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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/465875

APPLICANT: Nexense Ltd.

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: NEXAVER

CORRESPONDENT'S REFERENCE/DOCKET NO: EHRGT159US

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Nexense Ltd., has appealed the examining attorney's refusal to register the mark NEXAVER in standard character form under §2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(d). This refusal is the only issue on appeal.

FACTS

On August 11, 2004 applicant applied to register the mark NEXAVER in standard characters based on its bona fide intention to use the mark in commerce, §1(b) of the Trademark Act, and claiming priority under §44(d) for "Electronic sensors and medical apparatus, instruments and equipment including same" in international class 13. On November 10, 2004 applicant filed an preliminary amendment properly changing the

class from 13 to 10. In an office action dated March 15, 2005 the examining attorney refused registration based on a likelihood of confusion, Section 2(d) of the Trademark Act, with U.S. Registration No. 2745627 and required amendment of the identification of goods.

On August 9, 2005 applicant responded to the office action arguing against a likelihood of confusion with the cited registration, amending the description of goods and perfecting its section 44(e) basis by submitting its foreign registration. On September 1, 2005 the examining attorney issued a non-final office action, maintaining the refusal to register under Section 2(d) of the Trademark Act and requiring amendment as the description of goods in the application was beyond the scope of the description in the foreign registration. On March 1, 2006[1] applicant responded to the office action arguing against a likelihood of confusion and amending the description of goods. On April 14, 2006 the examining attorney made final the refusal to register under Section 2(d) of the Trademark Act and accepted the amended description of goods. On September 22, 2006 applicant filed a request for reconsideration and on October 13, 2006 a Notice of Appeal. On November 2, 2006 the examining attorney issued an action denying the request for reconsideration and maintaining the refusal under Section 2(d) of the Trademark Act. On December 21, 2006 applicant filed its appeal brief supporting its argument that the refusal under Section 2(d) of the Trademark Act should be reversed and the mark should be cleared for registration on the Principal Register.

ISSUE ON APPEAL

Whether the applicant's use of the mark NEXAVER in standard characters for "Medical devices, namely respiration sensors, pulse sensors, blood pressure sensors"

[1] On January 18, 2006 applicant filed a response containing duplicative foreign registration information.

creates a likelihood of confusion with Registration No. 2745627 for the mark NEXAVAR in typed form for "pharmaceutical preparations for the treatment of cardiovascular diseases, central nervous system diseases, cancer, respiratory and infectious diseases, diagnostics reagents adapted for medical use."

LIKELIHOOD OF CONFUSION ANALYSIS

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E .I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc*., 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq*.

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness

of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

ARGUMENT

1. THE MARKS ARE HIGHLY SIMILAR

The marks at issue are NEXAVER (applicant) and NEXAVAR (registrant). The marks only differ in a single soft sounding vowel. The marks are essentially phonetic equivalents and are thus similar sounding. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv). Therefore, the marks are highly similar.

Applicant argues that the marks are distinct in sound because of the difference in the final soft sounding vowel in the marks, VAR and VER. However, there is no correct pronunciation of a trademark. *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985); *In re Teradata Corp.*, 223 USPQ 361, 362 (TTAB 1984); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same. Further, the single vowel difference in the marks at most creates only a slight difference in sound. Slight differences in the sound of similar marks will not avoid a

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