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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 75/486139

**MARK:** HORIZON



**CORRESPONDENT ADDRESS:**

ELLIOTT C BANKENDORF  
WELSH & KATZ LTD  
120 S RIVERSIDE PLZ 22ND FL  
CHICAGO IL 60606

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Blue Cross and Blue Shield of New  
Jersey

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

6587/72925

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**FACTS**

The applicant appeals from the examining attorney's final refusal to register the mark HORIZON, for "prepaid financing and administration of medical, hospital and related health care services" and "comprehensive health care benefit programs, including those rendered through a health maintenance organization, namely, physician, dental, hospital, home health care, preventative health treatment, therapy, pharmacy, and ambulatory services."

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark is confusingly similar to U.S. Registration No. 1375260, SECURE HORIZONS (typed), for "prepaid health care services," Registration No. 1911733, SECUREHORIZONS (stylized), for "health care services in the nature of health care

utilization, review and cost containment services; and medical cost management and cost management for the health benefit plans of others,” and “prepaid health care services; and health care in the nature of a health maintenance organization,” and Registration No. 2084836, WELLNESS HORIZONS (typed) for “administration of pre-paid health care plans.”

Attached to the applicant’s appeal brief as Exhibit 1 is an agreement, dated September 26, 2008 between the applicant and the owner of Registration No. 2084836, in which the latter consents to registration of the applicant’s mark. Based on that agreement, the refusal to register the applicant’s mark based on Registration No. 2084836 is withdrawn. The refusal based on the other two registrations is maintained. No other issues remain.

## **ARGUMENT**

### **Introduction**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record.

*In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535

(TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). In comparing the goods and/or services, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

### **Similarity of the Marks**

The applicant's mark, HORIZON (typed) is similar to the registered marks, SECURE HORIZONS (typed) and SECUREHORIZONS (stylized).

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). When the applicant's mark is compared to a registered mark, "the

points of similarity are of greater importance than the points of difference.” *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). TMEP §1207.01(b).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii). In this case, the dominant feature in each mark is the word “Horizon.”

The law is well-settled that marks may be confusingly similar where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii).

The applicant's mark represents the registered marks with the second term, "Secure," deleted. The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

In its discussion of the registered marks, the applicant's brief misstates the facts. The applicant states "each registration employs a completely different font which dramatically alters the positioning of the letters in the mark" (Applicant's Brief at 8). This is simply not true. While the second cited mark is stylized, the first cited mark is in typed form. Of course the significance of this is that a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form will not generally avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

The applicant also notes that in its mark, the term HORIZON appears in the singular, while in the cited marks it appears in the plural. (Applicant's Brief at 8). While this may be true, it is an insufficient basis on which to distinguish the marks. Trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark. *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is "almost totally insignificant" in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).



### **Similarity of the Services**

The applicant's services are, *on their face*, very closely related if not identical to the registered services. The applicant's services include "prepaid financing and administration of health care services." The services in both of the cited registrations include "prepaid health care services." The applicant's services include "comprehensive health care benefit programs;" the services in both of the cited registrations include "prepaid health care services." The applicant's services specifically include "those rendered through a health maintenance organization;" the services in the second cited registration include "health care in the nature of a health maintenance organization."

It is well-established that where, as in this case, the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

The applicant scarcely disputes the similarity of the parties' services. Under the heading "The Services . . . Are Different" (Applicant's Brief at 9), the applicant makes two arguments.

First, the applicant states that its "services are not used generally in the field of health care services, but rather are specifically for those services offered by [the applicant], primarily operating under a license from the Blue Cross and Blue Shield Association, a

trusted name in the health care industry.” (*Id.*). The significance of this statement is not immediately apparent. If the applicant is suggesting that there are limitations on its services which do not appear in its identification of services, it is not a factor which the examining attorney, or the Board, may consider.

That is because likelihood of confusion is determined on the basis of the goods and/or services *as they are identified in the application and registration*. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii). When the application describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive . . . . There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a)(iii).

Moreover, even if the applicant’s services were limited in some manner, the registered services are not. Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of, *inter alia*, the registrant’s exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. Because both the applicant and the registrant

provide prepaid health care services and services in the nature of a health maintenance organization, their respective services occupy the same channels of trade and reach the same classes of purchasers.

Also under the “difference in services” heading, the applicant argues, based on *In re Int’l Lutheran Laymen’s League*, that “even if [the applicant] and registrants offered similar goods, due to a definite difference in sound and appearance from the registered marks, a determination of likelihood of confusion would be inappropriate in this instance.” (Applicant’s Brief at 9-10). Thus, this argument, although placed under the services heading, is not really about the services at all, but rather about the marks.

## **Other Arguments**

### **Priority of Use**

In arguing against the refusal in this case, the applicant relies in part on the alleged priority of use of its mark over that of the cited marks. (Applicant’s Brief at 5 and 15). This reliance is badly misplaced, as the applicant’s claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

## **Actual Confusion**

The applicant also claims that its mark and the cited marks have both been in use for many years with no evidence of actual confusion. (Applicant's Brief at 10). It is curious at best that the application for a mark supposedly in use since 1984 was filed on an intent-to-use basis in 1998 and remains so to this day.

In any event, the test under Trademark Act Section 2(d) is whether there is a *likelihood* of confusion. It is unnecessary to show *actual* confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an *ex parte* proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

## **Dilution**

The applicant notes that, "at the time the Examining Attorney rejected the applicant's mark," there were a large number of marks containing the term "Horizon" registered or pending for medical-related services. (Applicant's Brief at 12). Many of those marks have since been cancelled or abandoned. To the extent that they continue to exist, third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In*

*re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); *National Aeronautics and Space Admin. v. Record Chem. Co.*, 185 USPQ 563 (TTAB 1975); TMEP §1207.01(d)(iii). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Moreover, even if the applicant has shown that the cited mark is “weak,” such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

### **Sophisticated Purchasers**

Finally, the applicant argues that confusion is unlikely because the purchasers of its services are sophisticated. Although the plight of the uninsured has received a great deal of attention lately, the fact remains that the vast majority of Americans do have health insurance. Thus, consumers of the applicant’s services range from the most sophisticated business man to the least educated manual laborer. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

Moreover, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

### **Conclusion**

For the foregoing reasons, the applicant's mark, when used in connection with the applicant's services, is likely to cause confusion as to the source of those services, based on the existence of Registration Nos. 1375260 and 1911733 for similar marks and services. Accordingly, the refusal to register the applicant's mark under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

/James A. Rauen/  
Trademark Examining Attorney  
Law Office 109  
571-272-9211

Dan Vavonese  
Managing Attorney  
Law Office 109