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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PBC Supply, Inc.

Serial No. 77435787

Gregory C. Smith, Charles C. Garvey, Jr., Seth M. Nehrbass,
and Brett A. North of Garvey, Smith, Nehrbass & North,
L.L.C. for PBC Supply, Inc.

Midge F. Butler, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Zervas and Kuczma, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

PBC Supply, Inc. ("applicant") filed an application
(Serial No. 77435787) to register MEDISLIM (in standard
character form) on the Principal Register for "medically
supervised weight loss and weight reduction program for
patients" in International Class 44. Applicant claims
first use and first use in commerce on March 20, 1989.

The examining attorney finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the previously registered mark



(MEDSLIM MEDICALLY PRESCRIBED WEIGHT CONTROL RX and design, Registration No. 2808261), for "clinic services for weight reduction, diet planning and program supervision," also in International Class 44, as to be likely to cause confusion or mistake or to deceive. Registrant disclaimed MEDICALLY PRESCRIBED WEIGHT CONTROL and the representations of the caduceus and prescription symbol (RX).

Applicant appealed the final refusal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Neither the examining attorney nor applicant introduced any evidence into the record. Our determination under Trademark Act § 2(d) is therefore based on an analysis of the essential characteristics of the services and the differences in the marks. *See Federated Foods,*

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); and *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. The Similarity or Dissimilarity and Nature of the Services as Described in the Application.

In evaluating the relationship of the services, it is well settled that we must consider the services as they are identified in the application and registration and we cannot read limitations into those services that are not reflected therein. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Where the services are broadly described, and there are no limitations as to their nature or type, it is presumed that the scope of the application and registration encompasses all services of the nature and type described. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958); see also, *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1992).

Registrant recites "clinic services for weight reduction, diet planning and program supervision" and

applicant recites "medically supervised weight loss and weight reduction programs for patients." Medically supervised services are provided in clinical settings. Thus, both registrant's and applicant's services concern medically supervised services. Further, both registrant's and applicant's services concern weight reduction programs for patients. We therefore find that the services overlap.

In so finding, we reject applicant's argument that "Applicant's services are offered to consumers in a more structurally defined medical context, and not open to the general public." Brief at unnumbered pp. 2-3. Nothing in registrant's recitation of services precludes offering clinical services involving weight control in a "structurally defined medical context," and to the members of the general public. We also reject applicant's additional argument that, because applicant's services are "medically supervised," any likelihood of confusion is reduced because "a potential customer [who] wishes to obtain Applicant's Medislim program ... cannot simply walk into a pharmacy and purchase the product." Applicant's argument overlooks that fact that a potential customer may not consider registrant's services at a later time if he or she had a negative experience with applicant's services,

believing that the source of registrant's services was applicant.

B. The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression.

We next consider the marks. In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods [or services] offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212

USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the other hand, 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 the ultimate conclusion rests on a consideration of the marks in their entirety. *National Data Corp.*, 224 USPQ at 751. (For this reason, applicant's argument in its brief that "all of the words in a multi-word word mark should be given equal weight in the overall impression of the mark" is wrong.)

Registrant's mark is composed of MEDSLIM and MEDICALLY PRESCRIBED WEIGHT CONTROL as well as the representation of the caduceus and prescription symbol. MEDSLIM is the dominant feature in registrant's mark; it is in substantially larger letters than the other wording in the mark, and the remaining wording in registrant's mark is merely descriptive of registrant's services. Consumers will not look to such descriptive wording to distinguish registrant's mark from applicant's mark. Additionally, the symbols in the mark are descriptive of a feature of registrant's services, namely, the medical aspects of

registrant's services, and they too will not be considered as distinguishing features of registrant's mark.

Applicant concedes that "both Marks contain a single word which may be considered similar" Brief at unnumbered p. 2. We agree, and find that MEDISLIM is substantially similar to the dominant portion of registrant's mark. The terms only differ by the addition of the letter "I" in applicant's mark, with applicant's mark a combination of "MEDI" and SLIM, and registrant's mark being a combination of MED and SLIM. Both "medi-" and "med-" connote "medical," and the combinations both suggest a medical approach to controlling weight.

The lettering style of registrant's mark (which is rather ordinary) does not distinguish the marks. Applicant's mark is for the mark in standard character form, and therefore registrant is entitled to depictions of its mark in any font style. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

Because of the similarities between MEDISLIM and MEDSLIM, differing only by an "I" in the middle of the term which changes the pronunciation of registrant's mark only slightly, and because the additional wording and design elements in registrant's mark do not distinguish the marks,

we find that the marks, when considered as a whole, are similar in appearance, sound, meaning and commercial impression.

C. Conclusion

After careful consideration of the examining attorney's and applicant's arguments, we conclude that applicant's mark for its services is likely to cause confusion with registrant's mark for overlapping services.

Decision: The refusal to register under Trademark Act § 2(d) is affirmed.