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THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ortho Development Corporation

Serial No. 76432947

Karl R. Cannon of Clayton, Howarth & Cannon, P.C. for Ortho Development Corporation.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Holtzman, Rogers and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 22, 2002, Ortho Development Corporation (applicant) filed an intent-to-use application to register ORION-1, in standard character form, on the Principal Register for:

electrosurgical instruments for use in separating, severing, cutting, coagulating, vaporizing and devitalizing tissues for medical and surgical purposes, namely--high frequency control cabinets, including temperature controlling circuits, high frequency current overload detectors, high frequency

voltage overload detectors, and high frequency output controllers, footswitches, power cables, grounding cables, extension cables, and electrodes, for use in the medical fields of neurosurgery, gynecology, orthopedics, otolaryngology, plastic surgery, and urology, and excluding application surgical hand tools and clamps for surgical implant systems particularly involving the spine; said electrosurgical instruments being distributed to medical doctors and hospitals through scrutinized purchasing procedures conducted by medical doctors and medical specialty item distributors, and manufactured, distributed, and sold through trade channels associated within the medical implant manufacturing and medical device manufacturing industry to medical doctors and hospitals, in International Class 10.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of current Registration No. 2043954, issued March 11, 1997, for ORION, in standard character form, for:

goods in the medical field; namely, for plates, screws, rings and other components used in surgical implant systems particularly involving the spine, and for application tools and instruments; namely, surgical hand tools and clamps, in International Class 10.

The registration claims both first use and first use in commerce on September 14, 1993. The affidavits under Section 8 & 15 of the Act related to the cited registration have been accepted and acknowledged, respectively.

The examining attorney issued a final refusal and applicant appealed. For the reasons stated below, we affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent & Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." 15 U.S.C. § 1052(d). The opinion in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. We must determine whether there would be a likelihood of confusion by weighing all of the evidence bearing on those factors in each case according to the unique circumstances of the case. Id. at 567. We discuss the factors relevant here below, including all factors applicant discusses.

Comparison of the Marks

Applicant argues at some length, particularly in its reply brief, that the marks are different. Applicant argues that the marks differ in appearance, sound, connotation and commercial impression. Applicant's Brief at 14-15. The examining attorney disagrees, arguing that "ORION" is the dominant element in both marks. Examining Attorney's Brief at 4. The examining attorney argues further: "In fact, it is likely that the "1" portion of the applicant's mark will rarely be used when calling on the applicant's goods." Id. The examining attorney also

implies that "1" is not a "literal" element of applicant's mark. Id. In its reply brief applicant takes issue with these points and more generally with the position that the marks are similar. Applicant's Reply Brief at 2-4.

While we must reject the examining attorney's unsupported assumption that the "1" portion of applicant's mark would not be used in requesting the goods and the implication that "1" is not a literal element, we agree with the overall conclusion that the marks are similar. The simple facts are that applicant merely adds the numeral "1" to registrant's mark and that ORION is the dominant element in both marks.

We must consider the appearance, sound, connotation and commercial impression in comparing the marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Based on that comparison, we conclude that the mere addition of "1" has no significant effect on either the appearance, sound, connotation or commercial impression of ORION. The addition of a numeral, especially "1," to "ORION," an arbitrary mark, is insufficient to distinguish the two marks. In this case, the numeral "1" is likely to be perceived as merely designating a distinct version of a product primarily identified by the ORION mark. Therefore,

we conclude that ORION and ORION-1 are similar marks in all respects. In fact, the marks are virtually identical.

Comparison of the Goods and Trade Channels

Applicant's principal arguments relate to differences between the goods of applicant and registrant. Applicant has provided voluminous evidence illustrating the differences between the type of goods identified in its application versus the goods identified in the registration. The examining attorney argues that the goods of applicant and registrant are related: "The goods of the parties are related because 'electrosurgical instruments,' 'surgical hand tools' and 'clamps' are all used for surgical procedures." Examining Attorney's Brief at 5. Applicant attempted to distinguish its goods from those of the registrant by amending the identification of goods to exclude certain of the goods specified in the cited registration. Specifically, applicant inserted the following language to limit the goods: "excluding application surgical hand tools and clamps for surgical implant systems particularly involving the spine." Applicant's amendment also specified the channels of trade for its goods through the following language: "said electrosurgical instruments being distributed to medical doctors and hospitals through scrutinized purchasing

procedures conducted by medical doctors and medical specialty item distributors, and manufactured, distributed, and sold through trade channels associated within the medical implant manufacturing and medical device manufacturing industry to medical doctors and hospitals."

