

9/17/01

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Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Professional Systems Corporation

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Serial No. 75/461,790  
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Timothy D. Pescenye and Christopher M. Turk of Blank Rome  
Comisky & McCauley LLP for Professional Systems Corporation.

Michael W. Baird, Trademark Examining Attorney, Law Office 109  
(Ronald R. Sussman, Managing Attorney).

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Before Cissel, Quinn and Hohein, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Professional Systems Corporation has filed an  
application to register the mark "DATAEXPRESS" for "invoicing  
services, namely, collecting and assembling billing  
information, [and] generating and mailing statements,  
invoices, reports and collection letters."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/461,790, filed on April 3, 1998, which alleges a date  
of first use anywhere and in commerce of October 1997.

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 its services, so resembles the mark "NDEX NETWORK DATA EXPRESS," which is registered for "electronic transmission of messages, data and documents in the field of healthcare",<sup>2</sup> as to be likely to cause confusion, mistake or deception.

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

The 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 of the goods and/or services and the similarity or dissimilarity of the marks.<sup>3</sup>

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<sup>2</sup> Reg. No. 2,005,132, issued on October 1, 1996, which sets forth a date of first use anywhere of January 27, 1995 and a date of first use in commerce of April 19, 1995. The words "NETWORK DATA" are disclaimed.

<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of

Turning first to consideration of the respective services, it is well settled that services 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 services are related in some manner and/or that the circumstances surrounding their 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 entity 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).

In the present case, applicant contends that "registrant's communication services are quite different than the ... invoicing services which are provided by applicant under its mark." According to applicant, its services "are in the nature of traditional bookkeeping, but using computer technology to efficiently provide such services." While admitting in its brief that "electronic communication of data is used by applicant for connecting applicant's customers to applicant's computers in order to render applicant's invoicing

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differences in the essential characteristics of the goods [and/or

services," applicant argues that "this communication of data is ancillary to applicant's invoicing services and is not a separate service." Consequently, applicant insists that its services "are not directed to addressing the existing electronic network data communication of a customer's data to patients or their healthcare providers." Instead, applicant maintains that, among other things, its services "are specifically to assist the accounting department[s] of healthcare providers to perform their invoicing function" and, thus, it "does not provide services for addressing the general communication of network data" like registrant does. Applicant, in view thereof, urges that its services "are different in kind and would be purchased by different parties than registrant's" services.

Applicant supports its position with a declaration which is of record from its chief executive officer, Joseph J. Greco. In his declaration, Mr. Greco variously states that he has 20 years of "experience within the invoicing processing industry"; that applicant "operates state of the art systems for statement and collection letter processing, printing and mailing"; that under its "DATAEXPRESS" mark, applicant offers "traditional bookkeeping services, but uses computer technology to provide the services," which consist of "state  

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services] and differences in the marks."

of the art automated processing, printing and mailing of invoices and collection letters"; that such services "assist the accounting departments in various industries, including healthcare providers, to perform their invoicing functions"; that such services, however, "are not useful only in the healthcare field, but also have utility in other fields which seek to out[-]source statement and collection letter processing, printing and mailing"; that registrant's services, by contrast, "are directed to the electronic transmission of messages, data, and documents in the healthcare field" and are thus "quite different from the invoicing services which are provided by" applicant under its mark; that applicant "does not provide services for addressing the general communication of network data"; that while applicant "can receive data electronically from its customers, this communication of data is ancillary to" applicant's "invoicing services and is not a separate service"; and that applicant "has processed, printed and mailed invoices and collection letters based on information received from customers other than through electronic data transmission, e.g., printed information or data on computer disks sent by mail or courier service."

We agree with the Examining Attorney that, as he concedes in his brief, the respective services "are specifically different." We also concur with the Examining

Attorney that such specifically different services are, however, related in a meaningful commercial sense at least to the limited extent that registrant's "electronic transmission of messages, data and documents in the field of healthcare" are services which, as the Examining Attorney points out, "could be used to transmit data and documents" to applicant for use, in turn, in the rendering, to those in the healthcare field, of its "invoicing services, namely, collecting and assembling billing information, [and] generating and mailing statements, invoices, reports and collection letters."<sup>4</sup> As the Examining Attorney accurately observes:

[The] advertising specimens submitted by Applicant tout the ease of electronically transmitting files to Applicant. For example, the cover of Applicant's brochure indicates that Applicant's services consist of "Electronic Data Exchange for Patient Statement and Collection Letter Processing, Printing and Mailing." Inside the brochure, a potential customer is told, "It's easy! Your computer system's patient billing files can be electronically transmitted, 24 hours a day, seven days a

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<sup>4</sup> We disagree, however, with the Examining Attorney's further assertion that the respective services "are directly competitive, at least in part," because, just as "[a] medical practice has the option of using Applicant's services to mail statements, invoices, reports, and collection letters," it is also the case that, "alternatively, the registrant's services may be used to deliver such documents electronically." It appears to us, instead, that a medical firm which utilizes applicant's invoicing services to generate and mail billing statements, collection letters and the like would have no need to use registrant's electronic information transmission services to deliver the same documents produced as part of applicant's services.

week, via internet, modem or other electronic medium to the DataExpress Processing Center."

