

This Opinion is not a
Precedent of the TTAB

Mailed: July 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re PharmAssist Concierge Pharmaceutical Services, PLLC
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Serial No. 88326775
—

Dayna Thomas of The Law Office of Dayna Thomas, LLC,
for Applicant.

Robert Guliano, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

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Before Cataldo, Goodman and Johnson,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

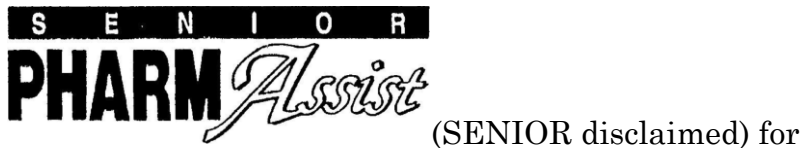
In re PharmAssist Concierge Pharmaceutical Services, PLLC dba PharmAssist
On Demand (“Applicant”), seeks registration on the Principal Register of the word

and design mark  (ON DEMAND and PLLC disclaimed)
for

Preparation of prescriptions by pharmacists; Pharmaceutical
consultations; Health care services, namely, wellness programs;

Pharmaceutical consultations provided via phone, online chat or video conferencing; Providing health care information by the Internet; Providing in-person holistic health care services; Providing medical information, consultancy and advisory services; Pharmaceutical advice in International Class 44.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the following Principal Register marks owned by two different entities:



¹ Application Serial No. 88326775 was filed on March 5, 2019, based upon Applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The description of the mark states: "The mark consists of the word 'pharm' in blue connected to the word 'assist' in green, above the word 'on' in green and 'demand' in magenta. The letters 'pllc' appear in blue vertically to the right of 'assist.' A magenta pill is the 'i' in 'assist' and another pill appears above the word 'assist' in magenta and green. The white in the drawing represents background areas and is not claimed as a feature of the mark." The color(s) blue, green, magenta is/are claimed as a feature of the mark.

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. Applicant's brief is at 10 TTABVUE and the reply brief at 13 TTABVUE. The Examining Attorney's brief is at 12 TTABVUE.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, this opinion is in a form provided in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board this opinion cites to the LEXIS legal database. Practitioners should also adhere to the citation form recommended in TBMP § 101.03.

providing medical information to and concerning senior citizens; providing medical testing; and providing medical information to and concerning senior citizens pertaining to medicine, health, and medications in International Class 42²; and

PHARM-ASSIST (in standard characters) for

Pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; Retail pharmacy services in International Class 35.³

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Applicant then sought a remand to the Examining Attorney to submit additional evidence, which was granted by the Board. After remand, the Examining Attorney maintained the refusal, and the appeal resumed. We reverse the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). See also *In re Majestic*

² Registration No. 2092629 issued September 2, 1997; second renewal. The registration also covers Class 36 services, but the Examining Attorney has not argued that the Class 36 services are related to Applicant’s services.

³ Registration No. 6659936 issued March 1, 2022.

Distilling Co., 315 F.3d 1311, 1315 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019); *In re Country Oven, Inc.*, Ser. No. 87354443, 2019 TTAB LEXIS 381, at *2 (TTAB 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.”). These factors, and others, are discussed below.

A. Similarity or Dissimilarity of Services

We consider the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 476 F.2d at 1361. Our comparison is based on the services as identified in Applicant’s application and the cited registrations. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307 (Fed. Cir. 2018) (citing *In re i.am.symbolic*, 866 F.3d at 1325). It is sufficient for a finding of likelihood of confusion if relatedness is established for any one of the identified services within the class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981).

For the second *DuPont* factor, it is sufficient that the respective services are related in some manner, or that the conditions and activities surrounding the

marketing of the services are such that they would or could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *19 (TTAB 2007)).

For convenience, we repeat the identifications.

Applicant's identification of services is as follows:

Preparation of prescriptions by pharmacists; Pharmaceutical consultations; Health care services, namely, wellness programs; Pharmaceutical consultations provided via phone, online chat or video conferencing; Providing health care information by the Internet; Providing in-person holistic health care services; Providing medical information, consultancy and advisory services; Pharmaceutical advice in International Class 44.

PHARM-ASSIST (in standard characters) services are as follows:

Pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; Retail pharmacy services in International Class 35; and

Registrant (SENIOR PHARM ASSIST ) services are as follows:

providing medical information to and concerning senior citizens; providing medical testing; and providing medical information to and concerning senior citizens pertaining to medicine, health, and medications in International Class 42; and

As to the PHARM-ASSIST registration, we find that "Preparation of prescriptions by pharmacists"⁴ is encompassed by Registrant's "processing online and telephone

⁴ We take judicial notice of the definition for "prescription": "a prescribed medicine" and "preparation": "the action or process of making something ready for use or service....". MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, accessed July 22, 2024). *See In re*

prescription orders in retail and central fill pharmacies” and “Retail pharmacy services.” *In re Hughes Furniture Indus.*, Ser. No. 85627379, 2015 TTAB LEXIS 65, at *10 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). The Examining Attorney also points to internet evidence that shows that pharmacies prepare prescription orders.

As to the SENIOR PHARM ASSIST and design mark, the Class 42 services include “providing medical information to and concerning senior citizens pertaining to medicine, health, and medications” while Applicant’s Class 44 services include “providing medical information.” Applicant’s Class 44 medical information services are broad enough to encompass Registrant’s services which are targeted to senior citizens on medicine and medication topics. *See In re Hughes Furniture Indus.*, 2015 TTAB LEXIS 65, at *10.

The Examining Attorney has also submitted third-party website evidence to show the relatedness of pharmacy services, wellness programs, and other of Applicant’s identified services but in view of these legally identical services, there is no need for us to discuss this additional evidence.⁵ *In re Max Cap. Grp. Ltd.*, Ser. No. 77186166,

Red Bull GmbH, Ser. No. 75788830, 2006 TTAB LEXIS 136, at *7-9 (TTAB 2006) (the Board may take judicial notice of online dictionary definitions that exist in print format).

