

This Opinion is Not a
Precedent of the TTAB

Mailed: September 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DCT LSPD, LLC

Serial No. 87019660

Joshua G. Jones of Reed & Scadino LLP,
for DCT LSPD, LLC.

Benjamin Rosen, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Bergsman, Gorowitz and Coggins,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

DCT LSPD, LLC (“Applicant”) seeks registration on the Principal Register of the mark LONE STAR PEDIATRIC DENTAL & BRACES and design, shown below, for “dentist services; orthodontic services; pediatric dentistry,” in International Class 44.¹

¹ Application Serial No. 87019660 was filed on April 29, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as August 1, 2010.



Applicant, in its application, describes its mark as follows:

The mark consists of a cow and a horse wearing braces holding a sign with the word[ing] “Lone Star Pediatric Dental & Braces” with an owl over the letter “L” and a cartoon star in place of the letter “A” and an armadillo at the feet of the cow.

Color is not claimed as a feature of the mark.

While Applicant disclaimed the exclusive right to use the words “Pediatric Dental & Braces,” it claimed that the entire word portion of the mark, LONE STAR PEDIATRIC DENTAL & BRACES, has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark LONE STAR (standard characters) for “medical services,” in Class 44, as to be likely to cause confusion.² Registrant’s LONE STAR mark registered under Section 2(f) of the Trademark Act (acquired distinctiveness).

² Registration No. 3582328, registered on March 3, 2009; Sections 8 and 15 affidavits accepted and acknowledged.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Preliminary Issues

A. Evidence attached to Applicant's brief.

Applicant attached evidence to its appeal brief. The Trademark Examining Attorney objected to the evidence attached to Applicant's brief on the ground that the evidence was not timely filed.³

Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides:

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

Applicant's submission of evidence with its brief was after the filing of the notice of appeal. Therefore, it is untimely. We sustain the objection, and we will not consider the evidence attached to Applicant's brief.

B. The third-party evidence in the prosecution history of the cited registration is not part of the record in this *ex parte* appeal.

Citing TBMP § 704.03(a) (June 2017), Applicant argues that the third-party evidence of use in the prosecution history of the cited registration is sufficient to

³ Examining Attorney's Brief (14 TTABVUE 3-4).

establish the weakness of the cited mark LONE STAR.⁴ TBMP § 704.03 refers to the application and registration files automatically of record in *inter partes* proceedings, not *ex parte* proceedings. Because neither Applicant nor the Examining Attorney submitted the prosecution history of the cited registration, it is not of record and it cannot be considered.

C. Google search result list as an exhibit to Applicant's response.

Applicant attached a Google search result list for "Lone Star Medical" as an exhibit to its November 1, 2016 Response to an Office Action. A list of Internet search results generally has little probative value, because such a list shows too little of the context in which the term is used on the listed web pages. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002) (finding the print-out of Internet search results to be of little probative value due to insufficient text to determine the nature of the information or its relevance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (noting that "[e]vidence of actual use of a phrase by a website has far greater probative value" than a search summary); *see also* TMEP § 710.01(b) (April 2017). The better practice is to submit copies of the website pages that show how the term is actually used.

In this case, however, Applicant submitted the list to show that different entities use the term "Lone Star" as part of their trade name or trademark. The content of the list is sufficient to accomplish that purpose. Accordingly, we consider the results of the Google search for the probative value it has.

⁴ Applicant's Reply Brief, pp. 1-2 (15 TTABVUE 2-3).

II. 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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.”); *see also In re i.am.symbolic, llc*, (No. 2016-1507; slip op. at 7) (Fed. Cir. Aug. 8, 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and

relatedness of the goods.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

A. The similarity or dissimilarity and nature of the services and established, likely-to-continue channels of trade.

Applicant is seeking to register its mark for “dentist services; orthodontic services; pediatric dentistry,” and the description of services in the cited registration is “medical services.”

“Dentistry” is defined as follows:

the profession or science dealing with the prevention and treatment of diseases and malformations of the teeth, gums, and oral cavity, and the removal, correction, and replacement of decayed, damaged, or lost parts, including such operations as the filling and crowning of teeth, the straightening of teeth, and the construction of artificial dentures.⁵

“Orthodontics” is defined as “the branch of dentistry dealing with the prevention and correction of irregular teeth, as by means of braces.”⁶

According to *Wikipedia*,

Dentistry is a branch of medicine that is involved in the study, diagnosis, prevention, and treatment of diseases, disorders and conditions of the oral cavity, commonly in the

⁵ *Dictionary.com* based on the **Random House Dictionary** (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

We have disregarded the definition from the **Collins English Dictionary** (collinsdictionary.com) attached to the October 6, 2016 Office Action (TSDR 9) because it is not clear it is based on “American English.” See *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1313 n.18 (TTAB 2014).

Citations to the TSDR data base are to the .pdf format.

