

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
August 13, 2013

Mailed:
August 26, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Clear Choice Holdings LLC
v.
Implant Direct Int'l
—

Opposition No. 91190485
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Neal G. Massand and Brian A. Colao of Dykema Gossett PLLC for Clear Choice Holdings LLC.

Patrick F. Bright of Wagner, Anderson & Bright, P.C. for Implant Direct Int'l.
—

Before Quinn, Gorowitz, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On January 20, 2009, applicant Implant Direct Int'l applied to register the mark REAL CHOICE, in standard characters, for dental implant services.¹ Opposer Clear Choice Holdings LLC opposes registration on the grounds that applicant's mark is likely to cause confusion with its mark CLEARCHOICE

¹ Application Serial Number 77652784, filed on the basis of a bona fide intention to use the mark in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant states in its brief that it is now Implant Direct Sybron International LLC ("IDS") and IDS now owns applicant's mark. Applicant's Brief at 9 n.1. However, no assignment has been recorded.

DENTAL IMPLANTS pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and also likely to cause dilution pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Both parties filed trial briefs, opposer filed a reply brief, and a hearing was held on August 13, 2013.

The Record

The parties made the following evidence of record by stipulation:

- Deposition transcripts of the following fact witnesses, with exhibits:²
 - Steve Boyd, manager and a founder and owner of opposer;
 - Lawrence Deutsch, marketing director of opposer; and
 - Dr. Gerald Alvin Niznick, president and CEO of applicant.
- Deposition transcripts of the following expert witnesses, with exhibits:
 - Michael Rappeport, opposer's survey expert, and
 - Hal Poret, who prepared a critique of the Rappeport survey on behalf of applicant.

² The Boyd and Niznick discovery deposition transcripts may be offered in evidence at trial because those witnesses are officers of the parties. Trademark Rule § 2.120(j)(1), 37 C.F.R. § 2.120(j)(1). Although no written stipulations are of record, it appears that the parties stipulated to introduction of the discovery depositions of all other witnesses as trial evidence. *See* Niznick Transcript at 112:1-12 ("Mr. Bright: One thing I do want to put on the record . . . Mr. Colao and I have agreed, that these depositions, meaning the deposition of ClearChoice under Rule 30(b)(6) where the witness was Mr. Boyd, Stephen Boyd, and the testimony of Mr. Deutsch for ClearChoice and the testimony of Dr. Niznick, are both what the Trademark Trial and Appeal Board calls discovery and evidentiary, meaning that they can be used in the evidentiary phase of the opposition. Correct? Mr. Colao: Yes, they can."). This stipulation is hereby approved. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.09 (3d ed. rev. 2 June 2013). The Board also will receive in evidence the expert deposition transcripts submitted pursuant to the parties' joint stipulation although they were untimely filed on October 18, 2012, after the close of trial on August 20, 2012, as Exhibits 1 and 2 to the "Joint Supplemental Notice of Reliance." The parties are advised that agreements to modify Board procedure should be submitted to the Board for approval. *See* TBMP § 705 ("Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence.").

All transcripts were introduced by notice of reliance. The parties are advised that otherwise admissible deposition transcripts are not admissible via notice of reliance but instead should be individually filed with the Board pursuant to the procedure identified in Trademark Rule § 2.125, 37 C.F.R. § 2.125.

The following additional evidence was made of record via notice of reliance:

- A status and title copy of opposer's pleaded Registration Number 3225921, as well as a certified copy of its file history;³
- The file history of the opposed application, Serial Number 77652784;⁴
- The following discovery documents:
 - Opposer's initial disclosures;
 - Opposer's response to applicant's interrogatories;
 - Opposer's response to applicant's request for production of documents;
 - Opposer's first amended response to applicant's interrogatories;
 - Applicant's responses to opposer's interrogatories;
 - Applicant's responses to opposer's requests for production of documents;

³ Opposer also attempted to introduce copies of its other three pleaded registrations – Nos. 3553219, 3685880, and 3181966 – as Exhibit 3 to the “Joint Supplemental Notice of Reliance.” However, opposer provided only plain copies of the registration certificates, which do not establish current status and title of the registrations. Pursuant to Trademark Rule § 2.122(d), this was not effective to make these registrations of record, and they are not in evidence. Furthermore, we take judicial notice of the fact that Registration No. 3181966 was cancelled July 12, 2013 pursuant to Section 8 of the Trademark Act. *See Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.9 (TTAB 2007); *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1487-88 n.10-12 (TTAB 2007); TBMP § 704.03(b)(1)(A).

