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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Scripps Health

Serial No. 76077292

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Before Hohein, Walters, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Scripps Health, a California corporation, has filed an application to register the mark shown below for the following services:

> Educational services, namely, conducting seminars, conferences and workshops in the field of health care, in Class 41; and,
>
> Health care services, in Class 42.[1]

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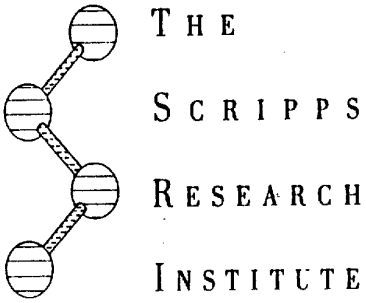
[1] Application Serial No. 76077292 filed on June 26, 2000. Applicant claims first use anywhere as of March 16, 1998, and first use in commerce as of April 1, 1998, and describes its mark as follows: "The mark consists of the word 'SCRIPPS' next to three stylized people forming a circle."

Registration has been refused under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney contends that applicant's mark, when applied to applicant's services, so closely resembles the two registered marks set forth below (both of which are owned by The Scripps Research Institute) as to be likely to cause confusion:

1. Registration No. 2099045 for the mark shown below for "scientific and medical research services";[2] and,



[2] Registration No. 2099045, issued on September 23, 1997. The exclusive right to use "Research Institute" is disclaimed.

2. Registration No. 1546838 for the mark SCRIPPS IMMUNOLOGY REFERENCE LABORATORY for "medical laboratory and research services."[3]

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.

We affirm.

Applicant has argued that there is no likelihood of confusion for the following reasons:

1. When considered in their entireties, the marks as a whole are dissimilar. The addition of the descriptive words ("Research Institute" and "Immunology Reference Laboratory") provides "valuable information to the consumer about the nature of the parties' respective services" and features that distinguish the marks. In addition, because "Scripps" is a surname, it is weak mark that is not entitled to a broad scope of protection;
2. The services are not similar. The Examining Attorney's "sweeping" conclusion that the services of the applicant and the registrant are related is incorrect because "the health care

[3] Registration No. 1546838 issued on July 4, 1989 under the provisions of Section 2(f) of the Lanham Act. The exclusive right to use "Immunology Reference Laboratory" is disclaimed.

field is vast and varied, and includes countless niche fields that have very little in common with one another." (Applicant's Brief, p. 5);

3. Because the services of the registrant and the applicant are targeted to different end-users, the same consumers will not encounter the marks of the registrant and the applicant. Therefore, the services of the registrant and the applicant move in different channels of trade; and,

4. Despite over 13 years of simultaneous use, applicant is not aware of any reported instances of actual confusion.

In support of its arguments, applicant submitted the following evidence:

1. Excerpts from its website, including a "Scripps History" which provides information regarding numerous related entities and affiliates that incorporate the "Scripps" name in their trademarks and trade names. The "About Scripps" section provides the following information:

> Affiliated with the health care delivery network are The Scripps Research Institute (TSRI) and the Scripps Foundation for Medicine and Science (SFMS). TSRI is one of the country's largest private not-for-profit research

organizations, recognized internationally for its basic biomedical research.

2. Excerpts from registrant's website corroborating (a) that registrant was one of the entities derived from the Scripps Metabolic Clinic founded in 1924 by Emily Browning Scripps, and (b) that registrant is recognized for its research in immunology, molecular and cellular biology, neurosciences, and other specialized medical fields; and,

3. In response to the first Trademark Office Action, applicant claimed ownership of Registration No. 1545762 for the mark RESEARCH INSTITUTE OF SCRIPPS CLINIC for "scientific and medical research services."[4]

In support of her arguments that the applicant's mark so closely resembles registrant's marks as to be likely to cause confusion, the Examining Attorney submitted fourteen use-based trademark registrations for both health care services and medical research services and nine use-based

[4] Registration No. 1545762 was registered to Scripps Clinic and Research Foundation and assigned to applicant. The assignment was recorded on November 6, 1995 at reel 1406, frame 0846. The Scripps Clinic and Research Foundation also assigned one of the cited registrations (Registration No. 1546838 for the SCRIPPS IMMUNOLOGY REFERENCE LABORATORY) to registrant. That assignment was recorded on November 6, 1995 at reel 1406, frame 0851.

trademark registrations for both medical research services and educational services in the field of healthcare.

Our determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In the case *sub judice,* the record consists of the application, the cited registrations, the excerpts from the websites of applicant and registrant, and the third-party registrations.

