

This Opinion is not a
Precedent of the TTAB

Mailed: August 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Pedifix, Inc.

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Serial Nos. 85074999 and 85075017

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David B. Kirschstein of Kirschstein, Israel, Schiffmiller & Pieroni, P.C.,
for Pedifix, Inc.

Sara N. Benjamin, Trademark Examining Attorney, Law Office 110
Chris A.F. Pedersen, Managing Attorney.

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Before Bucher, Cataldo and Adlin,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Pedifix, Inc. (“Applicant”) filed two use-based applications to register the marks DEXTERITY¹ and DEXTERITY BY PEDIFIX² (standard characters) for the goods set forth below:

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

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¹ Serial No. 85074999 was filed on June 30, 2010.

² Serial No. 85075017 was also filed on June 30, 2010.

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 Class 10.

The Trademark Examining Attorney refused registration to both applications under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered marks:

DEXTERITY (standard characters) for

medical examination and surgical gloves; disposable medical gloves,

in Class 10;³ and

DEXTERITE (standard characters) for

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

³ Registration No. 3994623, issued to SmartHealth, Inc. on July 12, 2011.

surgical manipulation; electrical surgical apparatus and instruments, namely, surgical articulated and motor driven instruments; jointed and motorised surgical apparatus and instruments for endoscopic and laparoscopic surgery (emphasis added)

in Class 10⁴ that registration of Applicant's mark would be likely to cause confusion among consumers as to the source of the goods.

When the refusal to register was made final in both cases, Applicant appealed. Applicant and the Examining Attorney filed briefs.⁵

Proceedings Consolidated

When, as here, Applicant has filed *ex parte* appeals to the Board in two co-pending applications, and the cases involve common issues of law or fact, the Board, upon request by the Applicant or Examining Attorney or upon its own initiative, may order the consolidation of the appeals for purposes of briefing, oral hearing, and/or final decision. TBMP § 1214 (2014). *See also, e.g., In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997) (Board *sua sponte* considered appeals in five applications together and rendered single opinion). Accordingly, the Board consolidates

⁴ Registration No. 4273785, issued to Dexterite Surgical January 15, 2013. The English translation of the foreign word in the mark is "DEXTERITY." The registration also recites goods in Class 9.

⁵ The attachments to Applicant's brief will be given no consideration. To the extent they were not made of record prior to appeal, they are untimely. *See* Trademark Rule 2.141(d). To the extent they were timely made of record during prosecution, they are duplicative and unnecessary.

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these appeals. References to the record refer to Application Serial No. 85074999 unless otherwise indicated.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key 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, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

‘785 Reg.

For purposes of our analysis of the *du Pont* factors as they apply to the instant refusal to register, we will concentrate our discussion on cited Registration No. 4273785 (‘785 Reg.) for the mark DEXTERITE (standard characters) for goods including “orthopaedic articles, namely, orthopedic braces.” We find this registration to be the most relevant for our *du Pont* analysis, and we proceed accordingly. Since this is the most relevant

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registration, if we find a likelihood of confusion, we need not find it as to the other. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The similarity or dissimilarity of the marks in terms of appearance, sound, connotation and commercial impression and the strength of the mark in the cited registration .

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

The mark in the '785 Reg. is DEXTERITE. The mark in application Serial No. 85074999, DEXTERITY, is identical to the registered mark in meaning and nearly identical in appearance. The sole difference between the marks is in the last letter, which may go unnoticed by consumers. Applicant

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