

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed: August 18, 2005
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Essential Medical Supply, Inc.
v.
Invacare Corporation

Cancellation No. 92042736

Enrique G. Estevez, Esq. of Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A. for Essential Medical Supply, Inc.

Bradford J. Patrick of Mansour Gavin Gerlack & Manos Co. LPA
for Invacare Corporation.

Before Hairston, Walters and Walsh, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

A petition has been filed by Essential Medical Supply,
Inc. to cancel a registration issued to Invacare Corporation
for the mark ESSENTIAL for "wheelchair cushion."¹

¹ Registration No. 2,746,780, issued August 5, 2003, claiming
first use and first use in commerce in August 2001.

As grounds for cancellation, petitioner asserts that since at least as early as 1991 it "has used the name ESSENTIAL in connection with wheelchair cushions by using the name on packaging and advertising..."; that it is the owner of application Serial No. 78252574 for the mark ESSENTIAL MEDICAL SUPPLY for "wholesale services featuring medical supplies"; and that respondent's mark ESSENTIAL, when used on wheelchair cushions, so resembles petitioner's marks ESSENTIAL and ESSENTIAL MEDICAL SUPPLY, INC. as to be likely to cause confusion.²

Respondent, in its answer to the petition to cancel, denied the salient allegations therein. As an affirmative defense respondent asserts that the petition is barred by laches and estoppel because prior to filing the petition to cancel petitioner did not notify respondent of its objections. In addition, respondent asserts that "[p]etitioner's claimed use of the mark ESSENTIAL as represented in the Petition only occurs as part of Petitioner's mark ESSENTIAL MEDICAL SUPPLY, INC. and is not used separately to identify any goods or services."

² We note that attached to the petition to cancel are copies of packaging and advertising materials. An exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced into evidence as an exhibit during the period for taking testimony. Trademark Rule 2.122(c). These exhibits were not introduced by petitioner at trial and therefore we have given them no consideration in reaching our decision herein.

Evidentiary Matters and the Record

Before turning to the merits of the case, we must consider several evidentiary matters. First, we note that both parties submitted their respective testimony by way of affidavit. While generally the Board requires a stipulation to introduce testimony in the form of an affidavit, since neither party has objected to the adverse party's testimony on this basis, we deem the parties to have stipulated to the introduction of testimony by way of affidavit.

Second, respondent has objected to the rebuttal testimony affidavits of petitioner's witnesses Carol Hoepner, Tara Baril, Elizabeth Flippinger, and Erica Ladd as improper rebuttal. The rebuttal testimony concerns alleged instances of actual confusion and the relationship between petitioner and respondent. Respondent's objections are sustained to the extent that testimony as to alleged instances of actual confusion are elements of opposer's case-in-chief. It was incumbent upon petitioner, during its case-in-chief, to introduce testimony relating to the specific nature of the alleged instances of actual confusion. In other words, petitioner could not wait until its rebuttal testimony period to offer details about the alleged instances of actual confusion.

However, the rebuttal testimony concerning petitioner's and respondent's relationship will be considered since this

evidence is in rebuttal to respondent's testimony that respondent sold products to petitioner.

In view of the foregoing, the record consists of the file of the subject application, the affidavit and rebuttal affidavit (with exhibits) of petitioner's owner, Carol A. Hoepner; and the affidavit of respondent's vice-president, Bridget A. Miller.

Briefs have been filed, but an oral hearing was not requested.

The Record

Petitioner's witness Carol A. Hoepner avers, in relevant part, that:

Since June 3, 1985, I have owned and operated Essential Medical Supply, Inc. ("EMS") a wholesaler of medical equipment presently located at 4515 Metric Drive, Suite 3, Winter Park, Florida 32792.

Since May 1, 1986, EMS has used the mark ESSENTIAL MEDICAL SUPPLY, INC. and design on all its advertisements, catalogs and goods.

EMS has come to be well known in the industry, particularly by the term ESSENTIAL, which is the most pertinent and distinctive component in its mark.

The U.S. Patent and Trademark Office has awarded trademark registration No. 2874628 to EMS's mark ESSENTIAL MEDICAL SUPPLY, INC. based on our company's continuous use of this mark in interstate commerce since May 1, 1986.

EMS has sold wheelchair cushions under the mark ESSENTIAL MEDICAL SUPPLY, INC. since 1987.

Invacare's use of the mark ESSENTIAL, for its wheelchair cushions has already caused confusion in the marketplace, as I myself have taken calls from customers confusing our company as to the source of wheelchair cushions sold under the mark ESSENTIAL by

Invacare; in addition I am aware that our customer service department has received numerous inquiries from customers who have mistaken EMS as the source of Invacare's ESSENTIAL wheelchair cushions.

Respondent's witness, Bridget Miller avers, in relevant part, that:

Since July 1993, I have been employed by Invacare Corporation ("Invacare") in its legal/risk management department. Currently, I am its Vice President and General Counsel.

According to the company records of Invacare, Invacare sold goods to Essential Medical Supply, Inc. ("EMS") between June 1989 and January 1994, and thereafter EMS's account was closed.

Invacare is the durable medical equipment industry leader and known as the manufacturer of a line of wheelchair cushions branded with the registered trademark ESSENTIAL®.