⁵ In the May 14, 2019 Office action, at TSDR 1 and the March 29, 2023 Office action at TSDR 1, the Examining Attorney took the position that the services in the Senior Pharm Assist and design mark were encompassed by Registrant’s medical information services but in the brief, it instead relies on relatedness evidence that pharmacy services providers also provide medical and medication information. As to the PHARM-ASSIST registration, the Examining Attorney took the position that retail pharmacies offer preparation of prescriptions and the services are related. August 24, 2022; March 29, 2023 Office action at TSDR 1. In the brief,

2010 TTAB LEXIS 1, at *3-4 (TTAB 2010) (citing *Tuxedo Monopoly*, 648 F.2d at 1336).

We find the second *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Similarity of the Trade Channels, Classes of Consumers and Conditions of Sale

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels” while the fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361.

As to trade channels, both Registrants’ and Applicant’s identifications are unrestricted. Because of the legal identity of the services in whole as to one cited registration and in part as to the other cited registration, we must presume that those legally identical services would be offered in the same trade channels and to the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Rsch Inst.*, Opp. No. 91190361, 2011 TTAB LEXIS 260, at *14 (TTAB 2011) (channels of trade and classes of consumers the same for legally identical goods) (citations omitted).

the Examining Attorney discussed the internet evidence to establish relatedness of the cited registrations’ services.

As to the fourth *DuPont* factor, we must make our determination based on the least sophisticated consumer. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014) (“Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers’”) (citation omitted); *In re FCA US LLC*, Ser. No. 85650654, 2018 TTAB LEXIS 116, at *29 (TTAB 2018) (same), *aff’d mem.*, 778 F. App’x 962 (Fed. Cir. 2019). In this case, the consumers of Applicant’s— and Registrants’ services are members of the general public who have a need to obtain pharmaceuticals or health, medical, medicine, or prescription information, and would include consumers who may have no medical expertise.

Applicant argues that “consumers use the highest degree of care to ensure they obtain their intended pharmaceutical and healthcare services. As such, consumers in this industry perform significant due diligence prior to selecting a pharmaceutical and healthcare service provider.” 10 TTABVUE 21. The Examining Attorney argues that “the consumers of the services of applicant and registrants include mere individuals—including vulnerable individuals such as senior citizens—with health care and prescription drug needs.” 12 TTABVUE 14.

However, neither Applicant nor the Examining Attorney presented any evidence, only presenting attorney argument. “Attorney argument is no substitute for evidence.” *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005).

A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 1000 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would

purchase the relevant services, there would be no likelihood of confusion between similar marks). Conversely, inexpensive goods may be purchased with little care or prior knowledge. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

As to Applicant's prescription fulfillment services, although it is true that some consumers may exercise more care in filling prescriptions and consider the price and availability of discounts, other consumers may fill prescriptions based on convenience or based upon the pharmacy networks directed by their medical insurance. *See, e.g., Mini Melts, Inc. v. Reckitt Benckiser LLC*, Opp. No. 91173963, 2016 TTAB LEXIS 151, at *26 (TTAB 2016) (Board found that over the counter pharmaceutical preparations that were relatively inexpensive would not be purchased on impulse and that reasonable care would be taken in purchasing them).

As to the information and consultation services, to the extent that the information or consultation services are fee-based, a consumer may exercise more care in their selection. On the other hand, if the services are offered without cost, the consumer may not exercise as a high a degree of care. Although we do not read price restrictions into the Applicant's or the cited registrations' identifications of goods, which are unrestricted, a lower price point may indicate a lower standard of care. *See Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1146 (Fed. Cir. 1985) (Consumers of low-cost products "have long been held to a lesser standard of purchasing care").

In view of the foregoing, we find this *DuPont* factor neutral. *See Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 TTAB LEXIS 347, at *25-26 (TTAB 2019) (finding fourth *DuPont* factor neutral because even if parties' goods were not subject to impulse buying, there was an absence of evidence in the record showing consumers will exercise a higher degree of care).

C. Strength of the Registered Mark

We consider Applicant's contention that the cited mark is weak. *See In re Guild Mortg. Co.*, Ser. No. 86709944, 2020 TTAB LEXIS 17, at *7 (TTAB 2020) ("an analysis of the similarity between marks may include an analysis of the conceptual strength or weakness of the component terms and of the cited mark as a whole"); *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015) (citations omitted) ("Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts."); *In re Smith and Mehaffey*, Ser. No. 74213737, 1994 TTAB LEXIS 19, at *8 (TTAB 1994) ("the descriptiveness or suggestiveness of a mark or portion of a mark may result in what is sometimes termed a more narrow scope of protection").

"A mark's strength is measured both by its conceptual strength ... and its marketplace strength ...". *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 (Fed. Cir. 2010). In determining the strength of the cited mark, we consider inherent

strength, based on the nature of the mark itself.⁶ *New Era Cap. Co. v. Pro Era LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *28-29 (TTAB 2020); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, Opp. No. 91157248, 2011 TTAB LEXIS 367, at *25 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength). We also consider whether the mark has commercial weakness in the marketplace, if there is evidence in the record. *DuPont*, 476 F.2d at 1361 (The sixth *DuPont* factor considers “the number and nature of similar marks in use on similar goods.”).

To determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary-fanciful continuum of words. See generally *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-211 (2000) (word marks registered without a claim of acquired distinctiveness that are arbitrary, fanciful or suggestive are “held to be inherently distinctive.”); *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

We note that each cited mark registered on the Principal Register without a claim of acquired distinctiveness. *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No.

⁶ There is no evidence of commercial strength in the record. Fame, or commercial strength, under the fifth *DuPont* factor generally is treated as neutral in ex parte proceedings because in an ex parte appeal, the owner of the cited registration is not a party, and the examining attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. See *In re Integrated Embedded*, Ser. No. 86140341, 2016 TTAB LEXIS 470, at *26 (TTAB 2016); *In re Thomas*, Ser. No. 78334625, 2006 TTAB LEXIS 135, at * 18 n.11 (TTAB 2006) (fame is not normally a factor in ex parte proceedings); TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(d)(ix) (May 2024).

