

This Opinion is Not a
Precedent of the TTAB

Hearing: September 28, 2021

Mailed: December 14, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Children's Hospital of Philadelphia
v.
Arkansas Children's, Inc.

Opposition No. 91242802

Lynn E. Rzonca of Ballard Spahr LLP
for The Children's Hospital of Philadelphia.

James E. Shlesinger of Shlesinger Arkwright & Garvey LLP
for Arkansas Children's, Inc.

Before Shaw, English, and Lebow,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:


Applicant, Arkansas Children's, Inc., seeks registration on the Principal Register

of the mark  **Arkansas
Children's** for:

- “Charitable fund raising services, namely, raising funds to support pediatric care, research, education and prevention programs” in International Class 36;

- “Transportation of human patients and organs by ground and air” in International Class 39;
- “Educational services and providing training, namely, conducting classes, seminars and residency and internship training for doctors, nurses, technicians and other professionals and paraprofessionals in the medical and health care fields” in International Class 41;
- “Scientific and medical research to improve child health and development” in International Class 42; and
- “Medical and hospital services” in International Class 44.¹

In its notice of opposition, Opposer alleges priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on prior use and registration of the following marks:

-  for “hospitals, medical services, medical research; medical testing; providing health and medical information; medical counseling services” in International Class 42;²

¹ Application Serial No. 87634029; filed October 4, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on an allegation on first use since May 15, 2017 and first use in commerce on May 16, 2017 for each class of services. “Arkansas Children’s” disclaimed. The application includes the following description: “The mark consists of a crescent moon shape enveloping a child’s head and profile with the words ‘ARKANSAS CHILDREN’S’ to the right of the drawing.” Color is not claimed as a feature of the mark.

² Registration No. 2472946; issued July 31, 2001.

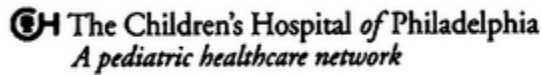
•  ³ and  ⁴ both for

“charitable fundraising services” in International Class 36; “educational services, namely, conducting medical residency training programs, medical fellowship training programs, and continuing medical education programs; training in the fields of nursing, social work, psychology and medical technology; providing medical, healthcare, and technical training for allied health professionals; conducting educational conferences, seminars, and workshops in the field of medicine and healthcare; conducting educational programs in the field of health and wellness” in International Class 41; “medical research; medical laboratories” in International Class 42; and “hospitals, medical services, medical clinics; dietary and nutritional guidance; emergency medical assistance; maintaining files and records concerning the medical condition of individuals; psychological counseling; medical testing for diagnostic or treatment purposes; medical counseling

³ Registration No. 5157959, issued March 7, 2017; “Children’s Hospital” disclaimed. Claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), as to “Children’s Hospital of Philadelphia.” The registration includes the following description of the mark: “The mark consists of the stylized letters ‘CH’ with a silhouette of a girl in the letter ‘C’ all in light baby blue and the wording ‘CHILDREN’S HOSPITAL OF PHILADELPHIA’ in dark royal blue.” The color(s) bright light baby blue and darker royal blue is/are claimed as a feature of the mark.

⁴ Registration No. 5188255; issued April 18, 2017; “Children’s Hospital” disclaimed. Claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), as to “Children’s Hospital of Philadelphia.” The registration includes the following description of the mark: “The mark consists of the stylized letters ‘CH’ with a silhouette of a girl in the letter ‘C’ and the wording ‘CHILDREN’S HOSPITAL OF PHILADELPHIA’.” Color is not claimed as a feature of the mark.

services; physical rehabilitation; providing health and medical information”
in International Class 44; and



- for “medical research in International Class 42” and “hospital services, medical services, medical testing; providing health and medical information; medical counseling services” in International Class 44.⁵

In its answer, Applicant admits that the certificate of registration for each pleaded registration “speaks for itself as to the purported information displayed.”⁶ Applicant otherwise denies the salient allegations in the notice of opposition.

The case is fully briefed. An oral hearing was held on September 28, 2021. For the reasons explained, we dismiss the opposition.

I. Evidentiary Record and Objections

A. Opposer’s Pleded Registrations

Applicant objects that Opposer’s pleaded registrations are not properly of record. Under Trademark Rule 2.122(d), a plaintiff may introduce its pleaded registration(s) by: (1) attaching to its complaint Office records showing the current status and title of the registrations; (2) appropriate identification and introduction during testimony;

⁵ Registration No. 3026022; issued December 13, 2005; “Children’s Hospital” disclaimed. Claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), as to “The Children’s Hospital of Philadelphia Pediatric Healthcare Network.” Color is not claimed as a feature of the mark.

⁶ 1 TTABVUE 8, ¶ 4; 8 TTABVUE 3, ¶ 4.

or (3) filing a notice of reliance during trial accompanied by Office records showing the current status and title of the registrations. 37 C.F.R. § 2.122(d); *United Global Media Grp. v. Tseng*, 112 USPQ2d 1039, 1041-42 (TTAB 2014) (explaining the ways in which a pleaded registration may be made of record).

Opposer asserts that its pleaded registrations are of record because it attached “soft” or “plain” copies of the registration certificates for the pleaded registrations to its notice of opposition. Opposer argues this evidence “show[s] their current status (registered) and title (owned by The Children’s Hospital of Philadelphia)” and “the status and title of [Opposer’s] asserted registrations has not changed since their issuance, nor did either party to this proceeding introduce any evidence to the contrary.”⁷ Opposer draws particular attention to Registration Nos. 5188255 and 5157959, which “issued on April 18, 2017 and March 7, 2017, respectively – just over a year before the Notice of Opposition was filed in this case.”⁸ Opposer argues “[s]uch registrations were issued at a time reasonably contemporaneous to the filing of the Notice of Opposition, and they have been properly introduced into evidence for that reason as well.”⁹

“The Board has routinely held that the submission of a photocopy of a pleaded registration, by itself, is insufficient for purposes of establishing a party’s current ownership, or the current status, of the registration, and therefore does not suffice to

⁷ Rebuttal Brief, 57 TTABVUE 9.

⁸ *Id.* at 10.

⁹ *Id.*

make the registration of record.” *Sterling Jewelers, v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014). Contrary to Opposer’s assertion, Opposer’s registration certificates do not show “current” status and ownership of the registrations, but rather reflect the status and ownership of the registrations when they issued. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117-18 (TTAB 2009) (explaining that copy of certificate of registration reflected registration date, not current status or title).

