

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG 5, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United States Surgical Corporation
v.
Acuderm, Inc.

Opposition No. 96,152
to application Serial No. 74/486,842
filed on January 28, 1994

John C. Andres, Esq., Carolyn H. Blankenship, Esq., and Neil
Y. Gilbert, Esq., for opposer

Keith V. Rockey and Kathleen A. Lyons of Rockey, Rifkin &
Ryther for applicant

Before Rice, Simms and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

United States Surgical Corporation filed its opposition
to the application of Acuderm, Inc. to register the mark
ACU-SUTURE for "surgical devices, namely, disposable devices
for sewing or stitching surgical sites."¹

As grounds for opposition, opposer asserts that
applicant's mark, when applied to applicant's goods, so

¹ Application Serial No. 74/486,842 , filed January 28, 1994, based upon
use of the mark in commerce in connection with the identified goods,
alleging first use and first use in commerce as of November 1, 1993.

resembles opposer's previously used and registered mark, AUTO SUTURE, for "surgical stapling instruments and staples therefor"² as to be likely to cause confusion under Section 2(d) of the Trademark Act. Opposer alleges, further, that it is and has been for many years an internationally known manufacturer and seller of wound closure devices such as surgical staplers and sutures under the trademark and trade name AUTO SUTURE; that many of opposer's wound closure instruments are disposable; that opposer has used the AUTO SUTURE trademark since at least as early as July 6, 1965; and that both parties' goods relate to surgery and wound closure and are sold in the same or similar channels of trade to the same or similar classes of customers, i.e., hospitals, distributors for hospitals and health care workers.

Applicant, in its answer, denied the salient allegations of the likelihood of confusion claim, alleging with respect to channels of trade and class of purchasers that its goods are sold primarily to office-based physicians; and asserted, as "affirmative defenses," that the parties' marks and goods are different and, thus, there is no likelihood of confusion, and that there have been no instances of actual confusion.³

² Registration No. 1,065,230, issued May 10, 1977 (renewed for term of 10 years, Section 15 affidavit filed).

³ Applicant's first pleaded affirmative defense is simply a denial of the ground for opposition. While this is not an affirmative defense, it

The Record

The record consists of the pleadings; the file of the involved application; and the following documents submitted by notices of reliance by the parties: a certified copy indicating title and status of opposer's pleaded Registration No. 1,065,230; certain specified discovery responses of applicant and opposer; and, by stipulation of the parties, affidavits in lieu of testimony depositions of Kathryn H. Maiolo, opposer's marketing administrative support supervisor, and Charles Yeh, applicant's president, both with accompanying exhibits. Both parties filed briefs on the case.

Opposer

Opposer's supervisor for marketing administrative support, Kathryn Maiolo, describes opposer as "a complete wound closure company, offering a full line of endoscopic instruments, stapling products and sutures." (Maiolo affidavit, p. 1.) Auto Suture Company is a division of opposer that sells all of opposer's wound closure products in the United States. Opposer began selling wound closure products in 1965 and launched its line of suture products in

is a permissible amplification of that denial. *See, Trademark Trial and Appeal Board Manual of Procedure*, Sections 318(b) and (c). Applicant's second pleaded affirmative defense is, likewise, merely a permissible amplification of applicant's denial of opposer's asserted ground for opposition. Neither actual confusion nor lack thereof are determinative of the issue of likelihood of confusion; rather, whether or not actual confusion has occurred is one factor to be considered in determining

1991. Opposer sells its products to hospitals, medical supply distributors, clinics and private doctors' offices, including dermatologists. However, the evidence of record indicates that opposer's products are primarily sold directly to hospitals for surgical use.⁴ For example, opposer's Maiolo exhibit 2, its 1995 suture price list, is entitled "Hospital Price List." Further, opposer describes its business as follows in its 1994 annual report (Maiolo exhibit 1), chairman's letter:

As 1992 came to a close, our core business of surgical stapling instruments was in its twenty-fifth consecutive year of growth; we were beginning to make inroads into the suture market; and our new line of products for laparoscopy was skyrocketing.

. . .

Our most important contact in the hospital had always been the surgeon. The Company's salespeople were expert at demonstrating the patient benefits and superior technology of our devices to clinicians.

During 1993, a sea change took place in hospital management. Operating room purchasing was controlled by a partnership consisting of the end user, in our case the surgeon, and financial or materials management, areas of the hospital where our salespeople had not previously developed strong ties or relationships.

likelihood of confusion. See, *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-3 (Fed. Cir. 1990).