⁴ It was unnecessary to submit the file history of the opposed application, as it forms part of the record of the proceeding without any action by the parties. Trademark Rule § 2.122(b)(1); TBMP § 704.03(a). For the same reason, it also was unnecessary to submit the pleadings in the case by notice of reliance.

- Applicant's supplemental responses to opposer's interrogatories;
- Opposer's survey report, prepared by Michael Rappeport of RL Associates, and verbatim survey responses;
- Expert report of Hal Poret, an analysis of opposer's survey prepared for applicant; and
- A series of letters and emails exchanged between opposer's counsel and applicant's principal.

All of these documents were proffered by opposer via notice of reliance.

It was improper for opposer to submit its own discovery responses. Trademark § 2.120(j)(5); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.10 (3d ed. rev. 2 June 2013). Additionally, letters, emails, and expert reports are not admissible by notice of reliance. Trademark Rule 2.122(e); TBMP § 704.08(a). However, applicant did not object to admission of any of these materials; in fact, applicant affirmatively incorporated by reference each of the documents submitted by opposer in its own notice of reliance. For these reasons, we hereby admit into evidence all the materials listed above for whatever persuasive value they may have.⁵

Finally, we take judicial notice of the excerpt from THE SYNONYM FINDER attached as Exhibit A to opposer's reply brief. We also take judicial notice of the following definitions of the adjectives "clear" and "real" on the Merriam-Webster Online Dictionary (m-w.com), referenced in applicant's brief, as available on the date of the oral hearing:

⁵ We note that several of the documents also appear in the record as deposition exhibits.

Definition of *CLEAR*

- 1 *a* : BRIGHT, LUMINOUS
b : CLOUDLESS; *specifically* : less than one-tenth covered
<a *clear* sky>
c : free from mist, haze, or dust <a *clear* day>
d : UNTROUBLED, SERENE <a *clear* gaze>
- 2 : CLEAN, PURE: as
a : free from blemishes <*clear* skin>
b : easily seen through : TRANSPARENT <*clear* glass>
c : free from abnormal sounds on auscultation
- 3 *a* : easily heard <a loud and *clear* sound>
b : easily visible : PLAIN <a *clear* signal>
c : free from obscurity or ambiguity : easily understood :
UNMISTAKABLE <a *clear* explanation>
- 4 *a* : capable of sharp discernment : KEEN <a *clear*
thinker>
b : free from doubt : SURE <not *clear* on how to proceed>
- 5 : free from guile or guilt : INNOCENT <a *clear*
conscience>
- 6 : unhampered by restriction or limitation: as
a : unencumbered by debts or charges <a *clear* estate>
b : NET <a *clear* profit>
c : UNQUALIFIED, ABSOLUTE <a *clear* victory>
d : free from obstruction <*clear* passage>
e : emptied of contents or cargo
f : free from entanglement or contact <staying *clear* of
controversy> <keep *clear* of the boundary>
g : BARE, DENUDED <*clear* ground>

Definition of *REAL*

- 1 : of or relating to fixed, permanent, or immovable
things (as lands or tenements)
- 2 *a* : not artificial, fraudulent, or illusory : GENUINE <*real*
gold>; *also* : being precisely what the name implies <a
real professional>
b (1) : occurring or existing in actuality <saw a *real* live
celebrity> <a story of *real* life> (2) : of or relating to
practical or everyday concerns or activities <left school
to live in the *real* world> (3) : existing as a physical
entity and having properties that deviate from an ideal,
law, or standard <a *real* gas> — compare IDEAL 3b
c : having objective independent existence <unable to
believe that what he saw was *real*>

d : FUNDAMENTAL, ESSENTIAL

e (1) : belonging to or having elements or components that belong to the set of real numbers <the *real* roots of an equation> <a *real* matrix> (2) : concerned with or containing real numbers <*real* analysis> (3) : REAL-VALUED <*real* variable>

f : measured by purchasing power <*real* income> <*real* dollars>

g : COMPLETE, UTTER <a *real* fiasco>

3 *of a particle* : capable of being detected — compare VIRTUAL 3

See UMG Recordings Inc. v. Mattel, Inc., 100 USPQ2d 1868, 1874 (TTAB 2011); FED. R. EVID. 201(c)(1), (2); TBMP § 704.12.

