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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Erie County Medical Center Corporation

Serial No. 77087329
Serial No. 77090835
Serial No. 77091006

Marybeth Priore of Colucci & Gallaher, P.C. for Erie County Medical Center Corporation.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Walters, Bucher and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Erie County Medical Center Corporation ("applicant") filed three use-based applications, in standard character format, for the marks identified below for "hospitals," in Class 44:

1. Western New York's Hospital of Choice;¹

¹ Serial No. 77087329, filed January 20, 2007. Applicant disclaimed the exclusive right to use "Western New York's Hospital."

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2. WNY Hospital of Choice;² and,
3. WesternNYsHospitalofChoice.³

The Trademark Examining Attorney refused to register applicant's marks under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's marks are likely to cause confusion with the mark HOSPITAL OF CHOICE for "healthcare services," in Class 44.⁴

Our determination of likelihood of confusion 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The

² Serial No. 77090835, filed January 25, 2007. Applicant disclaimed the exclusive right to use "WNY Hospital."

³ Serial No. 77091006, filed January 25, 2007. Applicant disclaimed the exclusive right to use "WesternNYsHospital."

⁴ Registration No. 3146430, issued September 19, 2006.

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fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity and nature of the goods and services as described in the applications and registration at issue.

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the services as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

As the Court of Customs and Patent Appeals, the predecessor of our reviewing court, explained in *Tuxedo*

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Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d
1335, 209 USPQ 986, 988 (CCPA 1981):

Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration unless set forth in its application.

Likewise, we must consider the services as set forth in the cited registration without considering applicant's argument that the registrant follows a "Christ-centered mission to bring medical care, health, and wellness to the community [it] serves," whereas applicant's hospital services do not have a "Christ-centered mission."⁵ Because there are no restrictions or limitations in the registration or in the applications, we must presume that the registrant's healthcare services include all types of healthcare services and that applicant's services include all types of hospital services. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Also, we cannot consider applicant's argument that the registrant renders its healthcare services in Kentucky

⁵ Applicant's Brief, p. 10, citing the registrant's website attached to applicant's response to the first Office action.

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while applicant renders its hospital services in Western New York.⁶ Because applicant is seeking a geographically unrestricted registration, we are required to evaluate the *du Pont* likelihood of confusion factors in terms of nationwide markets. This requirement is not eliminated by the fact that applicant and registrant may render their services in different geographic markets. *In re Integrity Mutual Insurance Co., Inc.*, 216 USPQ 895, 896 (TTAB 1982); *Giant Food Inc. v. Nations Foodservice, Inc.*, 214 USPQ 641, 644 (TTAB 1982), *rev'd on other grounds*, 710 F.2d 1565 (Fed. Cir. 1983); *Armco, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 77 (TTAB 1981).

To show that healthcare services and hospital services are related, the Examining Attorney submitted six third-party registrations based on use in commerce for both services. "Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a

⁶ Applicant's Brief, p. 10.

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type which may emanate from a single source." *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993), citing *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Moreover, it is beyond argument that healthcare services and hospital services are related. A hospital is "an institution in which sick or injured persons are given medical or surgical treatment."⁷ In other words, a hospital is a place that renders healthcare services.

In view of the foregoing, we find that healthcare services and hospital services are closely related services.

B. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Because there are no limitations as to channels of trade or classes of purchasers in either the applications or the registration, it is presumed that the registration and the applications encompass all of the services of the type described in the description of services, that the services so identified move in all channels of trade normal

⁷ The Random House Dictionary of the English Language (Unabridged), 924 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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for those services, and that the services are available to all classes of purchasers for the listed services. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Accordingly, we must presume that applicant's hospital services and the registrant's healthcare services move in the same channels of trade and are rendered to the same classes of purchasers.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the services are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874,

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23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

In addition, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the relevant public would be members of the general public who utilize healthcare and hospital services.

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Applicant's marks Western New York's Hospital of Choice, WNY Hospital of Choice, and WesternNYsHospitalofChoice incorporate the entire registered mark HOSPITAL OF CHOICE. The terms "Western New York's," "WNY," and "WesternNYs" are geographic designations that modify the name "Hospital of Choice," in effect, telling consumers that their "Hospital of Choice" services are in Western New York. The geographic designations emphasize the "Hospital of Choice" portion of applicant's marks making it the dominant portion of applicant's marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("there is nothing improper in stating, that for rational reasons, more of less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties"). *See also In re Collegian Sportswear Inc.*, 224 USPQ 174, 176 (TTAB 1984) (the addition of a geographic terms does not distinguish COLLEGIAN OF CALIFORNIA from COLLEGIAN because consumers are likely to believe that applicant's mark is a new line of clothing featuring a "California" style); *Liberty & Co., Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 65, 68 (TTAB 1982) ("the addition of the geographic term

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'OF LONDON' to the term 'LIBERTY' in opposer's mark 'LIBERTY OF LONDON' is not, in our opinion, sufficient to preclude likelihood of confusion when applicant's mark "LIBERTY" and opposer's mark 'LIBERTY OF LONDON' are both applied to shirts"). As in *Collegian Sportswear*, the addition of the terms "Western New York's," "WNY," and "WesternNYs" do not distinguish applicant's marks from the mark HOSPITAL OF CHOICE because consumers are likely to believe that applicant's marks represent a division of the HOSPITAL OF CHOICE healthcare services.

Because the marks share the term "Hospital of Choice," which is the only element in the registered mark and it is a clearly recognizable and prominent element in applicant's mark, we find that there are strong similarities between the marks in terms of appearance, sound, meaning and commercial impression.

D. The conditions under which and buyers to whom sales are made (i.e., impulse vs. careful, sophisticated purchasing).

Applicant contends that hospital services are not impulse purchases; they are expensive, personal to the consumer, and made with cautious deliberation.⁸ Even assuming, arguendo, that customers for healthcare and

⁸ Applicant's Brief, pp. 14-15.

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hospital services exercise a high degree of care, applicant does not provide any evidence regarding the decision process used by these careful and sophisticated purchasers, the role trademarks play in their decision making process, or how observant and discriminating they are in practice. Accordingly, the problem with applicant's "degree of consumer care" argument is that there is no corroborating evidence.

In addition, as indicated above, because the relevant purchasers of healthcare and hospital services are members of the general public, the relevant purchasers encompass consumers of all levels of care. Also, there are emergencies where people will go to the closest hospital or healthcare center without regard to the source of the services.

In view of the foregoing, the degree of consumer care is a factor that favors finding that there is a likelihood of confusion.

E. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Applicant contends that applicant and registrant have concurrently used their respective marks since October 2005 without any reported instances of actual confusion.

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However, the fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion has little probative value. First, the Board has no way of knowing whether the registrant is unaware of any reported instances of confusion. Second, it is not possible in this case to determine whether there has been any significant opportunity for actual confusion to occur because applicant and registrant render their services in different geographic trading areas. *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001). In view thereof, we are not persuaded that the absence of any instances of actual confusion is entitled to any weight in our analysis.

F. Balancing the factors.

In view of the facts that hospital and healthcare services are closely related and that applicant's marks and the registered mark are similar, as well as the presumption that the services move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's marks "Western New York's Hospital of Choice," "WNY Hospital of Choice," and "WesternNYsHospitalofChoice" all for hospital services is likely to cause confusion with the mark HOSPITAL OF CHOICE for healthcare services.

Decision: The refusals to register are affirmed.