

THIS OPINION IS
NOT A PRECEDENT
OF THE T.T.A.B.

Mailed:
May 7, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Medica Health Plans

v.

Sharon Rousmaniere

Opposition No. 91172089

Eric D. Paulsrud of Leonard, Street and Deinard for Medica Health Plans.

Jon A. Schiffrin, Esq. for Sharon Rousmaniere.

Before Drost, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On October 28, 2005, Sharon Rousmaniere ("applicant") filed an application (Serial No. 78742277) for the mark GOMEDICA (in standard character form) for "on-line business directories featuring medical providers; providing on-line directory information services also featuring hyperlinks to other web sites" in International Class 35. The application

claims a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 35 U.S.C. § 1051(b).

Medica Health Plans ("opposer") has opposed registration of applicant's mark. In the notice of opposition, opposer claims ownership of numerous registrations for marks comprising the term MEDICA alone or MEDICA and other terms, including the following registrations:

Registration No. 1761828 (renewed November 24, 2003) for the mark MEDICA (in typed form) for "comprehensive health care plans and health plan management services" in International Class 42;

Registration No. 2113265 (renewed September 2, 2007) for the mark MEDICA (in typed form) for "administration of prepaid healthcare plans; healthcare plan administration services; underwriting healthcare plans; underwriting insurance for prepaid healthcare" in International Class 36, and "healthcare in the nature of health maintenance organizations (HMO)" in International Class 42; and

Registration No. 2851516 (issued June 8, 2004) for the mark MEDICA (in typed form) for, inter alia, "physician, dental, hospital, clinic and pharmacy referral services provided via a global computer network" in International Class 35.

Applicant has also alleged that it has a family of marks, that it has priority and that confusion, mistake and deception are likely to be caused by applicant's use of its mark on the services described in its application. Further, opposer has alleged that its marks are "both well-known and famous in Registrant's geographic market area and elsewhere

throughout the United States." Notice of opposition at paragraph 20.

Applicant has filed an answer denying the salient allegations of the notice of opposition. The opposition has been fully briefed.

The Record

In addition to the pleadings and the status and title copies of the pleaded registrations submitted with the notice of opposition, see Trademark Rule 2.122(d), 35 C.F.R. § 2.122(d), the record contains the file history of applicant's application, opposer's notice of reliance, opposer's supplemental notice of reliance, the testimony, with exhibits, of Robert Longendyke, opposer's senior vice president of marketing and communications, and applicant's notice of reliance.

Standing/Priority

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, priority is not an issue in this case because (i) applicant has admitted that opposer is the prior user of the mark MEDICA on the services listed in each of the pleaded registrations, opposer's notice of reliance, ex. 18,

response to request for admission no. 4, and (ii) opposer's pleaded registrations are of record. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) 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). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Fame

The *du Pont* factor concerning the fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries*,

Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). That is, we look to the class of customers and potential customers of a product or service, and not the general public. Here, the relevant consuming public includes prospective and actual purchasers or users of healthcare providers. See *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas*, 77 USPQ2d 1492 (TTAB 2005), *aff'd*, 81 USPQ2d 1919 (Fed. Cir. 2007).

Opposer has established that it has a substantial number of members and substantial revenue and that its revenue and membership has been increasing; in 2001 opposer had 954,075 individual members with \$1,520,601,000 in revenue, and in 2005 opposer had 1,238,486 members with \$2,219,177,000 in revenue. Longendyke dep. at p. 38; ex. 1 at p. 31. Additionally, opposer has established that its advertising expenditures are substantial, amounting to "in excess of a million dollars a year" since 2001. Longendyke dep. at p. 40. Further, opposer has "about a 40 percent" market share in Minneapolis and "about 25 percent" market share in the state of Minnesota. *Id.* Opposer also offers

healthcare services to consumers in three additional states, i.e., North Dakota, South Dakota and Wisconsin.¹ Longendyke dep. at p. 7; ex. 6 to Longendyke dep.

