

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re West-Com Nurse Call Systems, Inc.
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Serial No. 86935321
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Dale P. DiMaggio and Kristina M. DiMaggio of Malin Haley DiMaggio & Bowen PA,
for West-Com Nurse Call Systems, Inc.

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Before Kuczma, Adlin and Coggins,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

West-Com Nurse Call Systems, Inc. (“Applicant”) seeks registration on the
Principal Register of the mark CAREBOARD (in standard characters) for:

Electronic indicator board incorporated and integrated into nurse-call systems including master stations, nurse stations, patient stations, audio and visual call panels, status panels, pull cord stations, communication control panels, and used in room for equipment and patient monitoring in hospitals, nursing homes and healthcare facilities; Medical workstation incorporated and integrated into nurse-call systems comprised of computer hardware and software for gathering and transmitting real time equipment and patient monitoring data and staff

information for use in hospitals, nursing homes and healthcare facilities; in International Class 9.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing Registration No. 4719872 owned by Aceso Interactive, Inc. ("Registrant"), for the mark ECAREBOARD (a standard character mark) for:

Video-on-demand transmission services, in International Class 38; and

Platform as a service (PAAS) featuring interactive computer software platforms for use by patients to access medical videos, patient-specific information, and advice on recovery processes during their hospitalization for use by hospitals and medical facilities, in International Class 42;

as a bar to registration.

When the refusal was made final, Applicant filed a notice of appeal and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under § 2(d) of the Trademark Act is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis,

¹ Application Serial No. 86935321 was filed on March 10, 2016, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as October 31, 2014.

two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We carefully considered all of the evidence of record and arguments as they pertain to the relevant *du Pont* factors including the channels of trade and the sophistication of customers as well as any evidence and arguments not specifically discussed in this opinion. To the extent that any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Marks

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). Inasmuch as Registrant's mark is ECAREBOARD while Applicant's mark is CAREBOARD, Registrant's mark incorporates Applicant's mark in its entirety.

While there is a perceptible difference between the marks, the proper test is not a side-by-side comparison, but instead whether the marks are sufficiently similar in terms of their overall commercial impression that persons who encounter the marks would be likely to assume a connection between the parties. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Franklin Mint*

Corp. v. Master Mfg. Co., 667 F.2d 1005, 212 USPQ 233, 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.”). Deletions of a portion of a mark, such as Applicant’s removal of the beginning letter “E” in Registrant’s mark, may be sufficient to avoid a likelihood of confusion only if the marks in their entirety convey sufficiently different commercial impressions. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression).

Applicant argues that here, there is no likelihood of confusion between its mark, CAREBOARD, and the cited mark, ECAREBOARD, in terms of sight, sound and commercial impression, as the addition of the letter “E” in the cited mark visually distinguishes the marks and changes their pronunciation. Thus, Applicant concludes, the marks create distinct commercial impressions overall such that consumers will not be confused,² citing *Altira Group LLC v. Philip Morris Companies Inc.*, 207 F.Supp.2d 1193, 63 USPQ2d 1438 (D. Colo. 2002) (despite the similarity and strength of the marks favoring plaintiff, no likelihood of confusion between the marks ALTIRA and ALTRIA) and *Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F.Supp.2d 1242, 82 USPQ2d 1722 (D. Kan. 2006) (no likelihood of confusion found between

² Applicant’s Brief on Appeal p. 4 (7 TTABVUE 9); Reply Brief p. 3 (10 TTABVUE 4).

CHLORAPREP and CHLORASCRUB where both marks were used for an antimicrobial solution used by medical professionals).