The notice of opposition was filed on August 2, 2018. Two registrations issued well over a decade before the notice of opposition was filed (Registration No. 2472946 issued July 31, 2001, and Registration No. 3026022 issued December 13, 2005), while the other two registrations issued well over a year before the notice of opposition was filed (Registration No. 5157959 issued March 7, 2017, and Registration No. 5188255 issued April 18, 2017). None of the registrations issued “reasonably contemporaneous” with the filing of the notice of opposition such that we can treat the registration certificates as sufficient to establish “current” status and title.¹⁰ See, e.g., *United Global v. Tseng*, 112 USPQ2d at 1043 (non-status and title copy of

¹⁰ In support of its argument that the registrations that issued on March 7, 2017 and April 18, 2017 are reasonably contemporaneous with the August 2, 2018 filing date of the opposition, Opposer cites to the Board’s non-precedential decision in *PC Club v. Enpower Servs.*, 2003 WL 23109093 (TTAB 2003) where the Board found that a registration issued on December 4, 1998 was reasonably contemporaneous with the filing of a notice of opposition on February 22, 2000. We are not bound by non-precedential decisions and each case must be decided on its own merits. *PC Club* was decided on the particular “facts of this case.” Moreover, the time between the issuance of Opposer’s registrations and when Opposer filed its notice of opposition is longer here than in *PC Club* at 15.5 and 17 months, respectively. In more recent non-precedential decisions, we have found that registrations issued approximately eleven months or more before a notice of opposition are not “reasonably contemporaneous” with the complaint.

pleaded registration attached to notice of opposition considered of record when issued approximately four months before notice of opposition filed; non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make them of record when issued “years earlier”); *Sterling Jewelers*, 110 USPQ2d at 1601 n.2 (plain copy of registration attached to notice of opposition indicating issuance five years before such filing not reasonably contemporaneous); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Prods. of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (status and title copy of registration prepared two months prior to filing of opposition was reasonably contemporaneous); *Peters Sportswear Co. v. Peter’s Bag Corp.*, 187 USPQ 647, 648 (TTAB 1975) (copies of registrations issued nine and ten years before the notice of opposition were filed did not establish current ownership and status of the registration).

Opposer’s unsupported argument that “the status and title of [Opposer’s] asserted registrations has not changed since their issuance”¹¹ is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). As the plaintiff in this proceeding, Opposer bears the burden of proving current status and title of the pleaded registrations. *Sterling Jewelers*, 110 USPQ2d at 1062; *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1958 (TTAB 2008) (opposer bears the burden of proof, including proving what registrations or common-law trademarks it owns).

¹¹ Rebuttal Brief, 57 TTABVUE 9.

Accordingly, the “plain” copies of the registration certificates Opposer attached to its notice of opposition are not sufficient to make the registrations of record. *Life Zone*, 87 USPQ2d at 1956-57 (pleaded registrations not considered where opposer introduced only “plain copies” of the registration certificates); *see also* Trademark Rule 2.122(c) (with an exception for status and title copies of pleaded registrations, “an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit it attached”).

Opposer also failed to introduce the pleaded registrations through the testimony of Stephanie Hogarth, Opposer’s Vice President of Marketing & Public Relations, and its sole representative.¹² Ms. Hogarth’s testimony is sufficient to establish Opposer’s ownership of the pleaded registrations but she did not testify as to the current status of the registrations. *See, e.g., Hard Rock Café Int’l (USA) Inc. v. Eles*, 56 USPQ2d 1504, 1511 (TTAB 2000) (pleaded registrations not of record where copies of the registrations did not show current status and title and witness’s “testimony was limited to indicating opposer’s ownership of the registrations”).

Opposer makes three additional arguments that the pleaded registrations should be considered, namely that: (1) Applicant has admitted to the pleaded registrations in its answer;¹³ (2) Applicant “admits to and accepts [Opposer’s] ownership and use of its marks several times in its brief”;¹⁴ and (3) the pleaded registrations are “an

¹² Opposer also took the testimony depositions of two of Applicant’s representatives.

¹³ Rebuttal Brief, 57 TTABVUE 9.

¹⁴ *Id.* at 7-8.

appropriate subject of judicial notice.”¹⁵ In support of this latter argument, Opposer cites to *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010) wherein the Federal Circuit took judicial notice of a third-party’s registrations. Applicant’s arguments are not persuasive.

In response to the allegation in the notice of opposition that “[c]opies of the Certificates of Registration for the Marks are attached as Exhibit A,” Applicant, in its answer, admitted only that each registration certificate “speaks for itself as to the purported information displayed.”¹⁶ However, as noted above, Opposer’s registration certificates do not show their current status. Applicant’s admission thus falls far short of an admission as to the current status and title of the pleaded registrations.

Applicant also did not concede in its brief that the pleaded registrations are subsisting and owned by Opposer, as Opposer argues. Rather, Applicant expressly objected that “Opposer’s pleaded registrations are not properly of record in this proceeding[.]”¹⁷

Last, we deny Opposer’s request that we take judicial notice of the pleaded registrations. *Indus. Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 949-51 (TTAB 1983) (“[T]he Board deems it inappropriate to exercise any discretion it may have to take judicial notice of the currency and subsistence of [the pleaded registration] in opposer’s name. Longstanding practice of the Board and consistent treatment of

¹⁵ *Id.* at 8-9. In support of its request for judicial notice, Opposer attached to its rebuttal brief records for the pleaded registrations from the Trademark Electronic Search System (TESS) database. *Id.* at 25-32.

¹⁶ Notice of Opposition, 1 TTABVUE 8, ¶ 4; Answer, 8 TTABVUE 3, ¶ 4.

¹⁷ Applicant’s Brief, 56 TTABVUE 7-8.

litigants militates against such action.”); *see also, e.g., Edom Labs Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (“The Board does not take judicial notice of registrations or applications residing in the Office.”); *UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) (“The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office.”) (citing *Corp. Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987)).

As we have explained repeatedly, Trademark Rule 2.122(d) is “simple and clear” in providing various ways in which a party can properly introduce a pleaded registration. *Sterling Jewelers*, 110 USPQ2d at 1061 (citing *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991)); *Syngenta Crop Prot.*, 90 USPQ2d at 1116-17 (opposer did not take advantage of any of the means to introduce pleaded registration); TRADEMARK TRIAL AND APPEAL BOARD MANUAL (TBMP) § 704.03(b)(1)(A) (2021) (noting the Federal Circuit’s decision in *Chippendales*, but explaining that because “the Trademark Rules of Practice specify ... how to make a [pleaded] registration of record,” the Board does not take judicial notice of a party’s pleaded registrations). Opposer failed to follow this simple and clear rule to its own detriment. *Acme Boot Co. v. Tony and Susan Alamo Found., Inc.*, 213 USPQ 591, 592 (TTAB 1980) (“It is within the Board’s authority to require parties to follow a simple straightforward and inexpensive procedure of uniform applicability to prove status and title of pleaded registrations, particularly when that practice has been so carefully described.... When such minimal requirements have been

painstakingly and repeatedly laid out, and the relevant regulations are so clear, opposer's failure to follow them is as its own peril.”).

In view of the foregoing, Applicant's objection to Opposer's pleaded registrations is sustained and we do not consider them.

B. The Record

The record includes the pleadings, and by operation of law, the file of Applicant's involved application. Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d).

In addition, Opposer introduced:

1. A notice of reliance on:
 - Applicant's responses to Opposer's Interrogatory Nos. 3, 6, 16, 17, 21-22, 24-26, 34-35, and 37;¹⁸
 - Merriam-Webster Dictionary definition for the word “circle”;¹⁹
2. Declaration of Stephanie Hogarth, Opposer's Vice President, Marketing & Public Relations, and accompanying exhibits;²⁰ and
3. February 24, 2020 trial depositions, with exhibits, of Fred Scarborough, Applicant's Executive Vice President and Chief Communications Officer, and Jeff House, Applicant's Vice President of Strategic Marketing.²¹

¹⁸ 28 TTABVUE 11-40.

¹⁹ *Id.* at 5-10.

²⁰ 29 TTABVUE (redacted); 30 TTABVUE (confidential).