To support his position the examining attorney has provided copies of several registrations claiming use of the same mark on the types of goods identified both in the application and in the cited registration. Among those are the following:

Reg. No. 2155987 for the mark BOSS, owned by Boss Instruments, Inc., for both "electrosurgical instruments" as well as "clamps" and "chisels" and other surgical equipment;

Reg. No. 2381704 for the mark INTUITIVE, owned by Intuitive Surgical, Inc., for "electrosurgical instruments" as well as "a full line of resposable (limited reuse) tools" including "clamps" as well as "scalpels, scalpel blades and handles" and other surgical equipment;

Reg. No. 2628871 for the mark DA VINCI, owned by Intuitive Surgical, Inc., for "electrosurgical instruments" as well as "a full line of resposable (limited reuse) tools" including "clamps" as well as "scalpels, scalpel blades and handles" and other surgical equipment;

Reg. No. 2643372 for the mark TAKING SURGICAL PRECISION AND TECHNIQUE BEYOND THE HUMAN HAND, owned by Intuitive Surgical, Inc., for "electrosurgical instruments" as well as "a full line of resposable (limited reuse) tools" including "clamps" as well as "scalpels, scalpel blades and handles" and other surgical equipment;

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Reg. No. 2591824 for the mark ENDOWRIST, owned by Intuitive Surgical, Inc., for "electrosurgical instruments" as well as "a full line of resposable (limited reuse) tools" including "clamps" as well as "scalpels, scalpel blades and handles" and other surgical equipment;

Reg. No. 2364862 for the mark INTUITIVE SURGICAL, owned by Intuitive Surgical, Inc., for "electrosurgical instruments" as well as "a full line of resposable (limited reuse) tools" including "clamps" as well as "scalpels, scalpel blades and handles" and other surgical equipment;

Reg. No. 1945609 for the mark APPLIED MEDICAL, owned by Applied Medical Resources Corp., for "electrosurgical cutters and coagulators" as well as "clamps" and other surgical equipment;

Reg. No. 1863112 for the mark APPLIED MEDICAL RESOURCES, owned by Applied Medical Resources Corp., for "electrosurgical cutters and coagulators" as well as "clamps" and other surgical equipment;

Reg. No. 2710996 for the mark ACMI, owned by ACMI Corp., for "electrosurgical units" and "hand instruments, namely graspers and forceps," "cold knife blades" and other surgical equipment; and

Reg. No. 2317585 for the mark CIRCON, owned by ACMI Corp., for "electrosurgical units" and "hand instruments, namely graspers and forceps," "cold knife blades" and other surgical equipment.

These registrations are not evidence that these marks are in use, but they are of some probative value and do indicate that the goods of applicant and registrant are of a type which may emanate from the same source. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The registrations provided by the examining attorney also indicate more broadly that the same mark has been registered for a wide range of medical and surgical equipment and supplies for use in a wide range of medical and surgical specialties, including spinal surgery, neurosurgery and all of the other fields specified by applicant.

Applicant's literature refers to its product as, " the first and only neurosurgical device . . ." Applicant's literature also indicates the following "Developing Fields of application: gynecology, orthopedics, otolaryngology, plastic surgery and urology." Registrant's products appear to be primarily for use in spinal surgery. The literature provided by applicant indicates that spinal surgery is a form of neurosurgery. For example, an article provided by applicant from www.medscape.com concerning spinal surgery was apparently reproduced from the Journal Of Neurosurgery. Thus the record indicates that neurosurgeons would currently be the primary users of both applicant's and registrant's products, though for different procedures.

Accordingly, after considering all of the relevant evidence of record, we conclude that the goods of the applicant and registrant are related.

With regard to the channels of trade, while applicant has attempted to restrict the channels of trade for its own goods in its application, the cited registration does not include any restrictions as to the channels of trade. We must consider the goods as described in the registration and, in the absence of any restrictions in the channels of trade, assume that registrant's goods travel in all trade channels appropriate for such goods. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). We have no basis for concluding that registrant's goods would not travel through the same trade channels as those specified in the application. In fact, the trade channels applicant has specified are quite broad and would apply to most surgical equipment or supplies, including those specified in the cited registration.

Accordingly, we conclude that the channels of trade of applicant and registrant are the same or overlapping.

