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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 Morgenstern Center for Orbital and Facial Plastic Surgery Inc.

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Serial No. 87267085
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John J. O'Malley of Volpe and Koenig, P.C.,
for Morgenstern Center for Orbital and Facial Plastic Surgery Inc.

Tara L. Bhupathi, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

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Before Wolfson, Kuczma, and Larkin, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Morgenstern Center for Orbital and Facial Plastic Surgery Inc. (Applicant) seeks registration on the Principal Register of the standard character mark MAIN LINE REFRESH (“MAIN LINE” disclaimed) for “Medical consultations; Medical services; Cosmetic and plastic surgery,” in International Class 44.¹

¹ Application Serial No. 87267085 was filed on December 13, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), on the basis of Applicant’s allegation of its bona fide intent to use the mark in commerce.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with three registered marks. The following two are owned by a single entity:

MAIN LINE HEALTH (Reg. No. 3947020) (standard characters, “HEALTH” disclaimed) for “Medical services; surgery; hospitals; medical imaging services; nursing services; mental health services; physical rehabilitation; addiction treatment services; home health care services; providing medical and psychological consultation to employees and their families in the areas of mental health, substance abuse, stress, and depression, provided through an employee assistance program; providing medical information” in International Class 44;² and



Main Line Health (Reg. No. 4295464) (“HEALTH” disclaimed) for “Medical services; surgery; hospitals; medical imaging services; nursing services; mental health services; physical rehabilitation; addiction treatment services; home health care services; providing medical and psychological consultation to employees and their families in the areas of mental health, substance abuse, stress, and depression, provided through an employee assistance program” in International Class 44.³

The third is owned by an unrelated entity:

² Issued April 19, 2011; Sections 8 and 15 combined declaration accepted and acknowledged.

³ Issued February 26, 2013; Sections 8 and 15 combined declaration accepted and acknowledged. The description of the mark reads: “The mark consists of three curving blue lines intersecting with three curving green lines atop the wording ‘MAIN LINE HEALTH’ in black.” The colors black, blue and green are claimed as a feature of the mark.



After the Examining Attorney made the refusal final, Applicant filed a Request for Reconsideration and a notice of appeal, and the appeal was suspended pending determination of the Request for Reconsideration. The Examining Attorney denied the Request for Reconsideration and returned the file to the Board for resumption of the appeal. For the reasons set forth below, we reverse the refusal to register.

I. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Not all of the *DuPont* factors are relevant to every case, and “only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94

⁴ Issued August 6, 2013; Sections 8 and 15 combined declaration accepted and acknowledged. The description of the mark reads: “The mark consists of the wording ‘MAIN LINE PLASTIC SURGERY’ in blue. In between the words ‘MAIN’ and ‘LINE’ are the silhouettes of a man and a woman embracing. The silhouettes are outlined in pink with a fainter outline in black.” The colors blue, pink, and black are claimed as a feature of the mark.

USPQ2d 1257, 1259 (Fed. Cir. 2010)). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (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 [or services] and differences in the marks.”). We discuss below these and other relevant factors, namely, channels of trade and classes of consumers, and have considered all of the arguments and evidence of record, including any not expressly discussed.

A. Relatedness of the Services; Trade Channels; Classes of Consumers

We begin by considering the *DuPont* factors addressing the similarity of the services, the channels of trade in which they may be encountered and the consumers to whom they are marketed.

Our determinations under these factors are based on the services as they are recited in the application and the cited registrations. *See In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Comput. 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 [or services] set forth in the application regardless of what the record may reveal as to

the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which sales of the goods [or services] are directed.”).

The services are in-part identical. In Registration No. 4378445, the services of “cosmetic and plastic surgery” correspond to the identical recitation in Applicant’s application. In Registration Nos. 3947020 and No. 4295464, the recitations include “medical services,” which are identical to Applicant’s “medical services.” Applicant’s “medical services” are also broad enough to encompass the services listed in Reg. No. 4378445 (“Cosmetic and plastic surgery; Cosmetic surgery services; Plastic surgery services”) and the “surgery” services listed in Registration Nos. 3947020 and No. 4295464. Applicant does not dispute that the services are related, indeed arguing that the services recited in the two cited registrations “are related in the same manner as Applicant’s services and the parties have been able to co-exist.”⁵ 13 TTABVUE 13.