91118587, 2006 TTAB LEXIS 330, at * 62 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the [services]”). Therefore, both marks are inherently distinctive, although the cited SENIOR PHARMASSIST and design mark’s strength is somewhat limited by the first word SENIOR which has been disclaimed. *See Sock It To Me, Inc. v. Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *30-31 (TTAB 2020) (SOCK IT TO ME for socks “taken as a whole, is inherently distinctive, although its strength is somewhat limited by its first word, SOCK, which is generic for socks”; “sock” disclaimed). Nonetheless, we may consider whether the cited marks are “weak as a source indicator” in the course of the *DuPont* analysis. *In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 TTAB LEXIS 150, at *23 (TTAB 2016).

In connection with evaluating the cited marks’ conceptual strength, active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used in a particular industry that the public will look to other elements to distinguish the source of the services. *See Juice Generation*, 794 F.3d at 1338; *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance.’”); *In re Guild Mortg.*, 2020 TTAB LEXIS 17 at *10 (same); *In re Dayco Prods. Eglemotive Inc.*, Ser. No. 73673493, 1988 TTAB

LEXIS 58, at *5 (TTAB 1988); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, Opp. No. 91062442, 1982 TTAB LEXIS 205, at *13 (TTAB 1982), *aff'd* 706 F.2d 1213 (Fed. Cir. 1983).

Third-party registrations may be used in the manner of dictionary definitions to show that a term has some significance in a particular field. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (even if “there is no evidence of actual use” of third-party registrations, such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”); *In re Melville Corp.*, Ser. No. 73736814, 1991 TTAB LEXIS 18, at *6 (TTAB 1991); *Plus Prods. v. Star-Kist Foods, Inc.*, Opp. No. 91064636, 1983 TTAB LEXIS 40, at *7 (TTAB 1983).

Dictionary definitions also can be used to show conceptual weakness. *See Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1035 (Fed. Cir. 2021); *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *26 (2022) (considering dictionary definitions and third-party registrations as evidence of the suggestiveness of MADE IN NATURE).

Applicant made of record copies of four registration certificates for third-party PHARMASSIST or PHARMASSIST-formative marks, and copies of registration certificates for the cited marks. Applicant had earlier provided in a Response to Office action a list of registrations and applications in the form of a chart; this chart did not make the registrations of record.⁷ *In re Duofold, Inc.*, 1974 TTAB LEXIS 271, at *6

⁷ The Board does not take judicial notice of registrations that reside in the USPTO. *See, e.g., In re Thomas Nelson Inc.*, Ser. No. 76681269, 2011 TTAB LEXIS 9, at *20 n.18 (TTAB 2011).

(TTAB 1974).⁸ The chart includes a PHARMASSIST-formative registration that was not subsequently made of record by the submission of a copy of a registration certificate. However, because the Examining Attorney did not timely advise applicant about the insufficiency of the third-party registration chart, any objection has been waived and we have considered this registration in the list for whatever probative value it may have. *In re City of Hous.*, Ser. No. 77660948, 2012 TTAB LEXIS 1, at *5 (TTAB 2012) (considering list of registrations for whatever probative value it may have because examining attorney waived objection). A chart of the third-party registrations is attached in an appendix to this decision.

On the other hand, we have not considered the third-party applications on the earlier chart, because they would only be evidence of their filing with the Office. *See Edom Lab'ys, Inc. v. Lichter*, Opp. No. 91193427, 2012 TTAB LEXIS 81, at *12 (TTAB 2012) (applications are evidence of nothing more than that they were filed with the USPTO) (citing *In re Binion*, Ser. No. 76590702, 2009 TTAB LEXIS 701, at * 11 n.3 (TTAB 2009); *Glamorene Prods. Corp. v. Earl Grissmer Co., Inc.*, Can. No. 92010868, 1979 TTAB LEXIS 53, at *2 n.5 (TTAB 1979)).

The Examining Attorney argues that none of the third-party registrations cover the same or similar services as the cited registrations. 10 TTABVUE 13.

Applicant's chart includes the mark, the registration number, the goods or services, and whether there is a disclaimer. November 11, 2019 Response to Office action at TSDR 5. A subsequent chart provided in a later office action omitted the PHARMASSIST OPTIX registration and the PHARMASSIST applications. June 26, 2023 Request for reconsideration at TSDR 5-6.

⁸ Serial no. unavailable.

However, we find four of the registrations, (PHARMASSIST SYMPHONY, PHARMASSIST OPTIX, PHARMASSIST RX COLLECT, and PHARMASSIST)⁹ are relevant in regards to the cited PHARM-ASSIST mark as they relate to prescription dispensing and prescription fulfillment. As the Examining Attorney points out, the other two registrations for career services for pharmacists and for analytical laboratory research services (PHARMASSIST CAREER SERVICES and PHARMASSIST), although in the pharmaceutical field, are of limited probative value. Applicant has not provided evidence or an adequate explanation of the relatedness of these services to the cited registrations' services to support a finding of weakness. *See In re i.am.symbolic*, 866 F.3d at 1328 (disregarding third-party registrations for other types of goods where applicant had neither proven nor explained how they were related to the goods in the cited registration).

. We also note that the two cited co-existing registrations offer related services (i.e., prescription information and retail pharmacy services) as shown by the Examining Attorney's website evidence, which the Examining Attorney appears to acknowledge. 10 TTABVUE 13.

Applicant provided a dictionary definition of "pharmacist" as

"a health-care professional licensed to engage in pharmacy with duties including dispensing prescription drugs, monitoring drug interactions, administering vaccines, and

⁹ November 11, 2019 Response to Office action at TSDR 5; February 22, 2023 Response to Office action at TSDR 114; June 26, 2023 Request for reconsideration at TSDR 28, 32, 34.

counseling patients regarding the effects of proper usage of drugs and dietary supplements.”¹⁰

Applicant also provided plain copy registrations of 36 third-party registered marks that include the term “pharmacist,” or phonetic equivalent, most with additional terms in the marks.¹¹

The Examining Attorney argues that “at best it [PHARMASSIST/PHARM ASSIST/PHARM-ASSIST] has a double meaning—one combining the prefix PHARM with the word ASSIST (as “a play on words between the prefix ‘pharm-’ and the word ‘assist’”) ¹² and one, because of the similarity in sound, calling to mind the word ‘pharmacist.’” ¹² TTABVUE 4, 6. However, the Examining Attorney contends that PHARMASSIST would not be likely seen as “a mere misspelling” because PHARM

¹⁰ June 26, 2023 Request for reconsideration at TSDR 14. MERRIAM-WEBSTER DICTIONARY, merriam-webster.com.

