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Mailed: January 22, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Healthcare Distribution Management Association

Serial No. 78602188

Thomas J. Moore of Bacon & Thomas, PLLC for Healthcare Distribution Management Association.

Priscilla Milton, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Hairston, Zervas and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application has been filed by Healthcare Distribution Management Association to register the mark HEALTHCARE DISTRIBUTORS INTERNATIONAL in standard character form for the following goods and services:

publications, namely, magazines, reports and newsletters in the field of healthcare product distribution; downloadable electronic publications in the nature of magazines, reports and newsletters in the field of healthcare product distribution; electronic publications in the nature of magazines, reports and newsletters in the field of healthcare product distribution recorded on electronic and

optical media (in International Class 16);

association services, namely, promoting the interests of the distributors of healthcare products, creating and exchanging knowledge that affects the future of distribution management, and influencing the standards and business processes that produce efficient healthcare commerce; online business directories featuring products, services and businesses related to the distribution of healthcare products; arranging and conducting trade show exhibitions in the field of the distribution of healthcare products and the management of healthcare product distribution businesses (in International Class 35);

arranging and conducting educational conferences in the field of the distribution of healthcare products and healthcare product distribution businesses (in International Class 41); and

arranging and conducting trade show exhibitions in the field of the distribution of healthcare products to hospitals (in International Class 44).

The application was filed on April 5, 2005 based on an allegation of applicant's bona fide intention to use the mark in commerce.¹ In addition, the application was filed seeking registration of its mark under Section 2(f) of the Trademark Act, based on applicant's ownership of Registration No. 2888102 for the mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION in typed or standard character form for the following goods and services:

publications and other printed matter, namely newsletters, books, guides, directories, and catalogs featuring information on the distribution of health care products and pharmaceuticals (in International Class 16);

providing business information in the field of product

¹ Application Serial No. 78602188.

information, marketing and operational supply chain efficiency for others; providing business information relating to the distribution of healthcare products and pharmaceuticals on a global computer network; business research; public and media relations (in International Class 35);

electronic mail services; providing on-line electronic bulletin boards for transmission of messages among computer users concerning products, services, and issues pertinent to the healthcare and pharmaceutical distribution industries; providing Internet access (in International Class 38);

educational services, namely, arranging and conducting educational and training conferences and seminars concerning marketing, sales, distribution, accounting, finance, technology and information services, personnel, and regulatory compliance in the area of the distribution of health care products and pharmaceuticals (in International Class 41); and

association services, namely, promoting the interests of the healthcare products and pharmaceuticals distribution industry; political advocacy and lobbying services in the fields of healthcare and pharmaceuticals via the Internet (in International Class 42).

The registration issued on September 28, 2004 under Section 2(f) of the Trademark Act, with a disclaimer of "ASSOCIATION" apart from the mark as shown.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its goods and services and that applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act. When the refusal was made final, applicant appealed. Applicant and the examining attorney have

filed briefs, and an oral hearing was held.

Applicant having filed the application seeking registration under Section 2(f) has conceded that the mark is merely descriptive under Section 2(e)(1). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984). Thus, the sole issue on appeal is whether applicant has carried its burden of establishing, by a preponderance of the evidence, a prima facie case that its merely descriptive mark has acquired distinctiveness under Section 2(f). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, *supra*; and *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

Trademark Rule 2.41(b) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as prima facie evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. See *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of the rule, is the analysis used in tacking cases, i.e., whether the marks are legal equivalents. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17

USPQ2d 1866 (Fed. Cir. 1991). See also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*; and *In re Dial-A-Mattress Operating Corp.*, *supra*. Therefore, a minor difference in the marks, such as an inconsequential modification or modernization of the later mark, would not be a basis for rejecting application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) *aff'd*, 769 F.2d 764 (Fed. Cir. 1985); and *In re Flex-O-Glass, Inc.*, *supra*. On the other hand, it has been made clear that two marks are not necessarily legal equivalents merely because they would be deemed confusingly similar. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*. Aside from the identity of the marks in the registration and the application, applicant is also required to establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods and services in the prior registration and the goods and services identified in the application to warrant the conclusion that the distinctiveness of the mark associated with the goods and services in the registration will "transfer" to the goods and services listed in the application.

See In re Rogers, supra.