⁵ Applicant submitted copies of the prosecution history files for cited Reg. Nos. 3947020 and 4295464 (“Main Line Health”) showing their owner entered into a coexistence agreement with a prior registrant for the mark “The Main Line Center For The Family” (Reg. No. 3623788) for, inter alia, “medical services” (4 TTABVUE 39-48) ; and a copy of the prosecution history file for cited Reg. No. 4378445 (“Main Line Plastic Surgery”) showing that the owner of that mark argued successfully against a refusal based on Reg. Nos. 3947020 and 4295464 by relying on, among other things, the weakness of the term “Main Line.” (4 TTABVUE 49-108). Although the prosecution history record for Reg. No. 4378445 includes several pages from a 2012 Corsearch report of third-party registrations that include the term “Main Line,” these prior registrations have no probative value here, because the information is seven years old and does not include current status or title verification. We also decline to accord the web pages from “YP.com” any probative value, because the telephone listings also date from 2012, and there is nothing in the record to prove the companies are still in business. Even though the material qualifies under *Safer* as evidence, it is too old and unreliable to be probative. See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (holding document obtained from the Internet admissible if it identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL)). Moreover, the majority of the listings appear to be for companies in unrelated industries. At <http://www.yellowpages.com/>, 4 TTABVUE 97-108.

Regarding trade channels and classes of consumers, because the services described in the application and the cited registrations are in-part identical and contain no pertinent limitations or restrictions, we must presume that the channels of trade and classes of purchasers for these services are the same. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

Given the in-part identical nature of the services of each cited registration, and the presumptive identical trade channels and purchaser classes for these services, the second and third *DuPont* factors weigh in favor of a finding that confusion is likely.

B. The Similarity or Dissimilarity of the Marks

Under this factor, we compare Applicant's mark and the cited marks "in their entireties as to appearance, sound, connotation and commercial impression." *In re Viterra*, 101 USPQ2d at 1908 (quoting *DuPont*, 177 USPQ at 567); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Where, as here, services are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-*

Plough HealthCare Prods. Inc. v. Ing-Jing Huang, 84 USPQ2d 1323, 1325 (TTAB 2007). We compare marks “in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (citing *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 685 (CCPA 1977). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted). Here, the average customer is an individual interested in obtaining medical services in general, and cosmetic or plastic surgery specifically, from a physician.

Applicant’s mark is MAIN LINE REFRESH. The registered marks are MAIN LINE HEALTH, MAIN LINE HEALTH and design, and MAIN LINE PLASTIC SURGERY and design. While it is axiomatic that we must view marks in their entirety and not dissect them, there is nothing improper in giving more weight to a particular feature of a mark for rational reasons, and the fact that a term is the leading element in a mark is one such rational reason. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). That “MAIN LINE” is the leading element in all three of the registered marks as well as in Applicant’s mark lends prominence to the wording and heightens the likelihood of confusion. *See, e.g., Palm Bay* 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear

on the label); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1639 (TTAB 2007); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

We also find that MAIN LINE is the dominant feature of the marks MAIN LINE HEALTH (Reg. No. 3947020) and MAIN LINE HEALTH and design (Reg. No. 4295464) because the final literal term, HEALTH, is generic for or merely descriptive of the recited health services and has been disclaimed in recognition of its nature. “That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *Nat’l Data*, 224 USPQ at 751; *see also Dixie Rests.*, 41 USPQ2d at 1533-34 (“DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression.”). Likewise, consumers are more likely to recall and remember the words MAIN LINE in Registrant’s mark MAIN LINE PLASTIC SURGERY and design (Reg. No. 4378445) and use these words to request the services because the phrase “PLASTIC SURGERY” is generic for the services and has been disclaimed.

Regarding the designs in Reg. Nos. 4295464 and 4378445, they are subordinate to the wording in the marks. In general, literal terms are more likely than an abstract design to be impressed upon a purchaser’s memory and to be used when requesting the goods. *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)); *see also In re Viterra*, 101 USPQ2d at 1908 (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.’”) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)). Here, the design in Reg. No. 4295464 is subordinate to the wording in the mark because it is set apart from the wording, the wording attracts the eye by its large and bold lettering, and the design is essentially unpronounceable so it will not be used to request the services. In Reg. No. 4378445, the design is likewise subordinate to the wording because it is suggestive of the beneficial results of plastic surgery, is unlikely to be verbalized, and is encompassed by the surrounding words.

