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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Health Information Network, Inc.

Serial No. 75/597,273

Clark R. Cowley of Whitaker, Chalk, Swindle & Sawyer,
L.L.P. for National Health Information Network, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Daniel P. Vavonese, Acting Managing Attorney).

Before Simms, Cissel and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

National Health Information Network, Inc. (applicant),
a Texas corporation, has appealed from the final refusal of
the Trademark Examining Attorney to register the mark shown
below:

Care ♥ Rx

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for computer software for use in healthcare management.¹

A copy of applicant's specimen of record is reproduced

below in reduced form:



The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 2,404,562, issued November 14, 2000, for the mark RXCARE for "electrical and scientific apparatus; namely, pharmacy management software applications."²

¹Application Serial No. 75/597,273, filed November 17, 1998, based upon allegations of use since February 14, 1997. Applicant has disclaimed the letters "RX."

²The underlying application for this registration was filed on March 19, 1998, prior to applicant's filing date. After the mark in this prior pending application was cited as a potential bar under Section 2(d) of the Act, applicant's application was suspended pending disposition of the earlier filed application. See TMEP §1208.02(c).

Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.

The Examining Attorney argues that applicant's mark, CARE RX and heart design, is a transposition of registrant's mark, RXCARE. According to the Examining Attorney, both marks create the same basic commercial impression. The Examining Attorney contends that the test for likelihood of confusion is not whether the respective marks can be distinguished in a side-by-side comparison, and that purchasers may retain only a general, rather than a specific, impression of a particular trademark.

Concerning the respective goods, the Examining Attorney argues that applicant's broadly described healthcare management software could include software for pharmaceutical applications similar to registrant's pharmacy management software, and that these goods may therefore travel in the same channels of trade. More particularly, the Examining Attorney argues that registrant's computer software for pharmacy management applications may include software for managing the pharmacy business as well as for the management of customer prescription information, whereas applicant's healthcare management software could include software for the management of pharmacies as well. In other words,

applicant's computer software as identified in the application is broad enough to include registrant's pharmacy management software. While the Examining Attorney appears to concede that prospective purchasers of the software may be relatively sophisticated, the Examining Attorney contends that this fact does not necessarily mean that the purchasers are sophisticated in the field of trademarks or that they would be immune from confusion where similar marks are used on similar products. The Examining Attorney also asks that we resolve any doubt in favor of registrant.

Applicant, on the other hand, maintains that confusion is unlikely. Applicant's counsel states that applicant is in the business of writing and licensing computer programs for use in the medical industry, primarily for pharmacies and large grocery chains. Counsel states that negotiations of these licenses often take months and that it is not possible for a pharmacy to purchase a license, drafted by counsel, as well as a computer program, without knowing that the computer software comes from applicant. Further, counsel indicates that licensing fees to the major chain store pharmacies may range from hundreds of thousands of dollars to millions of dollars.

Although applicant argues that the marks are distinct, applicant places significant emphasis on the assertion that purchasers of the respective software are sophisticated buyers who purchase the software only after careful consideration.³ Applicant also argues that registrant's software is for business management applications whereas applicant's software is sold to pharmacies for disease management as well as prescription management. Finally, citing authority, applicant asks us to resolve doubt in favor of publication.

Upon careful consideration of the arguments and the limited record of this case, we conclude that confusion is likely.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods

³ In its main brief, 11-12, applicant acknowledges only that employees of pharmacies "could potentially become confused," but that those persons are not the potential purchasers of the respective software.

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[or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, the marks are similar in that both consist of the words CARE RX, albeit in a different order. That is to say, applicant's mark is essentially a transposition of registrant's mark, with the addition of the design element. Where the primary difference between marks is the transposition of the elements that make up the marks and where this transposition does not change the overall commercial impression, there may be a likelihood of confusion. See, e.g., *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989)(THE WINE SOCIETY OF AMERICA and design, for wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant, held likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988)(RUST BUSTER, with "RUST" disclaimed, for rust-penetrating spray lubricant held likely to be confused with BUST RUST for penetrating oil); *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982)

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(SPRINT STEEL RADIAL, with "STEEL" and "RADIAL" disclaimed, for tires held likely to be confused with RADIAL SPRINT, with "RADIAL" disclaimed, for tires). See also TMEP §1207.01(b)(vii).

