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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Uromedica. Inc.

Serial No. 78099133

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Before Bucher, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On December 29, 2001, Uromedica, Inc. filed an
application to register on the Principal Register the mark
PROACT (in typed or standard character form) for goods
ultimately identified as "[a]djustable, surgically-
implantable devices for the treatment of incontinency" in
International Class 10.¹

¹ Application Serial No. 78099133, claims a bona fide intent to
use the mark in commerce under Trademark Act 1(b), 15 U.S.C.
§ 1051(b).

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark PROACT (also in typed or standard character form) for "[s]urgical device for adhesion control therapy consisting of an electronic controller that monitors treatment parameters and an applicator that contacts tissue to be treated" in International Class 10.² Adhesions are described as follows in material submitted by the examining attorney with her September 21, 2005 Office action, taken from www.ellisdigital.com:

Adhesions are bands of tissue that connect anatomic sites at locations where there should not be connections. Adhesions can have a significant impact on an individual's health and well-being ...

How do adhesions form?

Post-operative surgical adhesions are formed as a result of trauma or injury to tissue such as the surgical incision made into the abdominal wall.

* * *

When do post-operative adhesions form?

The development of post-adhesions is thought to occur within the immediate 3-5 days following the surgical procedure.

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs.

² Registration No. 2747103, issued August 5, 2003. Registrant is identified as NTERO Surgical Corp.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, but not exclusive, considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks involved in this appeal are identical and applicant has conceded their identity. Thus, the *du Pont* factor involving the similarities of the marks weighs heavily against applicant.

Applicant has argued that "PROACT is a mark which is also widely used on a number of other products and services, including Registration 2,358,470 for '[s]ervices, namely, providing medical information and consultation to organ transplantation candidates' and Registration 2,045,233 (cancelled in 2003 for failure to file Section 8

Affidavit) for a 'blood cholesterol monitor for medical use.'" Brief at p 5. Inasmuch as applicant relies on a cancelled registration and has not introduced a copy of any other registration into the record, including Registration No. 2358470, applicant's argument is without support. Also, because there is no evidence of use of PROACT by third parties or marks similar to PROACT in the record, and because the record does not reflect that PROACT has any meaning in connection with applicant's or registrant's goods, we find that PROACT is a strong mark.

Turning next to applicant's and registrant's goods, we find that there are differences between the two.³ However, it is well settled that goods need not be similar or competitive in nature to support a finding that the goods are related. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that

³ Applicant points out at p. 3 of its brief that while applicant's device is implantable in a patient, registrant's device is not implantable in a patient.

they emanate from or are associated with, the same source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Also, it is well established that when the marks at issue are the same, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *AmcOR, Inc. v. AmCOR Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source.").

The examining attorney takes the position that "adhesions and incontinence are common medical conditions which are often treated surgically in the same type of medical facilities"; and that "applicant's and the registrant's goods will be encountered by the same surgeons who treat these common post surgical conditions" Brief at p. 7. In the Office action dated September 21, 2005, at p. 3, the examining attorney specifies that such surgeons include surgeons in the urology and gynecology fields. The

examining attorney cites to the following record evidence in support of her position:

1. A webpage from www.ntero.com, which the examining attorney attributes to registrant, that links adhesions to almost any type of open surgery:

NTERO Surgical's mission is to develop devices and treatments to address common post-surgical problems. Currently, the company is focusing on preventing adhesion formation following open surgical procedures performed by general, colorectal and gynecologic surgeons.

Adhesion prevention remains one of the leading unmet needs for surgeons and patients undergoing surgery. It is well known that post-operative surgical adhesions lead to small bowel obstruction, chronic pelvic pain and infertility resulting in additional health care costs. The PROACT™ System, currently under investigation, offers a unique approach to adhesion prevention. It is not a barrier or gel product.

NTERO Surgical is committed to providing surgeons with an effective easy to use product that inhibits the formation of post-operative adhesions in surgery.

Take control in the prevention of surgical adhesions. Treat the tissue.

2. An excerpt from the Nexis database that links incontinence to adhesions:

... Usually the symptoms include frequent, urgent urination, getting up at night to void and occasionally urinary incontinence. ... Known causes include anything that can irritate the bladder, such as diverticulitis, endometriosis, appendicitis, pelvic adhesions, interstitial cystitis, urinary tract infections etc.
Hattiesburg American (Hattiesburg, MS)
September 19, 2002

3. An abstract of an article from www.greenjournal.org entitled "Labial Adhesions Presenting As Urinary Incontinence In Postmenopausal Women," by CJ Chuong and CP Hodgkinson, which links complications due to adhesions to incontinence, and states:

Most discussion on labial adhesions is about the pediatric group. A case is presented of a postmenopausal woman whose main complaint was urinary incontinence.

4. A "case report" from www.ncbi.nlm.nih.gov entitled "Vulval adhesions causing urinary incontinence" by "Parkingson DJ" and "Alderman B.," *Postgrad Med. J.* 1984 Sep;60(707);634-4, which also links complications due to adhesions to incontinence.

Applicant maintains that its goods are used for treatment for post-prostatectomy incontinent patients where the incontinence results from radical prostatectomy for prostate cancer or transurethral resection of the prostate for benign prostatic hyperplasia.⁴ Applicant's argument is unhelpful in this appeal - we are bound to consider the goods as they are defined in the identifications of goods, and applicant's goods as identified in the identification of goods are not limited to use due to radical prostatectomys or even to use in males. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority

⁴ For support, applicant cites to two items submitted for the first time with its appeal brief. This additional evidence is untimely and is not further considered because under Trademark Rule 2.142(d), the record in an application should be completed prior to filing an appeal.

is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). The identification of goods does not contain the limitations argued by applicant.