Standing and Priority

We first consider opposer's standing to bring this opposition against the involved application. Opposer has established its ownership of pleaded Registration No. 3225921, issued April 3, 2007 for the mark CLEARCHOICE DENTAL IMPLANTS for "dental services, namely dental implant services." Opposer's standing to oppose registration of applicant's mark is established by its pleaded registration, which the record shows to be valid and subsisting, and owned by opposer. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). In addition, because opposer's pleaded registration is of record, priority is not in issue with respect to the services identified in the registration, namely dental implant services. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). There is no dispute that opposer has priority vis-à-vis applicant, which filed the involved application on an intent-to-use basis on January 20, 2009.

Likelihood of Confusion

“We determine likelihood of confusion by focusing on the question whether the purchasing public would mistakenly assume that the applicant’s [services] originate from the same source as, or are associated with, the [services] in the cited registrations.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider all probative facts in evidence 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, 177 USPQ 563, 567 (CCPA 1973).

The parties have presented evidence on the following *du Pont* factors: similarity of the parties’ marks (factor 1); similarity of their services (factor 2); similarity of trade channels and the buyers to whom sales are made, including consumer sophistication (factors 3 and 4); fame of opposer’s mark (factor 5); the nature and extent of any actual confusion (factor 7); and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion (factor 8). Opposer also has submitted evidence concerning applicant’s alleged bad-faith intent in adopting its mark (*du Pont* factor 13; *see also*, *e.g.*, *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006)). We find the remaining factors to be neutral or inapplicable.

A. Similarity of the Services, Channels of Trade, and Classes of Customers

We begin with the similarities or differences between opposer’s and applicant’s services, the second *du Pont* factor. It is settled that in making our determination regarding the relatedness of the parties’ services, we must look to the services as identified in the application and opposer’s pleaded registration. *See*

Octocom Sys. Inc. v. Houston Computer Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). That is, because the scope of the registration applicant seeks is defined by its application (not by its use), it is the application (not its use) that we must look to in determining applicant's right to register:

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 sales of the goods are directed.

Id.

The services identified in opposer's Registration No. 3225921 for CLEARCHOICE DENTAL IMPLANTS are "dental services, namely dental implant services." The services identified in the application likewise are "dental implant services." Thus, the parties' services are identical.

The third *du Pont* factor assesses the similarity of the trade channels for the parties' services. Because there are no limitations to the recitation of services in the application or opposer's registration as to channels of trade and classes of purchasers, we must presume that the parties' services travel through all usual channels of trade and are offered to all normal potential purchasers. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *see also Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Moreover, because the services described in the application and opposer's registration are identical, we presume that the channels of trade and

classes of purchasers are the same. *See In re Vitterra 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); *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The second and third *du Pont* factors weigh heavily in opposer's favor.

B. Similarity of the Marks

We next address the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of “the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether they are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. 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*, No. 92-1086 (Fed. Cir. June 5, 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224

USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 a consideration of the marks in their entireties. *In re Nat’l Data Corp.*, 224 USPQ at 751.

Where, as here, the services are identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

The mark applicant seeks to register is REAL CHOICE. Opposer’s registered mark is CLEARCHOICE DENTAL IMPLANTS, with DENTAL IMPLANTS – the generic term for both parties’ identified services – disclaimed. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of

confusion.”) (*quoting In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). Thus, though we compare the marks REAL CHOICE and CLEARCHOICE DENTAL IMPLANTS in their entireties, we give more weight to the distinctive portions of the two marks: REAL CHOICE and CLEARCHOICE.

The absence of a space between the words CLEAR and CHOICE in opposer’s registration does not significantly impact the commercial impression made by its mark, as consumers are still likely to recognize the individual component words CLEAR and CHOICE. In appearance and sound, REAL CHOICE and CLEARCHOICE are similar; each prefaces the word CHOICE with a one-syllable term featuring a long “e” vowel sound framed by consonants. Indeed, REAL is an anagram of CLEAR minus the “c.”

Applicant disputes opposer’s contention that CLEAR and REAL have similar meanings. Nonetheless, opposer provided a thesaurus listing “real” as one of many synonyms for the adjective “clear.”⁶ Although we do not view the phrases REAL CHOICE and CLEARCHOICE as exact synonyms, their connotations are related.

