

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 7, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paradigm Health Corporation

Serial No. 74/654,345

Mary Cabanski-Evers of Wilson Sonsini Goodrich & Rosati for
Paradigm Health Corporation

Hannah M. Fisher, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney)

Before Hohein, Bottorff and Rogers, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration of the mark PARADIGM for
services recited in the application as "managed health care
services."¹

The Trademark Examining Attorney has refused
registration under Trademark Act Section 2(d), 15 U.S.C.

¹ Serial No. 74/654,345, filed March 31, 1995. The application
is based on use in commerce under Trademark Act Section 1(a), 15
U.S.C. §1051(a), with June 1, 1991 alleged as the date of first

§1052(d), citing Registration No. 1,985,915, which is for the mark PARADIGM for goods identified as "computer software in the fields of employee benefit consulting and health insurance services," as a bar to registration of applicant's mark.

When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have filed main briefs, and applicant has filed a reply brief. No oral hearing was requested. We reverse the refusal to register.

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 likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Upon careful consideration of the evidence of record pertaining to these factors, we find as follows.

Applicant's mark is identical to the cited registered mark, i.e., PARADIGM, a factor which weighs in favor of a finding of likelihood of confusion. Moreover, we reject applicant's contention that PARADIGM is a weak mark or that the registered mark should be accorded only a limited scope

use of the mark anywhere and July 1, 1991 alleged as the date of first use of the mark in commerce.

of protection. Applicant has not shown that PARADIGM is inherently weak as applied to registrant's goods, nor has applicant presented any probative evidence regarding the number and nature of similar marks in use on similar goods. Although we have considered the third-party registrations and applications submitted by applicant for marks which include the word PARADIGM,² it is well-settled that such registrations and applications are not probative evidence that the marks depicted therein are actually in use in commerce or familiar to purchasers. See, e.g., *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976).³

We also find that applicant's and registrant's respective services and goods are marketed to some of the same prospective purchasers, i.e., corporate and other

² Although evidence of third-party marks normally may not be introduced in the form of commercial search reports, we have considered such evidence in this case, for whatever probative value it may have. This is because the Trademark Examining Attorney, in her final refusal, did not object to applicant's search report evidence on the ground of its improper form but instead presented substantive arguments with respect to that evidence. See, e.g., *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

³ Additionally, we note that the third-party registrations and applications submitted by applicant are not particularly probative evidence under the sixth *du Pont* evidentiary factor, i.e., "the number and nature of similar marks in use on similar goods," because they do not cover goods or services which are similar to the goods and services involved in this case.

employers, including self-insured employers, which provide health insurance benefits to their employees. Applicant's assertion in its brief that it does not market its services directly to such employers, but only to large insurers, is belied by evidence of record.⁴ Moreover, even if that assertion is accurate, it is legally irrelevant in this case. Applicant's recitation of services is not limited in any way with respect to trade channels or classes of purchasers, and we accordingly must presume that applicant markets its services in all normal trade channels for, and to all normal classes of purchasers of, such services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The evidence of record shows that such corporate and other employers are among the normal classes of purchasers for "managed health care services."⁵

⁴ It appears from the printouts from applicant's web site, submitted by applicant, that "...Paradigm is dedicated to lowering the costs and improving outcomes for catastrophic and large loss medical injuries on behalf of workers' compensation insurers, state funds, self-funded employers and other managed care organizations." (Emphasis added.)

⁵See, e.g., the NEXIS® excerpts made of record by the Trademark Examining Attorney, which include the following: "[Community Care Network] offers a full line of employee benefits, specializing in serving businesses with two to 150 employees. Some of its products are managed health care plans..." (The Business Journal (Phoenix), June 18, 1993); "[t]he actual purchasers of managed health care plans are corporations that provide most Americans with health insurance as an employment benefit." (Harvard Mental Health Letter, February 1995.)