Sophistication of Purchasers

Applicant has also argued that the purchasers of both applicant's and registrant's goods are sophisticated and that both types of products are expensive: "Applicant submits that registration of the present mark is appropriate because surgeons, physicians and professional

buyers are highly sophisticated purchasers who are known for the degree of care they take during surgery and also in making their purchasing decisions regarding expensive surgical products. These individuals can readily distinguish between similar marks." Applicant's Brief at 20.

Applicant has represented that its own products are expensive and asserts that registrant's goods are likewise expensive and presents some literature with regard to registrant's goods. On this ex parte record, we cannot assume that all of the goods covered by the cited registration are in the \$15,000 range as applicant suggests. Nonetheless, based on the descriptions of the goods of both applicant and registrant we conclude that both are the type of goods as to which purchasers would exercise substantial care. And we conclude further that the typical purchasers would be sophisticated medical professionals. However, as we have noted many times, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). This is particularly the case where, as here, the marks are virtually identical. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). In addition, even sophisticated purchasers may not be aware of the range

of products offered by a party. In re Decombe, 9 USPQ2d 1812, 1815 (TTAB 1988). Accordingly, we conclude that the sophistication of relevant purchasers does not diminish the likelihood of confusion in this case.

Similar Marks In Use on Similar Goods

Applicant has also argued that the cited registered mark is weak as a result of third-party use: "Applicant further submits that with the barrage of identical marks already present in the marketplace, the addition of applicant's mark which is substantially different from the registered ORION marks, will not likely confuse sophisticated surgeons and physicians because those purchasers have already proven that they are able to readily distinguish between similar, and even identical marks." Applicant's Brief at 21.

Applicant claims that the cited mark is, "only one of nine (9) registrations issued to (7) different Registrants for the mark ORION in International Class 10." Id. However, the only documentation applicant provided with regard to these registrations is Exhibit A to its "AMENDMENT B AND REQUEST FOR RECONSIDERATION" which is a list of 10 USPTO records retrieved from a search for ORION in Class 10 in the USPTO TESS database. The only information in the list is the application serial number,

registration number, mark and an indication as to whether the record is "live" or "dead." The examining attorney did not object to the form of these records and discussed them. As a result, we will accept the list as evidence.¹ However, the list is of little probative value because it provides so little information. Most importantly, it includes no information as to the goods covered by these registrations.

The record does include information regarding two registrations in the list, in addition to the cited registration, because the examining attorney had refused registration initially on the basis of all three registrations. The examining attorney later withdrew objections based on Registration No. 1560703 for ORION for "balloon dilation catheters" and Registration No. 2259346 for ORION for "fiber optic illuminating device with coaxial lamp for use in surgical applications and medical procedures." Applicant has argued throughout that the issuance of these two prior registrations, in addition to the cited registration, warranted approval of its application.

As the Board has noted in another case, prior registrations, by themselves, are not evidence that the registered marks are in use. In re Melville, 18 USPQ2d

¹ In re Boyd Gaming Corp., 57 USPQ2d 1944, 1945 n. 4 (TTAB 2000).

1386, 1389 (TTAB 1991). In certain circumstances we will consider third-party registrations to determine whether the registrations demonstrate that a word in a mark has a commonly understood meaning and that the word is used in the mark to convey that meaning. Id. Merriam-Webster's Collegiate Dictionary (11th ed. 2003) defines "Orion" as "a constellation on the equator east Of Taurus represented on charts by the figure of a hunter with belt and sword" and "a giant hunter slain by Artemis in Greek mythology."² There is no indication that "ORION" has a well understood meaning in the surgical, medical or any other product field. We also dismiss applicant's unsupported assertion that prior ORION marks have coexisted in the medical field without confusion. Therefore, we conclude that ORION is arbitrary and a strong mark as applied to the registrant's goods. Furthermore, the registration of marks in prior applications does not bind us here. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Therefore, we reject applicant's argument that ORION is a weak mark in the medical products field.

² We take judicial notice of this dictionary definition. Marcel Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981).

Conclusion

In conclusion, we have weighed all evidence related to the du Pont factors regarding likelihood of confusion presented in this case and determined that there is a likelihood of confusion between applicant's mark and the cited mark. The principal factors dictating this result are the fact that the marks are virtually identical and the goods of applicant and registrant, as identified, are related and travel in the same or overlapping channels of trade, as well as the strength of the cited mark.

Decision: The refusal to register applicant's mark on the ground of likelihood of confusion is affirmed.