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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rodale, Inc.
v.
Healthy Heart Review, Inc.

Opposition Nos. 91151405 and 91151406

Gary D. Krugman and Jody H. Drake of Sughrue Mion PLLC for Rodale, Inc.

Katherine Hendricks of Hendricks & Lewis for Healthy Heart Review, Inc.

Before Hairston, Chapman, and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Rodale, Inc. (a Pennsylvania corporation) has opposed two applications filed on February 5, 2001, by Healthy Heart Review, Inc. (a Washington corporation), both to register the mark PREVENTION MD ("MD" disclaimed) on the Principal Register. Both applications are based on applicant's claimed dates of first use and first use in commerce of July 2000 and October 2000.

Application Serial No. 76205561 (the subject of Opposition No. 91151405) is for services identified as “medical testing and diagnostic services, and vaccinations” in International Class 42.

Application Serial No. 76205560 (the subject of Opposition No. 91151406) is for services identified as “educational services, namely, instruction in first aid, automated external defibrillation, cardiopulmonary resuscitation, wellness, travel medicine, and other life support and first aid training” in International Class 41.

As grounds for opposition, opposer made essentially the same allegations in its two notices of opposition, namely, that since long prior to any date upon which applicant can rely, opposer adopted and registered various marks which consist of or include the word PREVENTION for “various products and services in the health, nutrition, diet, and exercise field, and related collateral products and services” (Paragraph 2); that opposer owns numerous registrations with the term PREVENTION (over 20 are listed in opposer’s paragraph 3); that opposer “has long used the mark PREVENTION in connection with providing healthcare information and health screening and testing services” resulting in the mark becoming “distinctive in association with such services and [identifying] opposer as the source of such services rendered under the PREVENTION mark”

(Paragraph 4); that as a result of opposer's long use of its family of PREVENTION marks and its extensive advertising and promotion of its various products and services its PREVENTION marks have become "extremely well known to the public and have become famous" (Paragraph 5); and applicant's mark, when used in connection with its services, so resembles opposer's previously used and registered marks, consisting of or including the word PREVENTION, as to be likely to cause confusion, mistake, or deception in contravention of Section 2(d) of the Trademark Act.[1]

In applicant's answers it denied the salient allegations of the notices of opposition, and raised "affirmative defenses" which are more in the nature of further specific information as to the basis for applicant's denial of opposer's likelihood of confusion claim.

In an August 19, 2002 order, the Board granted opposer's motion to consolidate, and the two opposition proceedings were then consolidated.

The record consists of the pleadings (in both oppositions); the files of the two opposed applications;

[1] Opposer also pleaded in both oppositions claims under Section 2(a) false suggestion of a connection with opposer, and Section 43(c) dilution, 15 U.S.C. §§1052(a) and 1125(c), respectively. These claims were expressly dropped by opposer in footnote 2 of its motion (filed April 11, 2003) to amend the pleadings. Therefore, these two claims will not be further considered. (A decision on opposer's motion to amend its pleadings was deferred until after trial by Board order dated August 9, 2003. The motion to amend will be decided later herein.)

opposer's notices of reliance on (i) status and title copies of twenty of its registrations,[2] and (ii) applicant's answers to certain of opposer's interrogatories, and other discovery materials; and the testimony depositions, with exhibits, of Catherine M. Cassidy, editor-in-chief of opposer's PREVENTION magazine,[3] and Jeff E. Vaughan, opposer's executive director of corporate communications. Applicant submitted a notice of reliance on (i) several third-party registrations which include the word "PREVENTION" and several others which include the component "MD," and (ii) opposer's answers to two of applicant's interrogatories; and the testimony depositions, with exhibits, of Rodney L. Watson, applicant's president, and Gary W. Bequette, in charge of applicant's sales and marketing as well as department head for CPR and first aid training.

Both parties filed briefs on the consolidated case[4], and both parties were represented at the oral hearing held before the Board on November 19, 2003.

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[2] Nineteen of these twenty registrations were pleaded in opposer's notices of opposition, and opposer requested that the pleadings be considered amended to allow for the latest registration. To whatever extent it is necessary, the Board considers opposer's pleadings amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b), thereby including the twentieth registration as if pleaded by opposer.

[3] Portions of this testimony were submitted as "confidential."

[4] Opposer's motion (filed September 8, 2003) to extend its time to file a reply brief is granted.