²¹ 52 TTABVUE (public); 53 TTABVUE (confidential). Opposer improperly filed the transcripts under a notice of reliance, but the error is harmless. *See, e.g., Syngenta Crop Prot.*, 90 USPQ2d at 1115 (“[I]t is not appropriate to submit testimony under a notice of reliance, although doing so is harmless error.”) (internal citation omitted); *Sports Auth. Mich. Inc. v. PC Auth. Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party).

Applicant introduced:

1. First notice of reliance on:²²
 - Certified copies of the following six registrations in the name of Applicant: 5768261, 4965450, 2881080, 2708986, 1936412, and 5425526;²³
 - Printouts from the Trademark Electronic Search System database of third-party registrations;²⁴ and
 - Opposer's responses to Interrogatory Nos. 2, 4, 12, 13, and 19;²⁵
2. Second notice of reliance on a certified copy of the file history for Applicant's Registration No. 5768261;²⁶
3. Declaration of Shellee Robbins, "employed in Strategic Marketing with [Applicant]," and accompanying exhibits;²⁷ and
4. Declaration of Marcy Doderer, President and Chief Executive Officer of Applicant, and accompanying exhibits.²⁸

²² In its first notice of reliance, Applicant stated its intent to rely on the file history for Registration No. 5425526, 43 TTABVUE 5, but no such document was attached to the notice of reliance or otherwise introduced into the record.

²³ 43 TTABVUE 16-30.

²⁴ 43 TTABVUE 32-204.

²⁵ 43 TTABVUE 205-13 (public); 44 TTABVUE (confidential).

²⁶ 50 TTABVUE. Applicant submitted this document after its testimony period closed, but the delay was not within Applicant's control. Applicant ordered the certified copy more than six weeks before the close of its testimony period, and was "informed by the USPTO that because of the COVID-19 outbreak, [the] Order [was] delayed." 43 TTABVUE 5, 31. Applicant promptly filed the file history six days after it was issued. Accordingly, Applicant has demonstrated excusable neglect for the late filing and we have considered it. Fed. R. Civ. P. 6(b)(1)(B); *Pioneer Inv. Servs. Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380, 395 (1993).

²⁷ 45 TTABVUE.

²⁸ 47 TTABVUE.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be proven by a preponderance of the evidence in every inter partes case.²⁹ See *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)), *cert. denied*, ___ U.S. ___ (2021). An opposer may challenge the registration of another’s mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the opposer has a reasonable belief in damage that is proximately caused by registration of the applicant’s mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021).

As discussed in Section III.A below, the testimony of Stephanie Hogarth and

accompanying exhibits establish Opposer’s use of the marks



and



. This is sufficient to demonstrate Opposer’s entitlement to a statutory cause of action. See, e.g. *Syngenta Crop Prot.*, 90 USPQ2d at 1118 (pleaded registration not of record, but witness testimony “that opposer uses the [pleaded]

²⁹ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 remain applicable. See *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

mark” was sufficient to establish opposer’s entitlement to a statutory cause of action); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (entitlement based on a common law rights).

III. Priority Likelihood of Confusion

To prevail on its Section 2(d) claim, Opposer must prove priority and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 147, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

A. Priority

As discussed, Opposer has not properly introduced its pleaded registrations so Opposer may not rely on the registrations to establish priority. Opposer, however, may maintain a Section 2(d) claim if it demonstrates prior common law rights in its pleaded marks. *Syngenta Crop Prot.*, 90 USPQ2d at 1119 (“A claim under Section 2(d) of the Trademark Act may be based on ownership of prior common law rights, but because unregistered marks are not entitled to the presumptions established by statute, *see* Trademark Act § 7(b)-(c), it is Opposer’s burden to demonstrate prior common law rights.”).

Fred Scarborough, Applicant’s Executive Vice President and Chief Communications Officer testified that Applicant commenced use of the involved mark

in spring 2017, which is before the October 4, 2017 filing date of Applicant's involved application.³⁰ Accordingly, Opposer must prove use of its marks before spring 2017.

Ms. Hogarth, Opposer's Vice President, Marketing & Public Relations, testified that:

- Opposer uses the pleaded marks "throughout its promotional, marketing, and informational materials";




- Opposer first used the mark in 1965;
- "Opposer uses its Marks in connection with a wide variety of goods and services, including merchandise; charitable fundraising services to support children's healthcare; educational and training services, both for physicians and other healthcare professionals (such as residency programs and educational conferences); medical research; and, of course, medical services and counseling. The services rendered under Opposer's Marks are also delineated in the registration certificates corresponding to each of Opposer's Marks (U.S. Registration Nos. 2472946, 3026022, 5188255, and 5157959);³¹ and
- "Opposer's services are promoted throughout the United States, and Opposer treats patients from across the country. For example, Opposer treated over 26,000 patients from the states of Alabama, Arkansas, Florida, Kansas, Louisiana, Mississippi, Missouri, Oklahoma, and Texas between the years of 2015 and 2018."

Ms. Hogarth attached to her declaration:

- Charts showing that Opposer treated "6254 patients in 2015 and 6807 patients in 2016 in Alabama, Arkansas, Florida, Kansas, Louisiana, Mississippi, Missouri, Oklahoma, and Texas";

³⁰ Scarborough Deposition, 52 TTABVUE 24.

³¹ Copies of the registration certificates attached to the notice of opposition are not evidence, *see* Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c), but copies of the registration certificates attached to Fred Scarborough's deposition are properly of record as self-authenticating official records. 52 TTABVUE 111-16.

- Numerous promotional materials showing Opposer's use of the mark  for charitable services, medical and research services, and educational services;³² and

- A November 12, 2018 newspaper article from *The Daily Pennsylvanian* that



includes the photograph below showing the mark on a window of a building also bearing the mark "The Children's Hospital of Philadelphia" (yellow arrow added by the Board).³³



³² The record also shows use of this mark in the color white on hot pink and dark blue backgrounds.

³³ Hogarth Declaration, Exhibit J, 29 TTABVUE 81.

Ms. Hogarth did not testify regarding when Opposer commenced use of the mark



but her testimony and accompanying exhibits support that Opposer was using the mark before Applicant commenced use of its mark in the spring of 2017. *See Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (“The oral testimony even of a single witness may be adequate to establish priority, but only if it is sufficiently probative.... Oral testimony is strengthened by corroborative documentary evidence.”); *see also B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232 (CCPA 1945); *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361, 1372 (TTAB 2014); *GAF Corp. v. Amatol Analytical Servs., Inc.*, 192 USPQ 576, 577, 583 (TTAB 1976).



Ms. Hogarth testified that Opposer commenced use of the mark in 1965.³⁴ In response, Applicant argues that the mark “is seldom displayed in the record and this logo is never displayed without the literal element, The Children’s Hospital of Philadelphia. ... This logo does not stand by itself....”³⁵ Although the record



includes only one example of how the mark is used, it corroborates Ms. Hogarth’s testimony that the mark is in use. *Exec. Coach Builders*, 123 USPQ2d at 1184 (“Oral testimony is strengthened by corroborative documentary evidence.”).

³⁴ Hogarth Declaration, 29 TTABVUE 3-4, ¶ 2.

³⁵ Applicant’s Brief, 56 TTABVE 13.

