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**THIS DISPOSITION  
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Paper No. 12  
RFC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Advanced Cardiovascular Systems, Inc.

Serial No. 75/707,361

Lori N. Boatright of Blakely, Sokoloff, Taylor & Zafman for  
Advanced Cardiovascular Systems, Inc.

Janice A. Mooneyham, Trademark Examining Attorney, Law  
Office 115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Chapman and Bottorff, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 17, 1999, applicant filed the above-identified  
application to register the mark "VERSASAIL" on the  
Principal Register for "dilation catheters," in Class 10.  
The application was based on applicant's assertion that it  
possessed a bona fide intention to use the mark in commerce  
in connection with these goods.

The Examining Attorney refused registration under  
Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d),

on the ground that if applicant were to use the mark it seeks to register in connection with dilation catheters, it would so resemble the mark "VERSASEAL," which is registered<sup>1</sup> for "trocar seal components," in Class 10, that confusion would be likely.

Applicant responded to the refusal to register by arguing that confusion would not be likely between the mark it intends to use and the cited registered trademark. Applicant contended that the marks do not create similar commercial impressions because their connotations differ, based on the differences in the meanings of the respective suffix terms "SAIL" and "SEAL."

Applicant also argued that because a number of registered trademarks for medical devices include the term "VERSA," the cited registered mark is "less than a strong mark and, as a result, its scope of protection is limited." Applicant provided a list of nine such marks, along with copies of the registrations taken from the Trademark Text and Image Database of the United States Patent and Trademark Office. These registrations, all owned by different entities, are for the marks "VERSA-TRAC," "VERSA

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<sup>1</sup> Reg. No. 2,153,983, issued on the Principal Register to United States Surgical Corp. on April 28, 1998, based on a claim of use in commerce since October 28, 1994.

VAC," "VERSA LOK," "VERSA SAFE," "VERSA PULSE," "VERSA FX," "VERSA PEG," "VERSA TAPER," and "VERSA TONE." The goods listed in these registrations include a retractor used for surgery of the spine, a surgical smoke filtration apparatus, a connecting device for intravenous lines, an orthopedic spinal fixation device, surgical lasers, a gastronomy kit, intravenous infusion pumps and a diagnostic Doppler ultrasound instrument for use in surgical applications.

The Examining Attorney was not persuaded by applicant's arguments, however, and the refusal to register was made final in the second Office Action. She cited a dictionary definition of the word "catheter" as "a hollow, flexible tube for insertion into a body cavity, duct, or vessel to allow the passage of fluids or distend a passageway." The same dictionary defines "trocar" as "a sharp-pointed surgical instrument, used with a cannula to puncture a body cavity for fluid aspiration." She concluded that catheters and trocars are used for similar purposes, noting that the goods specified in applicant's application are catheters which would be used with trocars.

With respect to applicant's arguments regarding the weakness of the cited registered mark, the Examining Attorney noted that the third-party registrations submitted

by applicant are not evidence of use; that they are not evidence of what happens in the marketplace or that the public is familiar with the use of any of these marks. Additionally, she pointed out that these third-party marks each combine the suggestive term "VERSA" with terms that are very different from either "SEAL" or "SAIL," as well as from each other.

In support of her contention that the goods with which applicant intends to use the mark it seeks to register are related to the products identified in the cited registration, the Examining Attorney submitted copies of third-party registrations wherein the goods listed include both trocars and catheters. Several such registrations were submitted, including one in which the goods are identified as "medical catheter tips and catheters... trocar handlers; trocar systems consisting of trocars, trocar tips, obdurators, cannulas, and seals; trocar accessories, namely, universal seals..."; another wherein the listed goods include "medical catheters and catheter tips, trocar tips, sleeves and seals"; and another which identifies the goods in connection with which the registered mark is used as "medical and surgical catheters-particularly trocar catheters."

