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- EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85668043

MARK: EMEDESIS THE LEADER IN HOMECARE



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<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: E-FORMIS, LLC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

120152

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant E-FORMIS, LLC, appeals the examining attorney's refusal to register EMEDESIS THE LEADER IN HOMECARE DOCUMENT SERVICES (and design) for providing temporary use of non-downloadable computer software for use in obtaining and completing documents and forms for the healthcare industry. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on

the ground that the applied-for mark is likely to be confused with the registered mark E-MEDSYS for “computer software for tracking patient medical records information, namely, medical history, medication history and family history; Computer software for medical practice management, namely, bill processing, financial report generation and recording, collection processing, appointment scheduling and generation of user customized management reports; Computer software for providing medical patients secure Internet access to and management of information relating to their own appointments and medical profile; Computer software to facilitate communication between medical service providers and patients” in U.S. Registration No. 3634019.¹

FACTS

On July 3, 2012, applicant filed for registration on the Principal Register of EMEDESIS THE LEADER IN HOMECARE DOCUMENT SERVICES (and design). The identification specifies the services as “providing temporary use of non-downloadable computer software for use in obtaining and completing documents and forms for the healthcare industry.”

On October 31, 2012, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that the applied-for mark is likely to be confused with the mark in U.S. Registration No. 3634019, which is the wording E-MEDSYS. On March 17, 2013, the examining attorney made final the refusal to register. Applicant appealed the refusal to register on September 13, 2013 and filed its Appeal Brief (“Brief”) on October 7, 2013.

ARGUMENT

¹ The examining attorney also cited other registrations and one prior pending application in that Office Action. Those refusals were subsequently withdrawn in the Final Office Action dated March 17, 2013.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

I. APPLICANT'S MARK IS HIGHLY SIMILAR TO REGISTRANT'S MARK

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In this case, applicant's mark, EMEDESIS THE LEADER IN HOMECARE DOCUMENT SERVICES (and design), is confusingly similar to registrant's mark, E-MEDSYS. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH).

Applicant argues that the marks at issue are distinguishable based on applicant's inclusion of the wording "THE LEADER IN HOMECARE DOCUMENT SERVICES" in its mark. See Brief at 5-6. However, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). Here, the wording "THE LEADER IN HOMECARE DOCUMENT SERVICES" is descriptive and has been disclaimed.

Applicant also states that its mark is not similar to that of registrant because of applicant's inclusion of a square design containing a folder and cross. See Brief at 4. It is well established, though, that, for a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. See *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d

1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Finally, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). Here, the dominant, non-disclaimed portions of the marks, namely, "EMEDESIS" and "E-MEDSYS," are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Thus, given that the respective marks share phonetic equivalents of the same dominant, literal term, namely, "EMEDESIS" versus "E-MEDSYS," the marks must be found to be confusingly similar.

II. APPLICANT'S SERVICES AND REGISTRANT'S GOODS ARE RELATED

When analyzing an applicant's and registrant's goods and services for similarity and relatedness, that determination is based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application

and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

Here, the respective goods and services offered by applicant and registrant are related. Specifically, both applicant and registrant provide software in the area of medical care and healthcare, said software for use in locating, completing and submitting forms and documentation. Given the breadth of applicant's and registrant's identification of goods and services, it may be presumed that the software offered by each of the parties is intended for use by patients and healthcare providers alike. The documents and forms which may be completed through use of applicant's software may be the very same types of documents created by registrant's medical practice management software.

Applicant asserts that its trade channels and consumers are unique from that of registrant. In particular, applicant claims that its services are limited to home healthcare providers. *See* Brief at 7. However, absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and/or services and this wording is presumed to encompass all goods and/or services of the type described, including those in registrant's more narrow

identification. Contrary to applicant's statements, the only field of use offered in applicant's recitation of services is simply to identify "the healthcare industry" as a whole. No further specification was offered by applicant.

Also, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

Finally, applicant's arguments regarding the sophistication of the consumers of the goods and services at issue is simply not dispositive. *See* Brief at 8. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

CONCLUSION

For the reasons noted above, the examining attorney respectfully submits that applicant's proposed mark, EMEDESIS THE LEADER IN HOMECARE DOCUMENT SERVICES (and design), is confusingly similar to registrant's mark, E-MEDSYS, and prospective consumers encountering the marks in commerce are likely to mistakenly believe that the respective goods and services come from the same source. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register under Section 2(d) of the Trademark Act.

Respectfully submitted,

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