¹¹ February 22, 2023 Response to Office action at TSDR 14-81. The Examining Attorney does not address this third-party “pharmacist” registration evidence in the brief but discounted it in an office action as “irrelevant.” Applicant also provided applications with the term “pharmacist.” As already discussed, third-party applications are only evidence of filing in the USPTO and not probative. Some of the third-party registrations that contained the term “pharmacist” were duplicated in the submission.

¹² The Examining Attorney states that “the prefix ‘pharm-’ can suggest the words ‘pharmacist,’ ‘pharmacy,’ or ‘pharmaceutical.’” ¹² TTABVUE 4, 15. We take judicial notice that “pharm” is an abbreviation of pharmaceutical, pharmacist and pharmacy. MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed July 22, 2024). Applicant provided a definition of ASSIST which is defined as to “give support or aid” June 26, 2023 Request for reconsideration at TSDR 19. (Merriam-Webster Dictionary merriam-webster.com).

and ASSIST are separated in the cited marks.¹³ *Id.* The Examining Attorney does not address this third-party “pharmacist” registration evidence in the brief.¹⁴

While there is no correct pronunciation of a trademark that is not a known word, *In re Belgrade Shoe Co.*, 411 F.2d 1352, 1353 (CCPA 1969), and it is not possible for a trademark owner to control how purchasers will vocalize its mark, *Centraz Indus., Inc. v. Spartan Chem. Co.*, Opp. No. 91159335, 2006 TTAB LEXIS 20, at *10 (TTAB 2006), here we find aurally that the PHARM ASSIST/PHARM-ASSIST portion of Registrants’ (and Applicant’s) marks are the phonetic equivalents of “pharmacist.” *See In re Viterra Inc.*, 671 F.3d at 1367 (X-SEED and XCEED similar). Therefore, for purposes of considering the weakness of the cited marks, we consider the dictionary definition of “pharmacist” and the third-party registrations submitted by Applicant that have as a component the similar in sound term “pharmacist.” *See e.g., Foods, Inc. v. J.R. Simplot Co.*, Opp. No. 91072437, 1987 TTAB LEXIS 33, at *5-6 (TTAB 1987) (third-party registrations for the term “quick” (or any phonetic equivalent or variant) are relevant to show that this term is highly suggestive as indicating that the food item in connection with which the term is used may be prepared swiftly or rapidly); *see also Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No.

¹³ The Examining Attorney also submits that a separation of these term is apparent in Applicant’s mark because of the different colors used for PHARM and ASSIST. 12 TTABVUE 6.

¹⁴ In the March 29, 2023 Office Action at TSDR 1, the Examining Attorney stated that this evidence was “irrelevant” “because the word “pharmacist” “is different from and gives off a different commercial impression from the term PHARMASSIST in the mark” since “pharmacist” “is not a play on words” while “pharmassist” is “a novel word that sounds like ‘pharmacist.’”


91263919, 2022 TTAB LEXIS 383, at *56 (TTAB 2022) (in connection with conceptual strength, SMOK, the phonetic equivalent of “smoke,” is inherently weak in relation to opposer’s electronic cigarette goods); *W. Chem. Prods., Inc. v. W. Chem. Co.*, 1964 TTAB LEXIS 155, at *3-4 (TTAB 1964)¹⁵ (BRIGHT, or their phonetic equivalents BRITE and BRYTE, are relevant to the question of suggestiveness of the term “BRIGHT” in connection with cleaning and polishing preparations; third-party registrations not irrelevant or immaterial).

Although Applicant did not provide an explanation as to the relatedness of the goods or services in these “pharmacist” third-party registrations, some of the registrations appear sufficiently related on their face either to the cited SENIOR PHARM ASSIST and design’s medical, health or medicine information services or the cited PHARM-ASSIST’s prescription drug processing or retail store pharmacy services. These registrations have probative value. On the other hand, there are other “pharmacist” third-party registrations that have little probative value as they do not appear on their face sufficiently related to the services recited in the cited registrations, and Applicant has not provided an adequate explanation or shown that these registrations are sufficiently related to those services.¹⁶ *See In re i.am.symbolic*,

¹⁵ Proceeding no. unavailable.

¹⁶ Electronic newsletters, educational books, newsletter, agricultural services, pharmacist training, community pharmacist information and support, dietary and nutritional supplements, marketing services, online store services skincare, insurance, financial planning, educational services, association services, employment services, downloadable videos, audio video recordings for business professionals customized webpage services, voice tapes for media and education, pharmacist training, administration of a discount pharmaceutical program for professionals.

866 F.3d at 1328 (disregarding third-party registrations for other types of goods where applicant had neither proven nor explained how they were related to the goods in the cited registration).

We find the most relevant “pharmacist” registrations are those providing medical information (A PHARMACIST FOCUSED ON YOU, February 22, 2023 Response to Office action at 14; and A PHARMACIST PERSPECTIVE (“pharmacist’ disclaimed) *Id.* at 16); online information services for pharmacies (PHARMACIST MOMS *Id.* at 34 Supplemental register); medical and prescription drug information services (PHARMACIST PANEL (“pharmacist” disclaimed) *Id.* at 36) pharmaceutical information services, health and wellness consultations, (PHARMACISTANSWERS *Id.* at 44); health care consulting relating to risks with medication therapy (PHARMACISTS ADDING VALUE AND EXPERTISE *Id.* at 46), health and wellness consulting (PHARMACISTS WELLNESS CONSULTANTS (“consultants” disclaimed) *Id.* at 66); health care consulting in the field of medication (PHARMACIST GUIDE *Id.* at 144); downloadable video recordings featuring medical information (PHARMACIST NETWORK (Supplemental register) *Id.* at 142); patient advocate services including coordinating medication ( (“pharmacist” and “integrative healthcare” disclaimed, *Id.* at 32); pharmacy services and pharmaceutical prescription and dispensing services (PHARMACISTS UNBOUND *Id.* at 63); pharmacy services (PHARMACIST DRIVEN PATIENT

FOCUSED *Id.* at 23); and retail store pharmacy services (PHARMACISTS WHO CARE (“pharmacists” disclaimed *Id.* at 68).