Opposer's Motion to Amend the Pleadings

As a preliminary matter, we will determine opposer's motion for leave to file a consolidated amended notice of opposition. Applicant's testimony period closed on April 9, 2003, and on April 11, 2003 opposer moved under Fed. R. Civ. P. 15(b) for leave to file an amended consolidated notice of opposition to add a claim that each application is void ab initio because applicant did not use the mark in commerce in connection with any (application Serial No. 76205560) or some (application Serial No. 76205561) of the identified services prior to the filing date of the applications. Specifically, opposer contends that this new issue was raised by applicant and was tried by implied consent during the March 19, 2003 deposition of applicant's president, Rodney L. Watson; that applicant's attorney raised the issue of whether applicant renders any of its services in interstate commerce (or other commerce lawfully regulated by Congress); that the only service rendered by applicant outside the state of Washington is that identified as "vaccinations"; that opposer timely filed the motion for leave to amend because it had no basis to file a motion prior to the issue being raised during applicant's testimony period; and that the amendment will not delay the proceeding or prejudice applicant.

Applicant contends that consent is generally implied only if, during trial, a party acquiesces to the introduction of evidence that is relevant only to that issue, however, in this consolidated case, the testimony is relevant to the pleaded issue of likelihood of confusion (e.g., actual confusion circumstances); that the issue was not tried with the implied consent of applicant; that applicant will be unfairly and substantially prejudiced as opposer did not act on this issue until after the close of applicant's testimony period, thereby negating applicant's opportunity to offer further evidence on interstate use; and that the amendment would be futile because the use necessary to support application and registration includes not only providing services in more than one state, but also, services provided in one state to customers who travel across state lines.

While the witness, Rodney Watson, was questioned on direct and cross examination regarding applicant's activities outside the state of Washington, there is nothing in the record which would have alerted applicant that opposer intended to use the information as a separate ground for opposition, specifically that both applications were void ab initio. See Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185, 187 (CCPA 1984); and Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990). It

is reasonable, as applicant argues, that it believed this testimony related to the issue of likelihood of confusion.

We find that the issue of applicant's alleged failure to use its mark in connection with its services in interstate commerce rendering its applications void ab initio was not tried with the implied consent of applicant; and that to allow such an amendment of the pleading in this consolidated case at this time would constitute unfair surprise and be prejudicial to applicant.

Accordingly, opposer's motion for leave to file an amended pleading under Fed. R. Civ. P. 15(b) to add a claim of applicant's asserted non-use of the mark in interstate commerce is denied.

The Parties

Rodale, Inc., opposer, publishes various publications, including magazines such as *Prevention*, *Bicycling*, *Runner's World* and *Organic Style*. Its monthly *Prevention* magazine was first published in 1950 and the mark has been in continuous use since that date. This magazine includes articles covering a wide variety of health topics, such as weight loss, fitness, nutrition and diet, exercise, information on chronic diseases including cancer, heart disease, diabetes, arthritis and asthma, mental health topics, self-diagnosis based on symptoms, health news and medical breakthroughs including new vaccines and new

therapies. Opposer's *Prevention* magazine has a paid circulation (subscription and newsstand) of 3.2 million, with a "pass along" readership of 10 million. It is the 14th largest consumer magazine in the United States, ahead of *Playboy* and *Sports Illustrated*, and the number one magazine in the consumer health publication rankings.

Other publications in opposer's *Prevention* line and all offered under a PREVENTION mark are the following: special guides on various health topics, which are newsstand only publications, and are sold under the name *Prevention Guide;* books (totaling about 50-100 different titles) including health cookbooks, books for seniors, for kids and for women, sold through direct mail and bookstores and other retail and online outlets; "bookazines" which are books made available like a magazine; various newsletters (e.g., "Prevention Walking Club Newsletter"), (which are currently available online); compilations of free *Prevention* reports covering a variety of health topics such as back pain, high blood pressure and arthritis, offered as incentives for subscription via direct mail; and *Prevention Annual* which is a compilation of various health topics published over the course of a year. Opposer's various PREVENTION publications are available nationally and are sold or distributed to the general public.

Opposer also offered a book club service which was in existence for about 12 years ceasing in 2002. For over ten years, opposer has brought chefs into supermarkets to teach cooking healthy meals; it has put “freestanding inserts” in about one thousand different newspapers; it has provided at least one press release a month in connection with its “PREVENTION” magazine and the press releases are sent to over 2000 media outlets; and opposer has been involved in providing seminars on various health topics through professional events such as the American Dietetics Association Conference, and through opposer’s own “PREVENTION Walking Rally,” targeted to the general public.