Thus, both services, as the Examining Attorney persuasively notes, "target the same small group of consumers, [namely,] those members of a medical practice who are responsible for the electronic transmission of documents" for purposes of patient billing or invoicing. If such services, therefore, were to be provided under the same or substantially similar marks, confusion as to the source of sponsorship thereof would be likely to occur.

Turning, therefore, to consideration of the marks at issue, applicant notes, with respect to registrant's "NDEX NETWORK DATA EXPRESS" mark for "electronic transmission of messages, data and documents in the field of healthcare," that "there are a number of marks which include DATA or DATA EXPRESS for the same or virtually identical services." Specifically, the record contains copies of subsisting third-party registrations for the marks "IDX PARTNERSHIP INTERNATIONAL DATA EXPRESS" and design ("DATA EXPRESS" disclaimed) for "telecommunications and data storage and forward services, namely, sending and receiving facsimile, electronic mail, voice, audio, video, data, and interactive voice response (IVR) transmissions for others"; "DATA EXPRESS" and design ("DATA" disclaimed) for "electronic transmission of

digital information from one location to another"; and "AIR DATA EXPRESS" ("DATA EXPRESS" disclaimed) for "electronic and wireless transmission of messages, data and documents."<sup>5</sup>

Applicant maintains that the existence of such registrations "demonstrates that the terms DATA and EXPRESS, the only common portion of the marks, are relatively weak in the field of data/information exchange or transmission," citing *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988). Applicant also contends that "[t]he further weakness of the mark[s] is illustrated by the disclaimer of the DATA or DATA EXPRESS elements in the above registrations and the disclaimer of NETWORK DATA in the [cited] registration." In view of the weakness of the term "DATA EXPRESS," due to the descriptiveness, or at least a high degree of suggestiveness, inherent therein, applicant asserts that the mark which is the subject of the cited registration is entitled to only a narrow scope of protection and that it is not likely that customers for the specifically different services offered by applicant and the cited registrant will be confused as to the source or sponsorship of such services.

Applicant also argues that "[a]n analysis of the marks [at issue] in their entirety reflect[s] that they

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<sup>5</sup> In addition, the record contains a copy of a subsisting third-party registration for the mark "CCMM DATA EXPRESS" ("DATA" disclaimed) for "data communications processing apparatus for use with computers."

create entirely different commercial impressions" inasmuch as the predominant features of the cited registrant's mark are the terms "NDEX and "NETWORK." The overall commercial impression of such mark, applicant urges, "stresses the networking and data transmission aspect of the [cited registrant's] services" since "[t]he eye is naturally drawn to the first portion of the mark." Moreover, according to applicant, the shared words "DATA EXPRESS" in the marks at issue are, as noted above, "relatively weak" and thus "have a lesser significance as a source identifier," especially "when applied to services relating to the transmission of data," as is the case with the cited registrant's mark.

As to another of the *du Pont* factors, namely, the conditions under which and buyers to whom sales are made, applicant observes that "[w]here the decision to purchase is made by a sophisticated purchaser and concerns an expensive product, or is made after careful examination of the product, it may be enough to negate a likelihood of confusion." Here, applicant asserts, its services "are relatively expensive and involve giving a third party access to sensitive billing, customer and financial information." Inasmuch as "an organization that decides to use that service will only make the purchasing decision after careful consideration," applicant concludes that confusion as to origin or affiliation

of the respective services is not likely from the contemporaneous use of the marks at issue.

The Examining Attorney, on the other hand, acknowledges that applicant is correct in its contention that third-party registrations are useful both to demonstrate the sense in which a term is used in ordinary parlance and to show that a particular term has been adopted by those engaged in a certain field or industry because of the descriptive or suggestive significance conveyed by such term. The Examining Attorney, furthermore, admits that in this case "[t]he registrations referenced by Applicant appear to support Applicant's contention that the wording DATA EXPRESS is weak with regard to electronic message transmission services." However, the Examining Attorney asserts that the fact that "the term DATA EXPRESS may be relatively weak in the field of electronic transmission of data does not mean that the term is also weak in Applicant's related field of 'invoicing services, namely, collecting and assembling billing information, generating mailing statements, invoices, reports, and collection letters.'"

While the Examining Attorney thus concludes that "the relative weakness of the registrant's mark [does not] completely obviate any likelihood of confusion," it nevertheless stands to reason that, if differences in the

other portions of marks containing the term "DATA EXPRESS" are sufficient to distinguish such marks, due to the admitted weakness of the term "DATA EXPRESS," with respect to various electronic message transmission services," then the narrow scope of protection to which registrant's mark is entitled in its own field should be even more limited when considered against a mark sharing only the term "DATA EXPRESS" in an entirely different industry, to which electronic message transmission services are only ancillary to the services being rendered. Such is plainly the case with applicant's "DATAEXPRESS" mark for its various invoicing services, since while its services and the electronic messaging and data transmission services offered by the cited registrant are commercially related to a limited degree in that both involve transmission of documents and data, they nevertheless are otherwise specifically different. Applicant's services focus on invoicing and other matters of patient billing, while those of the cited registrant are basically that of a communications common carrier for the healthcare field. As a result, circumstances conducive to a likelihood of confusion are substantially reduced.

