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**THIS DISPOSITION IS NOT
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OF THE TTAB**

February 17, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Jamil, et al*

Serial No. 76032587

Dr. Basharat A. Jamil, pro se, for Jamil, et al.

Amy L. Alfieri, Trademark Examining Attorney, Law Office 109
(Howell, Managing Attorney).

Before *Seeherman, Quinn and Hohein*, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Basharat A. Jamil, Irfan Jamil, Furhan A. Jamil and
Usman A. Jamil, all of whom are United States citizens and who
will hereinafter be collectively referred to in the singular as
"applicant," have filed an application to register on the
Principal Register the mark "MCHEALTH CLINIC" and design, as
reproduced below,



for "healthcare services, namely, preventative, alternative, and

conventional healthcare."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to the services recited in the application, so resembles the following marks, which are registered by the same registrant for the various services indicated, as to be likely to cause confusion, mistake or deception:²

(i) the mark "RONALD MCDONALD HOUSE," which is registered for a "newsletter dealing with a housing program for families with hospitalized children" and for "providing temporary lodging and emotional support for families with hospitalized children";³

(ii) the mark "RONALD MCDONALD HOUSE" and design, as reproduced below,



¹ Ser. No. 76032587, filed on April 24, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce. The word "CLINIC" is disclaimed and, as further stated in the application:

The mark consists of the wording, "MCHEALTH CLINIC" with a stylized representation of a stethoscope forming the letter M. The letter M and the term CLINIC will appear in red and the lowercase letter "C," the term "HEALTH," and the stethoscope design will appear in blue.

² While the final refusal was also based on Reg. No. 1,794,979, which issued on September 28, 1993 for the mark "MCFIT" for "newsletters related to health and fitness programs," such registration has now expired. Accordingly, no further consideration will be given thereto.

³ Reg. No. 1,201,031, issued on July 13, 1982, which sets forth a date of first use of the mark anywhere and in commerce of, respectively, March 1979 for the goods and October 15, 1974 for the services; renewed. The word "HOUSE" is disclaimed.

which is registered for "providing temporary lodging and emotional support for families with hospitalized children";⁴

(iii) the mark "RONALD MCDONALD HOUSE" and design, as illustrated below,



which is registered for "providing temporary lodging and emotional support for families with hospitalized children";⁵

(iv) the mark "RONALD MCDONALD HOUSE FAMILY ROOM" and design, as depicted below,



which is registered for "providing hospitality rooms within hospitals for families with hospitalized children";⁶ and

(v) the mark "RONALD MCDONALD HOUSE FAMILY ROOM," which is registered for "providing hospitality rooms within

⁴ Reg. No. 1,337,332, issued on May 21, 1985, which sets forth a date of first use of the mark anywhere of January 1981 and a date of first use of the mark in commerce of February 1981; combined affidavit §§8 and 15. The word "HOUSE" is disclaimed.

⁵ Reg. No. 1,927,933, issued on October 17, 1995, which sets forth a date of first of the mark anywhere and in commerce of February 1994; combined affidavit §§8 and 15. The word "HOUSE" is disclaimed.

⁶ Reg. No. 2,381,540, issued on August 29, 2000, which sets forth a date of first of the mark anywhere and in commerce of March 11, 1992. The word "HOUSE" is disclaimed.

hospitals for families with hospitalized children."⁷

Applicant has appealed. Briefs have been filed, but an oral hearing was not held. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.⁸

Turning first to the similarity or dissimilarity in the goods and services at issue, Examining Attorney properly notes in her brief that it is well established that an applicant's services and those goods and/or services of the registrant need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the respective goods and/or services are related in some manner and/or that the circumstances surrounding their

⁷ Reg. No. 2,377,753, issued on October 26, 1999, which sets forth a date of first of the mark anywhere and in commerce of March 11, 1992. The word "HOUSE" is disclaimed.

⁸ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."

marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). The Examining Attorney, while making no mention of registrant's newsletter, maintains in view of the above that "applicant provides services that are related to the registrant's provision of healthcare services" because registrant "has created a physical presence within hospitals by providing hospitality rooms" and has furnished "assistance to the families of hospitalized children by providing temporary lodging and emotional support." Registrant's services, the Examining Attorney insists, are "sufficiently related to the health care field so that confusion between the applicant's mark and the registered marks would be likely."

Applicant, on the other hand, contends that healthcare consumers would not regard the provision by applicant of the services of "preventative, alternative, and conventional healthcare" as being commercially or otherwise "sufficiently related to" the provision by registrant of either such services as "temporary lodging and emotional support for families with hospitalized children" or "hospitality rooms within hospitals for families with hospitalized children." In particular, applicant argues in its reply brief that because "the scope of the

registered marks is 'housing' and '[hospitality rooms]'" while "the scope of the Applicants [sic] mark ... is medical care [offered] through health clinics, ... they are diametrically opposite" services which the general public is simply not likely, at least on this limited record, to consider as being related.

