1(b).

[2] These registrations are:

> Registration No. 726,044, issued January 2, 1962, of the mark CORDIS for "medical instruments, namely, intercalative angiographs, cardiac programmers";
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> Registration No. 846,345, issued March 19, 1968, of the mark CORDIS for "medical instruments, namely,

testimony depositions of opposer's witnesses David M. Urso and Peter J. Bacquie, with exhibits thereto; and the testimony deposition of applicant Anthony P. Furnary, with exhibits thereto.

Opposer and applicant filed main briefs at final hearing, but opposer did not file a reply brief. An oral hearing was held at which only opposer appeared and presented argument. We sustain the opposition.

Initially, we find that opposer has standing to oppose based on its ownership of its CORDIS marks and its non-frivolous likelihood of confusion claim. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *see generally Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). We further find that Section 2(d) priority is not at issue in this proceeding, in view of opposer's submission of status and

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cardiac pacers, radiopaque contrast medium injectors, catheters for guided angiography; and

Registration No. 2,081,010, issued July 22, 1997, of the mark CORDIS for "computer hardware components, namely, monitor, keyboard, mouse, internal modem, blank floppy and tape disks, and computer software used to collect data on medical procedures used by hospitals and to collect data on product inventory used in such procedures."

None of these registrations was pleaded by number in the notice of opposition. However, applicant has not objected to them on that basis, and instead has treated them as being of record. Accordingly, we deem the pleadings to be amended to include opposer's allegation of ownership of the registrations, *see* Fed. R. Civ. P. 15(b), and we deem the registrations to be properly of record.

title copies of its pleaded registrations. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the issue to be determined in this case is whether a likelihood of confusion exists.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Under the first *du Pont* factor, i.e., "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression," we find that applicant's mark CORIS is similar to opposer's mark CORDIS. But for the presence of the letter "d" in opposer's mark and its absence from applicant's mark, the marks are identical. In terms of appearance and sound, we find that any dissimilarity arising from the presence of the "d" in opposer's mark and its absence from applicant's mark is greatly outweighed by the otherwise strong similarity in

the way the marks look and sound. Neither of the marks has any inherent, readily understood meaning,[3] so there is no dissimilarity in connotation which would negate the marks' confusing similarity in terms of appearance and sound. Viewing the marks in their entireties, we find that they present highly similar commercial impressions and that they are likely to cause confusion if used on related goods. The first *du Pont* factor weighs in opposer's favor.

Also weighing in opposer's favor is the second *du Pont* factor, i.e., "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." Indeed, applicant's goods as identified in the application, i.e., "computer database management program for cardiologic medical and surgical information," is sufficiently broadly worded that it encompasses the software identified in opposer's Class 9 registration, i.e., "computer software used to collect data on medical procedures used by hospitals and to collect data on product inventory used in such procedures." Applicant argues that, in actuality, his software and opposer's software are "distinguishable" in that they perform different functions and are directed to different users. That argument is

[3] Applicant testified that its CORIS mark is an acronym for "Clinical Outcomes Research Information Systems," but there is no

unavailing, because we must compare the goods as they are identified in the application, not as they currently are marketed. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As identified in the respective application and registration, the parties' software goods are legally identical. We also find that applicant's software, which pertains specifically to "cardiologic medical and surgical information," is similar and closely related to the medical devices and instruments identified in opposer's other two pleaded registrations, which also are directed to cardiology- and surgery-related fields.

The third *du Pont* factor, i.e., "the similarity or dissimilarity of established, likely-to-continue trade channels," also weighs in opposer's favor. There are no limitations or restrictions as to trade channels or classes of purchasers in either party's identification of goods, and we therefore must presume that the goods move in all normal trade channels for such goods and are marketed to all normal classes of purchasers for such goods. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). There is nothing in the record

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evidence that this is a generally understood acronym in the

from which we can conclude that the normal trade channels and classes of purchasers for the goods identified in applicant's application are not the same as the normal trade channels and normal classes of purchasers for the goods identified in opposer's registrations. Even with respect to the parties' actual trade channels and classes of purchasers, applicant concedes that they "are related and overlap to some degree." (Applicant's brief at 9.) That being the case, it is immaterial, even if true, that those trade channels and classes of purchasers in other respects "are not identical and are distinguishable." (*Id*.)

With respect to the fourth *du Pont* factor, i.e., "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing," we note that the purchasers of the parties' respective goods apparently include physicians, who presumably are sophisticated or knowledgeable in their fields. However, "[t]he fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion when similar marks are used in connection with related goods and/or services. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Given the strong similarities between applicant's CORIS mark and registrant's CORDIS mark in terms of appearance and

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relevant field.

pronunciation, even sophisticated and careful purchasers might well overlook the presence or absence of the “d” in the respective marks. We therefore find that this *du Pont* factor weighs in applicant’s favor, but only slightly.