With respect to the overall commercial impressions engendered by the respective marks, the Examining Attorney emphasizes that such marks "are clearly similar, as the

registered mark contains Applicant's mark in its entirety." The Examining Attorney also contends that this is not a situation "where the appropriated wording is merely an insignificant part of a larger whole; instead, the term DATA EXPRESS comprises exactly half of the registrant's four-word mark." While the Examining Attorney concedes that "[a]pplicant's mark and, by incorporation, the registrant's mark[,] are both highly suggestive of information and speed," he asserts that the points of similarity of the marks are of greater importance than the points of difference due, apparently, to the fact that applicant's mark and registrant's mark "contain the wording DATA EXPRESS and are likely to have the same commercial impression." In view thereof, the Examining Attorney argues that "[c]onsumers are likely to arrive at the incorrect conclusion that applicant's DATA EXPRESS [sic, should be DATAEXPRESS] mark is merely a shortened form of the registrant's NDEX NETWORK DATA EXPRESS [mark]."

We agree with applicant, however, that the respective marks, when considered in their entirety, project different commercial impressions and hence are distinguishable, especially when used in connection with specifically different services. As the Examining Attorney concedes, the "DATA EXPRESS" portion of registrant's mark and

applicant's "DATAEXPRESS" mark "are both highly suggestive of information and speed." Such terms, therefore, are not only relatively weak, and in themselves are entitled only to a limited scope of protection, but registrant's mark adds the conspicuously different terms "NDEX NETWORK" as the first and most prominent elements of such mark. Thus, when used in the context of registrant's "electronic transmission of messages, data and documents in the field of healthcare," the connotation and overall commercial impression engendered by registrant's "NDEX NETWORK DATA EXPRESS" mark is of a high speed data network offered under the principal source-indicative term "NDEX." In striking contrast, applicant's "DATAEXPRESS" mark for its "invoicing services, namely, collecting and assembling billing information, [and] generating and mailing statements, invoices, reports and collection letters," projects an image of high speed conversion of billing information into invoices and similar kinds of statements. Moreover, because the terms "NDEX NETWORK" constitute the first two words of registrant's "NDEX NETWORK DATA EXPRESS" mark, they lend such mark a significantly different overall commercial impression than would be the case if the mark were, for example, "DATA EXPRESS NDEX NETWORK." The notable inclusion of the terms "NDEX NETWORK" as the first two elements of registrant's mark,

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together with the high degree of suggestiveness inherent in the terms "DATA EXPRESS" and the equivalent term "DATAEXPRESS," are accordingly sufficient to distinguish registrant's "NDEX NETWORK DATA EXPRESS" mark from applicant's "DATAEXPRESS" mark.

Finally, we concur with applicant that the nature of the conditions under which and buyers to whom sales of the respective services are made are such that, as a practical matter, confusion is not likely to occur from contemporaneous use of the marks at issue. In the case of registrant's "electronic transmission of messages, data and documents in the field of healthcare," it is clear that physicians, pharmacists, nurses and other healthcare professionals and their support staffs are, by the very nature of operating a medical practice, highly knowledgeable and sophisticated customers in general and would be expected to exercise a high degree of care and discrimination in the selection of goods and services used in connection therewith. See, e.g., Warner-Hudnut, Inc. v. Wander Co., 280 F.2d 435, 126 USPQ 411, 412 (CCPA 1960) [physicians and pharmacists constitute "a highly intelligent and discriminating public"]. To the extent that applicant's "invoicing services, namely, collecting and assembling billing information, [and] generating and mailing statements, invoices, reports and collection letters," are

directed to the same classes of healthcare providers, such services would likewise be purchased with care and deliberation, principally by those in charge of the accounting departments of the healthcare providers. Coupled with the fact that applicant's services would be relatively expensive and involve accessing sensitive billing, customer and financial information, the selection thereof would be made only after careful consideration and deliberation, thereby additionally lessening the prospects of a likelihood of confusion. See, e.g., *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

Accordingly, notwithstanding that to a limited extent, the respective services are related, given the facts that such services nevertheless are specifically different; that in their entirety the marks at issue are distinguishable in connotation and overall commercial impression; and that the purchase of such services under the respective marks is done carefully and with deliberation, we find that confusion is not likely to result from the contemporaneous use by applicant of the mark "DATAEXPRESS" for its "invoicing services, namely, collecting and assembling billing information, [and] generating and mailing statements, invoices, reports and collection letters" and the mark "NDEX

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NETWORK DATA EXPRESS" by registrant for its "electronic transmission of messages, data and documents in the field of healthcare."

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