Hearing:
March 30, 2006

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August 4, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Spire Corporation

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Serial No. 76559059

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Thomas J. Engellenner and Jennifer M. Adams of Nutter McClennen & Fish LLP for Spire Corporation.

Ellen Awrich, Trademark Examining Attorney, Law Office 116 (M. L. Hershkowitz, Managing Attorney).

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Before Seeherman, Hohein and Walters, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Spire Corporation has appealed from the final refusal of the Trademark Examining Attorney to register DECATHLON in standard character form as a trademark for "catheters."[1] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

[1] Application Serial No. 76559059, filed November 12, 2003, based on Section 1(b) of the Trademark Act (intent-to-use).

applicant's mark, if used on its identified goods, so resembles the previously registered mark DECATHLON for, inter alia, "hypodermic needles for medical use,"[2] that it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and an oral hearing was held before the Board.

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). See also, In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d

[2] Registration No. 2691884, issued March 4, 2003. The registration includes goods and services in Classes 3, 4, 5, 11, 17, 21, 22, 23, 24, 26, 27, 36, 38, 41, 42, as well as a number of items in Class 10 in addition to hypodermic needles, i.e., "artificial limbs, eyes and teeth, orthopedic footwear, braces, belts, bandages, and supports; sutures; abdominal trusses; splints; elastic bandages; orthopedic bandages for joints; orthopedic support stockings for varicose veins; medical belts; orthopedic shoes; apparatus for aesthetic massages; medical apparatus for therapeutic body exercises; gloves for medical use; condoms; babies' bottles; baby bottle nipples; and dental wax." It is clear, however, from the Examining Attorney's arguments that it is registrant's mark for hypodermic needles that is the primary good that she considers likely to cause confusion, and we therefore have confined our analysis of the issue of likelihood of confusion to this item.

1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning to the first du Pont factor, the similarity or dissimilarity of the marks, the marks here are identical. This factor weighs heavily in favor of a finding of likelihood of confusion. Further, this finding has an impact on the second du Pont factor, the similarity or dissimilarity of the goods, because the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists. In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001); In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983).

In order to establish the requisite relationship between the goods, the Examining Attorney has submitted a large number of use-based third-party registrations which show that, in each instance, a single mark has been

registered for, inter alia, both catheters and hypodermic needles. See, for example, Registration No. 2208919 for, inter alia, medical catheters and hypodermic needles and syringes; Registration No. 2635808 for, inter alia, catheters, introducers, needles and medical syringes; Registration No. 2691278 for, inter alia, urological drainage bags and catheters and needles for medical use; and Registration No. 2618526 for, inter alia, needles for medical use and catheters.[3] Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).[4]

Applicant has attempted to dismiss the probative value of these registrations by pointing out that they include other goods as well, arguing that taking "the Examiner's

[3] Although not all the registrations specify "hypodermic needles" as opposed to "needles" per se, there is no requirement for an applicant/registrant to list hypodermic needles separately as they would be encompassed by the identification "needles."

[4] The Examining Attorney also submitted a printout from the www.vasca.com website that explains dialysis to patients and family members. This website mentions that a particular option for dialysis involves use of hemodialysis needles, also called fistula needles. However, because the cited registration specifies hypodermic needles, this evidence does not show the relatedness of applicant's goods and the registrant's identified goods.

reasoning to its logical conclusion—that goods listed in the same registrations and provided by the same parties are "highly related"—then it follows that surgical ice packs are highly related to catheters and needles, which clearly does not make sense." Request for reconsideration, pp. 4-5. Applicant's argument might be persuasive if the Examining Attorney had submitted only one third-party registration which covered many disparate goods, and tried to assert that all the goods shown therein were highly related. However, the Examining Attorney has, as noted above, submitted a number of third-party registrations issued to different parties. While these registrations do list a number of items in addition to catheters and medical needles (which would include hypodermic needles), the additional items actually support the Examining Attorney's position. They show that in the medical field companies adopt a single mark for a variety of medical items. Therefore, the relevant classes of consumers are likely to assume that catheters and hypodermic needles come from a single source, even if these goods are not necessarily used together or used for the same purpose.

