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Subject: U.S. TRADEMARK APPLICATION NO. 85074999 - DEXTERITY - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85074999

**MARK:** DEXTERITY



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Pedifix, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant, Pedifix, Inc., has appealed the trademark examining attorney's final refusal to register the trademark DEXTERITY under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. Section 1052(d). Registration was refused on the Principal Register on the grounds that the applicant's mark is likely to be confused with the marks DEXTERITY of U.S. Registration No. 3994623 and DEXTERITE of U.S. Registration No. 4273785.

## FACTS

On June 30, 2010, applicant applied to register the standard character mark DEXTERITY based on use of the mark in commerce under Section 1(a) of the Trademark Act in connection with “silicone gel sheeting for the treatment of scars; orthopedic support bandages, namely, wearable pads for the hands, support bandages, finger bandages, finger guards for medical purposes; exercise articles for rehabilitation and therapeutic purposes, namely, polymer gel spheres for muscular rehabilitation; pads for preventing pressure sores; finger guards for medical purposes; compression sleeve for treating swelling and circulatory disorders, anti-inflammatory pad for treating sports injuries and tissue trauma; joint protector sleeves for the hands, thumb and wrists; carpal tunnel relief sleeves; heat therapy gloves and mittens for the hands” in International Class 10.

In an Office action issued on October 17, 2010, registration was refused under Section 2(d) of the Trademark Act based upon the mark DEXTER in typed form in U.S. Registration No. 1783339 registered for “biomechanical medical apparatus, for physical rehabilitation and performace [*sic*] evaluation of the hand” in International Class 10. Application Serial Nos. 77898229 and 79086708 were referenced as earlier-filed pending applications, and a partial requirement to amend the identification of goods was made.

In a response filed on January 10, 2011, applicant presented arguments against the Trademark Act Section 2(d) refusal and amended the identification to “silicone gel sheeting for the treatment of scars; orthopedic support bandages, namely, wearable pads for the hands, support bandages, finger support bandages, finger guards for medical purposes; exercise articles for rehabilitation and therapeutic purposes, namely, polymer gel spheres for muscular rehabilitation; pads for preventing pressure sores; compression sleeve for treating swelling and circulatory disorders, anti-inflammatory pad for treating sports injuries and tissue trauma; joint protector sleeves for the hands, thumb and wrists for medical purposes; carpal tunnel relief sleeves” in International Class 10 and “terrycloth gloves and mittens with gel inserts for use in heat therapy” in International Class 25.

A Notice of Suspension was mailed on January 31, 2011, suspending the application pending the disposition of Application Serial Nos. 77898229 and 79086708. The likelihood of confusion refusal based on U.S. Registration No. 1783339 and the requirement for an acceptable identification of goods were both maintained and continued.

The application was removed from suspension and an Office action was issued on February 27, 2013 in which registration was newly refused under Section 2(d) of the Trademark Act based upon the standard character mark DEXTERITY in U.S. Registration No. 3994623 registered for “medical examination and surgical gloves; disposable medical gloves” and the standard character mark DEXTERITE in U.S. Registration No. 4273785 registered for “equipment for camera image processing for surgical manipulation, namely, computers; computer software for surgical manipulation systems, namely, operating software for surgical devices” in International Class 9 and “articulated and motor driven instruments for use in urology, gynecology, vascular, cardiac and gastrointestinal laparoscopic surgery; artificial limbs, eyes and teeth; orthopaedic articles, namely, orthopedic braces; robotic surgical apparatus and instruments, namely, surgical articulated and motor driven instruments; computerized apparatus and instruments for surgical manipulation, namely, surgical articulated and motor driven instruments; articulated and motor driven arms for surgical manipulation; electrical surgical apparatus and instruments, namely, surgical articulated and motor driven instruments; jointed and motorised surgical apparatus and instruments for endoscopic and laproscopic [*sic*] surgery” in International Class 10. The Trademark Act Section 2(d) refusal based on U.S. Registration No. 1783339 and the identification of goods amendment requirement were maintained and continued.