The relevant third-party registrations that include the term PHARMASSIST or phonetic equivalent “pharmacist” coupled with the dictionary definition for “pharmacist” show the highly suggestive significance of PHARM-ASSIST and PHARM ASSIST (or without hyphen or space)¹⁷ or its phonetic equivalent—“pharmacist”—in the pharmaceutical field and in connection with the recited services in the cited registrations. This evidences conceptual weakness of the term PHARM-ASSIST/PHARM ASSIST in the cited marks.

Applicant also submitted third-party use evidence in the form of separate webpages of 38 PHARMASSIST formative marks or trade names (without or with a space or hyphen) for goods/services in the pharmaceutical industry.¹⁸ A chart with the 38 uses is attached in an appendix to this decision.

Evidence of third-party use of similar marks or portions of marks or trade names for the same or similar services is relevant to a mark’s commercial strength or weakness. *In re i.am.symbolic*, 866 F.3d at 1327 (“third-party use bears on strength or weakness” of mark) (citation omitted); *Brooklyn Brewery Corp. v. Brooklyn Brew*

¹⁷ The presence or absence of a hyphen or space in the provided third-party registrations is not significant. *See e.g., In re Best W. Family Steak House, Inc.*, Ser. No. 73315241, 1984 TTAB LEXIS 173, at *1 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Goodyear Tire & Rubber Co. v. Dayco Corp.*, Opp. No. 91057845, 1978 TTAB LEXIS 143, at *7 n.4 (TTAB 1978) (FAST-FINDER with hyphen is in legal contemplation substantially identical to FASTFINDER without hyphen).

¹⁸ As stated in note 15, these differences are not significant.

Shop, LLC, Opp. No. 91223982, 2020 TTAB LEXIS 269 at *55 (TTAB 2020) (six local Brooklyn-formative named establishments' use of the term "Brooklyn" in connection with beer sales have significant probative value as to commercial weakness), dismissed in part, *aff'd in part, vacated in part, and remanded*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021); *In re FabFitFun, Inc.*, Ser. No. 86847381, 2018 TTAB LEXIS 297, at *15 (TTAB 2018) (considering dictionary definition and use evidence of the term "smoking hot" and variant "smokin hot" as evidence of weakness); *Tao Licensing LLC v. Bender Consulting Ltd.*, Opp. No. 92057132, 2017 TTAB LEXIS 437, at *47-49 (TTAB 2017) (considering third-party use of "TAO-formative names" in connection with restaurant services and alcoholic beverages as evidence of commercial weakness of TAO under the sixth *DuPont* factor); *see also Palm Bay Imps.*, 396 F.3d at 1373 ("[T]he purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.") (citation omitted).

Although Applicant indicates generally that it provided third-party use ("all for the same services, related products and services, or for products and services within the same industry as the Cited Marks"), 13 TTABVUE 10, Applicant did not specifically correlate the uses to identify which uses it considers are related products or services to the cited marks.

The Examining Attorney criticizes these third-party uses as “not the same or similar” to the identified services in the cited registrations or otherwise directed to “licensed pharmacists or other professional consumer bases.”¹⁹ 12 TTABVUE 6.

However, we find from the webpage evidence that twelve of these uses on their face are directed to the relevant public for the services identified in the cited registrations. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1326-27 (Fed. Cir. 2018) (rejecting third-party use evidence that falls into broad categories absent evidentiary support that the goods are related and directed to the relevant market).

Those uses are: PHARM-ASSIST DRUGS LTD (full-service pharmacy); PHARMASSIST PROGRAM (Mail order prescriptions program); PHARM-ASSIST SERVICES INC. (Pharmacy consulting company); PHARM ASSIST (Pharmacy services); PHARM ASSIST CONSULTING (Medical consulting services) PHARMASSIST ROBOTX (Pharmaceutical dispenser); PHARM ASSIST SERVICES P.L.L.C. (Pharmacy services); NATIONWIDE PHARMASSIST (Pharmacy retail); AMERICAN PHARMASSIST (Healthcare consulting); PHARMASSIST COMPLIANCE SOLUTIONS (Healthcare consulting);



¹⁹ The Examining Attorney also criticizes a business directory entry, but because this is similar to a yellow page entry, we find it has probative value. *See Lloyd’s Food Prods. Inc. v. Eli’s Inc.*, 987 F.2d 766, 768 (Fed. Cir. 1993) (“showing that the mark appears in advertising, in the form of current listings in the yellow and white pages, carries the presumption that the service mark is being used by third parties in connection with the offering of the advertised services” has probative value and cannot be disregarded).

(Medication management (Canada));²⁰ PHARMASSIST (Medication management app, Apollo IO listed as the creator).

Applicant also provided a listing of corporate names from the National Corporation Directory from Secretary of States across the United States, of businesses incorporating the term “Pharmassist” or “Pharm Assist”; these listings for the most part indicate whether the corporations are active or dissolved or inactive.²¹ This list was accompanied by separate printouts of 50 of the listings with additional information such as addresses, registered agents, and current status.²² “Corporate names or parts of these names when used to designate goods or business houses, or as trade ‘nicknames,’ are trade names.” *Radio Corp. of Am. v. Rayon Corp. of Am.*, 139 F.2d 833, 835 (CCPA 1943) (quoting Nims on Unfair Competition and Trade-Marks, Third Edition, p. 246); *see also Am. Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926) (a corporate name “seems to fall more appropriately” into the class of trade names).