Overall, applicant’s REAL CHOICE mark makes a commercial impression similar to opposer’s registered mark CLEARCHOICE DENTAL IMPLANTS, particularly considered in the context of the parties’ identical identified services. The first *du Pont* factor weighs in opposer’s favor.

⁶ J.I. RODALE, THE SYNONYM FINDER 174 (1978), Opposer’s Reply Brief, Exhibit A.

C. Conditions of Sale and Consumer Sophistication

Under the fourth *du Pont* factor, we consider the conditions under which and buyers to whom sales are made. The evidence shows that dental implant services can be very expensive, costing from \$10,000 to \$50,000.⁷ We are constrained, however, to consider the parties' "dental implant services" as they are recited in the application and registration, which are not limited to services of any certain price. Moreover, there is no evidence establishing that purchasers of dental implants are sophisticated.⁸ The Board has previously noted that, "in purchasing healthcare services, even ordinary consumers are likely to exercise greater care and will know with whom they are dealing." *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1504 (TTAB 2005). Yet even assuming that ordinary consumers tend to exercise some sophistication when purchasing healthcare services, careful or sophisticated purchasers are not immune from source confusion where similar marks are used in connection with related services. *See In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("Human memories even of discriminating purchasers . . . are not infallible.") (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)).

We find that the similarities between the marks and the goods sold thereunder outweigh any sophisticated purchasing decision. *See HRL Assocs. Inc.*

⁷ Boyd Transcript at 36:7-10, 84:5-20.

⁸ Opposer's manager Steve Boyd testified that both parties offer their services to "[a]nybody who is missing one, several or all of their teeth or needs to have their bad teeth replaced." *Id.* at 115:16-18.

v. Weiss Assocs. Inc., 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Thus, the fourth *du Pont* factor is neutral.

D. Fame of Opposer's Mark

The fifth *du Pont* factor requires us to consider the fame of opposer's marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the services identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments and notice by independent sources of the services identified by the marks, and by the general reputation of the services. *Id.*, 63 USPQ2d at 1305-09. Some context in which to place raw numbers of product sales and advertising expenses may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309. Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer's evidence falls woefully short of establishing the fame of its mark. Opposer provides only scant, indirect evidence of fame in the form of testimony that it currently has 32 centers in 21 geographic marketplaces nationwide;⁹ that it has treated "thousands" of customers;¹⁰ and that its centers spend \$1 million per month advertising its services.¹¹ Conspicuous in its absence is any evidence, whether direct or indirect, that opposer's efforts to publicize its mark have succeeded in garnering consumer or third-party recognition of its mark. Applicant provides no evidence as to its sales or share of the dental implant services market, no detail as to how many "thousands" of customers it has treated nationwide, no evidence as to the time frame during which it has spent \$1 million per month on advertising,¹² and little specific evidence by which we could determine the forms of opposer's

⁹ Deutsch Transcript at 16:5-8.

¹⁰ *Id.* at 31:5-32:10.

¹¹ Boyd Transcript at 118:20-119:7. Applicant argues in its brief that testimony by Mr. Boyd regarding opposer's advertising expenditures is inadmissible because he lacked personal knowledge under FED. R. EVID. 602. We note that applicant's counsel did not object to this testimony at deposition. We also disagree with applicant's argument because, not only was Mr. Boyd designated as opposer's corporate representative, he also testified that he had personal knowledge of this subject. Boyd Transcript at 118:20-119:2. Applicant also objects that evidence of opposer's advertising expenditures should have come from original documents pursuant to FED. R. EVID. 1002. *See* Applicant's Brief at 22-23. In this case, any written evidence of advertising expenditures would fall under FED. R. EVID. 1004(d), an exception to the "best evidence rule" embodied in Rule 1002, because such documents are "not closely related to a controlling issue." *See Mag Instrument, Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1707-08 (TTAB 2010), *aff'd*, No. 2011-1052, -1053 (Fed. Cir. Nov. 9, 2011). Thus, we see no reason to exclude Mr. Boyd's oral testimony. In any event, should admission of Mr. Boyd's testimony be held erroneous on appeal, the error is harmless because opposer's advertising expenditures are insufficient to prove fame and do not affect our finding on *du Pont* factor 5 or our holding herein.