Also submitted with the final refusal to register were copies of excerpts from articles retrieved from the Nexis database. These articles appear to show that trocars and catheters are used together. For example, the Online Laproscopic Technical Manual, in explaining laproscopic placement of a peritoneal dialysis catheter, instructs the reader to use a pair of trocars inserted to properly position the catheter. Another article notes that a trocar is used to guide the catheter system which is used to deposit fertilized eggs into fallopian tubes. A third article discusses insertion of the catheter by two methods, one using a trocar and the other without using a trocar. The final article submitted by the Examining Attorney discusses insertion of a catheter by means of using a trocar. It states that "[a]fter incising down, the surgeon exposes and punctures the peritoneum with a trocar-enforced dialysis catheter, he then removes the trocar and advances the catheter downward toward the pelvis."

Applicant responded to the final refusal to register with a request for reconsideration, filed the day after applicant had filed a timely Notice of Appeal. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's reconsideration request.

The request for reconsideration summarized applicant's arguments on the issue of likelihood of confusion. Applicant contended that the refusal to register should be withdrawn because the marks in issue create different commercial impressions; because the registered mark is diluted and therefore is not entitled to wide scope of protection; and because the Examining Attorney has not met her burden of establishing that the goods identified in the cited registration are related to the goods specified in the application in such a way that consumers would expect these goods to emanate from a single source. Additionally, the Examining Attorney was "requested to consider that applicant has a family of 'SAIL' marks used in connection with dilation catheters."

Submitted in support of applicant's arguments were copies of printouts of several pages from applicant's WebSite, showing that applicant promotes the sale of its coronary dilation catheters under the marks "CrossSail," "OpenSail," "PowerSail" and "HighSail."

Additionally, applicant submitted web page entries from other businesses show the promotion of various products under several of the previously cited marks registered by third parties. Included in this group were the "Versa Pulse Laser," the "Versa-Stim" neuromuscular

stimulation electrodes, the "Versa FX femoral hip fixation system" and the "Versa-lok" connecting device for intravenous lines. Applicant argued that these entries show use of "VERSA" marks by third parties in connection with medical devices, and that they therefore establish the weakness of the cited registered mark.

Applicant's reconsideration request did not persuade the Examining Attorney to withdraw the refusal to register. Submitted with her response to applicant's request were copies of additional Internet Web pages which use the terms "trocar" and "catheter" together in connection with medical devices. Several use the term "trocar catheter." In addition to this evidence, the Examining Attorney submitted copies of seven more third-party registrations wherein the listed goods include both catheters and trocars.

The application file was returned to the Board, which resumed action on the appeal. Applicant filed an appeal brief and the Examining Attorney filed her responsive brief, but applicant did not request an oral hearing before the Board.

Accordingly, we have resolved this appeal based on the written record and arguments of applicant and the Examining Attorney in light of relevant legal authority on this

issue. After careful consideration, we hold that the refusal to register must be affirmed.

The predecessor to our primary reviewing Court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E. I. DuPont de Nemours & Co.*, 4F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. Confusion is likely in the case at hand because the marks create similar commercial impressions and the goods with which applicant intends to use the mark it seeks to register are related to the goods set forth in the cited registration.

Applicant argues strenuously that the marks "convey dramatically distinguishable commercial impressions." (Brief, p. 3). Distinctions in appearance, pronunciation and meaning are argued at length. We agree with the Examining Attorney, however, that when these marks are considered in their entirety, they create similar commercial impressions.

Although we must compare the marks "VERSASAIL" and "VERSASEAL" in their entirety, we may nevertheless recognize that the common, suggestive component term "VERSA" has more significance in creating the commercial

impression of each mark. Greater weight may be given to a dominant feature in determining whether there is a likelihood of confusion. In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985). As in many instances, the first term or syllable in each of these marks dominates. Presto Products v. Nice-Pak Products, Inc. 9 USPQ2d 1895 (TTAB 1988). The dominant element of each mark is the same.