We find that this evidence strongly indicates that a significant portion of the relevant consuming public associates MEDICA with opposer's business activities. Opposer has a significant market share in a major U.S. city and does business in four states. Its revenues, membership and advertising expenditures are significant in size. Opposer's website and advertising material of record prominently feature the MEDICA mark for a variety of healthcare related services. Longendyke dep. ex. 2 - 4. Thus, we find that MEDICA is an extremely well known mark in the geographic area in which it does business, especially in Minnesota, and that opposer is entitled to benefit from the *du Pont* factor regarding the fame of the mark. We acknowledge that MEDICA is not known nationally, but national fame is not necessary. See, e.g., *Karl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995) (opposer had established notoriety in a specific area of operation); *Berghoff Restaurant Co. v. Washington*

¹ Mr. Longendyke has testified that "Medica is going beyond the four-state region ... pretty much spanning the United States." Longendyke dep. at pp. 11 - 12. It is not clear which of opposer's services Mr. Longendyke is referring to in his testimony. Thus, we do not find that opposer offers its services nationally - his testimony in this regard has limited probative value.

Forge, Inc., 225 USPQ 603 (TTAB 1985) (opposer's proof of fame of its mark within a limited geographic area sufficient to find its mark famous for purposes of the likelihood of confusion analysis). This factor therefore weighs heavily in favor of finding a likelihood of confusion.

The Services

We turn next to the *du Pont* factor regarding the similarity or dissimilarity of opposer's and applicant's services, beginning with opposer's services recited in Registration No. 2851516. Opposer's services are "physician, dental, hospital, clinic and pharmacy referral services provided via a global computer network" and Applicant's services are "on-line business directories featuring medical providers; providing on-line directory information services also featuring hyperlinks to other web sites." Opposer maintains that the services are "not merely highly related, but identical." Applicant's response is that this is "speculation," but has not offered any specifics or evidence on how the services differ. Rather, applicant maintains that in view of the differences in the marks, confusion is not likely, and that this *du Pont* factor does not favor either party. Brief at p. 14.

A page from applicant's website explains applicant's services:

People Seeking Healthcare Consult GoMedica™

Through extensive key word marketing, search engine optimization, links on key sites, traditional advertising and more, we position GoMedica™ and you to be seen by people searching for healthcare providers.

When a person searches for your specialty - or the diagnostic procedures or treatments you offer - in your geographic area, your profile appears. Only after someone reads about you and then goes on to contact you do we charge a fee.

Longendyke ex. 11 at p. 1. Additionally, the following statements appear in a "demo" on applicant's website:

GoMedica helps people take control of their health by letting them search a wide range of healthcare options.

People can search for Physicians, Psychologists, Naturopaths, Acupuncturists, Dentists, Optometrists and many other practitioners.

They can also use GoMedica's keyword option to search by treatment or condition.

This step allows users to refine their search by choosing the type of specialist and distance they are willing to travel.

They can also use this page to search for specific treatments or insurance coverage among other things.

From this listing, the user can click through to the Provider Profile Page of a practitioner to learn more about him or her.

Longendyke dep. ex. 11 at pp. 4 - 10. With regards to opposer's services, Mr. Longendyke has testified that "we help people to find providers within [our] network, physicians, facilities, hospitals." Longendyke dep. at p. 10.

Because both opposer's and applicant's services encompass locating medical providers via a global computer network, we find that opposer's and applicant's services are legally identical.

As for opposer's comprehensive health care plans and HMO services recited in its two other registrations, we find that applicant's services are similar to those services. The Board has found services to be similar when they are related in some manner or the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same provider. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Here, applicant's services may be used to locate a provider of health care services within opposer's health care plans or HMOs. In other words, applicant's GoMedica services may be used to find Medica health care providers. Hence, there is a relationship between such services.

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity of the services in opposer's favor.

Classes of Consumers and Trade Channels

Applicant has admitted that "one intended group of users" of its services is "individuals seeking a physician or other health care." Opposer's notice of reliance, ex. 18, response to request for admissions no. 16. Such "users" include consumers of opposer's services recited in all three of the registrations mentioned above. Thus, the classes of purchasers overlap.