¹² There is no record support for opposer's assertion in its brief that opposer has spent a total of nearly \$84 million on advertising. Opposer's Brief at 17. Presumably, this figure was derived simply by multiplying \$1 million by the number of months opposer has been in existence. No witness testified that opposer has spent \$1 million in advertising each month since it began doing business, and such a conclusion is unsupported by any record evidence.

advertising and how that advertising uses opposer's mark.¹³ Because opposer has not proven that its mark is famous, the fifth *du Pont* factor is neutral.

E. Extent of Concurrent Use and Actual Confusion

Among the final relevant *du Pont* factors, factor 7 assesses the nature and extent of any actual confusion, while factor 8 is the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Proof of actual confusion is not necessary to show a likelihood of confusion, and its absence is not dispositive. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). A showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. Yet the opposite is not true; the lack of evidence of actual confusion carries little weight. *See J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965).

The parties had coexisted for approximately 4½ years at the time of the oral hearing, since applicant first used the REAL CHOICE mark in February 2009, without evidence of actual confusion.¹⁴ However, applicant contends, and opposer

¹³ *See, e.g.*, Boyd Transcript at 81:7-12 (stating that opposer advertises via television, newspaper, radio, billboards, magazines, direct mail, and the Internet), 104:15-105:5 (stating that some of opposer's ads feature celebrities Mike Ditka and Tony Curtis), and Exhibit 4-23 (2009 newspaper ad for opposer featuring Mike Ditka). Although 85% of the respondents to opposer's survey – which will be discussed further *infra* – said they had heard of ClearChoice, we give this result no weight in our fame analysis because the survey universe was selected from a list of individuals who opposer said had contacted it within the preceding three years, presumably all of whom should be familiar with opposer.

¹⁴ *See* Boyd Transcript at 10:16-18; Niznick Transcript at 27:5-9; Exhibits 20 and 22, applicant's response to opposer's interrogatory No. 4.

does not dispute, that there are only three markets where both marks are in use: Atlanta, San Francisco, and Washington, D.C.,¹⁵ limiting the opportunities for actual confusion to arise. *Du Pont* factor 8 is therefore neutral.

Opposer submitted a survey, which can be regarded as evidence of actual confusion. *See Blue Cross & Blue Shield Ass'n v. Harvard Cmty. Health Plan Inc.*, 17 USPQ2d 1075, 1078 n.7 (TTAB 1990). However, while we will not address and do not necessarily accept all the critiques of that survey in the analysis by applicant's expert Hal Poret, the survey still suffers from numerous serious flaws.

First and foremost, the survey did not follow an established format to measure likelihood of confusion, but was created by opposer's expert in a design never before used in a trademark survey or accepted by any court.¹⁶ The survey combined tests of applicant's mark REAL CHOICE and a different third-party mark opposer is challenging (represented as RIGHT CHOICE),¹⁷ an approach the Poret analysis criticized. It also used a small number of respondents to test each mark: 90. Mr. Poret pointed out that smaller samples produce larger error rates, and we have found similar numbers of survey respondents insufficient. *See Zimmerman v. Nat'l Ass'n of Realtors*, 70 USPQ2d 1425, 1436 (TTAB 2004) (96 survey subjects too low); *In re Kimpton Hotel & Rest. Group, Inc.*, 55 USPQ2d 1154, 1157 (TTAB 2000) (100 respondents insufficient).

¹⁵ Applicant's Brief at 14. How long the parties' services have overlapped in these markets is unknown.

¹⁶ *See* Rapoport Transcript at 62:23-65:17.

¹⁷ The Rapoport survey report ("Rapoport Report") states that the name RightChoice is used by a dental practice in New York City that offers dental implantation. *Id.* at 1.

In addition, rather than following the accepted approach of using a survey universe comprising potential consumers of applicant's dental implant services,¹⁸ opposer's survey was conducted among a sample of 150,000 customers who had contacted opposer within the preceding three years and did not live in the 19 markets¹⁹ where applicant offers its services. Thus, the survey universe was purposely selected to be aware of opposer²⁰ and not applicant.²¹ Moreover, respondents were asked only whether they were familiar with dental implants, not if they were prospective consumers of dental implants.²²

The survey was designed, in relevant part, to test the hypothesis that: "When potential consumers who are aware of ClearChoice encounter the name RealChoice used in the context of dental implant services, they are likely to confuse it with ClearChoice."²³ During the survey, respondents were told that the

¹⁸ 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR Competition § 32:159 (4th ed. 2013) ("In a traditional case claiming 'forward' confusion, not 'reverse' confusion, the proper universe to survey is the potential buyers of the *junior user's* goods or services. . . . A survey of the wrong 'universe' will be of little probative value in litigation.").