The fifth *du Pont* factor requires us to consider evidence pertaining to “the fame of the prior mark (sales, advertising, length of use).” Opposer has presented evidence showing that its domestic sales under the mark exceeded $3.6 billion from mid-1990 to 2000, including an average of over $500 million per year from 1996 to 2000; that it spent approximately $37.6 million in advertising and promotional expenses in the United States from mid-1990 through 2000, including an average of over $5 million per year from 1996 through 2000; and that when opposer was purchased by Johnson & Johnson in 1996 and merged with the Johnson & Johnson division known as Johnson & Johnson Interventional Systems, the new company retained the Cordis name in order to retain the name recognition and value of that name in the marketplace.

Applicant has conceded that opposer’s CORDIS name and mark are “extremely well known” in the relevant market with respect to opposer’s medical devices and instruments, but argues that there is no evidence that opposer’s mark is famous in the software field. However, the purchasers of opposer’s medical devices and instruments, to whom the

CORDIS mark and name admittedly are famous, also would be the purchasers of opposer's software products sold under that same CORDIS mark and name. We find that opposer's medical device and instrument products are sufficiently related to opposer's (and applicant's) software products that the fame of the CORDIS mark in the medical device and instrument field carries over as well to the market for the parties' software.

We conclude that opposer's CORDIS mark is a famous mark in the relevant market, for purposes of the fifth *du Pont* evidentiary factor. As in all cases involving a famous mark, this *du Pont* factor is entitled to substantial and even dominant weight in our likelihood of confusion analysis. *See, e.g., Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

There is no evidence pertinent to the sixth *du Pont* factor, i.e., "the number and nature of similar marks in use on similar goods." The absence of such evidence weighs in opposer's favor, inasmuch as it suggests that opposer's mark is a strong mark in the marketplace which is entitled to a broad scope of protection.

There is no evidence of any instances of actual confusion, a fact which weighs in applicant's favor under the seventh *du Pont* factor. However, we find that weight to be counterbalanced and essentially negated by the evidence of record pertaining to the eighth *du Pont* factor, i.e., "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." Apparently, only 32 units of applicant's product have been sold, and those sales occurred only during the period from 1994-1997. The company marketing the product is in bankruptcy. Applicant testified that he subsequently has received over one hundred inquiries from physicians, who are potential purchasers both of applicant's software and of opposer's products, regarding when applicant's software will be available. However, we find this testimony to be hearsay at worst, and unpersuasively anecdotal at best. We cannot and do not conclude, on this record, that the nature and extent of applicant's sales and advertising of its software have been so extensive that the absence of instances of actual confusion between applicant's mark and opposer's mark is factually surprising or legally significant. *See Gillette Canada Inc. v. Ranir Corp.,* 23 USPQ2d 1768 (TTAB 1992). We conclude that the seventh and eight *du Pont* factors, relating to actual confusion, are

neutral in this case or, at best, weigh only minimally in applicant's favor.

Under the ninth *du Pont* factor, i.e., "the variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)," we find that opposer uses its CORDIS mark as a house mark and as its trade name in connection with a wide variety of products in the relevant market. This factor weighs in opposer's favor in our likelihood of confusion analysis.

We find that there is no significant probative evidence as to any of the remaining *du Pont* factors.

Having carefully considered and weighed the evidence with respect to all of the *du Pont* factors for which evidence has been made of record, we conclude that a likelihood of confusion exists. Opposer's mark is a famous mark in the relevant field, a fact which weighs heavily in opposer's favor. The strength of opposer's mark, and the broad scope of protection to which it is entitled, is further established by the fact that there are no similar third-party marks in use on similar goods. Applicant's mark is highly similar to opposer's famous mark. The goods identified in applicant's application are legally identical and/or closely related to the goods identified in opposer's registrations. The parties' goods are marketed in the same trade channels and to the same classes of purchasers.

Opposer uses its mark as a house mark and trade name in connection with a wide variety of products. All of these factors weigh in opposer's favor. The only factors favoring applicant are the relative sophistication of purchasers and the apparent absence of actual confusion, but for the reasons discussed above we find that these factors weigh in applicant's favor only slightly, and that they are outweighed decisively by the evidence of record on the other *du Pont* factors which clearly point to the existence of a likelihood of confusion.

In summary, we find that opposer has standing to oppose, that Section 2(d) priority is not an issue in view of opposer's registrations, and that a likelihood of confusion exists. In view thereof, we find that opposer has established its Section 2(d) ground of opposition. We have carefully considered all of applicant's arguments to the contrary, including those not specifically discussed in this opinion, but find them to be unpersuasive of a different result.

Decision: The opposition is sustained. Registration to applicant is refused.