Additionally, "SEAL" and "SAIL," the second components of these marks, respectively, are quite similar, even though distinctions between them can be made. The marks in their entireties are "VERSASAIL" and "VERSASEAL," which sound very much alike when they are pronounced, and are similar in appearance. Although we have compared these marks for similarity in sound, appearance and connotation, similarity in any one of these elements is a sufficient basis for holding that confusion would be likely. In re Mack, 197 USPQ 755 (TTAB 1977). The differences between "SALE" and "SEAL" are insufficient to eliminate the likelihood of confusion which would arise if the marks were used on closely related goods.

As noted above, applicant argues that in view of the use and registration of third-party marks which include the term "VERSA" as a prefix, the cited registered mark is not entitled to a broad scope of protection. It is well

settled that third-party registrations are not evidence of use, and as such do not show that the public is familiar with the use of such marks and is therefore accustomed to distinguishing among them based all on other elements besides the commonly adopted component. National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). In addition to the registrations, however, applicant has provided evidence that four of the marks shown in the third-party registrations are actually used in connection with the promotion of the goods specified in the registrations.

Neither the registrations nor the Internet evidence showing promotion of products under four of the third-party marks persuades us that "VERSASAIL" is not likely to be confused with "VERSASEAL" when both are used in connection with related medical devices. Simply put, none of the cited third-party marks is likely to cause confusion with any of the other cited third-party registered marks because of obvious differences among the marks and the products specified in the registrations. In the case at hand, however, as discussed above, the marks do create similar commercial impressions, such that if applicant were to use its mark in connection with goods which are related to

those set forth in the cited registration, confusion would be likely.

We therefore turn to consideration of the relationship between the goods specified in the application and the cited registration, respectively, dilation catheters and trocar seal components. The materials submitted by the Examining Attorney in support of the refusal to register establish that these products are related. It is important to remember that in order to find that confusion would be likely, they need only be related in some manner, or the conditions surrounding their marketing must be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that they emanate from a single source. In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The evidence of record establishes that catheters and trocars are closely related medical devices that are even used together in some surgical procedures. As noted above, there are types of catheters known as "trocar catheters." Third parties have registered their marks for both catheters and trocars. Significantly, two of these registrations list trocar seals as well as catheters. Third-party registrations tend to show that the goods

listed therein may emanate from a common source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988).

We are not persuaded to the contrary by applicant's argument that the purchasers of these medical devices are sophisticated, and would therefore not be likely to be confused. It is well settled that the fact that purchasers are sophisticated and knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable enough about trademarks that they are immune from source confusion caused by the use of similar marks on related products. In re Decombe, 9 USPQ 2d 1812 (TTAB 1988). This record shows that manufacturers have registered their marks for catheters and trocar seals and that catheters and trocars are used together in the same surgical procedures. Under the circumstances, even the sophisticated individuals who make the decisions to purchase such medical devices would be likely to assume that the use of these similar marks on such related goods indicates that they emanate from a single source.

Applicant argues that the mark it seeks to register would become a member of a family of marks for catheters which combine the term "SAIL" with different prefixes. This argument is irrelevant in this appeal proceeding, in

which our task is to determine whether confusion is likely between the mark applicant seeks to register by means of the above-identified application and the mark cited by the Examining Attorney as a bar to registration. Whether or not applicant uses or intends to use other marks which are also likely to cause confusion with registered trademarks is not before the Board in this appeal proceeding.

When the entire record before us is considered, we cannot reach the conclusion that confusion would be likely if applicant were to use the mark it here seeks to register without admitting that this is a close case. Any doubts which we may have, however, must be resolved in favor of the registrant and prior user, and against applicant, who, as the second comer, has a duty to select a mark which is not likely to cause confusion with the mark of another entity already in the market in this field. *J & J Snack Foods v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

DECISION: the refusal to register under Section 2(d) of the Lanham Act is affirmed.