Accordingly, in each of the registered marks, as well as in Applicant’s mark, consumers are likely to focus on the dominant words MAIN LINE. Applicant concedes that “Applicant’s Mark and the Cited Registrations share an identical literal element because they both use the phrase ‘MAIN LINE.’” 13 TTABVUE 10. Nonetheless, we must compare the marks in their entireties in terms of their appearance, pronunciation, connotation and overall commercial impression. We cannot assume that consumers have the luxury of making side-by-side comparisons between marks, and they must rely instead upon their imperfect recollections. *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015); *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). “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.” *Cai*, 127 USPQ2d at 1801; *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *St. Helena Hosp.*, 113 USPQ2d at 1085 (marks “must be considered . . . in light of the fallibility of memory” and “not on the basis of side-by-side comparison.”) (quotation omitted).

Applicant contends that because MAIN LINE is geographically descriptive, and HEALTH and PLASTIC SURGERY are merely descriptive, the marks are distinguishable based on their additional elements: the term REFRESH in Applicant’s mark and the different words and design features in the Registrants’ marks.

The Examining Attorney attached evidence from The American Heritage Dictionary and Wikipedia showing that MAIN LINE is a generally known geographic place or location in Pennsylvania. Applicant is located in Wayne, Pennsylvania and the evidence from Wikipedia shows that Wayne, Pennsylvania is within the confines of Main Line, PA.⁶ Despite the fact that the term MAIN LINE was not disclaimed in the cited registrations, the owners of all three registrations list their correspondence

⁶ *See at* <https://www.ahdictionary.com/word/search.html?1=Main%20Line> (dictionary) and at https://en.wikipedia.org/wiki/Philadelphia_Main_Line (Wikipedia), attached to March 18, 2017 Office Action at TSDR 30-31.

address as being in Bryn Mawr, Pennsylvania.⁷ According to the Wikipedia article submitted by the Examining Attorney, Bryn Mawr is part of the Main Line region:⁸

The Pennsylvania Railroad built its main line during the early 19th century as part of the Main Line of Public Works that spanned Pennsylvania. Later in the century, the railroad, which owned much of the land surrounding the tracks, encouraged the development of this picturesque environment by building way stations along the portion of its track closest to Philadelphia.

The railroad placed stops about two minutes apart, starting with Overbrook. The surrounding communities became known by the railroad station names which started at Broad street station in Center City Philadelphia and went on to 32nd St. Station, and then the Main Line stations: Overbrook, Merion, Narberth, Wynnewood, Ardmore, Haverford, Bryn Mawr, Rosemont, Villanova, Radnor, St. Davids, Wayne, Strafford, Devon, Berwyn, Daylesford, and Paoli.

Today, the “Main Line” is another name for the western suburbs of Philadelphia along Lancaster Avenue (U.S. Route 30) and the former Pennsylvania Railroad Main Line, extending from the city limits to, traditionally, Bryn Mawr and ultimately Paoli, an area of about 200 square miles.

The record thus shows that the term “Main Line” in Applicant’s mark and in the registered marks is inherently weak, given its geographical significance.

Applicant argues that “since the common element of the [marks] is ‘weak’ in that it is geographically descriptive, it is unlikely that consumers will be confused unless the overall combinations have other commonality.” 13 TTABVUE 10.

⁷ Main Line Health, Inc. owns Reg. Nos. 3947020 and 4295464, and is located at 130 S. Bryn Mawr Avenue, Bryn Mawr, Pennsylvania. Main Line Plastic Surgery PC owns Reg. No. 4378445 and is located at 945 E Haverford Rd Suite 102, Bryn Mawr, Pennsylvania.

⁸ At https://en.wikipedia.org/wiki/Philadelphia_Main_Line, attached to March 18, 2017 Office Action at TSDR 35.

Given the geographic nature of the term, it is not unsurprising that many local medical services providers incorporate “Main Line[”] into their trademarks. For example, the attached search from the online Yellow Pages for medical and healthcare services identified at least 123 medical service providers using “Main Line.” See Exhibit A.

Request for Reconsideration 4 TTABVUE 10.

Exhibit A is a printout of the Real Yellow Pages, listing the name, address, telephone number and a brief description of about 110 medical clinics, physicians and surgeons, located in Pennsylvania, that use “Main Line” in their trade name.⁹ Five of them include the beginning of a review apparently written by a user of the services:

12. Main Line Women's Health

(5)

1030 E Lancaster Ave,
Bryn Mawr, PA 19010
(484) 772-8690

Physicians & Surgeons, Obstetrics...
Website Directions Services

I've been going to Main Line Women's since I was 22 (9 years). All of the doctors are highly professional, and the staff has always been nothing b...