Opposer has a website which covers the same topics as the magazine including breaking news in the medical field, such as vaccines; it receives about 600,000 visitors per month.

As explained previously, opposer has introduced twenty of its registrations for marks which consist of or include the word PREVENTION into the record. The most relevant of those are the following:

(1) Registration No. 694267, issued March 8, 1960, for the mark PREVENTION for a “magazine” (Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed);

(2) Registration No. 2222899, issued February 9, 1999 for the mark PREVENTION HEALTH BOOKS for a “series of books on health, fitness, diet, exercise and lifestyle” (“Health Books” is disclaimed);

(3) Registration No. 2118079, issued December 2, 1997, for the mark PREVENTION MAGAZINE HEALTH BOOKS for a “series of books on health, fitness, diet, exercise and lifestyle” (“Magazine Health Books” is disclaimed);

(4) Registration No. 1455284, issued September 1, 1987, for the mark PREVENTION’S FAMILY HEALTH LIBRARY for a “series of health related books published periodically” (“Family Health Library” is disclaimed)(Section 8 affidavit accepted, Section 15 affidavit acknowledged);

(5) Registration No. 1959078, issued February 27, 1996, for the mark PREVENTION’S GUIDE for a “magazine in the field of health, fitness, diet, exercise and related lifestyle issues,” (“Guide” is disclaimed)(Section 8 affidavit accepted, Section 15 affidavit acknowledged);

(6) Registration No. 1929896, issued October 24, 1995, for the mark THE PREVENTION PULSE for a “newsletter in the field of health and fitness” and “conducting business surveys in the field of public opinion and market research” (Section 8 affidavit accepted, Section 15 affidavit acknowledged);

(7) Registration No. 1296113, issued September 18, 1984, for the mark THE PREVENTION TOTAL HEALTH SYSTEM for a “series of books devoted to health topics” (“Health” is disclaimed)(Section 8 affidavit accepted, Section 15 affidavit acknowledged);

(8) Registration No. 1854917, issued September 20, 1994 for the mark PREVENTION AT WORK for educational services namely conducting seminars on various health topics, and for providing health information; fitness testing; nutrition counseling, and motivational programs in the nature of health, fitness and nutritional counseling (Section 8 affidavit accepted, Section 15 affidavit acknowledged); and

(9) Registration No. 2643325, issued October 29, 2002, for the mark PREVENTION for “production of radio and television programs and entertainment services, namely, conducting a series of programs in the fields of health, fitness, diet, exercise and lifestyle distributed over radio, television, satellite, cable, audio and visual media, and via a global computer network” and “information services in the fields of health, fitness, diet, exercise and lifestyle provided electronically via a web site on a multi-user global computer information network; and electronic publications via the world wide web containing on-line

magazines, columns and articles in the fields of health, fitness, diet, exercise and lifestyle."

A significant part of opposer's circulation and sales of its *Prevention* magazine comes from subscription. However, there is also a large distribution through retail chain stores such as Wal-Mart and Kmart; supermarket stores such as Safeway and Kroeger; bookstores such as Barnes & Noble and Borders; drug stores such as CVS and Eckerd; specialty stores such as health food stores and fitness centers; and in major transportation centers such as train stations and airports. In addition, opposer distributes the publication free to doctors' offices, emergency clinics, sports medicine clinics, and the like.

Opposer distributes *Prevention* magazine through its "Spirit of Women Health Network," which is a partnership between opposer and about a dozen hospital networks throughout the country, representing about 80 hospitals. It is an educational program to provide information to women about their health. Specifically, through this program opposer distributes about 110,000 free copies of its publications to these hospitals for educational programs on such health issues as diabetes or heart disease. In September 2002, the Spirit of Women partnership offered a cruise, which included healthy lifestyle seminars, daily fitness programs, workshops, etc., under opposer's PREVENTION mark.

Opposer sells videotapes (commenced in 1999 and with plans to produce at least two per year for the next five years) and audiotapes (since at least 1996) on health-related topics (e.g., fitness, exercise, disease specific information) under opposer's PREVENTION mark. It also sells various collateral goods such as umbrellas, golf balls, binoculars, note pads, calendars, recipe cards, towels, hats and shirts under this mark.