Although the Examining Attorney argues this evidence is “minimally” probative, 10 TTABVUE 13, we find that the listing has probative value with respect to the 60 active corporations listed, even if we do not have evidence of use. *See In re Broadway*

²⁰ Although the Examining Attorney discounted the probative value of the foreign uses, our primary reviewing court has indicated that given “the growing availability and use of the internet as a resource for news medical research results, and general medical information, we find that the foreign publication evidence in this record carries some probative value with respect to prospective consumer perception in the United States.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 969 (Fed. Cir. 2007). Therefore, we find this use has some probative value.

²¹ August 14, 2023 Request for Remand, 6 TTABVUE.

²² *Id.* at 19-66.

Chicken, Inc., Ser. No. 74326626, 1996 TTAB LEXIS 2, at *19 (TTAB 1996) (telephone directory listings, a search of the American Business Directory and a search of a Dun & Bradstreet database of 9 million company/business names containing the term Broadway (either as a service mark or trade name) relevant to whether term Broadway was weak and entitled to a narrow scope of protection). A chart of those active corporate names is attached in an appendix to this decision.

As the Examining Attorney points out, this list does not indicate the nature of the services, 10 TTABVUE 13, which does reduce the probative value somewhat but that does not mean the list or accompanying printouts is entitled to no weight.²³ On the other hand, the nature of the term itself—“pharmassist” (or “pharm-assist” or “pharm assist”)—in this listing of corporate names (or trade names) likely references a business with some connection to the pharmaceutical industry given its phonetic equivalency to “pharmacist.”

Considering the evidence of both the third-party use and active trade names, we find that PHARMASSIST or PHARM ASSIST or PHARM-ASSIST has marketplace weakness. PHARM ASSIST/PHARM-ASSIST (or without a space or hyphen) is highly suggestive; the phonetic equivalent of this term—pharmacist—is highly suggestive if not descriptive. The above uses and trade names tend to show consumer exposure to third-party use of PHARM ASSIST/PHARM-ASSIST in the pharmaceutical industry such that consumers will look not just to the component of marks containing the term

²³ A small number of the corporate names indicate the nature of the business generally e.g., “staffing,” “temporary personnel,” consulting, “weight management and alcohol recovery,” “career services,” “pharmacy franchising,” and “pharmacy.”

to identify and distinguish source, but also to the other parts of the marks to distinguish them.

We find that PHARM ASSIST/PHARM-ASSIST (or without a space or hyphen) has conceptual and commercial weakness in connection with the services recited in the cited registrations and entitles marks containing this term to a narrower scope of protection. *See Juice Generation*, 794 F.3d at 1336 (“the weaker an opposer's mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection”); *In re Hartz Hotel Servs., Inc.*, Ser. No. 76692673, 2012 TTAB LEXIS 75, at *13 (TTAB 2012) (“GRAND HOTEL is highly suggestive, and therefore the scope of protection to which the cited registration is entitled is quite limited.”).

The fifth and sixth *DuPont* factors weigh against a finding of likelihood of confusion.

D. Similarity or Dissimilarity of the Marks

The first *DuPont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *See Palm Bay Imps.*, 396 F.3d at 1371 (quoting *DuPont*, 476 F.2d at 1361). The test, under the first *DuPont* factor, 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 that confusion as to the source of the goods or services offered under the respective marks is likely to result. While the marks must be considered in their

entireties, “in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).


Disclaimed matter that is descriptive or generic of a party’s goods is typically less significant or less dominant when comparing marks. *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011) (when a mark consists of two or more words, some of which are disclaimed, the word not disclaimed is generally regarded as the dominant or critical term) (citing *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997)); *In re Hughes Furniture Indus.*, 2015 TTAB LEXIS 65, at *16 (disclaimed terms not dominant portion of mark) (citations omitted); *In re Code Consultants, Inc.*, Ser. No. 75645560, 2001 TTAB LEXIS 685, at *12 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark's commercial impression”).


Where both words and a design comprise the mark (as in one of the cited marks and Applicant’s mark), the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *See CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983) (“in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of

the goods to which it is affixed”); *In re Appetito Provisions Co.*, Ser. No. 73423405, 1987 TTAB LEXIS 47, at *3 (TTAB 1987).

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d at 1058.

Applicant’s mark is  (ON DEMAND and PLLC

disclaimed) and the cited marks are  (Registration No. 2092629 (SENIOR disclaimed)) and PHARM-ASSIST (Registration No. 6659936 in standard characters). We compare each mark in turn.

 (Registration No. 2092629 (SENIOR disclaimed))

PHARMASSIST is the first term in Applicant’s mark and most likely to be impressed upon the purchaser. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 91074797, 1988 TTAB LEXIS 60, at *8 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also Palm Bay Imps.*, 396 F.3d at 1371 (VEUVE as the first word is a prominent feature of the mark).




The terms ON DEMAND and PLLC in Applicant's mark are smaller in size, making them appear less prominent; they are also disclaimed and have less source indicating significance. *See In re Dixie Rests.*, 105 F.3d at 1407 (disclaimed matter not the dominant portion of the mark DELTA CAFÉ and design); *In re Allegiance Staffing*, Ser. No. 85663950, 2015 TTAB LEXIS 180, at *11 (TTAB 2015) ("Because descriptive words have little source-indicating significance, it is appropriate that we give less weight"); *In re Taylor & Francis (Publ'rs), Inc.*, Ser. No. 75229157, 2000 TTAB LEXIS 380, at *6 (TTAB 2000) (PRESS, as applied to printing or publishing establishment, "is in the nature of a generic entity designation which is incapable of serving a source-indicating function"); *see also In re Code Consultants*, 2001 TTAB LEXIS 685, at *12 (disclaimed matter is often "less significant in creating the mark's commercial impression").

The design element in Applicant's mark also is entitled to less weight as consumers will call for the mark by their literal portions. *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 TTAB LEXIS 108, *6 (TTAB 2018) ("In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.").

We find the dominant feature in Applicant's mark is PHARMASSIST.