The cases on which Applicant relies provide little, if any, support here. *Altira* involved marks that were found to be similar in appearance and sound, ALTIRA and ALTRIA, despite the fact that two letters in defendant's mark were in reverse order from plaintiff's mark. The marks in *Media-Flex* both began with the same descriptive prefixes which were followed by entirely different suffixes. Here, by contrast, the "E" in Registrant's mark would be perceived as a characteristic or feature of Registrant's services, namely, that the products or services are electronic or Internet-related. Indeed, the "E" prefix is commonly recognized and understood as a designation for the Internet, particularly when it is followed by a separately identifiable term such as "CAREBOARD." See *In re Int'l Business Machines Corp.*, 81 USPQ2d 1677, 1679 (TTAB 2006) (the "E" in ESERVER would be perceived as a prefix standing for "electronic," and identify a server involved with the Internet); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000) ("E" is a prefix that is generally recognized as meaning "electronic" in connection with computers and the Internet); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1397 (TTAB 1999) ("E-ticket" is an abbreviated form of "electronic ticketing;" "E" has become a common descriptive term for the electronic abbreviation for electronic (*i.e.*, "E-")). Thus, the leading "E" is at best suggestive and less significant in creating the overall commercial impression of Registrant's mark. While marks must be compared in their entireties, there is nothing improper in giving more weight to certain features of the marks as being

more dominant or otherwise significant. *See In re Viterra*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 224 USPQ at 751.

Applicant also relies on Trademark Manual of Examining Procedure (“TMEP”) § 1207.01(b)³, which at subsection (iii) provides that additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entirety convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. In this case, however, the marks in their entirety convey substantially identical commercial impressions, and there is no evidence that the shared term CAREBOARD is merely descriptive or diluted. To the contrary, Applicant’s mark removes the descriptive “E” from Registrant’s mark. In short, the difference (a single, descriptive letter deletion) between the marks is not sufficient to avoid a likelihood of confusion given that the dominant portion of each mark is the identical, inherently distinctive term CAREBOARD. Both marks convey the same overall commercial impression as a whole, and thus are very similar.

B. Similarity of the Goods and Services and Channels of Trade

The nature and scope of the goods and services must be determined based on the identification of goods and services listed in the application and cited registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 USPQ2d at 1162; *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722.

³ Applicant’s Brief on Appeal p. 3 (7 TTABVUE 8).

Applicant explains that Registrant’s “[p]latform as a service (PaaS) is a cloud computing model that delivers applications over the Internet. As a PaaS provider, Registrant provides the cloud services and access needed in order for customers to use its video on demand transmission services.”⁴ Applicant argues that in contrast, its proprietary products are medical workstations incorporated into the nurse-call systems comprised of computer hardware and software for gathering and transmitting real time equipment and patient monitoring data and staff information for use in hospitals, nursing homes and healthcare facilities.⁵ According to Applicant, Registrant’s platform as a service and video on demand services do not include the nurse-call systems, equipment, or features listed in Applicant’s identification of goods. Thus, Applicant contends the goods and services identified in its application and the cited registration are distinguishable, limited in scope and marketed differently.⁶

Applicant’s argument that its “electronic indicator boards as a component integrated into the entire nurse call systems are clearly different from Registrant’s platform as a service and video on demand services”⁷ misses the mark. Applicant’s goods and Registrant’s services need only be “related in some manner” or, because of “the circumstances surrounding their marketing ... give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v.*

⁴ Applicant’s Brief on Appeal p. 5 (7 TTABVUE 10).

⁵ *Id.*

⁶ *Id.* at p. 6 (7 TTABVUE 11).

⁷ *Id.*

Triumph Learning LLC, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The Examining Attorney points out that Applicant's identified goods and Registrant's services could be marketed to the same customers, namely, hospitals providing a patient information board for communication purposes.⁸ Furthermore, Applicant's and Registrant's websites contain highly similar promotional information. For example, the webpage describing Applicant's goods indicates that its "Patient CareBoard™" product: "Helps ensure that patients and staff are on the same page. It helps boost staff efficiency as well as keeps patients informed along the way by communicating important reminders, updates, current requests and general information to assigned staff."⁹ Similarly, a portion of Registrant's website explains that Registrant's "eCareBoard®" is "[c]ritical to clinicians and informative for patients, families and caregivers" It also promotes Registrant's "eCareBoard®" as enhancing "communication between caregivers, patients and families; ... Increases patient's and family's understanding of their care and care journey; Engages patients in the care process ... eCareBoard® features: The eCB integrated with UpCare gives patients a medium to digitally communicate with the care team; ... Presents care team, patient goals, patient schedule, activity level, allergy, medication and diet information."¹⁰

⁸ March 23, 2017 Request for Reconsideration Denied at 1.