The marks here also have a similar suggestive meaning or connotation: care in the dispensing of prescriptions. The similarities in sound, appearance and meaning or connotation outweigh the relatively minor differences.

With respect to the goods, we agree with the Examining Attorney that applicant's software for healthcare management is broadly described and could include (and in fact does include) software for the management of prescriptions by pharmacies. Registrant's goods are software for pharmacy management. While applicant tries to limit registrant's goods to use only in the administration of a pharmacy business, the identification is not so limited, referring only to "pharmacy management applications." This could well include software for use in the management of prescription information.

The respective software products may also travel in the same or similar channels of trade and be sold to the same class of potential purchasers--pharmacies. Of course, it is not necessary that the respective goods be identical or even competitive in order to support a finding of

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likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source, or that there is an association or connection between the sources of the respective goods. See, for example, *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

While the Examining Attorney has not discussed in detail the question of purchaser sophistication, the Examining Attorney does appear to concede that the purchasers may be relatively sophisticated. The software in the respective identifications is in fact likely to be purchased by pharmacies. However, while counsel argues that licenses to the major chain store pharmacies may cost hundreds of thousands of dollars, not only is this assertion unsupported by any evidence of record, such as an affidavit or declaration from a knowledgeable employee of applicant, but also this high cost is not an inherent or

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necessary element of the respective descriptions of goods. That is to say, computer software for pharmacy management may not intrinsically be as expensive as applicant's counsel claims applicant's particular products are. In any event, we must consider the issue of likelihood of confusion on the basis of the identifications in the application and the cited registration, since it has been repeatedly held that in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). We are not free to limit the scope of those descriptions based on mere argument of counsel.

Furthermore, in likelihood-of-confusion cases, as contrasted with mere descriptiveness or genericness cases, doubts are resolved in favor of the registrant. It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and to the extent that

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we have any doubt as to likelihood of confusion, we must resolve that doubt in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988). The authority applicant has relied upon deals with issues of mere descriptiveness or genericness, where the doubt is resolved in favor of the applicant--that is, in favor of publication. Those cases are therefore distinguishable.

Finally, applicant raises several additional issues which we briefly address. First, applicant argues that it has a right to registration over the cited registrant because applicant commenced use in commerce prior to the first use of the registered mark and because the cited registration had not become incontestable at the time applicant filed its application. Applicant also maintains that the Examining Attorney should have determined who among the pending applications had prior rights, and that a subsequently used mark cannot preclude the registration of an earlier-used mark.

As the Examining Attorney has noted, however, the priority among conflicting pending applications is determined based on the effective filing dates of the

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applications without regard to whether an assertion of use in a later-filed application is earlier than the filing date or the dates of use asserted in the earlier-filed application. See Trademark Rule 2.83(a):

Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the "Official Gazette" for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

And, as stated in TMEP §1208.01:

In ex parte examination, priority among conflicting pending applications is determined based on the effective filing dates of the applications, without regard to whether the dates of use in a later-filed application are earlier than the filing date or dates of use of an earlier-filed application, whether the applicant in a later-filed application owns a registration for a mark that would be considered a bar to registration of the earlier-filed application, or whether an application was filed on the basis of use of the mark in commerce or a bona fide intent to use the mark in commerce.

See also *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) ("Section 2(d) says an applicant can register, unless his mark is likely to cause confusion with a mark 'registered in the Patent Office...'" (emphasis added)). That is, the language of Section 2(d)

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precludes the registration of a mark where a confusingly similar mark is already registered even though the applicant may have prior use. Applicant's remedy in such a situation is to seek cancellation of the cited registration.

Applicant also argues, main brief, 7, 8, that there is a "presumption that an unopposed mark should not be denied registration based on likelihood of confusion in the absence of an opposition to the registration proceeding." This argument is not understood. Applicant's mark herein sought to be registered has not yet been published for opposition purposes and there has, therefore, been no opportunity for an opposition to have been filed by the owner of the cited registration.

Nor can there be any occasion to suspend this appeal and remand the application for the introduction of additional evidence relating to the "highly sophisticated purchasers" of applicant's goods, as requested in applicant's briefs. That evidence should have been filed during the prosecution of this application and before appeal. See Trademark Rule 2.142(d). In any event, a request for suspension and remand should have been by a separate paper filed in this case, and not incorporated into the briefs.

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Decision: The refusal of registration is affirmed.