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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Shield California Health Care Center, Inc.
d/b/a Shield Mail Order Medical Supply

v.

Mail Order Meds, Inc.

Cancellation No. 26,206

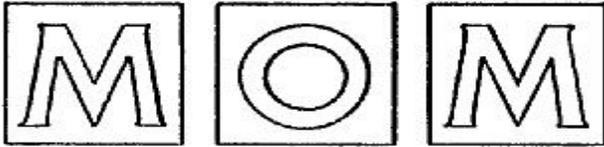
James Yuanxin Li of Sedgwick, Detert, Moran & Arnold for
Shield California Health Care Center, Inc. d/b/a Shield
Mail Order Medical Supply.

Andrew M. Gold of Bogatin, Corman & Gold for Mail Order
Meds, Inc.

Before Cissel, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Shield California Health Care Center, Inc. d/b/a
Shield Mail Order Medical Supply has filed a petition to
cancel the registration of the mark shown below,



for "providing services of mail order pharmacy; providing information regarding health and health related topics."¹ As grounds for cancellation, petitioner alleged that respondent's mark so resembles petitioner's previously used mark MOMS for mail order services in the field of medical supplies as to be likely to cause confusion under Section 2(d) of the Trademark Act; and that respondent fraudulently obtained its registration when it falsely stated in its application that no other entity had the right to use the mark in commerce, when in fact petitioner had been using a similar mark in nationwide commerce prior to respondent's alleged date of first use.²

Respondent, in its answer, denied the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of

¹ Registration No. 1,930,015 issued October 24, 1995, canceled July 27, 2002 under Section 8 of the Trademark Act. Because the case had been tried prior to cancellation of the involved registration, a decision on the merits is being issued.

² Petitioner did not pursue the fraud claim at trial, and thus, we have given it no consideration.

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involved registration; the testimony deposition of petitioner's president, Jim Snell, with related exhibits; and petitioner's notice of reliance on, inter alia, respondent's responses to petitioner's interrogatories and portions of the discovery deposition of Mark LeBlanc, respondent's operations manager. Respondent did not take testimony or submit any other evidence. Only petitioner filed a brief on the case. No oral hearing was requested.

The record shows that petitioner is in the business of selling disposable medical supplies by mail to end users at home. Petitioner's products are typically used by individuals with chronic or debilitating illnesses such as diabetes, HIV and AIDS. Petitioner's president, Jim Snell, testified that petitioner began business in 1992. The MOMS mark (which is an acronym for Mail Order Medical Supply) was first used in an advertisement in November 1992 in a newsletter titled Help for Incontinent People. The advertisement offered readers who sent in the accompanying coupon a copy of petitioner's 1993 catalog. The mark was next used on the order form in petitioner's 1993 catalog, copies of which were mailed to customers beginning in January 1993. Copies of petitioner's initial advertisement and its 1993, 1994,

and 1995 catalogs wherein the MOMS mark appears were introduced during Mr. Snell's testimony. According to Mr. Snell, petitioner currently sends out approximately 200,000 catalogs monthly to customers in all fifty states and Puerto Rico. Petitioner also has a web site at which customers may place orders.

The little information we have about respondent comes from the excerpts of the discovery deposition of its operations manager, Mark LeBlanc. Mr. LeBlanc testified that respondent provides prescription medications and supplies to individuals by mail. Respondent's primary customers are the chronically ill, including persons with HIV/AIDS, diabetes, and transplant recipients. Respondent offers its services throughout the United States and has a web site at which customers may place orders.

This brings us to the ground of priority and likelihood of confusion upon which petitioner has brought this proceeding. With respect to priority, the evidence establishes petitioner's use of its MOMS mark since November 1992, which is prior to the filing date of the application which matured into respondent's registration, namely November 21, 1994. (It is also prior to respondent's claimed date of first use of October 1,

1994.) Thus, in this case, priority rests with petitioner.

With respect to the issue of likelihood of confusion, we have, in making this determination, considered 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 1974). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA).

We turn first to compare the marks MOMS and MOM and design. Although the marks must be compared in their entirety, there is nothing improper in giving more weight to a particular portion of a mark if it would be remembered and relied upon to identify the goods or services. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986). Thus, if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to refer to the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB

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1987). In the present case, the literal portions of the marks differ only by the letter "S." Moreover, the design portion of respondent's mark does not serve to distinguish its mark from petitioner's mark. In sum, we find that the marks are substantially similar in terms of sound, appearance, connotation, and overall commercial impression.

We turn next to the parties' services. The evidence shows that petitioner is in the business of selling disposable medical supplies by mail primarily to persons with chronic illnesses or debilitating diseases. Respondent's services are identified as "providing services of mail order pharmacy; providing information regarding health and health related topics." Thus the parties' services are closely related. Moreover, the record shows that the parties offer their services to some of the same purchasers, namely chronically ill persons, and that they also make ordering available over the Internet.

Under the circumstances, we conclude that consumers familiar with petitioner's mail order services in the field of mail order supplies offered under the mark MOMS would be likely to believe, upon encountering respondent's mark MOM and design for mail order and

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related pharmacy services, that the services originated with or are somehow associated with or sponsored by the same source.

Decision: The petition to cancel is granted.³

³ No Director's order canceling Registration No. 1,930,015 will be issued as the registration has been canceled under Section 8 as explained in footnote 1.