Moreover, in the example of use that is of record, the mark creates a separate commercial impression because it is physically separated on a different line from the accompanying (illegible) words and is displayed in a significantly larger size.³⁶

Ms. Hogarth did not testify specifically as to when Opposer commenced use of the



mark. She testified that “Opposer’s marks are

used throughout its promotional, marketing, and informational materials[,]” but none of the promotional materials attached to her declaration show use of the mark



. *Exec. Coach Builders*, 123 USPQ2d at 1184

(rejecting testimony that was internally inconsistent and contradicted by the documentary evidence of record). Nor is there any other evidence of record showing



use of the composite mark

In sum, Ms. Hogarth’s testimony regarding Opposer’s prior use of the marks






and

is clear and convincing and supported by

documentary evidence. Accordingly, we find that Opposer has established prior common law rights in the marks and services set forth below:³⁷

³⁶ Hogarth Declaration, 29 TTABVue 81, Exhibit J.

³⁷ The exhibits to the Hogarth Declaration include examples of Opposer using  as a standalone mark. Opposer, however, did not plead or argue rights in the logo  separate

Opposer's Prior Common Law Rights	
Mark	Services
	<ul style="list-style-type: none"> • Hospitals, medical services, medical research; medical testing; providing health and medical information; medical counseling services • Charitable fundraising services to support children's healthcare; • Educational and training services, both for physicians and other healthcare professionals

and apart from the composite mark



so we have not considered

whether Opposer has prior common law rights in the logo



standing alone.

Opposer's Prior Common Law Rights	
	<ul style="list-style-type: none"> • Charitable fundraising services to support children's healthcare; • Educational services, namely, conducting medical residency training programs, medical fellowship training programs, and continuing medical education programs; training in the fields of nursing, social work, psychology and medical technology; providing medical, healthcare, and technical training for allied health professionals; conducting educational conferences, seminars, and workshops in the field of medicine and healthcare; conducting educational programs in the field of health and wellness; • Medical research; medical laboratories; and • Hospitals, medical services, medical clinics; dietary and nutritional guidance; emergency medical assistance; maintaining files and records concerning the medical condition of individuals; psychological counseling; medical testing for diagnostic or treatment purposes; medical counseling services; physical rehabilitation; providing health and medical information

Opposer, however, has not proven prior common law use of the mark



by a preponderance of the evidence because Ms.

Hogarth's testimony regarding use of this mark is vague and inconsistent with the exhibits to her declaration, none of which show use of the mark. *Exec. Coach Builders,*

123 USPQ2d at 1184 (“[T]estimony ‘should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.’”) (quoting *B.R. Baker Co. v. Lebow Bros.*, 66 USPQ at 236).³⁸


B. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).



In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc.*

³⁸ This determination is of little consequence because the mark contains additional points of difference from Applicant’s mark. Accordingly, if we find no likelihood of confusion between

Applicant’s mark and Opposer’s marks  and , we also would

find no likelihood of confusion with the mark .

Conversely, if we find a likelihood of confusion between Applicant’s mark and Opposer’s

marks  and  there would be no need to consider whether there

is a likelihood of confusion with the mark .

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”).

1. Similarity of the Services, Trade Channels and Classes of Consumers

Applicant “does not challenge the similarity or dissimilarity and nature of the [parties’] services” or the “established, likely-to-continue trade channels of the parties.”³⁹ Indeed, Opposer uses its marks in connection with the same services identified in the involved application, namely, charitable fundraising for pediatric care (Cl. 36), educational services for healthcare professionals (Cl. 41), medical research (Cl. 42), and medical and hospital services (Cl. 44). In addition, Opposer’s medical and hospital services are highly related to, and arguably encompass, Applicant’s “transportation of human patients ... by ground and air” as these services are a necessary part of providing medical and hospital services.

Because the services are identical and otherwise closely related, the channels of trade and classes of consumers also overlap. *Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1935 (TTAB 2012).

Accordingly, the second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.⁴⁰

³⁹ Applicant’s Brief, 56 TTABVUE 20.


⁴⁰ Applicant limits its concession to the extent “Opposer is using the literal elements CHOP or THE CHILDREN’S HOSPITAL OF PHILADELPHIA either alone or in combination with a design. Opposer has not established recognition of a design by itself or prior use of a design


2. Strength of Opposer's Marks


We next assess the strength of Opposer's marks because this affects the scope of protection to which the marks are entitled. In determining the strength of a mark, we consider both its inherent or conceptual strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition of the mark. *Chippendales*, 96 USPQ2d at 1686 ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).").

a. Conceptual Strength

Both of Opposer's marks incorporate the silhouette profile of a child, which is descriptive of Opposer's services, all of which relate to children's healthcare. The

mark  also includes the descriptive terms "Children's Hospital of Philadelphia," and the letters "C" and "H," which in the context of the mark, are likely to be understood as an abbreviation for "children's hospital." Consumers

encountering Opposer's mark  may also view it as incorporating the letters "C" and "H" given the nature of Opposer's services but this is less certain given that the design around the child's profile is almost a closed circle in contrast to a letter "C," which is three-quarters of a circle.

by itself." *Id.* We have found, however, that Opposer has proven prior use of the standalone mark  for substantially the same services as those identified by the mark

 .

Pertinent to conceptual strength, Applicant submitted printouts from the Trademark Electronic Search System (TESS) database for active, third-party use-based registrations for services that are the same as and similar to those of Opposer.⁴¹ *Sock It To Me, Inc.*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (“[T]hird-party registrations may be probative of conceptual strength or weakness as they may be considered to demonstrate the meaning of a word [or design] which comprises the mark, or a portion thereof, to show that there is a well-known and commonly understood meaning of that word and that the mark has been chosen to convey that meaning.”) (internal quotation marks omitted); *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (“Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.”).




Of the registered third-party marks submitted by Applicant, approximately:

- ten marks include the words “children’s hospital”;
- ten additional marks include the word “children” or “children’s”;
- seventy-five marks incorporate the silhouette of a child or children alone or with images of adults;

⁴¹ Applicant’s First Notice of Reliance, 43 TTABVUE 32-204. We have not considered the canceled third-party registrations.


- thirty-five marks display the profile silhouette of a child or children, either alone or with images of adults; and
- twenty marks display the silhouette of a child encompassed within a circle or partial circle.⁴²


The most pertinent registered marks are highlighted in the chart below:



Reg. No.	Mark and Description of Mark	Pertinent Services
4477966	 <p>ChildSafe</p> <p>Description: “The mark consists of the profile of a female child facing right surrounded by a filled square framed inside with a circle and the word ‘CHILDSAFE’ below the square.” No color claim.</p>	Psychological counseling, and health care management for children and adolescents who have been traumatized by all forms of abuse; case management services, namely, coordination of medical treatment, and legal, social, and psychological services for children and adolescents who have been abused, neglected, or sexually abused, and for their families
6149292 and 6149303	 <p>The Jimmy Fund</p> <p>Description: “The mark consists of the silhouette of a child’s head with a cap in a navy circle.”</p>  <p>Description: “The mark consists of the silhouette of a child’s head with a cap in a navy circle to the left of ‘The’</p>	<i>Both for</i> charitable fundraising for promotion of public education and awareness of biomedical sciences research, particularly with regard to the prevention, detection, diagnosis and treatment of cancer, and for the furnishing of medical assistance for the prevention, detection, diagnosis and treatment of cancer; charitable fundraising for biomedical research, particularly with regard to the prevention, detection, diagnosis and treatment of cancer and AIDS

⁴² We have not included marks incorporating circles constituting specific designs such as the sun or a globe.