We turn next to a consideration of whether there is a commercial relationship between the services recited in applicant's application, i.e., "managed health care services,"⁶ and the goods identified in the cited registration, i.e., "computer software in the fields of employee benefit consulting and health insurance services." As has often been stated, it is not necessary that the parties' respective goods and services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services 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 producer or that there is an association or connection between the producers of the respective goods and services. See *In re*

⁶ Applicant, throughout its argument, has relied on the asserted fact that its actual services are a specialized type of managed health care, i.e., covering only catastrophic or chronic injuries or illnesses. However, that alleged limitation is not reflected in applicant's recitation of services. Accordingly, any asserted limitations in the scope of applicant's actual services are legally irrelevant in this case, and we must presume that applicant's services include all services which would normally be encompassed within the words "managed health care services." See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Melville Corp., 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, because applicant's mark is identical to the registered mark, there need be only a viable relationship between applicant's services and registrant's goods in order to warrant a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

We find that the requisite viable commercial relationship between applicant's services and registrant's goods has not been established by the evidence of record in this case. There simply is no evidentiary basis in this record upon which we might conclude that the relevant purchasers would be likely to assume or expect that "computer software in the fields of employee benefit consulting and health insurance services" and "managed health care services" might originate from a single source, or from sources which are otherwise affiliated or connected. There has been no showing that applicant, or any other provider of managed health care services, also sells or distributes software such as registrant's, either separately or for use in conjunction with its services. Nor is there any evidence that providers of registrant's

type of software typically also are engaged in the rendering of managed health care services. In the absence of any such evidence, we cannot find that purchasers would be likely to assume a source connection between the respective goods and services. *Distinguish, e.g., Hilson Research v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). Likewise, in the absence of such evidence, the mere fact that both registrant's goods and applicant's services generally involve health care or health insurance is not a sufficient basis for finding that they are commercially related, i.e., that purchasers would assume the existence of a source, sponsorship, affiliation or other connection.

We are not persuaded by the Trademark Examining Attorney's arguments on this issue, i.e., that purchasers are "likely to think that registrant's software is endorsing or promoting applicant's managed health care," or that purchasers are "likely to regard registrant's software as an introduction to the subject of employee benefits, particularly in the health field, and applicant's services as a refinement of these alternatives, how to provide high quality care at the lowest price." (Trademark Examining Attorney's Brief at 3.) Those arguments have no basis in

the evidentiary record, but rather appear to be based wholly on speculation and conjecture.

In summary, after careful consideration of the evidence of record, we find that several of the relevant likelihood of confusion factors weigh in favor of a finding of likelihood of confusion in this case, i.e., the identity of the marks, the overlap in purchasers of the respective goods and services, and the absence of any evidence of use of similar marks on similar goods or services. However, we find that those factors are outweighed by the absence of any demonstrated commercial relationship between applicant's services and registrant's goods.⁷ See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Given the essential dissimilarity of applicant's services and registrant's goods in terms of their natures and functions, and the absence of any evidence that these types of goods and services ever share any type of source, sponsorship or other affiliation, we

⁷ Our decision herein is not based on any finding that the actual purchasers of the respective goods and services, i.e., the managers and/or administrators of the Human Resources departments of companies which provide benefits to their employees, are necessarily sophisticated purchasers. Applicant has presented no evidence in support of its claim that such purchaser sophistication exists. Moreover, in a case wherein there was a rather extensive record on this issue, the Board nevertheless found that human resources officials were not necessarily sophisticated or knowledgeable with respect to trademarks. See *Hilson Research, supra*, 27 USPQ2d at 1433-34.

Ser. No. 74/654,345

conclude that confusion is unlikely to result from
applicant's and registrant's contemporaneous use of

Ser. No. 74/654,345

the mark PARADIGM on or in connection with their respective goods and services.

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

G. D. Hohein

C. M. Bottorff

G. F. Rogers

Administrative Trademark Judges
Trademark Trial and Appeal Board