Opposer's annual sales and advertising figures for the last five years were submitted under seal as confidential but suffice it to say, they are extremely significant numbers.

Opposer engages in partnerships with radio media, including one with CBS whereby opposer provides five scripts a week for five health minutes read as a Health Watch Tip each weekday. Through a contractor, since 1999 opposer has offered "PREVENTION Walking Tours" throughout the United States and in Canada and Europe. Partnerships with various television media include one with NBC involving one minute "Ounce of Prevention Tips" distributed to over 200 affiliates begun in 1999; a more recent one with CBS involving market research or polls on important health topics, a monthly segment on CBS's The Early Show, and a newly-planned series of afternoon specials; one with The Weather Channel for two years in 2000-2002; and one with The

Discovery Channel and The American Cancer Society involving a poll on cancer myths, including a "Discovery Health/Prevention Magazine Special" on cancer. It partners with print media such as "The New York Times" which syndicates articles from *Prevention* Magazine nationwide.

Opposer collaborates with other organizations to offer medical testing. For example, opposer partnered with Wal-Mart and a pharmaceutical company in November 2000 to offer glucose screening for diabetes for customers at Wal-Mart; and in 1999 opposer co-sponsored with Pfizer Corporation (and other companies) the first of its "Heart Healthy Tours," involving an 18-wheel truck (opposer's PREVENTION mark covering the 64-foot sides of the truck) visiting various retail locations and health fairs throughout the United States. Through this program, opposer and the co-sponsors provide (i) several types of screening and tests (e.g., cholesterol tests, general health assessment tests, bone density tests, derma tests) free of charge, and (ii) health information, also free of charge. The truck was on the road for six months from May to October, going to over 25 locations with an average of 500 tests per location and the truck tours have occurred three times, thus involving over 30,000 testings. Another truck tour is being planned.

Opposer's editor-in-chief of *Prevention* magazine, Catherine Cassidy, testified that through opposer's

publications, seminars, and other activities, all offered under its PREVENTION mark, opposer "offers advice and instruction in connection with new therapies,… new vaccines,… first aid." (Dep., pp. 65-66.)

Applicant, Healthy Heart Review, Inc., was first organized in 1993 and was incorporated around 1995 or 1996. It offers classes (online and at physical locations) on topics such as CPR, first aid, wellness, and travel medicine; and it provides flu and pneumonia vaccinations, as well as medical and diagnostic testing. In its early years, applicant provided tests relating to the heart (e.g., cholesterol, blood pressure, body composition), but it branched out to other health areas such as drug tests and bone density tests. It was then that applicant decided to select a new, more comprehensive mark, first using "PREVENTION PLUS," but later changing the mark to "PREVENTION MD." According to Mr. Watson, applicant's president, applicant "believes very much in proactive rather than reactive health." (Dep., p. 13.)

Applicant has two offices (in eastern and western Washington state); and it offers its services (classes, testing and vaccinations) mainly to hospitals, corporations and at private health fairs and supermarkets. Applicant has a website ("preventionmd.com") where it advertises its services and provides online classes. It also produces

posters and fliers to advertise the flu and pneumonia vaccinations. Specifically, applicant offers its services to the public, but most of its customers for CPR/first aid classes are hospitals. Applicant's flu and pneumonia vaccinations are generally done through corporations such as Safeway and Bi-Mart for the public, or for corporate clients such as Bank of America for the employees, or for high-rise buildings in Washington cities such as Seattle and Bellevue. The flu and pneumonia vaccinations are offered in the states of Washington, Oregon, Idaho and Montana, and applicant's other services are conducted within the state of Washington. Applicant offers a class in conjunction with the American Heart Association Training Center. Applicant provides travel vaccinations through its two offices.

Applicant markets its services by sending letters to corporations and it follows up with telephone calls.

Applicant is aware of no instances of actual confusion.