It is applicant's contention that HEALTHCARE DISTRIBUTORS INTERNATIONAL and HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION create the same continuing commercial impression and that "the primary impression of the present mark is almost identical to the primary impression of the registered mark" (brief, p. 8). Citing the *Dial-A-Mattress* case, applicant asserts that both marks share the term HEALTHCARE and that DISTRIBUTORS in its applied-for mark is nearly identical to DISTRIBUTION in its registered mark. Applicant further argues that the term INTERNATIONAL in its applied-for mark as well as the term MANAGEMENT and the disclaimed term ASSOCIATION in its registered mark "are each not highly distinctive, and are each related to the relevant goods and services" (brief, p. 8). Applicant argues that, as a result, "Applicant's members, and those familiar with Applicant, would immediate[sic] associate" its applied-for mark HEALTHCARE DISTRIBUTORS INTERNATIONAL with its registered mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION "because of the similarity between the two" (*Id.* at 9). Applicant did not submit any additional evidence in support of its claim that HEALTHCARE DISTRIBUTORS INTERNATIONAL has acquired distinctiveness under Section 2(f) of the Trademark Act.

The examining attorney, finding applicant's arguments unpersuasive, maintains that the two marks are not legal equivalents. The examining attorney contends that HEALTHCARE DISTRIBUTORS INTERNATIONAL "when used in connection with the identified goods/services describes the intended users, healthcare distributors and the scope of the services, international in scope" (brief, unnumbered p. 11). The examining attorney further contends that, in contrast, "[u]se of HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION in connection with applicant's goods and services conveys to the consumer that a trade association is offering goods and services whose subject matter is management in the fields of healthcare distribution" (*Id.*). Thus, the examining attorney argues that the marks "are not indistinguishable and certainly do not create the same, continuing commercial impression such that the consumer would consider them both the same mark" (*Id.* at unnumbered p. 10).

We agree with the examining attorney that applicant's present mark, HEALTHCARE DISTRIBUTORS INTERNATIONAL, while perhaps confusingly similar to, is clearly not the legal equivalent of the registered mark, HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION. Unlike the *Dial-A-Mattress* case on which applicant relies, the differences between the marks

involved in this case go far beyond a minor difference in spelling.

The dictionary and Internet evidence made of record by the examining attorney clearly shows that the applied-for mark HEALTHCARE DISTRIBUTORS INTERNATIONAL connotes a feature or characteristic of the goods and services identified thereby, namely, that they will be purchased and/or utilized by healthcare distributors to provide health related products and services that are international in scope. The registered mark, HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION, also connotes a feature or characteristic of the identified goods and services. Specifically, the mark connotes an association that provides management of the distribution of healthcare related goods and/or services. Thus, the two marks connote or convey different features of goods and/or services in the field of healthcare, and as a result, create different commercial impressions. Therefore, the two marks cannot be considered "the same" for purposes of Trademark Rule 2.41(b).

Because the marks are not the same, Trademark Rule 2.41(b) cannot be used to establish that HEALTHCARE DISTRIBUTORS INTERNATIONAL has acquired distinctiveness as a mark for any goods or services, let alone the goods for

which registration is now sought. Thus, it is unnecessary to consider the relationship between the goods and services for which the marks have been registered and the goods and services identified in the application.²

Finally, we find that applicant's proffered disclaimer, in the alternative, of either DISTRIBUTORS or DISTRIBUTORS INTERNATIONAL fails to overcome our above finding that its applied-for HEALTHCARE DISTRIBUTORS INTERNATIONAL mark is not the legal equivalent of its previously registered mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION. As a result, neither proposed disclaimer would establish that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f).

² It is noted that the examining attorney does not argue that the goods and services in applicant's registration are unrelated to the goods and services in the subject application. Nevertheless, even if the marks were the same, we would find that the registration is insufficient in and of itself to establish that the distinctiveness of the registered mark for goods and services identified thereby has transferred to the more broadly identified Class 16 goods and Class 35 services as well as the additional Class 44 services identified in this application. See, e.g., *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) ("[n]othing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration."); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (prior registration for specific services involving credit cards does not automatically entitle applicant to a registration for broader financial services); and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475 (TTAB 1988) (preexisting registration of gold ring device for rifle scopes insufficient to demonstrate that the gold ring device has become distinctive of applicant's binoculars and spotting scopes).

Ser No. 78602188

Accordingly, applicant's request in the alternative to disclaim the above wording is denied.

In view of the foregoing, we find that the evidence of acquired distinctiveness is insufficient to permit registration of HEALTHCARE DISTRIBUTORS INTERNATIONAL for the recited goods and services under Section 2(f).

Decision: The refusal to register is affirmed.