As to the cited word and design mark, , the dominant element is PHARM ASSIST. It is the most prominent portion of the mark. The disclaimed term SENIOR is much smaller in size in comparison to PHARM ASSIST, has less source indicating significance, and the black rectangle encompassing the disclaimed term SENIOR also is entitled to less weight. *In re Dixie Rests.*, 105 F.3d at 1407 (design element and disclaimed matter not the dominant portion of the mark DELTA CAFÉ and design); *In re Hughes Furniture*, 2015 TTAB LEXIS 65, at *15-18 (disclaimed terms in smaller font and the design element that serves as a carrier for the wording is less dominant than HUGHES which also is in larger bolder lettering).

In considering Applicant's mark and the cited mark, we find they are similar in appearance, sound, and meaning with respect to the shared term PHARMASSIST/PHARM ASSIST. The presence of a space in PHARM ASSIST in the cited mark as compared to PHARMASSIST in Applicant's mark is not significant. *In re Best W. Family Steak House, Inc.*, 1984 TTAB LEXIS 173, at *1 (BEEFMASTER and BEEF MASTER "are practically identical").

The marks also differ in appearance, sound, and meaning, because of the additional matter in each mark – disclaimed terms and design elements.

As we found above, the term PHARMASSIST/PHARM ASSIST is in common use in the pharmaceutical industry, may be the phonetic equivalent of "pharmacist," and is highly suggestive. Therefore, the scope of protection to which the cited registrations are entitled is quite limited.

If the matter shared by the two marks is highly suggestive, merely descriptive, or commonly used or registered in the industry for similar goods or services, an addition of a term or terms or other matter to another's mark may avoid confusion. *See In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986) ("The record shows that a large number of marks embodying the words 'bed and breakfast' are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words 'bed and breakfast.'"); *In re Hartz Hotel Servs., Inc.*, 2012 TTAB LEXIS 75, at *13 (numerous third-party uses of GRAND HOTEL marks for hotel services show that consumers distinguish between these marks even though the only distinguishing element is a geographically descriptive term; "GRAND HOTEL is highly suggestive, and therefore the scope of protection to which the cited registration is entitled is quite limited.").

When we compare the marks



and



SENIOR PHARM Assist in their entireties, in view of the highly suggestive nature of the shared term PHARMASSIST/PHARM ASSIST, we find the additions of ON DEMAND and PLLC and the design element to the term PHARMASSIST in Applicant's mark is sufficient to distinguish it from the cited mark SENIOR PHARM ASSIST and design.

Registration No. 6659936 PHARM-ASSIST (in standard characters)

Turning now to the cited mark PHARM-ASSIST, it is in standard characters, so we must consider all depictions “regardless of font style, size, or color,” including the font style and colors used in Applicant’s mark. *Citigroup*, 637 F.2d at 1353; *see also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (the rights associated with a mark in standard characters reside in the wording and not in any particular display).


As already discussed, PHARMASSIST is the first term in Applicant’s mark and the dominant feature, with the disclaimed matter PLLC and ON DEMAND and the design element entitled to less weight. The addition of a hyphen in Registrant’s mark PHARM-ASSIST has no meaningful impact on the analysis. *See Goodyear Tire & Rubber Co.*, 1978 TTAB LEXIS 143, at *7 n.4 (FAST-FINDER with hyphen is in legal contemplation substantially identical to FASTFINDER without hyphen).

PHARM-ASSIST, the cited mark, and the term PHARMASSIST in Applicant’s mark, are nearly identical in appearance, sound, and connotation. However, the marks also differ in appearance, sound, and connotation due to the additional literal terms in Applicant’s mark ON DEMAND and PLLC as well as the addition of a design element.

“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.” *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160 (CCPA 1958); *see also Juice Generation*, 794 F.3d at 1338 (“The weaker [a registrant’s] mark, the closer an

applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”).

If the matter common to the marks is highly suggestive, additions to marks may be sufficient to avoid a likelihood of confusion, even if such additions are descriptive matter. *In re Hunke & Jochheim*, 1975 TTAB LEXIS 13, at *5 (TTAB 1975)²⁴ (“the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to distinguish between them so as to avoid confusion”; given the narrow scope of protection, DURABL and HIG•DURABLE distinguishable to avoid confusion); *see also*, *In re Bed & Breakfast Registry*, 791 F.2d 159 (BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not confusingly similar).

Considering the marks PHARM-ASSIST and  in their entirety, and in view of the weakness of the highly suggestive term PHARMASSIST/PHARM-ASSIST in connection with pharmacies, its phonetic equivalency to “pharmacist,” and the narrow scope of protection to which Registrant is entitled, we find the addition of the terms ON DEMAND and PLLC and the design element in Applicant's mark sufficient to render Applicant's mark distinguishable from the cited mark PHARM-ASSIST.

The first *DuPont* factor weighs against a finding of likelihood of confusion.

²⁴ Proceeding no. unavailable.

II. Conclusion

The second and third *DuPont* factors weigh in favor of likelihood of confusion. The fourth *DuPont* factor is neutral. The strength of the mark under the fifth and sixth *DuPont* factors and the similarity of the marks under the first *DuPont* factor weigh against likelihood of confusion.

Although we find the services identical or identical in part, overlapping channels of trade and classes of consumers, in view of the narrow scope of protection afforded the term PHARM ASSIST/PHARM-ASSIST in the cited marks, we find confusion is unlikely. The first *DuPont* factor, in this case, is the dispositive factor. *See Kellogg Co. v. Pack-Em Enters. Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) (“[W]e know of no reason why, in a particular case, a single du Pont factor may not be dispositive.”).

Decision: The Section 2(d) refusal to register Applicant’s mark

 is reversed.