Priority

In these consolidated oppositions, as explained earlier, opposer has filed status and title copies of twenty of its registrations.[5] In view of opposer's two valid and

[5] Opposer submitted proper status and title copies of twenty registrations under a timely notice of reliance filed in February 2003. In this regard, when a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it

subsisting registrations for educational and informational services, the issue of priority with respect to educational services does not arise herein. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer's two registrations are: (1) Registration No. 1854917 for the mark PREVENTION AT WORK for the following services:

> "educational services, namely, conducting seminars on the subjects of health, fitness, nutrition, and other related topics; fitness instruction, and publication of magazines, informational booklets and printed materials on the subject of health, fitness, nutrition and other related topics," and
>
> "providing health information; fitness testing; nutrition counseling, and motivational programs in the nature of health, fitness and nutritional counseling"; and

(2) Registration No. 2643325 for the mark PREVENTION for the following services:

> "production of radio and television programs; and entertainment services, namely, a continuing series of programs in the fields of health, fitness, diet, exercise and lifestyle distributed over radio, television, satellite, cable,

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was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the United States Patent and Trademark Office. See TBMP §704.03(b)(1)(A) (2d ed. June 2003), and the cases cited therein. The Board hereby takes judicial notice that five of the twenty registrations are no longer valid and subsisting. Specifically, Registration Nos. 1183328 (expired, Section 9); 2005317 (cancelled Section 8); 2017515 (cancelled Section 8); 2040555 (cancelled Section 8); and 2046093 (cancelled Section 8). These registrations will not be further considered herein.

> audio and visual media, and via a global computer network," and
>
> "information services in the fields of health, fitness, diet, exercise and lifestyle provided electronically via a web site on a multi-user global computer information network; and electronic publications via the world wide web containing on-line magazines, columns and articles in the fields of health, fitness, diet, exercise and lifestyle."

Opposer has also established common law rights in its PREVENTION mark in connection with the medical tests and screenings done on its "Heart Healthy Tours" as of 1999. We recognize that opposer offered these medical tests and screenings under the auspices of its *Prevention* Magazine. Nonetheless, as fully discussed later herein, we find that opposer's PREVENTION mark is famous for publications relating to health and wellness; and that the public receiving the medical tests and screenings would understand the tests were offered by opposer (along with the co-sponsors) as part of opposer's PREVENTION marketing, and they would associate opposer as a source of the medical tests and screenings.

Applicant's earliest proven first use is sometime in 2000, perhaps late 2000. Applicant's president, Rodney Watson, testified as follows:

> Q. When did you start using that mark [PREVENTION MD]?
> A. I believe we started using it about 2000, I think. Originally, we started out with Prevention Plus.

> Q. And you started using prevention MD in about July of 2000?
> A. Somewhere in that -- yes, somewhere in that time frame. (dep., p.8);
>
> Q. When again, did you switch to Prevention MD, do you recall?
> A. It would have been right at -- to my recollection it was right at the end of 2000, somewhere in that area, I believe. I am not entirely sure, but I think around 2000. (dep., p. 12); and
>
> Q. I notice that the report [Exhibit 12 a trademark search report for the mark Prevention Plus] has a date on the -- not the cover page, but the first page inside the report of May 2000.
> A. Yes, it does.
> Q. Does that help you remember when you began using Prevention MD in connection with your services?
> A. Well, it was obviously after that date, but again, it's just -- you know, it is gone. It would have been, you know, late 2000 when we started, somewhere in that area that we started making -- [a change from Prevention Plus]. (dep., pp. 27-28).

Thus, opposer has established prior common law rights with regard to medical testing and diagnostic services.

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the 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 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Based on the record before us, we find that confusion is likely.

The first du Pont factor we consider in this case is the fame of opposer's mark. Opposer has clearly established that its mark PREVENTION for magazines and publications on health and fitness is famous within the meaning of the du Pont factors as shown by opposer's extremely extensive annual sales figures and advertising sums, and the tremendous success of the *PREVENTION* magazine from its launch in 1950, having the largest circulation of any magazine in the health field and fourteenth in circulation of all magazines (ahead of *Sports Illustrated* and *Playboy*). The circulation numbers are 3.2 million subscriptions and 10 million "pass along" readership.

We are aware that applicant contends opposer's mark is famous only for magazines. However, we find not only that opposer has established the fame of its PREVENTION mark for magazines, but also that the fame of the mark extends into the health and wellness field. The fame of opposer's mark increases the likelihood that consumers will believe that applicant's services emanate from or are sponsored by the same source. See Recot Inc. v. M.C. Becton, 214 F.3d 1332, 54 USPQ2d 1894 (Fed. Cir. 2000); and Kenner Parker Toys Inc.

v. Rose Art Industries Inc. 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the Court stated in the Kenner Parker case, 22 USPQ2d at 1456:

> A strong mark, on the other hand, casts a long shadow which competitors must avoid. See e.g., Nina Ricci, 889 F.2d at 1074. Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls.