According to the records of the company of Invacare, Invacare has neither awareness of, nor possession of, any actual or potential confusion in the trade, or among the public, concerning the source of manufacture of Invacare's wheelchair cushions marketed under its registered trademark ESSENTIAL® and of any goods sold by EMS under its registered mark Essential Medical Supply, Inc.®

According to the company records of Invacare, EMS has never demanded that Invacare cease and desist use of Invacare's registered trademark ESSENTIAL.®

Petitioner's witness Carol Hoepner, avers in her rebuttal affidavit, in relevant part, that:

The relationship between [petitioner and respondent] was much closer than that between mere seller and buyer, in fact, EMS was an authorized distributor for Invacare and Invacare acted as an original equipment manufacturer for Essential's Endurance Wheelchair.

Petitioner EMS has been unable to previously notify Invacare of instances of actual confusion because we did not become aware of the problem until we discovered

Invacare's pending application for federal registration of the mark ESSENTIAL.

While myself and others in our company separately handled a number of phone calls from dealers asking various details regarding "Essential" wheelchair cushions which were not in our catalog, because we had no formal process for internally sharing this anecdotal information, the misguided calls were individually attributed to inattentive customers.

We did not collectively recognize that there was a serious problem of confusion in the marketplace until after one of our employees by chance happened to check the on-line trademark records available from the Patent and Trademark Office and discovered that Invacare had filed an application for trademark registration for the subject mark. Once this was brought to the company's attention and the information about the various misguided phone calls was pieced together, it became clear that there was trademark confusion taking place.

Priority

Turning first to the issue of priority, although petitioner's witness, Ms. Hoepner, avers that petitioner owns a registration for the mark ESSENTIAL MEDICAL SUPPLY, INC., petitioner failed to make such registration of record. (See Trademark Rule 2.122(d)). Thus, petitioner may not rely on this registration to prove its priority. Instead, petitioner must rely on common law use of ESSENTIAL MEDICAL SUPPLY, INC. to prove its priority. Petitioner's witness Ms. Hoepner averred

that since 1986 petitioner has used the mark ESSENTIAL MEDICAL SUPPLY, INC. and design on all its advertisements, catalogs and goods and that petitioner has sold wheelchair cushions under the mark ESSENTIAL MEDICAL SUPPLY, INC. since 1987. It is not necessary that petitioner submit documentary evidence to support its date of first use. The testimony of a single witness can be sufficient to prove priority. See 3 J. Thomas McCarthy: McCarthy on Trademarks and Unfair Competition § 16.06(2) (4th ed. 2005). Petitioner's 1987 date of first use is earlier than respondent's claimed date of first use of August 2001. Thus, petitioner has established its priority with respect to the mark ESSENTIAL MEDICAL SUPPLY, INC. for wheelchair cushions.

Likelihood of Confusion

Our determination 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 likelihood of confusion issue. See *In re E. I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1971). In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider first the goods of the parties, and obviously they are identical - wheelchair cushions. This factor weighs in favor of a likelihood of confusion.

Considering next the marks, as our principal reviewing court has indicated, while marks must be considered in their entirety, including any descriptive matter, 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, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive . . . with respect to the involved goods and services is one commonly accepted rationale for giving less weight to a portion of a mark . . . " Id.

In this case, when the respective marks are considered in their entirety, it is plain that they are highly similar in appearance, sound, connotation and commercial impression. The dominant portion of petitioner's mark ESSENTIAL MEDICAL SUPPLY, INC. is the word ESSENTIAL due to the descriptive or generic nature

of the words MEDICAL SUPPLY, INC. The word ESSENTIAL is respondent's mark in its entirety.

Moreover, the proper test for confusing similarity is not whether the marks in their entireties are distinguishable on the basis of a side-by-side comparison inasmuch as this is not ordinarily the way that consumers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Here, the descriptive words MEDICAL SUPPLY, INC. in petitioner's mark, while not present in respondent's mark, are insufficient to distinguish such marks, due to the fact that their shared term ESSENTIAL creates a substantial similarity in sound, appearance, meaning and commercial impression in the marks. This factor also favors a likelihood of confusion.

This brings us to the affirmative defenses of laches. To prevail on this affirmative defense, respondent had to establish that there was undue or

unreasonable delay by petitioner in asserting its rights, and prejudice to respondent resulting from the delay. *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Quest de la France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001). For purposes of determining whether there has been unreasonable delay, we look to the publication date and issue date of the subject registration. See *National Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1581, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (laches runs from the time from which action could be taken against the trademark rights inhering upon registration). Petitioner brought this cancellation proceeding on December 5, 2003, only four months after the issuance of the registration on August 5, 2003. Thus, petitioner did not unduly delay in bringing this petition to cancel. Moreover, there is no evidence that respondent was prejudiced in this very short period of time. In view thereof, we find that respondent has not demonstrated that petitioner's claim is barred by laches.

The parties have argued with respect to whether any instances of actual confusion have occurred. The testimony of petitioner's witness is too limited to establish actual confusion. Nonetheless, the fact that there is no evidence of actual confusion of record does

Cancellation No. 92042736

not persuade us to find that confusion is not likely. Evidence of actual confusion is not a prerequisite to finding likelihood of confusion.

We accordingly conclude that contemporaneous use by respondent of the mark ESSENTIAL in connection with wheelchair cushions is likely to cause confusion with petitioner's use of ESSENTIAL MEDICAL SUPPLY, INC. in connection with the identical goods.

Decision: The petition to cancel is granted.