A. <u>The marks of applicant and registrant are similar</u>.

The similarity or dissimilarity of the marks are analyzed in their entireties as to appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co., supra.* While marks must be compared in their entireties, it is not improper to accord more or less weight to a particular feature of a mark. *In re National Data Corporation,* 753 F.2d 1056, 24 USPQ 749, 751 (Fed. Cir. 1983). That a particular feature of a mark is descriptive with respect to the products at issue justifies giving less weight to that portion of the mark. *In re National Data Corporation, supra*. In Registration No. 2099045 for the mark THE SCRIPPS RESEARCH INSTITUTE and

Design and in Registration No. 1546838 for the mark SCRIPPS IMMUNOLOGY REFERENCE LABORATORY, the terms "Research Institute" and "Immunology Reference Laboratory" are descriptive. Not only has applicant disclaimed the exclusive right to use the terms "Research Institute" and "Immunology Reference Laboratory", but applicant has conceded that those terms are descriptive. (Applicant's Brief, p. 4). Thus, because the terms "Research Institute" and "Immunology Reference Laboratory" are descriptive, those terms will not be regarded as dominant and will generally be given less weight than the more arbitrary parts of the marks (*i.e.,* the name "Scripps").

The significance of the "Scripps" name in registrant's marks is reinforced by its location as the first word in the marks.[5] *Presto Products Inc. v. Nice-Pak Products Inc.,* 9USPQ2d 1895, 1897 (TTAB 1988)("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered").

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[5] With respect to Registration No. 2099045 for the mark THE SCRIPPS RESEARCH INSTITUTE and Design, the word "The" does not have any trademark significance. "The" is a definite article. When it is used before a noun, it denotes a particular person or thing. Dictionary.com (v 1.0.1). *See, In re Universal Package Corporation,* 222 USPQ 344, 345 (TTAB 1984); *Conde Nast Publications Inc. v. The Redbook Publishing Company,* 271 USPQ 356, 357 (TTAB 1983). Thus, as used in "The Scripps Research Institute," the word "The" simply emphasizes the "Scripps" name.

The word portions of registrant's marks incorporate the entirety of the word portion of applicant's mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *Johnson Publishing Co. v. International Development Ltd.,* 221 USPQ 155, 156 (TTAB 1982)(EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re Denisi,* 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *In re South Bend Toy Manufacturing Company, Inc.,* 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

The word portion of a composite mark (*i.e.,* SCRIPPS, THE SCRIPPS RESEARCH INSTITUTE, and SCRIPPS IMMUNOLOGY REFERENCE LABORATORY) is usually considered the dominant part of a mark because it is more easily remembered and used in communications. Neither applicant's stylized humans forming a circle, nor registrant's molecule design, will be used by in asking for or discussing the services and it is unlikely that the design elements will be used in textual materials (by applicant, registrant, or third-parties) because it would be impractical to use the design features. *CBS Inc. v. Morrow,* 708 F.2d 157 9, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Appetito Provisions Co.*

Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). Accordingly, the design elements are unlikely to be remembered when the consumer is confronted with substantially similar word marks. *In re Decombe*, 9 USPQ2d 1813, 1814 (TTAB 1988).

With respect to applicant's argument that registrant's marks are entitled to only a narrow scope of protection because "Scripps" is a surname, we note that Registration No. 1546838 for the mark SCRIPPS IMMUNOLOGY REFERENCE LABORATORY is registered under the provisions of Section 2(f) of the Lanham Act. Having acquired distinctiveness, the mark SCRIPPS IMMUNOLOGY REFERENCE LABORATORY is entitled to the same trademark protection as any other validly registered trademark. *E. I. du Pont de Nemours & Co. v. Societe Dupont*, 161 USPQ 489, 491 (TTAB 1969).

While there are obvious differences between applicant's mark SCRIPPS and Design and registrant's marks THE SCRIPPS RESEARCH INSTITUTE and Design and SCRIPPS IMMUNOLOGY REFERENCE LABORATORY, the design elements and descriptive wording do not detract from the similarity created by the use of the "Scripps" name which is the dominant portion of both applicant's mark and registrant's marks. We are satisfied that when the marks are taken as a whole, they are similar in sound, appearance, meaning, and commercial impression.

B. The services of applicant and registrant are related.

Applicant is seeking to register its mark for the following services:

> Educational services, namely, conducting seminars, conferences and workshops in the field of health care, in Class 41; and,
>
> Health care services, in Class 42.

Registrant has registered its marks for "scientific and medical research services" and "medical laboratory and research services" in Class 42.

We start with the well-settled proposition that it is not necessary that the services of the applicant and registrant be similar or even competitive to support a finding of likelihood of confusion. Likelihood of confusion may be found if the respective services are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that could give rise to the mistaken belief that they emanate from the same source. *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Seaguard Corporation v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984).