¹⁹ See Exhibit 22, attachment to applicant's supplemental responses to opposer's interrogatories.

²⁰ The Poret analysis raises questions as to whether this assumption underlying the survey hypothesis and design was borne out by the results. Some 15% of the 180 total survey respondents said that they had never heard of CLEAR CHOICE, while another 38% said they had never had contact with CLEAR CHOICE, for a total of 53% – more than half.

²¹ See Rappeport Transcript at 34:9-13 (answering that survey respondents were from "places RealChoice was not available. That's the whole point."). Surveys in which the target population was consumers of the plaintiff's product have been criticized for not studying the full range of potential customers. See Shari Seidman Diamond, *Reference Guide on Survey Research*, in REFERENCE MANUAL ON SCIENTIFIC EVIDENCE 359, 379 (3d ed. 2011).

²² Questionnaire, Appendix A to Rappeport Report, at 1.

²³ Rappeport Report at 2.

interviewer would read them the names of companies that provide dental implant services, and asked whether they had heard of the two marks at issue here; 45 heard CLEAR CHOICE first followed by REAL CHOICE, while the other 45 heard the marks in reverse order. Respondents were also asked about the control name RIGHT OPTION during the portion of the survey relevant here. The results were:

- 86% of the 90 respondents said they had heard of CLEAR CHOICE, 13% had not heard of it, and 1% were not sure;
- 27% of the 45 respondents [i.e., 12 people] who heard REAL CHOICE before CLEAR CHOICE said they had heard of REAL CHOICE while 73% had not heard of it;
- 4% of the 45 respondents [i.e., 2 people] who heard REAL CHOICE after CLEAR CHOICE said they had heard of it, 96% had not heard of it; and
- 3% of the 90 respondents said they had heard of the control name RIGHT OPTION and 97% had not heard of it.²⁴

The survey then combined “the estimates of guessing and prior actual contact” with both names tested, REAL CHOICE and RIGHT CHOICE, to increase statistical reliability of what the survey author considered to be noise, arriving at a figure of 6%. This 6% “estimate of the guessing/prior contact” was subtracted from the 27% result to yield a 21% result for the name REAL CHOICE. In a second measure of noise, the survey again combined respondents who said they had heard of the controls across both names tested to arrive at a 4% estimate of noise, yielding a 23% result for the name REAL CHOICE.

In sum, 21% to 23% more survey respondents said they had heard of CLEAR CHOICE and not REAL CHOICE when questioned about the terms in that order

²⁴ *Id.* at 9.

than when asked with the terms in reverse order. Opposer's expert contends that this result shows confusion in those percentages; that is, that 21% to 23% of potential consumers who are aware of CLEAR CHOICE and encounter the name REAL CHOICE in the context of dental implant services are likely to confuse it with CLEAR CHOICE.²⁵

Survey respondents also were asked follow-up questions:

- Q1a. What, if anything, can you tell me about [INSERT NAME], aside from the fact that they provide dental implant services?
- Q1b. By any chance, have you or has anyone in your household ever had any contact with [INSERT NAME]?

Those respondents who said they or someone in their household had contact with the company were asked:

- Q1c. By any chance, have you or has anyone in your household ever had any work done by [INSERT NAME]?

However, opposer's expert report does not address the responses to these follow-up questions, and they apparently were not factored into the survey results.

Mr. Poret contends in his analysis that, among the 24 respondents who were asked about REAL CHOICE or RIGHT CHOICE before CLEAR CHOICE and answered that they had heard of REAL CHOICE or RIGHT CHOICE, 16 respondents gave additional answers indicating that they were not confused by the test names. Mr. Poret states that four subjects said they had not heard of CLEAR CHOICE, so they could not be experiencing source or trademark confusion between

²⁵ *Id.* at 12.

the parties. According to Mr. Poret, 12 other subjects gave responses suggesting that they recognize the parties here (or the user of the RIGHT CHOICE mark) as separate entities and were not confused.²⁶ Mr. Poret argues that this leaves only 8 out of 90 respondents who possibly could have been confused, that is, less than 9% of respondents before accounting for survey noise and margin of error.