We also note that applicant sells its catheters in a kit that contains, inter alia, an introducer needle. Although such a needle is different from a hypodermic

needle, the fact that applicant sells a needle as part of its DECATHLON catheter kit shows that needles and catheters are products that may be sold by the same company. Accordingly, consumers who are familiar with DECATHLON catheters and the needles used with them are likely to believe, upon seeing the identical mark DECATHLON used on hypodermic needles, that there is a connection as to the source of these 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 & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Applicant has also pointed to registrations for DECATHLON in different classes in an attempt to show that the U.S. Patent and Trademark Office has considered such

other registrations not to be likely to cause confusion.[5] These three "pairs" of DECATHLON registrations submitted by applicant are for carpets, rugs, floor and door mats in one registration,[6] and floor tiles of plastic composition in the other; horticultural chemicals for use as an insecticide in one registration, and mothproofing preparations in the other;[7] and interchangeable lens sport glasses in one registration, and optical lenses and spectacles in another. We do not know the circumstances involved in each of the particular decisions to allow one registration despite the existence of the other. However, a determination by an Examining Attorney that confusion is not likely when the same mark is used on very different goods from the medical products involved in this appeal does not have any effect on our decision herein. What we must decide is whether, on the record before us here, the Examining Attorney has demonstrated that there is the requisite viable relationship between the goods at issue such that the use

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[5] Applicant has not argued that the four third-party registrations which it has made of record show that DECATHLON has a suggestive significance for the registrant's goods, or otherwise that the registered mark is a weak mark that is entitled to a limited scope of protection. We confirm that on the basis of the evidence of record, the registered mark must be considered arbitrary and hence strong.

[6] This registration is in fact the same registration that has been cited against applicant's mark.

[7] The latter registration is, again, the same registration that has been cited against applicant's mark.

of the identical mark DECATHLON in connection with both is likely to cause confusion. We find that the record supports such a conclusion, and we therefore find that the du Pont factor of the similarity of the goods favors a finding of likelihood of confusion.

Applicant has apparently attempted to limit the scope of the registered mark by asserting that "the cited registration is owned by a sporting goods retailer that operates a chain of sporting goods stores." Brief, p. 5. Therefore, applicant contends that: "At most, [registrant] may be selling medical devices for sports injuries in its retail sporting goods stores, but it is not in the medical business at all." Brief, p. 6.

The determination of likelihood of confusion must be based on the goods or services as they are identified in the applicant's application and the cited registration, rather than what extrinsic evidence such as the registrant's website shows the goods or services to be. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); In re Simulations Publications, Inc., 521 F.2d 797, 187 USPQ 147 (CCPA 1975); In re Riley Co., 182 USPQ 510 (TTAB 1974). The identification in the cited registration is for "hypodermic needles for medical use"; thus, we must deem

these goods to include all hypodermic needles for any type of medical use, not merely to treat sports injuries.

Moreover, the registrant's hypodermic needles cannot be deemed to be sold, as applicant argues, solely in registrant's own sporting goods stores. Even if we were to accept the rather dubious contention that hypodermic needles are sold in sporting goods stores, hypodermic needles for medical use are certainly sold to hospitals and clinics and to doctors and other medical personnel. Catheters may also be sold in some of these same channels of trade. Applicant has, in fact, asserted that its goods are sold to hospital purchasing departments, which applicant has acknowledged are the same departments that purchase hypodermic needles.