APPENDIX

Third-party Registrations

Registration No.	Mark	Goods/Services
Reg. No. 2866045	PHARMASSIST SYMPHONY	Computer software for controlling medicinal pill, capsule and tablet dispensing machines and workstations consisting of computer processors, pill singulation and dispensing machines, electronic displays, and optical scanners
Reg. No. 3001903	PHARMASSIST	Analytical laboratory research services in the field of pharmaceuticals
Reg. No. 4019106	PHARMASSIST OPTIX	optical pill counting machine comprising computer hardware and software for prescription dispensing and verification
Reg. No. 5179171	PHARMASSIST CAREER SERVICES (career services disclaimed)	Career services in the field of pharmacy, namely, career placement and career planning services; revise or create resumes; curriculum vitae; career services, namely, revise or create cover letters, perform an active job search, provide interviewing tips and advice, perform mock interviews; provide career information; provide career consultations
Reg. No. 5239808	PHARMASSIST RX COLLECT (RX Collect disclaimed)	pharmacy prescription fulfillment machines, namely, prescription collation

Reg. No. 2331220	PHARMASSIST	Automatic and semi-automatic dispensing systems
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Third-party use (websites)

PHARMASSIST	Pharmaceutical fluid dispensing pump
PHARMASSIST ANALYTICAL LABORATORY	Analytical laboratory
PHARMASSIST SMART CABINET AND ROBOT X	Robotic Pharmaceutical Laboratory
PHARM-ASSIST DRUGS LTD	Full-service pharmacy
PHARMASSIST PROGRAM	Mail order prescriptions program
PHARMASSIST COMPATIBLE	Pharmacy transfer tubing
PHARM-ASSIST SERVICES INC.	Pharmacy consulting company
PHILADELPHIA PHARM ASSIST MEETING	Pharmacist club
THE PHARMASSIST MANUAL	Book on pharmaceuticals
PHARMASSIST FOR THE AGED AND DISABLED	State funded pharmaceutical program
PHARM ASSIST	Pharmacy services
PHARMASSIST CONTRACT RESEARCH ORGANIZATION	Clinical research organization
PHARM ASSIST CONSULTING	Medical consulting services
PHARMASSIST ROBOTX	Pharmaceutical dispenser
PHARMASSIST	Pharmaceutical training services (Australia)
PHARMASSIST: SOLUTIONS	Pharmacy software (UK)
PHARMASSIST MULTIMEDIA CD	Health related CD

PHARM-ASSIST BY CASTILLO AND ASSOCIATES	Pharmaceutical mobile app for taking medications
PHARM ASSIST SERVICES P.L.L.C.	Pharmacy services
PHARMASSIST HIGH VOLUME SOLUTIONS	Patient safety
PHARMASSIST FLUID TRANSFER PUMP	Tool for filling oral doses
NATIONWIDE PHARMASSIST	Pharmacy retail
PHARMASSIST	Prescription label printer
NORTH DAKOTA PHARMASSIST PROGRAM	Program for impaired pharmacists
PHARMASSIST PRN SCHOLARSHIP	Pharmacist scholarship
AMERICAN PHARMASSIST	Healthcare consulting
PHARMASSIST COMPLIANCE SOLUTIONS	Healthcare consulting
MYPHARMASSIST	Pharmacist education
PHARMASSIST PROGRAM	Volunteer program to connect pharmacists to professional resources and peer support
PHARMASSIST CAREER SERVICES	Career services
PHARMASSIST	Pharmacy medication training program
	Medication management (Canada)
PHARMASSIST BY INNOVATION	Computer software
MONTANA PHARMASSIST PROGRAM	Program for assisting in making prescription drugs more affordable
PHARMASSIST	Computer software business distribution solution in the pharmaceutical field
INNOVATION PHARMASSIST CORE DISPENSER SMART CABINET	cabinet
PHARMASSIST	Medication management app, Apollo IO

GENEREX PHARMASSIST PVT LTD.	Company located in India
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Statewide Corporate Names - Active

Pharmassist Properties LLC	Alabama
Pharm Assistants PLLC	Arizona
PharmAssist Consulting LLC	Arizona
PharmAssist Holdings LLC	Arizona
PharmAssisted LLC	Arizona
Your Pharm Assist LLC	Arizona
PharmAssist Consulting Inc.	California
Pharm-Assist Temporary Personnel Services	Colorado
Pharmassist Group	Delaware
Pharmassist Group LLC	Delaware
Pharmassist Holdings LLC	Delaware
Pharmassist Pharmacy Franchising LLC	Delaware
Pharmassist Pharmacy LLC	Delaware
U.S. Pharmassist Corporation	Delaware
Pharm Assist Advantage Inc.	Georgia
Pharm Assistance Inc.	Georgia
PharmAssist Consultants LLC	Georgia
PharmAssisters Enterprises LLC	Georgia

Pharm Assist Prn LLC	Kansas
PharmAssist Weight Management and Alcohol Recovery LLC	Kansas
PharmAssistToGo LLC	Maryland
PharmAssist US LLC	Maryland
PharmAssist Care LLC	Massachusetts
American Pharmassist	Michigan
American Pharmassist Group LLC	Michigan
Can/Am Pharmassist	Michigan
Pharmassist	Michigan
Pharmassist Corp.	Michigan
Pharmassist Pharmacy LLC	Michigan
Pharmassist Career Services	Missouri
Pharmassistance Associated Enterprises	Missouri
Pharmassist	New Hampshire
Pharmassist Consulting Services Limited Liability	New Jersey
Pharmassist Inc.	New Jersey
Pharmassist Staffing LLC	New Jersey
NM Pharm-Assist	New Mexico
Pharm-Assist LLC	New Mexico
Pharmassist Group	New York
Pharmassist Group	New York

Pharmassist Consulting LLC	New York
Pharmassist Inc.	New York
QC Laboratories Pharmassist Division	New York
My Pharmassist LLC	New York
Pharm-Assist Inc.	North Carolina
The PharmAssist Co.	North Carolina
Pharmassist Consultants Inc.	Ohio
Pharmassist Inc.	Ohio
PharmAssist Consulting	Pennsylvania
Pharmassist Temporary Services	Pennsylvania
Pharmassist Consulting LLC	Pennsylvania
Pharmassist Staffing	Pennsylvania
My Pharmassist	South Carolina
Pharm Assist	South Carolina
Pharmassist LLC	Tennessee
Pharmacist Concierge Pharmaceutical Services PLLC	Texas
Pharmassist Inc.	Texas
Pharmassist LLC	Texas
Pharmassist Med LLC	Texas
Pharmassist Services LLC	West Virginia
Pharmassist Healthcare Dashboards LLC	Wisconsin