⁴ The evidence of minimal sales of opposer's products to a small number of doctors, including dermatologists, does not belie our conclusion herein that opposer's sales are primarily to hospitals, but it does establish that opposer markets and sells its products, as well, to doctors, such as dermatologists, who may perform surgical procedures in their offices or clinics.

Opposer regularly participates in conferences and conventions, such as those sponsored by the American College of Surgeons, the Association of Operating Room Nurses and the Society of American Gastrointestinal Endoscopic Surgeons.

The record includes packaging for three of opposer's suture products, which packaging includes the mark AUTO SUTURE, apparently used as a house mark, in conjunction with one or two marks used to identify the particular product and/or a component thereof. For example, some of the trademarks used in connection with opposer's suture products include BIOSYN, SURGIWIP, SURGIDAC, SURGITIE, POLYSORB, and ENDOSTITCH.

Applicant

Applicant has been selling products used by dermatologists and dermatology clinics nationally since 1983. Applicant's catalog and packaging for several different products establish that applicant identifies its products by marks that include the prefix ACU followed by terms which applicant describes as the generic or descriptive names of applicant's products. For example, applicant's packaging of record includes the marks ACU-FIT for gloves, ACU-PUNCH for disposable skin biopsy punches, and ACU-DISPO-CURETTE for disposable dermal curettes. Applicant's president, Charles Yeh, testified that applicant

has used this formula to create all trademarks used on or in connection with its products since 1983. The record supports use by applicant of specific ACU trademarks in connection with a variety of products for medical and surgical use since July 1995, the date of applicant's catalog, in which all products are identified therein by marks with the prefix ACU.⁵ Applicant's catalog features a broad range of products including scalpels, cauteries, curettes, electrosurgical supplies, gloves, masks, needles, and scissors. Mr. Yeh testified that applicant first used the mark at issue herein, ACU-SUTURE, in connection with the surgical devices identified in this application since at least December 1993,⁶ with annual sales since that time of approximately \$35,000.

Applicant markets its products directly to office-based dermatologists and their employees; and customers purchase products directly from applicant. Applicant makes no sales through medical supply distributors, nor does applicant sell

⁵ Applicant has submitted photocopies of sixteen registrations that applicant claims it has "[f]rom time to time, ... sought and/or received." (Yeh affidavit, p.2.) As applicant has neither submitted status and title copies of these registrations nor testified to their current status and title, these registrations are not properly of record and will be considered as evidence only of the fact that such registrations issued in applicant's name. See, *Trademark Trial and Appeal Board Manual of Procedure*, Section 703.02(a). Also in this regard, applicant has not established that it has a family of ACU marks and we agree with opposer that such a line of reasoning is not relevant to our consideration herein. See, *Baroid Drilling Fluids, Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

⁶ While the applicant claims, in the application, first use as of November 1, 1993, applicant's answer to opposer's interrogatory no. 2 states that applicant's first sale occurred in December 1993. Thus, we adopt the later date herein.

its products to hospitals. Applicant markets its products through the periodic distribution of its product catalog to dermatology offices and clinics nationwide (approximately 10,000 copies) and through applicant's exhibits at dermatologic conferences, such as those sponsored by the American Academy of Dermatology, the American Society of Dermatologic Surgery and similar state-based organizations.

Analysis

Inasmuch as a certified copy of opposer's registration is of record, there is no issue with respect to opposer's priority in connection with the surgical stapling products identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, opposer has established its priority in connection with suture products through evidence of its use of the mark AUTO SUTURE in connection with suture products since at least as early as March 15, 1991.⁷

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations are the similarities between the

⁷ We disagree with applicant's contention that the record does not support opposer's use of the mark AUTO SUTURE in connection with surgical suture products.

goods, the similarities between the marks, and the similarities between the channels of trade and classes of purchasers.

With respect to the goods of the parties, contrary to applicant's contention that the issue of likelihood of confusion herein is limited to consideration of the goods identified in opposer's registration, opposer is entitled to rely also on any prior use it has made of its mark in connection with particular goods or services. As noted above, we find that the record establishes that opposer not only owns a registration of the mark AUTO SUTURE for surgical stapling instruments and staples therefor, but also that opposer has made prior use of its mark for suture products.

