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RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Novoste Corporation

Serial Nos. 75/299,005 and 75/384,383

Jason A. Bernstein of Bernstein & Associates for Novoste Corporation.

John D. Dalier, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 28, 1997, application S.N. 75/299,005 was filed to register the mark "BETA-CATH" on the Principal Register for "radiological apparatus for medical purposes, namely radiation therapy catheter delivery devices; component parts thereof, namely, transfer or loading devices, delivery catheters, radioactive sources, marker seeds, connectors, receptacles, sterile sheaths, and pumps, syringes or other devices used to create motive force; and

accessories therefor, namely non-radioactive sources (dummy or passive sources), passive-run devices (dummy transfer devices), radioactive source recovery equipment, bail-out containers, biohazard containers, radioactivity shields, radiation safe containers, storage containers with radioactivity shielding, transport cases, tubing, cannulas, connectors, adapters, extensions, sterile sheaths, sterile drapes, covers, protectors, timers, and lighting devices," in Class 10. Later that year, on November 4, 1997, applicant filed application S.N. 75/384,383 to register the mark "β-CATH," (the Greek symbol for "beta" followed by the hyphen and the term "CATH"), on the Principal Register for the same goods. Each application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the listed goods.

In each instance, the Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that if applicant were to use the mark sought to be registered in connection with the goods specified in the application, applicant's mark would so resemble the marks "BETA" and "BETA C," which are registered, respectively, for " instruments and apparatus for medical diagnosis, namely, otoscopes, opthalmascopes, laryngoscopes and

endoscopes," in Class 10[1], and "medical dose calibrator for measuring low-level radiation," also in Class 10[2], that confusion would be likely.

Applicant responded to the refusals to register with arguments that confusion would not be likely because of differences between the goods specified in the application and those which are listed in the cited registrations, differences between the marks themselves, and the sophistication level of purchasers of these products. Both applications were amended to add the word "therapeutic" to the first clause, so that it now reads "radiological apparatus for medical therapeutic purposes."

The Examining Attorney was not persuaded by these arguments, and in the second round of Office Actions, he made final the refusals to register under Section 2(d) of the Act. Attached in support of these actions were copies of a number of third-party registrations. In one group, the identification-of-goods clauses in the registrations include both endoscopes and catheters. In the second group, the third-party registration identification-of-goods clauses list both diagnostic products and therapeutic

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[1] Reg. No. 2,071,509, issued on the Principal Register to Hein Optotechnik GmbH & Co., a corporation of the Federal Republic of Germany, on June 17, 1997.
[2] Reg. No. 1,966,973, issued on the Principal Register to Capintec Inc., a Delaware corporation, on May 22, 1995.

goods. The Examining Attorney argued that the first group of registrations demonstrates that purchasers have a basis upon which to expect endoscopes and catheters bearing similar trademarks to emanate from the same source. The second group of third-party registrations is argued to support the Examining Attorney's conclusion that diagnostic and therapeutic products bearing similar marks can be expected to come from a single source.

Applicant timely filed Notices of Appeal in both applications, followed by appeal briefs. The Examining Attorney filed his briefs on appeal and applicant filed reply briefs. Then applicant requested and was granted suspension of action on the appeals and remands to the Examining Attorney for consideration of additional evidence, but the Examining Attorney was not persuaded to withdraw the refusal to register in either case, and both applications were returned to the Board for resumption of action on the appeals.

Because of the similarity of the facts and issues involved, these two appeals were consolidated by action of the Board on November 27, 2000. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the records and arguments before us in light of the relevant legal

authority on this issue, we find that if applicant were to use the two marks it here seeks to register in connection with the products specified in the applications, confusion would be likely with the two cited registered marks. In connection with the goods listed in the applications and the cited registrations, these marks are similar because they create similar commercial impressions and the goods listed in the applications and the cited registrations, respectively, are related.

Our primary reviewing court, in the case of In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is likelihood of confusion under Section 2(d) of the Lanham Act. As is frequently the case, in the case at hand, the most relevant of these factors are the similarity of the marks and the similarity of the goods. First we will discuss these similarities as they relate to the mark and goods in Reg. No. 2,071,509. Then we will discuss the similarities in connection with the mark and goods in Reg. No. 1,966,973.

The registration for the mark “BETA,” as noted above, lists the goods as “instruments and apparatus for medical diagnosis…” and includes “endoscopes” in the list that follows. “BETA” is similar to both of applicant’s proposed

marks, “BETA-CATH” and its equivalent in pronunciation and connotation, “β-CATH.” These two marks take the registered mark “BETA” or the Greek symbol for the registered mark “BETA” and add hyphens and “CATH,” which is a suggestive term in connection with applicant’s catheter device. Simply adding a suggestive term to a registered mark or its equivalent in this fashion is not sufficient to overcome the likelihood of confusion. Cocoa-Cola Bottling Company v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975).