Upon consideration of the foregoing, and the other evidence properly made of record by applicant and the examining attorney, we find that applicant's "adjustable, surgically implantable devices for the treatment of incontinency" and registrant's "surgical device for adhesion control therapy ..." are related goods. Both are applied within a patient's body, and hence require the services of a surgeon. If the surgery involves the urinary tract and/or urogenital system, the services of a urological surgeon would be needed by the patient. Additionally, even though one device is identified as being for the treatment of incontinency and the other is identified as being for the treatment of adhesions, ultimately, they both may be used in the treatment of incontinency - the record evidence shows that adhesions cause incontinency. Further, even if the two medical

devices are used to treat different causes of incontinency, i.e., one from a prostatectomy and the other from adhesions formed because of surgery, they are still related; the examining attorney has established that adhesions are of concern in any surgical procedure. Finally, it is likely that the same urological surgeon who undertakes the prostatectomy would use registrant's goods to address potential adhesions, and would later implant applicant's goods in the patient so that the patient could have a means of controlling his bladder.

We next consider the similarity or dissimilarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made. Applicant argues that because applicant's goods are implantable surgical devices, the "goods description ... calls for a narrow trade channel definition"; that buyers of registrant's goods are sophisticated purchasers; and that neither applicant's nor registrant's products are subject to impulse purchase.⁵

⁵ Applicant further argues that registrant's goods are only used in colorectal and gynecologic patients, citing to a page from Respondent's website submitted for the first time with applicant's brief. Applicant's argument is not well taken because applicant's identification of goods is not so limited and there is no evidence which we may consider in support of applicant's contention. (As noted earlier in footnote 4, the submission of evidence for the first time with applicant's brief

Because there are no trade channel limitations in the identifications of goods, we must assume that applicant's goods are sold in all channels that are appropriate for the sale of medical devices for the treatment of incontinency that are surgically implantable, and not "a narrow trade channel," which applicant attributes to its goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Of course, the medical devices that are the subject of applicant's application and registrant's registration would be purchased by hospitals and medical personnel.⁶ Thus, the trade channels, as well as the purchasers, of both goods overlap. Further, we consider the hospitals and medical personnel to be sophisticated purchasers, and find that they would not purchase applicant's or registrant's goods on impulse. Nonetheless, because of the identity of the marks, we note that even these sophisticated purchasers are likely to be confused as to the source of the two products. We hence find that the *du Pont* factors regarding trade channels, sales conditions and purchasers do not favor applicant.

is untimely, and such evidence will not be considered. See Trademark Rule 2.142(d).)

⁶ Applicant maintains in his response filed January 25, 2005 that applicant's goods are "sold to surgeons and not sold to consumers generally."

We now turn to applicant's contention at pp. 4-5 of applicant's appeal brief, i.e., that "[t]here is no evidence of actual confusion."⁷ Applicant's contention is not persuasive on the question of likelihood of confusion. First, uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *In re Majestic Distilling Company, Inc., supra.* Second, a page from applicant's website submitted by the examining attorney with her September 21, 2005 Office action states, "ProACT™ is not currently available in the United States."⁸ It is clear that there has not been a sufficient opportunity for confusion to occur, even if it were likely to occur.

Applicant maintains that it has adopted the PROACT mark to "expand a family of closely related marks for its

⁷ Applicant adds that "[t]his is clearly true, because Applicant's priority date is only a bit more than one month after the date of first use alleged by Applicant." Applicant's "priority date" is the date of filing of its intent to use application, which is a constructive use date, not an actual use date. We do not understand what applicant is trying to convey in pointing out the proximity of the filing date of its application to the first use date recited in registrant's registration, in the context of whether there have been any instances of actual confusion.

⁸ Further, applicant's August 15, 2005 response included a letter dated August 8, 2005 from the Food and Drug Administration ("FDA") which states "your application is approved and you may continue your investigation at the institutions enrolled in accordance with the investigational site waiver granted in our March 31, 2005 letter. Your investigation is limited to 10 institutions and 109 subjects." Evidently, applicant's product has not yet received FDA approval for sale in the United States.

line of implantable, adjustable urinary incontinence control products." To establish that it has a family of marks, applicant must present evidence showing that the marks it maintains are part of its family of marks are used and promoted in such a way that the public associates not only the individual marks, but the common characteristic of the family, with applicant. See *J& J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). Applicant has introduced no evidence which we may consider tending to show that it has a family of marks. Because of this lack of evidentiary support, applicant's contention that it has a family of marks is rejected.

In view of the foregoing, we find that the potential for confusion between applicant's and registrant's goods is substantial; and that applicant's mark PROACT for "adjustable, surgically-implantable devices for the treatment of incontinency" is likely to cause source confusion among purchasers with the identical registered mark PROACT for "[s]urgical device for adhesion control therapy consisting of an electronic controller that monitors treatment parameters and an applicator that contacts tissue to be treated." We arrive at our decision even if the *du Pont* factors not specifically discussed

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above but mentioned in applicant's appeal brief are resolved in applicant's favor or are deemed neutral.

Decision: The refusal to register under Section 2(d) is affirmed.