It is nonetheless obvious that, as identified, each of the respective services is directed in a broad sense to some aspect of the field of healthcare, with applicant providing "preventative, alternative, and conventional healthcare" through venues that could include medical clinics or even hospitals and registrant providing, for families of hospitalized children, temporary lodging and emotional support as well as hospitality rooms within hospitals. More importantly, however, the respective services would appear on their face to be complementary in that the families of children in need of clinical or hospital care not infrequently require temporary lodging and emotional support, as well as hospitality rooms within a hospital, in order to be able to stay with their children during the provision of medical treatment. Furthermore, such families would consequently find a newsletter dealing with a housing program for families with hospitalized children to be of interest concerning details of and developments in temporary lodging which is conveniently located to a hospital or medical clinic needed by their children. Accordingly, we agree with the Examining Attorney that the healthcare services which applicant intends to provide through its medical clinic or could provide in a hospital are "sufficiently related to" registrant's newsletter

dealing with a housing program for families with hospitalized children and its services of providing temporary lodging and emotional support, as well as in-hospital hospitality rooms, for families of child patients that, if offered under the same or substantially similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Turning, then, to consideration of the marks at issue herein, the Examining Attorney asserts in her brief that:

The applicant's mark is ... likely to be confused with the [registrant's] marks[,] ... all of which contain the wording, RONALD MCDONALD. The owner of these marks, McDonald's Corporation, has established a famous family of marks containing the prefix "MC." The Trademark Trial and Appeal Board has recognized the fame of these marks as well as the establishment of a family of marks by McDonald's Corporation. In the case of *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995), the ... Board held that the applicant's MCCLAIM mark for "legal services" so resembled the McDonald's family of marks that confusion was likely, as many of the latter marks combine the distinctive MC prefix with suggestive or descriptive terms, and the term CLAIM is descriptive or suggestive when used in connection with legal services. Additionally, in the case of *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989), the ... Board held that the applicant's MCTEDDY mark, when used in connection with teddy bears, was likely to cause confusion as to source in light of the well-known MC and MAC family of marks owned by McDonald's Corporation.

As evidenced by the decisions of the ... Board, the McDonald's Corporation is widely known by consumers for its use of the prefix "MC" in conjunction with a wide variety of goods and services. Thus, the examining attorney maintains that consumers are likely to believe that MCHEALTH CLINIC is associated with the cited marks containing the wording ... RONALD MCDONALD HOUSE, and originates

from the same source, namely, McDonald's Corporation.

Applicant, observing in its initial brief that the "driving force and controlling factor" behind the refusal to register "seem to be the 'fame'" of the cited marks "and the size of" the registrant, insists that "[t]he fame and the size of a corporation should have no role in the USPTO decision" concerning whether confusion is likely. However, as set forth in *du Pont, supra*, "[t]he fame of the prior mark (sales, advertising, length of use)" is a factor to be considered "[i]n testing for likelihood of confusion ... when [evidence thereof is] of record." In particular, the Examining Attorney correctly points out in her brief that:

Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than [sic] a weaker mark. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1987 [sic] (Fed. Cir. 2000) (Trademark Trial and Appeal Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods [or services]." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1898.

Nevertheless, the rights conferred by a famous mark, in legal contemplation, are not the same as a right in gross, which would preclude the registration to another of the same or similar mark(s) for any goods and services. For instance, even though famous marks, as noted above, are entitled to a wide latitude of

legal protection, our principal reviewing court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), underscored in its reversal of the Board's finding of a likelihood of confusion that "the Board gave too much weight to certain *DuPont* factors, such as the strength of opposer's mark, and failed to give due weight to countervailing *DuPont* factors, such as the sophistication of purchasers." As set forth in *du Pont*, supra, "[t]he evidentiary elements are not listed ... in order of merit" inasmuch as "[e]ach may from case to case play a dominant role."

In this case, however, there simply is no evidence which is properly of record which currently establishes the fame of any marks owned by registrant, including an asserted family of "MC"-prefixed marks, much less any evidence showing that marks which include the name "RONALD MCDONALD" or the phrase "RONALD MCDONALD HOUSE" presently are famous. The Examining Attorney's reliance on certain factual finding by the Board in *McDonald's Corp. v. McClain*, supra, and *McDonald's Corp. v. McKinley*, supra, to support her contention regarding the existence at the present time of a "famous family of marks containing the prefix 'MC'" is misplaced for several reasons. Not only are such cases, which were respectively decided on May 23, 1995 and September 25, 1989, now over nine and 14 years old, but even if they issued on the same date as this opinion, the findings of fact and conclusions of law stated therein do not constitute evidence which is binding on either applicant or the Board in *this* proceeding. See, e.g., *Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530