Applicant’s argument that the Examining Attorney has had to improperly dissect its marks in order to conclude that they are similar to the cited registered marks is not persuasive. While we have considered the marks in their entireties, it is well settled that one feature of a mark may be recognized as more significant in creating the commercial impression for a mark, and that greater weight is given to that dominant feature in determining whether confusion is likely. “CATH” is clearly less significant in applicant’s marks because of its suggestive nature in connection with applicant’s products. The term “BETA” and the Greek alphabet equivalent of it have more source-identifying significance in these circumstances, and it is

the term “BETA” which is the registered mark in its entirety.

The goods in this registration are related to the products listed in both applications. The evidence made of record by the Examining Attorney establishes this. It shows that third parties have registered their marks for both catheters and endoscopes, applicant’s goods and one of the products listed in the cited registration. From this evidence we can conclude that prospective purchasers of these products have a basis upon which to expect them to emanate from a single source if the marks use thereon are similar. Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that the goods identified in the applications are not related to those specified in this registration because applicant’s goods are for therapeutic use and the goods in the cited registration are used for diagnosis. This argument is not well taken. The second group of third-party registrations made of record by the Examining Attorney shows that the use of similar marks on both types of products would be understood as an indication that they come from the same source.

If “BETA-CATH” or its equivalent, “β-CATH,” were to be used in connection with the goods set forth in these

applications, confusion would be likely in view of the registered mark “BETA” for related products.

We thus turn to the cited registration of the mark “BETA C” for “medical dose calibrator for measuring low-level radiation.” Confusion between the marks applicant seeks to register and this mark would be likely because applicant’s marks are similar to this mark and the record shows that the medical device identified in the registration is commercially related to the medical device identified in both applications.

“β-CATH,” “BETA-CATH” and “BETA C” are similar because they create similar commercial impressions. As noted above, the two marks applicant seeks to register are essentially equivalents. The cited registered mark “BETA C” would be understood by anyone familiar with applicant’s marks to be an abbreviation of them, replacing the term “CATH” in applicant’s mark with its initial letter, “C.” Applicant’s marks are similar to the cited registered mark because they share the same dominant component, “BETA” or its Greek equivalent, and the commercial impressions they generate in connection with the medical devices specified in the applications and the registration are accordingly similar.

The issue then becomes whether the goods are related in such a way that the use of these similar marks on them is likely to cause confusion. It is well settled that the goods do not have to be identical or even directly competitive in order to find that the use of similar marks on them is likely to cause confusion. They need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The promotional materials submitted by applicant show that the goods specified in the applications are catheters used to deliver intravascular radiation to prevent the problem of restenosis in patients. Applicant's product is a hand-held system which uses hydraulic pressure to send a train of radioactive seeds through a catheter. After the seeds have remained at a lesion site for a specific length of time, the isotopes are hydraulically returned to the transfer device, which stores the radiation source when it is not in use. The product specified in the cited registration is a "medical dose calibrator for measuring low-level radiation." These medical devices can

clearly be used in close conjunction with each other during radiation therapy and treatment. Both are medical devices used in radiation therapy, so they would be encountered by the same people under circumstances which would be likely to lead to the mistaken assumption, based on the similarities discussed above between the marks, that a single source is responsible for both.

Applicant's argument that confusion would not be likely with respect to either of its marks vis-à-vis either of the cited registered marks because of the sophistication of the purchasers of these goods is not well taken. Simply put, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or that they are immune from source confusion when similar marks are used in connection with similar products. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

Applicant's argument that its products are expensive and that they therefore must travel in different channels of trade from those in which the goods set forth in either of the cited registrations travel is without evidentiary support. We have no basis upon which to conclude that applicant's products, if they are marketed in commerce,

will be either more or less expensive than the goods of either of the owners of the cited registrations.

Similarly unpersuasive is applicant's argument that third-party registrations and applications containing the term "BETA" demonstrate weakness in the term as an identification of source. Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. In re Hub Distributing, Inc. 218 USPQ 284 (TTAB 1983). They are not evidence of what happens in the marketplace or that the public is familiar with those marks, nor does the existence of other similar marks on the register aid an applicant in registering yet another mark which is likely to cause confusion with a mark that is registered. National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). In re National Novice Hockey League, Inc., 222 USPQ 638 (TTAB 1984).

Further, although applicant argues that there have been no incidents of actual confusion, this is not supported by the record, and even if it were, the lack of actual confusion would not be persuasive that confusion would be unlikely if applicant were to use its marks. At this juncture, although applicant has apparently promoted its products in this country by using these marks,

applicant has not used either mark in connection with the sale of these products in commerce here, so there has been little, if any, opportunity for actual confusion to have occurred. In any event, as the Examining Attorney points out, it is unnecessary to show actual confusion in order to establish that confusion is likely. Weiss Associates Inc. v. HRL associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Any doubt as to whether confusion would be likely must be resolved in favor of the registrant and against the applicant, who has a legal duty to select marks which are totally dissimilar to trademarks already in use in this field of commerce. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

In summary, confusion would be likely if applicant were to use either of the marks it here seeks to register in view of the two cited registrations because the marks create similar commercial impressions and the goods set forth in the applications are commercially related to those specified in the cited registrations.

Decision: The refusals to register under Section 2(d) of the Act in both applications are affirmed.