Reg. No.	Mark and Description of Mark	Pertinent Services
	<p>in orange stacked above 'JIMMY' in navy and 'FUND' in blue.</p> <p>Disclaimer: "Fund"</p>	
<p>2793197 and 5731708</p>	<div data-bbox="358 459 548 583" data-label="Image"> </div> <p>Description: None; no color claim.</p> <div data-bbox="358 737 737 856" data-label="Image"> </div> <p>"The mark consists of the silhouette image of a child above a curved line to the left of the words 'ST. JUDE CHILDREN'S' above the words 'RESEARCH HOSPITAL'."</p> <p>Disclaimer: "Children's Research Hospital"</p>	<p><i>Both for charitable fund-raising; educational services, in the fields of medicine and research; training of clinicians and scientists in the field of biomedical research; hospital and medical services; medical clinics</i></p>

Reg. No.	Mark and Description of Mark	Pertinent Services
5263735	 <p>Description: “The mark consists of the words ‘Circle of Care’ above the words for ‘families of children with cancer’. To the left of the words is an outline of a circle and within the circle is a design element of a silhouette of a child on a swing.”</p> <p>Disclaimer: “For Families of Children with Cancer”</p>	<p>Charitable services provided to families of children with cancer; and “providing personal support services for children with cancer and their families, namely, emotional support in the form of companionship, information about resources for coping with the emotional effects of a cancer diagnosis, coping strategies, grief counseling and ongoing peer support; providing on-line information about personal support services for patients and families of patients with cancer, namely, emotional counseling, emotional support, and coping strategies for children with cancer and their families”</p>
4790673	 <p>Description: The mark consists of a figure of a running child holding a kite attached by a string which is trailing behind him in white and the drawing of the mark is lined to indicate the color orange (Pantone 165) and such color is claimed as a feature of the mark.</p> <p>The colors orange and white are claimed as features of the mark.</p>	<p>“Hospital and health care services”</p>

Reg. No.	Mark and Description of Mark	Pertinent Services
4944773	 <p>Description: "The mark consists of the design of two face profiles, one in green and one in the background color, within a circle shaded in blue; with 'AWHONN' (in blue) to the right of the design above a green line with the words 'PROMOTING THE HEALTH OF WOMEN AND NEWBORNS' (in black) below the green line. The white is background and not claimed."</p> <p>Disclaimer: "Promoting the Health of Women and Newborns"</p>	<p>Charitable fundraising services for promoting research, education, and programs to improve the health care of women and newborns; educational services, namely, providing on-line and in person classes, courses of instruction at the professional and continuing nursing education level, educational conventions in the nature of conferences, seminars, non-downloadable webinars, and case assessments in the nature of online interactive simulations, testing and feedback to nurses and health care professionals in the field of women's health, perinatal, and newborn nursing; distributing educational material for others in the field of women's health, perinatal, and newborn nursing in connection therewith</p>

Reg. No.	Mark and Description of Mark	Pertinent Services
4125706	 <p>Passport for Care</p> <p>Description: “The mark consists of two concentric circles overlaid with a silhouette of a child with its arms stretched upwards, and overlaid with spaced-apart lines that are perpendicular to the long axis of the silhouette; between the two circles are the words ‘PASSPORT FOR CARE -- GUIDELINES FOR LONG-TERM SURVIVORS OF CHILDHOOD CANCER’. The phrase ‘PASSPORT FOR CARE’ also appears above and the [sic] to the right of the circles.”</p> <p>Disclaimers: “Care,” “Care,” and “Guidelines For Long-Term Survivors Of Childhood Cancer”</p>	<p>Providing medical information, consultancy and advisory services, in the nature of providing patients and survivors of chronic illnesses with their personal medical information, and offering healthcare guidelines individualized to their medical history</p>
2723543	 <p>Cincinnati Children's Hospital Medical Center</p> <p>Description: None; no color claim Disclaimer(s): “Cincinnati Children’s Hospital Medical Center”</p>	<p>Education services, namely, conducting fellowship training, pediatric residency training, research training including extensive doctoral and post doctoral programs, international educational programs, child abuse prevention programs, patient services programs, pediatric dentistry fellowships, emergency medical services programs, and hosting national educational conferences in the field of pediatric and adolescent medicine</p>

Applicant also introduced evidence of third-party marks used by hospitals in the Children’s Miracle Network of Hospitals.⁴³

- More than fifty of the marks incorporate the generic terms “children’s hospital”;
- Approximately thirty-five additional marks incorporate the generic word “children” or “children’s”;
- More than thirty marks incorporate the words “children’s hospital” or “children’s” and a geographic location;
- More than twenty-five marks incorporate the image of a child or the figure of a person that could be construed as a child;
- Approximately thirty marks incorporate a circle or partial circle design; and
- More than twenty marks are entirely or substantially in the color blue.

The most pertinent marks, set forth below, incorporate the design of a child or figure encompassed by a circle or semi-circle:





⁴³ Robbins Declaration, 45 TTABVUE.

		
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The nature and quantity of third-party use and registration of: (1) the words “children’s hospital,” or “children[’s],” with or without a geographic descriptor; (2) a profile silhouette of a child; (3) the design of a circle or semi-circle; and (4) the color blue, for services the same as and related to those of Opposer, is comparable to the “extensive” and “considerable” evidence found persuasive as to the strength of the marks in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports S.L.U.*, 797 F.2d 1363, 116 USPQ2d 1129, 1136-37 (Fed. Cir. 2015); *Juice Generation*, 115 USPQ2d at 1674-75. There are, however, no third-party marks of record incorporating the letter “h” or both letters “c” and “h,” and only two third-party marks (below) incorporate a design likely to be perceived as the letter “c”:




Overall, we find that the mark  has some conceptual strength given the more abstract nature of the design, but the mark  is highly

suggestive of Opposer's services and falls on the weaker end of the spectrum of distinctiveness.

b. Commercial Strength

A mark's commercial strength is the degree to which the mark has achieved recognition among the relevant public. "[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark." *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). The commercial strength or fame of a mark is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). Rather, likelihood of confusion fame "varies along a spectrum from very strong to very weak." *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)).

Evidence that the public is confronted with significant use by others of similar marks for similar services tends to indicate a lack of commercial strength. *DuPont*, 177 USPQ at 567. Here, the record shows it is common for children's hospitals to use marks incorporating images of children and circles as well as the generic term "children[s]" or "children's hospital" coupled with a geographically descriptive term. The number of third-party marks in use incorporating these elements is powerful evidence that consumers have become conditioned to distinguish such marks based on minute differences in the designs and geographic descriptors. *Juice Generation*,

115 USPQ2d at 1674 (extensive third-party use and registration is “powerful on its face”). We recognize, however, that Applicant’s involved mark  is more similar to Opposer’s marks than any of the marks in use by third-party children’s hospitals.