Applicant filed a response on August 27, 2013 in which it argued against the Trademark Act Section 2(d) refusal and amended the identification of goods to “silicone gel sheeting for the treatment of scars; wearable pads for the hands for use in cushioning and protecting the metacarpal heads and to protect the thumb and other digits from forceful trauma, pressure, shock and shear; support bandages used to cushion the base of the thumb and reduce tenderness over palmar incisions, finger support bandages, finger guards for medical purposes; exercise articles for rehabilitation and therapeutic purposes, namely, polymer gel spheres for muscular rehabilitation; pads for preventing pressure sores; compression sleeve for treating swelling and circulatory disorders, anti-inflammatory gel pad for treating sports injuries and tissue trauma; gel-based joint protector sleeves for the hands, thumb and wrists for medical purposes; carpal tunnel relief sleeves, terrycloth gloves and mittens with gel inserts for use in heat therapy for the hands” in International Class 10.

In an Office action issued on September 17, 2013, the Trademark Act Section 2(d) refusal was withdrawn with respect to U.S. Registration No. 1783339 and maintained and made final with respect to U.S. Registration Nos. 3994623 and 4273785. The partial requirement for an acceptable identification of goods was also maintained and made final.

Applicant filed a Request for Reconsideration along with a Notice of Appeal on September 24, 2014 in which it amended the identification to “silicone gel sheeting for the treatment of scars; support bandages, namely, wearable pads for the hands for use in cushioning and protecting the metacarpal heads and to protect the thumb and other digits from forceful trauma, pressure, shock and shear; support bandages used to cushion the base of the thumb and reduce tenderness over palmar incisions, finger support bandages, finger guards for medical purposes; exercise articles for rehabilitation and therapeutic purposes, namely, polymer gel spheres for muscular rehabilitation; pads for preventing pressure sores; compression sleeve for treating swelling and circulatory disorders, anti-inflammatory gel pad for treating sports injuries and tissue trauma; gel-based joint protector sleeves for the hands, thumb and wrists for medical purposes; carpal tunnel relief sleeves, terrycloth gloves and mittens with gel inserts for use in heat therapy for the hands” in International Class 10.

The Request for Reconsideration was denied in an action mailed October 11, 2013 and applicant submitted its appeal brief to the Board on December 13, 2013. Applicant submitted an amended appeal brief on December 18, 2013 and by a January 5, 2014 Board Order, the amended brief was made the operative brief herein.

### **ISSUE ON APPEAL**

The sole issue on appeal is whether applicant’s use of the mark DEXTERITY in connection with “silicone gel sheeting for the treatment of scars; support bandages, namely, wearable pads for the hands for use in cushioning and protecting the metacarpal heads and to protect the thumb and other digits from forceful trauma, pressure, shock and shear; support bandages used to cushion the base of the thumb and reduce tenderness over palmar incisions, finger support bandages, finger guards for medical purposes; exercise articles for rehabilitation and therapeutic purposes, namely, polymer gel spheres for muscular rehabilitation; pads for preventing pressure sores; compression sleeve for treating swelling and circulatory disorders, anti-inflammatory gel pad for treating sports injuries and tissue trauma; gel-based joint protector sleeves for the hands, thumb and wrists for medical purposes; carpal tunnel relief sleeves, terrycloth gloves and mittens with gel inserts for use in heat therapy for the hands” creates a likelihood of confusion with the registered marks DEXTERITY in U.S. Registration No. 3994623 for “medical examination and surgical gloves; disposable medical gloves” and DEXTERITE in U.S. Registration No. 4273785 for “equipment for camera image processing for surgical manipulation, namely, computers; computer software for surgical manipulation systems, namely, operating software for surgical devices” and “articulated and motor driven instruments for use in urology, gynecology,

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