And the in the Recot case, 54 USPQ2d at 1897, the Court stated:

> Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.
> …
> This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive.

This factor, the fame of opposer's mark, weighs heavily in opposer's favor.

Turning next to a consideration of the parties' respective goods and services, in Board proceedings, the issue of likelihood of confusion must be determined in light

of the goods or services as identified in the involved application and registration and, in the absence of any specific limitations therein, on the presumption that all normal and usual channels of trade and methods of distribution are or may be utilized for such goods or services. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Of course, the plaintiff may assert (and prove) common law rights in a particular mark for particular goods or services as well. See Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990).

Applicant’s services are essentially (i) educational services providing instruction in CPR, first aid, wellness, and travel medicine, and (ii) medical testing and diagnostic services, and providing vaccinations. Opposer owns registrations for educational services in the nature of conducting seminars on health, fitness and related topics and producing radio and television programs on the health and fitness topics and providing information services in the fields of health and fitness via a web site to a multi-user global computer information network. As identified, we find

that applicant's and opposer's educational services are closely related.

Further, as explained earlier, opposer has established common law rights in the use of its PREVENTION mark for glucose screening for diabetes (in partnership with Wal-Mart and a pharmaceutical company), and for cholesterol tests, general health assessment tests, bone density tests, derma tests, and the like (in partnership with Pfizer Corporation and other co-sponsors of the "Heart Healthy Tours"). Applicant argues that although opposer is "allegedly famous for PREVENTION Magazine and the various promotional and advertising activities it engages in to promote the magazine," opposer's "focus is on being a source for 'health information' [but it is not a medical testing company]" (Brief, p. 15.) It is true that opposer is not a medical testing company. However, opposer has been providing health information in its *Prevention* Magazine since 1950, and it has provided medical tests and screenings (in cooperation with other co-sponsors) since 1999. Thus, there is a reasonable basis for the public to attribute the medical tests and screenings -- glucose tests in Wal-Mart, and various medical tests and screenings on the "Healthy Heart Tours" to opposer as the source thereof.

We find that opposer has established there is a close relationship between applicant's medical and diagnostic

services and opposer's common law rights in its mark for medical tests and screenings.

Turning next to the du Pont factors of trade channels and purchasers, with regard to the educational services, neither applicant's application nor opposer's relevant registrations includes any type of restriction as to trade channels or purchasers. Therefore, we must presume in this administrative proceeding that those services are sold in all normal channels of trade to all usual classes of purchasers for such goods and services. See Octocom Systems Inc. v. Houston Computers Services Inc., supra; and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra.

With regard to the medical testing and diagnostic services, there are no restrictions in applicant's identification of those services, thus it must be presumed that they are offered by applicant through all normal channels of trade to all usual classes of purchasers (including the general public), and opposer's evidence establishes that it offers (with co-sponsors) medical tests and screenings to the general public.

We find that the channels of trade and the classes of purchasers for the parties' services, as identified, and as proven by opposer, are similar and overlapping.

Turning next to a consideration of the similarities/dissimilarities of the marks, it is well

settled that marks must be considered in their entireties because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of one mark to another to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's and opposer's marks[6] share the dominant term PREVENTION. Applicant has added the component "MD" to the word "PREVENTION," and opposer's marks which consist of the word PREVENTION alone or include the word PREVENTION therein, such as PREVENTION'S GUIDE and

[6] Although opposer pleaded a "family" of marks, it did not seriously argue that point in its brief on the case. Moreover, it is well settled that mere adoption, use and registration of a number of marks having a common feature for similar or related goods or services does not in and of itself establish a "family" of marks. Rather, in order to establish a "family" of marks, it must be demonstrated that the marks asserted to comprise the "family," or a number of them, have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and Dan River, Inc. v. Apparel Unlimited, Inc. 226 USPQ 186 (TTAB 1985). The record before us does not prove that opposer has a "family" of PREVENTION marks.

PREVENTION AT WORK. However, these differences do not serve to distinguish the marks. The only word in opposer's primary mark and the dominant word in others of its registrations is PREVENTION and the dominant word in applicant's mark is PREVENTION. Thus, these marks, although obviously not identical, are similar in sound and appearance.