We also must consider Opposer’s evidence regarding the extent to which it has rendered and advertised its services in connection with its marks, and any unsolicited media recognition Opposer has received in connection with its marks. *See DuPont*, 177 USPQ at 567. Ms. Hogarth testified that:

- “The promotion of Opposer’s services relies greatly on the use of its Marks, which act as visual indicators of the superb quality consumers have come to associate with these services.”⁴⁴ “[C]onsumers are exposed to Opposer’s Marks ... in advertising ... at professional events where Opposer exhibits including the Pediatric Academic Societies Meeting and American Academy of Pediatrics National Conference & Exhibition; in news announcements; and through marketing and advertising that takes place via digital media, social media, email, television, literature, and mailings.”⁴⁵
- In 2018 and “historically,” Opposer has made significant expenditures in promoting “the services offered under Opposer’s Marks.”⁴⁶
- “Opposer makes extensive use of social media in promoting its services under the Marks[.]” Opposer has 404,900 followers from all social media accounts on Facebook, Twitter, Instagram, YouTube, LinkedIn and Pinterest;⁴⁷

⁴⁴ Hogarth Declaration, 29 TTABVUE 6, ¶ 9.

⁴⁵ *Id.* at 4-5, ¶ 5.

⁴⁶ *Id.* at 4, ¶ 4 (public); 30 TTABVUE 4, ¶ 4 (confidential). Opposer’s promotional expenditures are confidential so we refer to them generally.

⁴⁷ Hogarth Declaration, 29 TTABVUE 5, 27, ¶ 6, and Ex. F.

- From 2014-2018, Opposer’s YouTube page had 8,968,092 views in the United States and 548,356 hours watched in the United States. In 2018, Opposer’s YouTube page had 4,372,377 U.S. viewers and 288,209 hours of content was watched in the United States.⁴⁸
- From 2014-2018, Opposer’s website at chop.edu had 30,426,951 “users” and 51,138,158 “sessions” in the United States. In 2018, Opposer’s website had 7,942,756 “users” and 12,179,026 sessions in the United States.⁴⁹
- “Opposer has been repeatedly recognized for the quality of its services rendered under the Marks,” including online coverage in:⁵⁰
 - *The Daily Pennsylvanian* (November 12, 2018);
 - *Fortune* magazine (November 18, 2013);
 - *Parent Magazine* as “one of the Most Innovative Children’s Hospitals of 2018” (October 1, 2018);
 - *U.S. News & World Report* as “the No. 2 Best Children’s Hospital in the nation” for 2019-20, “coming in as the No. 1 Best Children’s Hospital for Pediatric Diabetes & Endocrinology and Pediatric Gastroenterology & GI Surgery” and ranking “among the top seven programs in each of [ten ranked specialty programs] for 2019-20, earning a No. 1, No. 2 or No. 3 spot for seven of those specialties”; and
 - *U.S. News & World Report*, as the No. 1 pediatric training program in the U.S. for “seven consecutive years.”⁵¹
- Opposer fundraises through its website using Opposer’s marks and raised “\$1.5 million for childhood cancer as part of an annual run and walk event. Opposer’s fundraising reaches consumers nationwide.”⁵²
- “Opposer treats patients from across the country. For example, Opposer treated over 26,000 patients from the states of Alabama, Arkansas,

⁴⁸ *Id.* at 6, 64, 72, ¶ 8 and Ex. I.

⁴⁹ *Id.* at 6, 48-62, ¶ 7, Ex. H.


⁵⁰ *Id.* at 6, ¶ 9.


⁵¹ *Id.* at 6-7, ¶¶ 9-11, Exs. J-M.

⁵² *Id.* at 8, ¶ 13, Exs. O-P.


Florida, Kansas, Louisiana, Mississippi, Missouri, Oklahoma, and Texas between the years of 2015 and 2018.”⁵³

There are a few issues with the Hogarth Declaration. First, as already discussed,


the mark  appears only once in the exhibits to the Hogarth Declaration. The

absence of the mark  in Opposer’s promotional materials suggests that consumer exposure to this mark may have been limited. Second, while the mark

 appears in some of Opposer’s social media pages, Opposer’s

social media accounts predominantly display the mark , which has not been pleaded in this case. Third, the articles in *Parents Magazine*, *Fortune*, and *U.S. News*

& *World Report* do not display the mark . Rather they refer to Opposer as Children’s Hospital of Philadelphia or by the acronym CHOP.⁵⁴ Popup

advertisements displaying the mark  are interspersed throughout some of the articles, but these are targeted advertisements and it is uncertain how often such advertisements are displayed throughout these online articles.


⁵³ In its brief, Opposer asserts that “[a]s of at least 2013, [Opposer] generates annual revenues of about \$2 billion” and cites to an article in *Fortune* magazine citing this figure. 55 TTABVUE 12. Opposer, however, cannot rely on the truth of the statement in the article, which is hearsay, to establish its annual revenue and there is no other evidence on this point.


⁵⁴ *Id.* at 83-162, Exs. J-M. The issue is not whether Opposer is renowned, but whether the marks for which Opposer has proven priority are renowned or well-recognized.


The foregoing somewhat diminishes the probative value of the Hogarth Declaration regarding the commercial strength of Opposer's mark




c. Summary Regarding the Strength of Opposer's Marks

Opposer's mark  is not particularly strong from a conceptual standpoint, but the record shows that the mark has some commercial strength. The

mark  has some conceptual strength but no commercial strength has been

established. On balance, we find that the mark  is entitled to a

slightly more than normal scope of protection while the mark  is entitled to a normal scope of protection.


3. Similarities Between the Marks

Under the first *DuPont* factor, we consider the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567; *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). The issue 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. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1160; *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.”).

We also are mindful that where, as here, the services are identical and highly related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

Opposer argues that the design portion of the marks are “nearly identical” such that “confusion is inevitable.”⁵⁵ Applicant’s mark  incorporates a

⁵⁵ Opposer’s Brief, 55 TTABVUE 35.

profile silhouette of a child from the shoulders up partially encompassed within a circular shape, just like Opposer's marks  and .

We further find that Applicant's Mark and Opposer's mark




are similar in that: (1) the profile design in both marks faces to the right; (2) literal elements appear to the right of the design in initial capital letters and a sans serif font; and (3) both marks incorporate the word "Children's" and a geographic location. In addition, Applicant's mark does not claim color so the mark may be displayed in the same color as Opposer's marks. Indeed, there is evidence that Applicant displays its mark in a similar color blue to Applicant's mark




and that both parties have displayed their marks in white against a dark blue background at professional events.⁵⁶

Notwithstanding these similarities, there are differences in the marks. The design

portion of Opposer's mark  is dominated by the stylized and interlocking letters "C" and "H," which are significantly larger than the profile silhouette design that floats inside the letter "C." The outline of the silhouette is not particularly delineated and is closed-in, facing the stem of the letter "H. In Opposer's

⁵⁶ Hogarth Declaration, 29 TTABVUE 14, 21, 24, 17-19; Doderer Declaration, 47 TTABVUE 8, 10, 14, 32, 40, 43, 45, 68, 70-129.

mark , the circular shape is less recognizable as the letter “C” while the letter “H” is more pronounced.




Significantly, the letter “H,” which is a dominant part of Opposer’s marks, is missing from Applicant’s mark. Moreover, the profile silhouette and circular design in Applicant’s mark are fused together with the shoulders of the profile design grounded in the circular design. The features of Applicant’s profile silhouette are clearly delineated and the child is looking out of the opening in the circular design as opposed to Opposer’s marks where the profile design faces into the letter “C” or “H.”

In addition, the openings in the circular designs are different in size and position. In Opposer’s marks, the opening is very narrow and appears at the top right of the design whereas the opening in Applicant’s circular design is larger and positioned in the middle of the right side of the shape. The circular design in Applicant’s mark is likely to be perceived as the letter “C,”⁵⁷ but it also may be perceived as a crescent moon, as described in Applicant’s application. The three-dimensional nature of the design also suggests a circular motion not present in Opposer’s two-dimensional mark.