Given that opposer characterizes its mark as famous, we question why opposer's expert chose not to follow the *Ever-Ready*²⁷ survey format, which we have accepted and which has been called the "gold standard" in likelihood of confusion cases.²⁸ 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 32:173.50 (4th ed. 2013) (quoting J.B. Swann, *Likelihood of Confusion Studies and the Straightened Scope of Squirt*, 98 TRADEMARK REP. 739, 746 (2008)); *see also Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1753 (TTAB 2006) (stating "given the way in which this survey format carefully follows the *Ever-Ready* likelihood of confusion survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein").

²⁶ According to Mr. Poret, these 12 individuals said during the survey that they had contacted one but not the other of the parties (or RIGHT CHOICE), indicating that they understood them to be distinct sources.

²⁷ *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976). In that case, plaintiff Union Carbide conducted a survey to determine whether there was a likelihood of confusion between defendant's EVER-READY lamps and plaintiff's EVEREADY batteries, flashlights and bulbs. The survey asked: "Who do you think puts out the lamp shown here? [showing a picture of defendant's EVER-READY lamp and mark]," "What makes you think so?" and "Please name any other products put out by the same concern which puts out the lamp shown here." *Id.* at 640.

²⁸ Opposer's expert testified that he designed the survey to test initial interest confusion. *See* Rappeport Transcript at 37-39. Our primary reviewing court has not embraced the theory of initial confusion. *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

Because we cannot conclude that opposer's survey actually measured an appreciable likelihood of confusion, we give it no weight in our analysis. *See In re Hotels.com, L.P.*, 87 USPQ2d 1100, 1109-10 (TTAB 2008), *aff'd*, *In re Hotels.com LP*, 573 F3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009). *Du Pont* factor 7 is neutral.

F. Applicant's Intent

Finally, opposer emphasizes that applicant initially adopted a logo that was virtually identical to opposer's logo, including incorporating the same shooting star design, and that applicant copied elements of opposer's website. In response, applicant's CEO, Dr. Niznick, did not deny that applicant initially used a logo incorporating a shooting star in the same manner as opposer's logo, but emphasized that it was changed promptly after opposer objected. Dr. Niznick testified:

. . . I told my IT people, "We want to put together a Web site that we could offer to doctors," and I referred them to the ClearChoice Web site as an example of the kind of patient information that we would need, just like I look at [dental implant maker] Nobel's Web site or anybody else's. This is what they came up with.

As soon as your client contacted us and objected to it, I immediately changed and responded and went to something that is very distinct from – in the look, eliminating the star, putting an implant in, different color background, different font.²⁹

Bad faith, or intent to confuse, falls under the thirteenth *du Pont* factor, "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[A] party which knowingly adopts a mark similar to one used by another for related goods should not be surprised to find

²⁹ Niznick Transcript at 27:16-28:1.

scrutiny of the filer's motive." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). "[W]here there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First Int'l Servs. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See, e.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.") (quotation omitted).

In light of applicant's change to its logo after contact by opposer, we cannot conclude that applicant manifested a bad-faith intent to deceive consumers, even if it did intend to copy opposer's logo and website. We therefore find the final likelihood of confusion factor to be neutral.

Weighing the Factors

We have carefully considered all of the record evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). All relevant factors either favor opposer or are neutral. On balance, we find by a

preponderance of the evidence that applicant's REAL CHOICE mark is likely to cause confusion with opposer's mark CLEARCHOICE DENTAL IMPLANTS when used in association with dental implant services. To the extent we have any doubt, it must be resolved in favor of the prior registrant. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d at 1202; *Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1514 (TTAB 2000).

Likelihood of Dilution by Blurring

We conclude by briefly addressing opposer's claim that applicant's mark will dilute its mark under Trademark Act § 43(c), 15 U.S.C. § 1125(c), by blurring its distinctiveness. To prevail on a dilution claim, opposer must prove that: (1) its mark is famous, (2) its mark became famous prior to the date of the application to register the applicant's mark, and (3) applicant's mark is likely to blur the distinctiveness of the opposer's famous mark. *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011).

Dilution requires a more stringent showing of fame than likelihood of confusion. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012). For all the same reasons we have determined that opposer has not met its burden to prove that its mark is famous for purposes of likelihood of confusion, opposer has not met its higher burden to prove fame in the dilution context, and its dilution claim must fail. *See id.* at 1727.

Decision: The opposition is sustained on the ground of likelihood of confusion pursuant to Section 2(d) of the Trademark Act and dismissed as to likelihood of dilution under Trademark Act Section 43(c).