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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Johnson & Johnson,
assignee of
Arrow International Investment Corp.

Serial No. 78/044,248

Norm D. St. Landau of Drinker Biddle & Reath LLP for
Johnson & Johnson, assignee of Arrow International
Investment Corp.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Johnson & Johnson, assignee of Arrow International
Investment Corp., has appealed from the final refusal of
the Trademark Examining Attorney to register NAVIGATOR as a
trademark for "medical devices, namely, pain management
catheters." The application, which was filed on

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January 22, 2001, is based on an asserted bona fide intention to use the mark in commerce.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark NAVIGATOR, previously registered for "extracorporeal electronic apparatus for locating the position of a catheter disposed within a patient's body"¹ as to be likely, if used in connection with applicant's identified goods, to cause confusion or mistake or to deceive.

Both applicant and the Examining Attorney have filed appeal briefs. Applicant did not file a reply brief, nor did it request an oral hearing.

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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

¹ Registration No. 2,339,532, issued April 11, 2000, and claiming dates of first use of December 3, 1994.

The marks here are identical. As our principal reviewing court said in **In re Shell Oil Co.**, 992 F.2d 1204, 26 USPQ2d 1687, (Fed. Cir. 1993), the identity of words, connotation, and commercial impression weighs heavily against the applicant. Even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.

Turning to the goods, applicant's are pain management catheters, while the registrant's are an apparatus for locating the position of a catheter within a patient's body. Applicant argues that there are obvious differences between the goods, including that registrant's is not a catheter, but an electronic device which is used outside the body, while applicant's is inserted within the body. Applicant also points out that its device and the registrant's cannot be substituted for each other. We agree that there are clear differences between the goods, and that "there is no risk that the similarities between the marks would result in physicians using the wrong medical tool." Applicant's brief, p. 6. However, the question we must determine is not whether the goods will be confused, but whether there is likely to be confusion over the source of the goods. It is well-established that it is

not necessary that the goods of the parties be similar or 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 of the parties 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 originate from the same producer. **In re International Telephone and Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1986)).

There is an obvious complementary quality to applicant's and registrant's goods, namely, registrant's apparatus can be used to locate the position of applicant's pain management catheters. Moreover, the Examining Attorney has submitted third-party registrations which show that companies have registered their marks for both catheters and devices to locate catheters. Although the companies have not used a single mark for both goods, the registrations do show that both types of goods may emanate from the same source.

Applicant's primary argument is that its catheters are epidural catheters specially designed to be inserted into

the spinal cords of patients so that physicians can administer pain medication, and that these goods are marketed to neurosurgeons and anesthesiologists. On the other hand, applicant asserts (without any supporting evidence) that registrant's goods are used to locate central venous catheters in patients, and are used in procedures performed in the field of cardiology.

The major problem with applicant's argument is that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in an applicant's application vis-à-vis the goods and/or services recited in the cited registration. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976). The registrant's goods, as identified in the registration, are not limited to use in cardiology, but may be used to locate the same pain management catheters identified in applicant's application. Thus, we must, based on the identifications, assume that the goods are used by doctors and other professionals in the same field.

Because the goods, as identified, are complementary, and because the evidence shows that goods of these types may emanate from a single source, we find that the goods

are related, and that consumers, upon seeing the identical mark NAVIGATOR on pain management catheters, are likely to believe that they come from the same source as the registrant's catheter-locating apparatus.

In reaching this conclusion we have given due consideration to applicant's argument that the purchasers and users of these goods are sophisticated. We certainly agree that the physicians and other professionals who would use both pain management catheters and an electronic apparatus for locating the position of a catheter within a patient would be knowledgeable and careful about their work. It is not as clear to us that the decision to purchase a catheter for administering pain medication would be the subject of great deliberation, as we have no information about whether such a catheter is a sophisticated or expensive piece of equipment, or would be more similar to a needle for giving injections. However, even if we assume that catheters for pain medication are purchased with care, we do not believe that the sophistication of the purchasers would avoid confusion. As noted above, the marks are identical, and goods of the type of both applicant and the registrant can emanate from a single source. As a result, doctors and hospital staff who use and/or purchase such equipment are likely to assume,

when the identical and arbitrary mark NAVIGATOR is used on both, that they come from the same source.

We also note applicant's argument that it is highly unlikely that the customers for applicant's and registrant's goods would purchase or use them without first investigating their source. To the extent that applicant is suggesting that confusion is not likely because consumers will know the company names of the sellers of the products, that argument is to no avail. It is our mandate to determine whether applicant's use of NAVIGATOR for its pain management catheters is likely to cause confusion with the registered mark NAVIGATOR for the identified catheter locating apparatus, not whether confusion is likely if consumers ignore those trademarks and rely on other indicia of origin.

Finally, we think this situation is appropriate for invoking the well-established principle that doubt must be resolved against the newcomer and in favor of the prior user or registrant. See **In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes**, 487 F.2d 918, 179 USPQ 729 (CCPA 1973). Here, although the registrant's mark was registered in 2000, based on an application filed in 1997 and use claimed in 1994, applicant, rather than

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adopting a different mark, chose to file an intent-to-use application for the identical mark in 2001.

Decision: The refusal of registration is affirmed.