13. Main Line Plastic Surgery

(5)

864 County Line Rd, Bryn Mawr, PA 19010
(484) 222-0010

Medical Clinics, Skin Care
Website Services

Dr. Raymond Jean is the absolute best surgeon in this area. His kind demeanor, and honesty are a breath of fresh air. I am a veteran of botox and ...

⁹ Although the list is numbered from 1 to 123, several of the entries are missing. At <https://www.yellowpages.com>, attached to Request for Reconsideration, 4 TTABVUE 14-38.

65. Main Line Dermatology

(6)

995 Old Eagle School Rd Ste 304f,
Wayne, PA 19087
(610) 688-3099

Physicians & Surgeons, Dermatology
Website

I have been a patient here, for many years. I have also taken one of my children here as a young teen for a pre-cancer skin condition. I currently l...

74. Main Line Health Center Exton

(1)

83 Dowlin Forge Rd, Exton, PA 19341
(610) 363-6062

Medical Clinics, Clinics
Website

staff is beyond ignorant lost my information and tried to get me to pay for another test because they lost the first

114. PMA Medical Specialists Sleepwellness Center of the Mainline

(1)

15 Industrial Blvd Ste 202, Paoli, PA 19301
(484) 324-6763

Physicians & Surgeons

This place is absolutely horrific. The one receptionist is miserable and it's obvious. She's unfriendly and rude. My actual sleep study I had done w...

The Examining Attorney argues that telephone directory listings in general are given little weight “because they establish nothing more than that the listed names have been assigned telephone numbers.” (citing *National Steel Prods. Co. v. Quonset Hut, Inc.*, 211 USPQ 820, 823 (TTAB 1981)). Although telephone directory listings of names, addresses and phone numbers by themselves are insufficient to establish actual use, here the entries tell us a little about the nature of each business, and some include consumer reviews. Thus, the listings have probative value in illustrating that “Main Line” is a term widely used in connection with cosmetic and plastic surgery and related medical services. *Cf.* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) (October 2018) (“Telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term.”). Given the widespread use of the term “Main Line” in connection with

medical services, we find the term is weak when used in association with Applicant's and the Registrants' services. Accordingly, we find the marks are distinguishable based on the additional elements in each.

Applicant's mark contains the additional, suggestive, term REFRESH. The Examining Attorney submitted copies of seven third-party registrations for marks including the word REFRESH to show that the term REFRESH has a descriptive connotation with respect to cosmetic and plastic surgery services and may be considered weak in association with these services.¹⁰ The third-party registrations essentially function as a dictionary in this situation, and "show the sense in which [the term REFRESH] is used in ordinary parlance." *Juice Generation, Inc. v. GS Enters., LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); see also *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *In re Nashua Corp.*, 229 USPQ 1022, 1023 (TTAB 1986) ("Third-party registrations may provide some evidence as to the meaning of a mark or portion of a mark in the same way dictionaries are used."). The most relevant are two registrations for the marks REFRESHLIFT and REFRESHED AESTHETIC SURGERY for "cosmetic and plastic surgery;" REFRESH YOUR BEAUTY for services including "medical skin care treatment," and MD REFRESH for a "clinic providing medical aesthetic procedures" such as liposuction, body contouring treatments and injectable filler treatments. We find the evidence shows that REFRESH is suggestive for cosmetic and plastic surgery.

¹⁰ March 18, 2107 Office Action at TSDR 11-29.

Applicant's mark is distinguishable from the cited registrations given the additional term REFRESH in the mark. Moreover, although the literal elements in the marks (HEALTH and PLASTIC SURGERY) are themselves quite weak, two of the cited marks combine an arbitrary or suggestive design feature with the wording to create unique marks that are more dissimilar than similar to Applicant's mark MAIN LINE REFRESH. As to the cited word mark MAIN LINE HEALTH, it too is distinguishable as a whole from Applicant's mark on the basis of the differing terms "HEALTH" and "REFRESH," resulting in different overall commercial impressions. We further note that the cited registrations coexist with each other, and as shown by the prosecution history of Registration Nos. 3947020 and 4295464, the owners of these marks appear to believe that confusion is unlikely. *See infra*, note 5.

Decision: The refusal to register Applicant's mark under Section 2(d) is reversed.