⁹ *Id.* at 3-5.

¹⁰ *Id.* at 2.

In other words, the identified goods and services are marketed to the same consumers, including hospitals, and provide overlapping functions, namely, providing patients with information on their care while hospitalized. Thus, the respective products and services are highly similar in purpose. Applicant's product aims to "keep patients informed." Registrant's product likewise "enhances communication between caregivers, patients and families." This close similarity is further supported by Applicant's specimen of record, which states that the goods "provid[e] up[-]to[-]date real time patient information for staff, patient, and patient's family to see[,] allowing patients, along with their family and friends, to be collaborative partners in their care plan" ¹¹

The Examining Attorney has established that despite certain differences, Applicant's goods and Registrant's services are related because they run on software and platforms that are often sold by the same source under the same marks.¹² Specifically, ten third-party registrations from the USPTO's X-Search database, owned by nine different owners, show that the same marks are registered for use in various industries in connection with the same or similar types of goods and services as those of identified in the application and cited registration.¹³ This evidence shows that the goods and services listed therein, namely, software and platforms, are of a

¹¹ Specimen, TSDR 5.

¹² Examining Attorney's Appeal Brief (9 TTABVUE 7).

¹³ See September 14, 2016 Final Action at 2-37, for Registration Nos. 5041487 for CHUTE, 4657723 for NABLE, 4744817 for METANEXGEN, 4919205 for IIP & Design, 5020166 for EXENSIO, 5037434 for CLOUDTRAX, 5023757 for CME MESSENGER, 5012867 for HACKERRANK, 5030814 for ACCELERATIONSYSTEMS, and 5026801 for ACCELERATIONSYSTEMS & Design.

kind that may emanate from a single source under a single mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). *See also In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

Additionally, the specimen of record shows that Applicant's CareBoard product is offered both as installed software and as Web-based software to hospitals and other healthcare facilities¹⁴ which are the same types of entities identified in Registrant's description of services. Accordingly, products and services similar to Applicant's and Registrant's are encountered in the same channels of trade by hospital employees responsible for such purchases as well as by various users of the products and services in hospitals and healthcare facilities. Therefore, Applicant's potential customers are likely to believe that Applicant's electronic indicator board that is integrated into nurse-call systems used for equipment and patient monitoring and its computer hardware and software for gathering and transmitting real time equipment and patient monitoring data and staff information, used in hospitals and other healthcare facilities, are related products emanating from Registrant or that Applicant's goods and Registrant's services are associated with the same source.

¹⁴ Applicant's specimen at 7 of 7.

C. Sophisticated Purchasers

The identifications of goods in Applicant's application and services in the cited registration reveal that the relevant purchasers are hospitals and healthcare and medical facilities, which Applicant argues are "sophisticated."

Here, any potential sophistication of the purchasers is outweighed by the findings of the strong similarity of the marks and the close relatedness of the goods and services. Under these circumstances, where the marks are nearly identical, even sophisticated purchasers may be confused. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990) (similarities in the marks and products overshadow the sophistication of the purchasers of expensive computer hardware and software systems); *In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009) ("While the purchasers of these products are likely to be professionals or at least somewhat careful purchasers, this would not mean there is no likelihood of confusion when the very similar marks CAPRI and CAPRI COLLECTION are used on products that have been shown to originate from a common source."); *In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1274 (TTAB 2009) ("Here, we cannot conclude that the sophisticated purchasers of ultrasound and MRI medical diagnostic equipment would not be confused when the marks TITAN and VANTAGE TITAN are used on these goods. These purchasers are likely to be aware that a single entity can be the source of both such products.").

II. Conclusion

In view of the highly similar marks and the closely related nature of the goods and services, even sophisticated and knowledgeable purchasers of Applicant's goods would be likely to be confused.

Decision: The refusal to register Applicant's mark CAREBOARD under § 2(d) of the Trademark Act is affirmed.