⁶ *Dictionary.com* based on the **Random House Dictionary**.

dentition but also the oral mucosa, and of adjacent and related structures and tissues, particularly in the maxillofacial (jaw and facial) area. Although primarily associated with teeth among the general public, the field of dentistry or dental medicine is not limited to teeth but includes other aspects of the craniofacial complex including the temporomandibular and other supporting structure.⁷

A dentist is a healthcare professional.⁸

“Medical” is defined as “of or relating to the science or practice of medicine.”⁹

“Medicine” is defined, inter alia, as “the art or science or restoring or preserving health due to physical condition, as by means of drugs, surgical operations or appliances, or manipulations: often divided into medicine proper, surgery, and obstetrics.”¹⁰

By definition, “medical services” is broad enough to encompass “dentist services; orthodontic services; pediatric dentistry” because dentistry is a branch of medicine. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

The Examining Attorney also introduced excerpts from 15 third parties rendering both dental and medical services and copies of 10 use-based, third-party registrations that include dental and medical services in the description of services. Third-party registrations based on use in commerce that individually cover a number of different

⁷ February 24, 2017 Office Action (5 TTABVUE 6).

⁸ *Id.* at 7.

⁹ *Dictionary.com* based on the **Random House Dictionary** (2017).

¹⁰ *Id.*

services may have probative value to the extent that they serve to suggest that the listed services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Representative registrations, with relevant portions of the identifications, are listed below.

Mark	Reg. No.	Services
ADVANCED CHOICE	3975769	Dentist services; dentistry; medical services
FOR KIDS, FOR PARENTS, FOR FUN	4109966	Dentist services; medical services
ARIYANA	4134346	Dentist services; medical services

Relying on an article published in *The Atlantic*¹¹ and the Obamacare website (obamacarefacts.com),¹² Applicant argues that “medical services” and dentistry are distinct activities.

...[S]ince the beginning of time, dentistry and medicine have been considered inherently distinct practices. The two have never been treated the same way by either the medical system or public insurance programs.¹³

* * *

The Affordable Care Act, or Obamacare, greatly expanded access to medical care. ... But dental coverage is not a

¹¹ Khazan, “Why Don’t We Treat Teeth Like the Rest of Our Bodies?” (September 2014) attached to Applicant’s November 1, 2016 Response to an Office Action (TSDR 9-19).

¹² Applicant’s November 1, 2016 Response to an Office Action (TSDR 20-25).

¹³ Khazan, “Why Don’t We Treat Teeth Like the Rest of Our Bodies?” (September 2014) attached to Applicant’s November 1, 2016 Response to an Office Action (TSDR 12).

required benefit under either Obamacare or most Medicaid plans.¹⁴

The partition between dentistry and the rest of medicine dates back to the dental profession's roots as an offshoot of hairdressing. Until the 1800s, barbers served as rudimentary dentists, pulling painful teeth and lancing abscesses after they finished trimming whiskers.¹⁵

While dentistry is a category of medicine and falls within the broad category of medical services, it is also a distinct activity. However, we must consider the services as they are described in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”); *see also Paula Payne Products v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). Because we do not read limitations into the identification of services, we cannot exclude dentistry from Registrant’s “medical

¹⁴ *See also* the Obamacare website attached to Applicant’s November 1, 2016 Response to an Office Action (TSDR 20) (“Dental insurance, for the most part, isn’t covered under Obama Care (the Affordable Care Act).”)

¹⁵ Khazan, “Why Don’t We Treat Teeth Like the Rest of Our Bodies?” (September 2014) attached to Applicant’s November 1, 2016 Response to an Office Action (TSDR 13).

services.” *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”). Therefore, we must presume that Registrant’s “medical services” include all categories of medicine, including “dentist services; orthodontic services; pediatric dentistry” and therefore, we find that the services are identical.

Because the services described in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

B. The strength of the registered mark, the number and nature of similar marks in use in connection with similar services.

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is

measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (same); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2017) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

We focus on the inherent strength of Registrant’s mark because there is no evidence regarding the market strength of Registrant’s mark LONE STAR. Applicant contends that “Lone Star” is commonly used to refer to the State of Texas.¹⁶ The State of Texas has the nickname “The Lone Star State.”¹⁷ Registrant is located in Weatherford, Texas, and, thus, registered its mark under Section 2(f) of the Trademark Act because “Lone Star” is primarily geographically descriptive of a medical practice in Texas. *See In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1617-18 (TTAB 2007) (“It is well settled that a recognized nickname or other informal name for a geographic location is considered the equivalent of the official or formal name . . .”).

¹⁶ November 1, 2016 Response to Office Action (TSDR 5).

¹⁷ *Wikipedia*, August 22, 2016 Office Action (TSDR 8).