The connotation created by both applicant's mark PREVENTION MD and opposer's marks such as PREVENTION, PREVENTION'S GUIDE and PREVENTION HEALTH BOOKS would all be similar in that the word "PREVENTION" connotes the idea of thwarting or averting something before it becomes a problem, in this case relating to health and wellness. Applicant's mark may be viewed by consumers as another of opposer's "PREVENTION" marks.

When considered in their entireties, we find that applicant's "PREVENTION MD" mark and opposer's "PREVENTION" marks are similar in sound, appearance, connotation and commercial impression. See In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

Applicant argues that there is common use and there are third-party registrations of marks which include the word "PREVENTION" in the relevant fields, thus weakening the term as a mark. As evidence thereof, applicant submitted its notice of reliance on 23 third-party registrations which

include the word “PREVENTION,” and opposer’s answer to applicant’s interrogatory No. 10 asking about opposer’s knowledge of any third-party uses, to which opposer responded by listing five third-party marks.

To begin with, several of the 23 third-party registrations from the USPTO’s Trademark Electronic Search System (TESS) are not for related goods or services, (e.g., Registration Nos. 2614317 for a dietary supplement to assist in recovering from a hangover; 2414692 for distributorships and rental of medical equipment; 2042724 for mouthwash and medicinal antiseptic gargle; and 2674701 for herbicides and pesticides). Others are for marks with significantly different and separate commercial impressions (e.g., Registration Nos. 2075208 for the mark AMERICAN SOCIETY OF CLINICAL ONCOLOGY 1964 PREVENTION RESEARCH TREATMENT EDUCATION and design; 2516657 for the mark CSTR EDUCATION PREVENTION QUALITY RESEARCH and design; 2607311 for the mark H.O.P.E. HIGHMARK OSTEOPOROSIS PREVENTION AND EDUCATION and design; and 2442041 for the mark HEALTHY HEART COMMUNITY PREVENTION PROJECT “YOU GOTTA HAVE HEART” and design. The record, therefore, includes only a minimal number of relevant third-party registrations. (Applicant listed seven in its brief on appeal.)

Moreover, it is well settled with regard to the weight to be given to third-party registrations, that these

registrations are not evidence of use of the marks shown therein in the marketplace or that the public is familiar with them. Thus, we cannot assume that the public has become able to distinguish between them. See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989).

Opposer's answer to applicant's interrogatory No. 10 shows that opposer is aware of uses by others of five marks which include the word "PREVENTION." But, applicant did not pursue information on any of these third-party uses and there is no further information in the record thereon (e.g., the goods or services involved, the nature of the uses, the extent of the uses). Therefore, this evidence of third-party use is entitled to little probative weight under the du Pont factor of the number and nature of similar marks in use.

In short, the mere fact that there are a few third-party registrations and that opposer is aware of a few third-party uses of marks which include the term "PREVENTION" does not detract from opposer's use of and the public perception of its marks, including the fame of opposer's marks as discussed above.

The absence of actual confusion is not surprising given the relatively short duration of use by applicant of its

mark (commencing sometime in 2000), and that applicant offers its services in a limited geographic area in the Northwest. Thus, this du Pont factor is neutral. In any event, the test is not actual confusion, but likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

In balancing the du Pont factors in this case, we keep in mind the holding of our primary reviewing Court that fame, when present, plays a "dominant" role in determining the question of likelihood of confusion. For example, in the Recot case, 54 USPQ2d at 1897 and 1898, the Court stated:

> The fifth *DuPont* factor, fame of the prior mark, when present, plays a "dominant" role in the process of balancing the *DuPont* factors. Famous marks thus enjoy a wide latitude of legal protection. (Citations omitted.)
> …
> Accordingly, we hold that the fame of the mark must always be accorded full weight when determining likelihood of confusion.
>
> …
>
> Indeed, this court and its predecessor court have consistently stated that the fame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods.

Given the fame of opposer's mark, and the long shadow it casts, we find that the marks and the goods and services are sufficiently similar and related to support a finding of likelihood of confusion. (And in this case it is also established that there are overlapping trade channels and similar purchasers.)

We agree with applicant that there is no evidence of applicant's intent to cause confusion in this case. Nonetheless, this factor is of little weight in this case because, as stated by the Court of Appeals for the Federal Circuit (our primary reviewing court), in J & J Snack Foods Corp. v. McDonald's Corp., supra, 18 USPQ2d at 1891: "Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion. (citation omitted)."

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The oppositions are sustained and registration to applicant is refused for each application.