In addition, Applicant’s mark incorporates its trade name “Arkansas Children’s” while Opposer’s mark  incorporates Opposer’s trade name.

⁵⁷ Opposer cites to notes from a focus group of nurses to support its assertion that the circular design in Applicant’s mark will be perceived as the letter “C.” Scarborough Deposition, 52 TTABVUE 98-100. The record, however, does not establish what mark was the subject of the focus group. *Id.*

Although the trade names are descriptive, and Applicant has disclaimed the exclusive right to use “Arkansas Children’s,”⁵⁸ the literal portions of the marks contribute to the overall appearance, sound and commercial impression of the marks. Patients and their families, healthcare professionals and donors will use the trade name portion of the marks when calling for or referring to the parties’ services. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods [or services] to which it is affixed.’”).

Overall, while Applicant’s mark  shares some similarities with Opposer’s marks  and  and is displayed in a similar color scheme, we find that the marks in their entirety are more different than similar in overall appearance, sound, connotation and commercial impression.

⁵⁸ Applicant asserts that “[t]he Declaration of Marcella L. Doderer, President and CEO of Applicant, dated October 15, 2018 [and filed in support of Reg. No. 5768261], expressed an acquired distinctiveness in ARKANSAS CHILDREN’S as a mark synonymous with the services provided by Applicant over the years evidenced by an appeal for funds and hospital services, circa 1935; transportation of human patients and organs by ground since 1978, and by air since 1985; and educational and scientific medical research services since at least as early as 1969.” Applicant’s Brief, 56 TTABVUE 6-7. Applicant properly introduced the file declaration under notice of reliance at 50 TTABVUE, but the declaration is not testimony because it was not executed during Applicant’s testimony period nor was it submitted as an exhibit to and affirmed in any testimony. *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *3-4 (TTAB 2019).

4. Sophistication of Consumers and Conditions Under Which Services are Rendered

We now consider the conditions under which the parties' services are likely to be purchased, e.g. whether on impulse or after careful consideration, as well as the degree of any consumer sophistication. We have observed that "few things are more important in life than health and well-being[.]" *CareFirst of Md., Inc. v. FirstHealth of Carolinas, Inc.*, 77 USPQ2d 1492, 1503-04 (TTAB 2005). Accordingly, "even ordinary consumers are likely to exercise greater care and will know with whom they are dealing" in seeking medical treatment. *Id.* at 1504. Similarly, healthcare professionals and donors to hospitals and medical research institutions are likely to investigate and exercise some degree of sophistication utilizing the parties' services or making a charitable contribution.

Opposer argues that "patient families and donors[] could easily assume that [the parties] are affiliated ... because in healthcare, entities frequently operate affiliated, yet geographically distinct, locations under the same brands."⁵⁹ We disagree as even the least sophisticated consumer is likely to exercise at least some heightened degree of care with respect to the parties' services.

The fourth *DuPont* factor therefore weighs against a finding of likely confusion.

5. Applicant's Intent in Adopting the Involved Mark

Opposer argues that Applicant adopted the involved mark in a bad faith attempt to trade off the goodwill of Opposer's marks. There is no dispute that Applicant hired

⁵⁹ Rebuttal Brief, 57 TTABVue 6.

third-party Latitude to assist with its rebranding efforts; that during that process, Latitude identified five “admired” brands in a “competitive landscape,” one of which



was Opposer’s mark ;⁶⁰ and that none of the third-party marks identified as “admired” or competitive brands during Applicant’s “brand evolution” process incorporate the profile silhouette of a single child from the shoulders up, compassed within a circular design element, and displayed in the color blue.⁶¹ The literal element in Applicant’s mark is also displayed in all lowercase letters and a sans serif font, the same as the literal elements of Opposer’s mark



.⁶² There are, however, additional relevant facts.

Applicant’s predecessor long used and registered a mark incorporating a “child’s



silhouette from the shoulder’s up inside a circle” in the color blue:

(“Prior Mark”).⁶³ The Prior Mark seemingly co-existed with Opposer’s marks without

⁶⁰ Scarborough Deposition, 53 TTABVUE 3-4 (confidential). This document was filed under seal but Applicant addressed this information in its publicly-filed brief. Applicant’s Brief, 56 TTABVUE 23.

⁶¹ Scarborough Deposition, 53 TTABVUE 4 (confidential).

⁶² Scarborough Deposition, 52 TTABVUE 89-90.

⁶³ Scarborough Deposition, 52 TTABVUE 34-35, 89, 109-10, 173-75, 183. This mark was the subject of now cancelled Registration No. 1936412. *Id.* at 109-10.

confusion. In 2015, Applicant was incorporated to encompass “several businesses.”⁶⁴ The “restructuring of the organization” prompted Applicant to “evolve” its brand “to make sure that instead of describing one element of the work, we described [all of] the work.”⁶⁵ Applicant identified the silhouette of a child, circular movement, and the color blue as “iconic elements” of the Prior Mark that were important to maintain in evolving its brand.⁶⁶ The record supports Applicant’s contention that the reason for maintaining these elements was to maintain brand equity not to trade off the goodwill of Opposer’s marks.⁶⁷

Opposer attempts to make much of the fact that the involved mark does not include the outline of the state of Arkansas; Opposer identifies that feature as a “key element” of the Prior Mark.⁶⁸ But Applicant’s involved mark retains the word “Arkansas” as part of the mark’s literal element. Accordingly, the mark retains the commercial impression of Arkansas even though it does not incorporate the outline of the state.

⁶⁴ *Id.* at 32-34.

⁶⁵ *Id.*

⁶⁶ *Id.* at 68, 82-83, 171, 183.

⁶⁷ *Id.* at 89, 170-71, 183.

⁶⁸ Opposer’s Brief, 54 TTABVue 23 (confidential). Opposer redacted this argument in its publicly-filed brief, but the absence of the outline of the state of Arkansas in Applicant’s involved mark is apparent on the face of the mark.

Opposer further argues that Applicant “adopted its mark despite the fact that”⁶⁹ another proposed logo received a more favorable rating in a survey.⁷⁰ But the favorability rating of Applicant’s mark was only 2% less than the most favored mark while the unfavorability rating of Applicant’s mark was only 1% greater than that of the most favored mark.⁷¹ In other words, the difference between the favorable and unfavorable ratings between the marks was negligible. Further, Mr. Scarborough explained that “[t]he logo we chose tested positively for the retaining brand equity and tested very similarly to the existing logo, so much so that there was no perceived difference in the logo that had been in the market for 35 years and the logo we were testing that was new.”⁷² This testimony is credible given that Applicant’s mark retains many of the same elements of the Prior Mark.

For all of these reasons, we find that Opposer has fallen short of establishing that Applicant acted in bad faith in adopting the involved mark.

⁶⁹ The mark surveyed was slightly different from Applicant’s involved mark displaying “Arkansas Children’s” in all capital letters while the words in the involved mark are in lowercase letters with initial capitalization. Scarborough Deposition, 52 TTABVUE 89-90.

⁷⁰ Opposer’s Brief, 56 TTABVUE 19 (confidential). Although Opposer redacted this argument in its publicly-filed brief, Mr. Scarborough’s testimony on this issue was not filed under seal (*see* 52 TTABVUE 86-88) so we do not treat this information as confidential.