Additionally, because neither party further limits its trade channels beyond the Internet, we consider the parties' respective services to be offered in all of the normal and usual channels of trade and methods of distribution for such on-line services. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). In view thereof, we find too that the trade channels overlap or are otherwise related to one another.

The *du Pont* factors regarding the classes of consumers and trade channels are therefore resolved in opposer's favor.

The Marks

We next consider the similarity or dissimilarity of the marks as to appearance, sound, connotation and commercial

impression. *Palm Bay*, 73 USPQ2d at 1691. While we must consider the marks in their entirety, in articulating reasons for reaching a conclusion on the issue 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 of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We keep in mind that when marks would appear on identical services, as they partially do here, the degree of similarity necessary to support a conclusion of likely confusion declines with respect to that class of services (in this case, the International Class 35 services). *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's mark GOMEDICA only differs from opposer's mark MEDICA in that applicant's mark includes the word GO before MEDICA. The connotation of GOMEDICA is to go with, or to go to, MEDICA, both of which encourage the consumer to use the service offered by a provider known as MEDICA. See *Malarkey-Taylor Assocs. V. Cellular Telecommunications Indus. Assn.*, 929 F. Supp. 473, 40 USPQ2d 1136 (D.D.C. 1996) ("The Court finds several confusing similarities between WirelessNOW and Go Wireless Now! ... Defendant precedes those words with 'Go' and completes its mark with an exclamation point, but each of these additions can easily be read as

flourishes added to encourage people to use a product with a name composed of 'wireless' and 'now' in conjunction with each other."). Because GO is a directive to the consumer, we give more weight to MEDICA in applicant's mark and find that the marks are highly similar in connotation and commercial impression.

The marks are similar in appearance too. Both marks include the term MEDICA. Further, as opposer correctly points out, applicant's mark is in standard character form, and hence applicant is not limited to displaying its mark in a particular manner or style. Applicant may depict its mark with GO in substantially smaller lettering than MEDICA, or in a different font or color shade than MEDICA. See *Phillips Petroleum Co. v. C.J. Webb Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). In fact, applicant has admitted that "a proposed use of GOMEDICA will be the use of a capital letter 'G' and a capital letter 'M'"; and that "a proposed use of GOMEDICA will be using the word 'Go' in a lighter shade of blue and the word 'Medica' in a darker shade of blue." Longendyke dep. ex. 18, response to request for admissions nos. 7 and 8. Also, in response to opposer's request for admissions no. 6, applicant admitted that it intends to use its mark in the following form:



We therefore find that MEDICA in applicant's mark will create a greater impression on purchasers than GO. With respect to the sound of the marks, the addition of GO to MEDICA is a minor addition; the pronunciation of MEDICA is not affected by the addition of GO.

Applicant has made of record numerous third-party use-based registrations for marks containing the term "medica" in the health and healthcare fields. According to applicant, they show that "medica" is "diluted"; that "all of these marks coexist on the Principal Register, even with the shared use of 'medica'"; that "this portion of the underlying marks ought to be given a narrow scope of protection"; and that "'medica' translates to 'medical,' and is so commonly used that the public will look to other elements to distinguish the source of the goods, including but not limited to, the other different letters that compose GOMEDICA" Brief at p. 12.

We first make it clear that we reject any suggestion by applicant that MEDICA is a descriptive term. MEDICA is the subject of several registrations which are entitled to the presumptions of Section 7(b) of the Trademark Act, 35 U.S.C. § 1057(b), and applicant's suggestion that MEDICA is descriptive is a collateral attack on such registrations, which are not the subject of a counterclaim or a separate petition. See *Countour Chain-Lounge Co., Inc. v. The*

Englander Co., Inc., 324 F.2d 186, 139 USPQ 285 (CCPA 1963); Trademark Rule 2.106(b)(2)(ii), 37 C.F.R. § 2.106(b)(2)(ii).

We next point out that the third-party registrations submitted by applicant are not evidence of use of the marks shown therein. Without evidence of use, the third-party registrations prove nothing about the impact of the third-party marks on purchasers in terms of conditioning consumers as to the existence of similar marks in the marketplace.

AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). They may, however, be relied on to show that a word common to each mark has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). In this case, the record does not show that there is any English language definition of "medica." The third-party registrations for marks including MEDICA for goods or services related to the healthcare field establish that those in the healthcare field use MEDICA in a manner intending to connote "medical." Such use tends to show that MEDICA is suggestive. However, this does not appreciably weaken the strength of opposer's mark.

Applicant has also argued that "medica" can be translated to "doctor" or "medical" and cites to several third-party registrations which include a translation

statement identifying "medica" as "doctor" or "medical," and an entry from *Cassell's Spanish & English Dictionary* (1969) submitted with applicant's notice of reliance. We are not persuaded by applicant's argument. Simply because a translation exists does not persuade us that consumers of opposer's services would "stop and translate" opposer's mark. *Palm Bay*, 73 USPQ2d at 1696 ("The doctrine [of foreign equivalents] should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent," citing *In re Pan Tex Hotel Corp.*, 190 USPQ 109 (TTAB 1976)).

Additionally, applicant has submitted third-party registrations "showing 'GO' used with other words for similar services ... in which none of them found 'go' to be descriptive in any way such as GO LOCAL, GO NANNIES, GO HWY, and GO SMART, which are all involved with online information services." Applicant's brief at p. 6. She has also submitted third-party registrations in support of her contention that "'go' coexists with a stand alone mark, such as TIME and GOTIME for online magazines and travel information services, PORT and GOPORT for software for interfacing a global computer network and providing access to a global computer network, and PAN and GOPAN for online database retrieval and removing information from computer networks" *Id.* at p. 7. According to applicant, "'go,'

which has not been found descriptive in the past for similar services, should be given more weight due to the descriptive or suggestive nature of the term 'medica.'" Brief at p. 7.

Applicant's argument is not persuasive. Some of the marks comprise slogans which the assigned examining attorney may have considered unitary and for this reason did not require a disclaimer of GO. Others are for services that are unrelated to applicant's and registrant's services. See Registration No. 3238889 for "educational services, namely, instructing youngsters and women in the fundamentals of running, track and field and cross country by organizing and conducting running clubs and training programs." Also, each case must be decided on its own merits, and previous decisions by examining attorneys are not binding on the Board. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity or dissimilarity of the marks in opposer's favor.

Conditions of Sale and Sophistication of Purchasers

Applicant maintains that this factor "is of minimal importance." This factor hence does not favor either party.

Variety of Goods/Services on Which the Mark is Used

As mentioned at the beginning of this decision, opposer has pleaded that it owns a family of marks. It has not specified the members of its alleged family of marks, and has not even sought to establish that it has advertised and promoted the family in a manner designed to create an association of common origin for all marks containing the family formative or "surname." See generally, 4 *McCarthy on Trademarks and Unfair Competition* § 23:61 (4th ed. 2007).

Additionally, opposer has not specified what "health plan products and services" it would like us to consider under this *du Pont* factor, and we will not cull through the record to locate evidence of use of such marks on "health plan products and services" which opposer could be referring to in arguing that this factor be resolved in its favor. We therefore find that this factor does not favor either party.

Remaining du Pont Factors

We have also considered the limited discussion of the remaining *du Pont* factors which the parties have provided in their briefs and any evidence pertaining thereto. Such factors either are not relevant or are neutral in our analysis.²

² Applicant, in her discussion regarding her right to exclude others from the use of her mark, has requested that we take judicial notice of opposer's failure to oppose an earlier application, since abandoned, for the mark GOMEDICA. Applicant's request is denied as being outside the scope of matters for which

Conclusion

In balancing the above factors, and particularly considering the regional fame of MEDICA and Federal Circuit precedent providing that the fame of the mark is a dominant factor in questions of likelihood of confusion, we find that opposer has established by a preponderance of the evidence that there is a likelihood of confusion between its marks and applicant's mark.

DECISION: The opposition is sustained and registration to applicant is refused.