Applicant has argued that its catheters are designed for use in hemodialysis, and that it "markets and sells its products to the renal disease/hemodialysis departments in hospitals." Reply brief, p. 3. Applicant goes on to say that because medical professionals "do not need *hypodermic needles* to create a vascular access or to administer the actual hemodialysis treatment, the market for Applicant's catheters is highly unlikely to be the same market for hypodermic needles. Id. (emphasis in original). However, this argument ignores the fact that applicant has

identified its goods as "catheters" per se, not catheters for use only in hemodialysis. Where the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). The same principle holds true for an application, namely, that where the goods are broadly described, the identification is deemed to encompass all goods of the nature and type described, and the goods are deemed to be sold in all trade channels appropriate for such goods.

Because both hypodermic needles and catheters can be purchased by a hospital purchasing department for use in administering medication or effecting a procedure on an individual patient, the goods must be deemed to travel in the same channels of trade and be purchased and used by the same consumers.

Applicant relies on Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 USPQ

786 (1st Cir. 1983), in support of its position that the goods are sold in different channels of trade, but that decision is inapplicable to the present case for several reasons. First, it is an infringement case, and the Court looked to the ways in which the specific goods of the parties were marketed and sold. As we have stated, we must determine the issue of likelihood of confusion based on the goods as they are identified in the application and registration, not on what the evidence shows such goods to actually be, and we must deem the goods to travel in all appropriate channels for the goods as they are identified. Second, in the Astra case the evidence showed that the plaintiff's pharmaceutical preparations were sold only to the hospital pharmacy, which was autonomous in its purchasing decisions, while the defendant's blood analyzer machine was marketed to the hospital chemistry lab, and never to the pharmacy or anyone who would be administering the plaintiff's drugs. Here, because both hypodermic needles and catheters (not limited to hemodialysis catheters) are used directly on patients, and may be bought for the same patients and/or handled by the same medical personnel, the separation in the classes of purchasers that was present in the Astra case is not present here.

The du Pont factor of the similarity of trade channels favors a finding of likelihood of confusion.

The next factor we will discuss is the conditions under which and the buyers to whom sales are made. We agree with applicant that the medical personnel who would purchase and use both catheters and hypodermic needles must be considered sophisticated purchasers. However, because of the third-party registration evidence that companies may adopt a single mark for a variety of products in the medical field, including catheters and needles, even these sophisticated purchasers would assume, if the identical mark were used on these goods, that the goods emanated from a single source. Further, even if the goods were purchased with care, because the marks are identical even a careful purchaser would not be able to distinguish between the two marks. This du Pont factor must be considered neutral.

Applicant and the Examining Attorney have not discussed any other du Pont factors in their briefs. During the course of examination, however, applicant made the claim that it is not aware of any instances of confusion despite the fact that applicant has been using its mark since March 2004.[8] At the same time, applicant has

[8] As noted previously, applicant has based this application on the intent-to-use provisions of Section 1(b) of the Act, and has

questioned whether the registrant has used its mark for hypodermic needles at all, pointing out that the registration was based on Section 44(e) of the Trademark Act.[9] Because we have no information about the extent of the registrant's use of its mark; because the record does not indicate the extent to which applicant has advertised and used its mark; because in this ex parte proceeding we have not heard what registrant's experiences have been vis-à-vis actual confusion; and because approximately two years of contemporaneous use is a relatively short period of time, we cannot conclude from applicant's statement that it has experienced no instances of actual confusion that there is no likelihood of confusion. This du Pont factor is therefore neutral.

Applicant and the Examining Attorney have not discussed any of the remaining du Pont factors. To the extent that any are applicable, they must be considered to be neutral. After considering all of the relevant du Pont factors, we find that applicant's mark DECATHLON for

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not filed an amendment to allege use. The HHS approval letter dated April 19, 2004 and submitted by applicant states that "this letter will allow you to begin marketing your device."

[9] To the extent that applicant is attempting to assert that the registrant has abandoned the use of its mark, this would be an impermissible collateral attack on the registration.

catheters is likely to cause confusion with the registered mark DECATHLON for hypodermic needles for medical use.

Decision: The refusal of registration is affirmed.