F.2d 1400, 189 USPQ 141, 142-43 (CCPA 1976) [because ultimate conclusion regarding likelihood of confusion is necessarily drawn from all probative facts in evidence in each individual case, such conclusion, as distinguished from general rules of law or interpretation, cannot be controlled by earlier conclusions reached in another case]; and National Dairy Products Corp. v. Parman-Kendall Corp., 122 USPQ 332, 333 (TTAB 1959) ["facts found by a court and the conclusions drawn therefrom in a case involving another party are not binding on this applicant or controlling on this tribunal"].⁹

Because there is no proof that the cited marks are part of a famous family of registrant's marks, we must decide the issue of likelihood of confusion on the basis of each of the cited marks individually. When such marks and applicant's mark are considered in their entirety, we find that applicant's "MCHEALTH CLINIC" and design mark is substantially different in sound, appearance, connotation and commercial impression from registrant's "RONALD MCDONALD HOUSE" and "RONALD MCDONALD HOUSE

⁹ This is not to say, of course, that the Board is totally unaware of registrant and its fast-food products and restaurant services. Rather, like applicant, this panel is certainly familiar with such. Applicant, we note, has essentially admitted that registrant is very well known if not famous for its fast-food operations inasmuch as applicant, in its reply brief, makes the statement that "McDonald's Corporation should rest assured that nobody will show up in a McHealth Clinic to buy a bigmac and[,] vice versa, nobody will go to McDonald's Restaurant to have a blood test!" In the context of this appeal, however, one of the issues before us is whether there is evidence which proves that marks which contain the "MC"-prefix, or which consist of or include the name "RONALD MCDONALD" or the phrase "RONALD MCDONALD HOUSE," form a famous family of marks for such services as providing temporary lodging and emotional support, as well as hospitality rooms within hospitals, for families with hospitalized children and such ancillary goods as newsletters dealing with a housing program for families with hospitalized children.

FAMILY ROOM" marks. Applicant, in this regard, reiterates in its reply brief the argument which it made in its initial brief, emphasizing in particular that:¹⁰

A comparison of the designs of [registrant's] ... marks with the Applicants [sic] mark indicates that there is no similarity between the designs due to the fact that the heart-shaped stethoscope M in the design of the Applicants [sic] mark is clearly distinct from the M used in the registered designs. The color scheme of the Applicant['s] design, [with] M and Clinic [in] red and rest [in] blue on white base (red, white and blue), will most likely leave the impression and image of M-Clinic in the eyes of the viewers, thus leaving no confusion between the sound, connotation and commercial impression of the Applicants [sic] design and the registered designs.

On the other hand, the Examining Attorney in her brief "maintains that it is the prefix, "MC," not the design element, which will be remembered most by consumers," noting that:

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is controlling in determining likelihood of confusion. In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB

¹⁰ Applicant also repeats in its reply brief a contention which it raised throughout the prosecution of its application. Specifically, referring to an article which reports that, on or about November 27, 2001, "Judge David Neuberger" of "London's High Court ... ruled that a Chinese restaurant owner can use the name McChina for his chain of fast-food outlets despite protests from hamburger giant McDonald's," applicant urges that, in light of such ruling, it is clearly entitled to a finding of no likelihood of confusion because not only is its mark different from registrant's marks, but its services are even more different from registrant's goods and services than the fast-food restaurant services at issue in the English court's ruling. The fact that the Examining Attorney, as applicant further points out, "has failed to address or refute the latest Court decision by Judge Neuberger" is of no moment, however, inasmuch as such a decision from a foreign court, interpreting a different statutory framework, is irrelevant in this appeal.

1999); In re Appetito Provisions Co. [Inc.],
3 USPQ2d 1553 (TTAB 1987); Amoco Oil Co. v.
Amerco, Inc., 192 USPQ 729 (TTAB 1976); TMEP
§1207.01(c) (ii).

It is plain, however, that the word portions of the respective marks are comprised of, and distinguished by, more than just the prefix "MC." Clearly, in terms of overall sound, appearance, connotation and commercial impression, the word portion of applicant's "MCHEALTH CLINIC" and design mark is substantially different from the word portions of registrant's "RONALD MCDONALD HOUSE" marks and its "RONALD MCDONALD HOUSE FAMILY ROOM" marks. Even allowing for the descriptiveness, as evidenced by the disclaimers thereof, of the words "CLINIC" and "HOUSE," it obviously remains the case that the suggestive term "MCHEALTH" in applicant's mark bears essentially no resemblance to the name "RONALD MCDONALD" in registrant's marks.¹¹ We therefore agree with applicant that, on this record, contemporaneous use of the marks at issue is not likely to cause confusion as to source or sponsorship, notwithstanding the complementary nature of the respective goods and services.¹²

Decision: The refusal under Section 2(d) is reversed.

¹¹ It is pointed out that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, our principal reviewing court has indicated that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

¹² We hasten to add, however, that a different result might pertain in a proceeding (such as an opposition) in which evidence that registrant possesses a famous family of "MC"-prefixed marks is made of record.