⁷¹ Scarborough Deposition, 53 TTABVUE 80-81 (confidential exhibits). In another graph, the favorability rating of Applicant mark was 5% lower than the most favored mark, but this also is not a particular significant difference.


⁷² Scarborough Deposition, 52 TTABVUE 89.

6. Absence of Evidence of Actual Confusion


The eighth *DuPont* factor is “[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.”⁷³ *DuPont*, 177 USPQ at 567. Applicant started using its mark in the spring of 2017 so the parties’ marks have been in concurrent use for about 4 years. This is not a particularly significant amount of time, but the record supports a finding that there has been some opportunity for actual confusion to have occurred between Applicant’s Mark and

Opposer’s mark  :

- Applicant has used the involved mark consistently and prominently in advertising its services through all the same media outlets through which

Opposer has consistently used the mark  .⁷⁴

- Applicant displays its mark in blue or in white on a dark blue background,

similar to how Opposer displays its mark  .⁷⁵

- Applicant’s marketing and advertising expenses for fiscal years 2017-2020 exceeded \$7,500,000. Applicant invested \$2.3 million dollars in advertising

⁷³ The seventh *DuPont* factor concerns “[t]he nature and extent of any actual confusion,” but no such evidence is of record here. *DuPont*, 177 USPQ at 567.

⁷⁴ Doderer Declaration, 47 TTABVUE 5-6 ¶ 11-13, 8-132.

⁷⁵ Hogarth Declaration, 29 TTABVUE 14-44, Doderer Declaration, 47 TTABVUE 8-132.

in 2017 and \$1.9 million in 2018.⁷⁶ Opposer's (confidential) advertising expenditures are comparable.⁷⁷

- Both parties' have a national reputation⁷⁸ and both parties' social media platforms where the marks are displayed "have a national reach."⁷⁹
- For each fiscal year Applicant's mark has been in use, Applicant has "on average, admitted greater than 15,000 patients; greater than 82,200 census days of patients and observations; and more than 308,400 outpatient visits a year."⁸⁰ From 2017-2018, Opposer treated thousands of patients in Arkansas and nearby states such as Alabama, Florida, Kansas, Louisiana, Mississippi, Missouri, Oklahoma, and Texas.
- Applicant "is regularly ranked by U.S. News & World Report in several specialties among the nation's top programs, including Cardiology & Heart Surgery and Pulmonary the last four years; Nephrology in three of the last four years; and Urology in two of the last four years." During this same time, Opposer was also consistently recognized by U.S. News & World Report, including in the same specialty areas as Applicant.⁸¹

⁷⁶ Doderer Declaration, 47 TTABVUE 5, ¶¶ 10-12.

⁷⁷ Hogarth Declaration, 30 TTABVUE 4, ¶ 4.

⁷⁸ Scarborough Deposition, 52 TTABVUE 101-102; Opposer's Brief, 55 TTABVUE 29.

⁷⁹ Hogarth Declaration, 29 TTABVUE 5-6 and 27-79, ¶¶ 6-8 and Exs. F-I; Scarborough Deposition, 52 TTABVUE 55; Doderer Declaration, 47 TTABVUE 71, 74, 88, 131.

⁸⁰ Doderer Declaration, 47 TTABVUE 4-5, ¶ 9.

⁸¹ Hogarth Declaration, 29 TTABVUE 5, ¶ 10 and 145-146, Exhibit L.

- Applicant’s medical transport vehicles and aircrafts prominently bear Applicant’s mark.⁸² Applicant has rendered its medical transportation services in Pennsylvania and New Jersey where Opposer operates “brick and mortar healthcare facilities under its marks.”⁸³
- Both parties are members of the fundraising organizations the Children’s Miracle Network and The Woodmark Group.⁸⁴ And “[b]oth parties solicit philanthropy from donors across the United States using materials that bear their respective marks, and targeting the same audiences.”⁸⁵

In its brief, Opposer highlights the specifics above⁸⁶ and recognizes that:

ACH offers the same services as CHOP offers. It offers them to the same audience groups—children and parents, healthcare professionals, and donors who want to support pediatric healthcare. ACH offers its services in the same national trade channels as does CHOP. CHOP and ACH participate in the same fundraising organizations, like The Woodmark Group and the Children’s Miracle Network. They provide services in overlapping geographic areas. They use overlapping digital and internet marketing (including for fundraising, recruitment, social media, and ads geared toward patient families), and television.⁸⁷

⁸² Doderer Declaration, 47 TTABVUE 41-42.

⁸³ Opposer’s Notice of Reliance, 28 TTABVUE 28, Applicant’s Response to Interrogatory No. 22 (“Applicant renders transport services where needed across the United States. In the past five years this included” 22 states, including Pennsylvania and New Jersey.); Hogarth Declaration, ¶ 5 and Exhibit B, 29 TTABVUE 4, 14-15.

⁸⁴ Hogarth Declaration, 29 TTABVUE 8-9, ¶¶ 14-15; Robbins Declaration, 45 TTABVUE 2-41, ¶¶ 3-5 and Exs. A-B; Scarborough Deposition, 52 TTABVUE 42-43.

⁸⁵ Opposer’s Brief, 55 TTABVUE 29-30; Hogarth Declaration, 29 TTABVUE 8, 169-75, ¶ 13 and Exs. O, P, and Q, (public), 30 TTABVUE 250 (confidential); Applicant’s Response to Interrogatory No. 3, 28 TTABVUE 15; Scarborough Deposition, 52 TTABVUE 96-97, 117-119, 260.

⁸⁶ Opposer’s Brief, 55 TTABVUE 29-33.

⁸⁷ *Id.*, 55 TTABVUE 9-10.

Even though there has been only four years concurrent use, there has been some meaningful opportunity for actual confusion to have occurred. Accordingly, the absence of any evidence of actual confusion is somewhat probative and weighs slightly in Applicant's favor.⁸⁸


7. The Potential for Confusion (the Twelfth *DuPont* Factor)

Opposer argues that the extent of potential confusion "is substantial" because "[t]aken together, the striking overlap and similarity between the parties' marks, services, trade channels, and audiences leads to only one conclusion – confusion is exceedingly likely."⁸⁹ In essence, Opposer reiterates its arguments under the first, second, and third *DuPont* factors. While the second and third *DuPont* factors increase the potential for confusion, the overall differences in the parties' marks and sophistication of the purchasers mitigate against potential confusion. Accordingly, we find the twelfth *DuPont* factor neutral.

IV. Conclusion

Plaintiff has proven its entitlement to a statutory cause of action and priority in

the marks  and , but has not established that

Applicant's mark  is likely to cause consumer confusion. Although

⁸⁸ Applicant's First Notice of Reliance, 43 TTABVUE 209-10, Opposer's Response to Interrogatory No. 13 ("Opposer ... is not currently aware of any such incidents" of actual confusion between the parties' marks).

⁸⁹ Opposer's Brief, 55 TTABVUE 35-36.

the parties' services, trade channels, and consumers are the same, the marks are overall distinguishable and the relevant consumers are likely to exercise great care with respect to the parties' services. The absence of actual confusion in the circumstances here further supports that confusion is unlikely. For these reasons, we find that Opposer has failed to prove its Section 2(d) claim.

Decision: The opposition is dismissed.