Because “Lone Star” is primarily geographically descriptive of businesses located in Texas, Applicant asserts that there are “dozens” of medical practices referred as “Lone Star” citing the results of a Google search.¹⁸ Applicant submitted the results of a Google search for “Lone Star Medical” discussed above. The results include the following:¹⁹

- Lone Star Circle of Care - Ben White Health Clinic;
- LoneStar Oral & Maxillofacial Surgery;
- Lonestar Medical PA;
- Lone Star Pediatric Dental;
- Lone Star Urology;
- Lone Star Circle of Care Lakeaire;
- Lone Star Orthodontics;
- Lone Star Medical Group; and
- Lone Star Family Health Center.

The third-party use of “Lone Star” confirms Applicant’s contention that other entities use the term “Lone Star” in connection with medical services rendered in Texas. The distinguishing feature of the third-party marks or trade names is the medical specialty rendered by the third parties (*e.g.*, Oral & Maxillofacial Surgery, Orthodontics, Family Health Center, *etc.*). Therefore, unlike a situation involving an arbitrary or fanciful mark, the addition of other matter to a primarily geographically

¹⁸ November 1, 2016 Response to Office Action (TSDR 5).

¹⁹ *Id.* at TSDR 6-8. Registrant is Lone Star Pain Medicine, PLLC.

descriptive mark may be enough to distinguish it from another mark. *Cf. In re Hartz Hotel Servs. Inc.*, 102 USPQ2d 1150, 1154 (TTAB 2012); *In re Hunke & Jocheim*, 185 USPQ 188, 189 (TTAB 1975).

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Sure-Fit Prod. Co. v. Saltzson Drapery Co., 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958). Under these circumstances, marks comprising the term “Lone Star” in connection with medical services rendered in Texas should be accorded a narrow scope of protection.

C. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such 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) (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*,

565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The marks are similar because they share the primarily geographically descriptive term “Lone Star.” However, Applicant’s mark differs from Registrant’s mark in that it includes the term PEDIATRIC DENTAL & BRACES identifying Applicant’s practice area, as well as a distinctive design highlighting that practice area. *See In re Norfolk Wallpaper, Inc.*, 216 USPQ 903 (TTAB 1983) (cumulative differences between THE NORFOLK PLAN for installation of wallpaper and wallpaper store services and NORFOLK for paints and varnishes make likelihood of confusion remote).

When the marks LONE STAR and LONE STAR PEDIATRIC DENTAL & BRACES and design, shown below,



are considered in their entirety, the differences make them more dissimilar than similar.²⁰ In reaching this finding of fact, the existence of Registrant’s registration

²⁰ Accordingly, we disagree with the Examining Attorney who contends that the “the additional design elements and the disclaimed wording, ‘PEDIATRIC DENTAL AND [sic] BRACES’ do not sufficiently distinguish the marks in order to obviate confusion.” 12 TTABVUE 5.

and the fact that Registrant's right to use the mark LONE STAR for medical services has become incontestable cannot alter the fact that that "Lone Star" has a geographical connotation nor can it extend Registrant's rights in LONE STAR to preclude the registration for similar services of any and all marks which contain this term. *See Am. Thread Co. v. Filatures Des Trois Suisses, S.A.*, 142 USPQ 392, 393 (TTAB 1962).²¹

The Examining Attorney contends that because Applicant's mark contains Registrant's entire mark, the marks are similar citing *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT similar). However, *Wella* is not applicable to the facts before us because in *Wella* the common element is the arbitrary term "Concept," whereas the common element in the case before us is a geographically descriptive term.²²

In view of the foregoing, we find that the marks in their entirety are not similar.

²¹ Because of the geographic connotation of the term "Lone Star" and its narrow scope of protection or exclusivity of use, we disagree with the Examining Attorney's contention that "the average purchaser will generally associate both marks with the most distinctive element 'LONE STAR', the sole element of the registrant's mark, and the first, largest, and most distinctive term of applicant's mark." 12 TTABVUE 5-6. As noted above, when the marks are considered in their entirety, they are distinguishable.

²² The Court specifically noted that "[w]hen one incorporates the entire arbitrary mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion. [Internal citations omitted]. And inclusion of a merely suggestive or descriptive element, of course, is of much less significance in avoiding a likelihood of confusion." *Wella*, 194 USPQ at 422.

D. Conclusion.

Because the term “Lone Star” has a geographic connotation and the record demonstrates that there are multiple third party trade names or service marks incorporating the term “Lone Star” for medical services, we find that the marks LONE STAR and LONE STAR PEDIATRIC DENTAL & BRACES and design are not similar and, therefore, Applicant’s mark LONE STAR PEDIATRIC DENTAL & BRACES and design for “dentist services; orthodontic services; pediatric dentistry” is not likely to cause confusion with LONE STAR for “medical services.”

Decision: The refusal to register Applicant’s mark LONE STAR PEDIATRIC DENTAL & BRACES and design is reversed.