The Examining Attorney submitted fourteen use-based registrations for both health care services and medical

research services and nine use-based registrations for both educational services in the field of health care and medical research services. The third-party registrations submitted by the Trademark Examining Attorney have probative value to the extent that they serve to suggest that the services listed therein are of a kind that emanate from a single source. *In re Infinity Broadcast*ing *Corporation,* 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.,* 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The fact that the third-party marks have been adopted and registered for health care services, educational services in the field of health care, and medical research services is probative of the fact that those services are related.

Applicant's information about the history of the various "Scripps" entities that may be related and rendering services that emanate from a single source does not help its argument for registration. Applicant has not argued, nor proven, that the relationship between applicant and registrant, if any, is so close as to obviate any confusion. Accordingly, we do not undertake a "unity of control" analysis. *In re Wella A.G.,* 5 USPQ2d 1359, 1361 (TTAB 1988). The fact with which we must deal with *sub*

judice is that the records of the U.S. Patent and Trademark Office show that applicant's "Scripps" mark and registrant's "Scripps" marks are owned by different entities.

The excerpts from the websites submitted by applicant evidence that the services of applicant and registrant are of a type that emanate from the same source. The "Scripps History" shows that various Scripps entities were derived from the Scripps Memorial Hospital and evolved into related entities with different specialties. In fact, the "About Scripps" excerpt cited above states that the registrant is affiliated with the health care delivery network.

Applicant itself is the owner of Registration No. 1545762 for the mark RESEARCH INSTITUTE OF SCRIPPS CLINIC for "scientific and medical research." Applicant's argument that healthcare services and educational services in the field of healthcare are not related to scientific and medical research appears contrived in light of its ownership of a registration for "scientific and medical research" and it is not well taken.

In view of the third-party registrations, applicant's website indicating that registrant's medical research services are affiliated with applicant's health care delivery network, and applicant's ownership of a trademark

registration for "scientific and medical research", we find that applicant's health care services and educational services in the field of health care and registrant's scientific and medical research services are related.

C. The services of applicant and registrant move in the same channels of trade.

It is well-settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods or services as they are identified in the involved application and cited registrations, rather than on what any evidence may show as to the actual nature of the products, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum,* 211 USPQ 639, 640 (TTAB 1981). Accordingly, applicant's argument that there is no overlap between its services and the services rendered by the registrant is not persuasive because there is no restriction in the description of services as to either the application or the registrations. We must therefore consider the applicant's services and the registrant's services as if they were being rendered in all of the normal channels of trade to all of the normal

purchasers for such services. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra; Toys R Us v. Lamps R Us,* 219 USPQ 340, 343 (TTAB 1983).

Because there are no restrictions in applicant's description of services, the "educational services, namely, conducting seminars, conferences, and workshops in the field of health care," are not limited to "providing health care directly to patients, and to provide (sic) health related information directly to the patient." (Applicant's Brief, p. 6). Applicant's services may include seminars, conferences, and workshops in the field of medical research, including biomedical research. In addition, persons involved in scientific and medical research may also be involved and familiar with health care services. Thus, based on the description of services, applicant's health care services and educational services in the field of health care may be rendered to consumers involved with scientific and medical research and, therefore, the channels of trade and class of purchasers overlap.

D. <u>The lack of any reported instances of actual confusion is not a significant likelihood of confusion factor</u>.

Applicant argues that there has been no actual confusion between applicant's mark and registrant's marks

despite thirteen years of simultaneous use. However, the fact that an applicant in an *ex parte* proceeding is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases has no way to know whether the registrant is unaware of any instances of actual confusion, nor is it usually possible to determine whether there has been any significant opportunity for actual confusion to have occurred. *In re Opus One Inc.,* 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Jeep Corporation,* 222 USPQ 333, 337 (TTAB 1984); *In re Barbizon International, Inc.,* 217 USPQ 735, 737 (TTAB 1983). In this case, even those relevant consumers who were familiar with the past affiliation between applicant and registrant may very well have associated the respective services of the applicant and registrant with a single source, making confusion more likely. Accordingly, applicant's argument regarding the lack of actual confusion is of no probative value in our likelihood of confusion analysis.

We accordingly find that there is a likelihood of confusion between SCRIPPS and Design used in connection with "health care services" and "educational services, namely, conducting seminars, conferences, and workshops in the field of health care" and the marks THE SCRIPPS

RESEARCH INSTITUTE and Design for "scientific and medical research services" and SCRIPPS IMMUNOLOGY RESEARCH LABORATORY for "medical laboratory and research services."

Decision: The refusal to register is affirmed.