We agree, further, with opposer's contention that surgical stapling products and suture products are closely related as both types of products are "wound closure products." We are not convinced that opposer's stapling and suture products are significantly different from applicant's suture products, contrary to applicant's contention that such products may have different specific uses, such as for endoscopic surgery versus dermatologic procedures, as internal versus external closures, or as disposable versus non-disposable devices. Further, the goods identified in opposer's registration and in this application are not

limited as to the nature of their use. Thus, we conclude that the suture products of the parties are the same or very similar and opposer's stapling products are closely related to applicant's suture products.

There is no dispute that the goods of both parties are sold for use by physicians, nurses and health care personnel in connection with patient care and surgery. While the record shows that there are some differences in the channels of trade by which the goods of the parties reach these end users, there is substantial overlap. In fact, applicant has conceded that the trade channels and consumers of both parties' goods are the same. (Applicant's brief, p. 20.) Further, as neither the application nor the pleaded registration contains such limitations to the identifications of goods, we presume that the goods of the applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for such goods. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the goods of applicant and registrant are sold through the same channels of trade to the same classes of purchasers.

While the goods of the parties vary in price depending upon the nature of the specific product, for example, some surgical stapling products are more expensive than some

suture products, none of the goods involved herein can be considered expensive. However, the record supports the conclusion that the purchasers of such goods are sophisticated and their purchases are made with discrimination. Despite its contentions otherwise, opposer's own annual report (Maiolo exhibit 1) indicates that opposer's salespeople devote considerable effort to developing and maintaining relationships with surgeons to demonstrate the superiority and efficacy of their products; and that, while the cost concerns of materials management personnel are playing an increasing role in hospital purchasing decisions, the doctor, as the end user, continues to be key in the purchasing decision. Both opposer's annual report and applicant's sales catalog support the conclusion that the parties' goods herein are marketed for very specific uses and that individual products may contain slightly different qualities so that doctors carefully choose which products are to be ordered for which specific uses. Thus, we conclude that purchasers of the parties' products are sophisticated and purchases are made with relative care and consideration.⁸

Turning to the marks herein, we base our consideration on a comparison of the marks in their entirety, noting that, in articulating reasons for reaching a conclusion on

⁸ The fact that an order may be placed by a purchasing agent for a hospital, clinic or doctor's office does not lead to a contrary

the issue 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 the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this regard, we find that there are significant differences between opposer's and applicant's marks such that they do not convey similar overall commercial impressions. Both parties' marks consist of the term SUTURE with a prefix. The term SUTURE is clearly generic in connection with applicant's and opposer's suture products and highly descriptive, at least, in connection with opposer's surgical stapling products. In view of the fact that AUTO and ACU comprise the first two syllables of the parties' marks and are followed by the highly descriptive and generic term SUTURE, we find that AUTO and ACU are the dominant portions of the respective marks and that there are significant visual and aural differences between AUTO SUTURE and ACU-SUTURE. We find, also, that the connotation of AUTO SUTURE is distinctly different from the connotation of ACU-SUTURE. We take judicial notice of the definition of AUTO as "1: self: same one, 2: automatic: self-acting."⁹ AUTO SUTURE, as used in connection with opposer's goods, is

conclusion.

⁹ *Merriam-Webster's Collegiate Dictionary*, 10th ed., 1993.

likely to be perceived as suggesting either the dissolvable nature of some of opposer's stapling and suture products or that the benefits of the product's use are "automatic." On the other hand, the prefix ACU suggests the word "accurate" so that the mark ACU-SUTURE is likely to be perceived in connection with applicant's goods as suggesting that the suturing task can be accurately performed with applicant's product.

Further, while opposer has alleged that it is "an internationally known manufacturer and seller of wound closure devices," the record is entirely devoid of any evidence regarding the strength of opposer's mark and the nature and extent of its reputation.

Opposer has not met its burden of proof with respect to its claim of likelihood of confusion. Based on the record before us, we conclude that the differences between the parties' marks, despite the identity and related nature of the parties' goods, are sufficient that purchasers are not likely to be confused by the contemporaneous use of the marks, especially in view of the sophisticated nature of the purchasers of both parties' goods and the relative care with which they are likely to make their purchasing decisions. We note that neither party is aware of any instances of actual confusion and, while neither the presence nor absence of actual confusion is determinative of the issue of

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likelihood of confusion, we find this to be a factor supportive of our conclusion herein.

The likelihood of confusion claimed by opposer amounts to only a speculative, theoretical possibility. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed Cir. 1992).

Decision: The opposition is dismissed.

R. L. Simms

J. E. Rice

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board