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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78602188
Applicant	Healthcare Distribution Management Association
Applied for Mark	HEALTHCARE DISTRIBUTORS INTERNATIONAL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No.:	78602188
Application Filing Date:	April 5, 2005
Mark:	HEALTHCARE DISTRIBUTORS INTERNATIONAL
Owner/Applicant:	Healthcare Distribution Management Association
Attorney's Reference:	HEAL6002/TJM

APPLICANT'S BRIEF

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DESCRIPTION OF THE RECORD

The present application was filed on April 5, 2005, requesting registration of the mark HEALTHCARE DISTRIBUTORS INTERNATIONAL based on an intention to use the mark under Section 1(b) for goods and services in Classes 16, 35, 41 and 44, and claiming acquired distinctiveness based upon the claimed ownership of Registration No. 2,888,102 of the mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION for goods and services in Classes 16, 35, 38, 41 and 42, with a disclaimer of “association” and a claim of acquired distinctiveness.

On May 9, 2005, a Preliminary Amendment was filed which amends the address of the applicant.

On November 2, 2005, an Office Action was mailed which objects to the mark as merely descriptive, rejects the claim of acquired distinctiveness, suggests registration on the Supplemental Register, requests a disclaimer of “HEALTHCARE DISTRIBUTORS,” and requests reclassification of services from Class 44 into Class 35.

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On May 2, 2006, a Response to Office Action was filed, which argues that the mark is unitary and inherently distinctive, and should be approved for publication.

On June 25, 2006, an Office Action was mailed which makes final the objection to the mark as allegedly descriptive, suggests registration on the Supplemental Register, and requests a disclaimer of "HEALTHCARE DISTRIBUTORS."

On December 22, 2006, a Notice of Appeal was filed together with a Response to Office Action. The Notice of Appeal requests suspension of the appeal and remand of the application to the Examining Attorney for consideration of the Response to Office Action. The Response to Office Action requests reconsideration, argues that acquired distinctiveness has been established, and argues that a disclaimer should not be required.

On January 3, 2007, the Trademark Trial and Appeal Board mailed an Office Action which suspends the appeal and remands the application to the Examining Attorney.

On January 31, 2007, an Office Action was mailed which denies the request for reconsideration, and returns the file to the Trademark Trial and Appeal Board for resumption of the appeal.

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On March 1, 2007, the Trademark Trial and Appeal Board issued an Office Action which allows 60 days for the filing of Applicant's brief.

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STATEMENT OF THE ISSUE

Whether the Office Action dated January 31, 2007, which maintains the final refusal in the Office Action dated June 25, 2006, is correct in asserting that Applicant's mark is precluded from registration by inadequate evidence of acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f) (1999).

ARGUMENT

I. THE STANDARD OF REVIEW.

In ex parte cases, the question is simply "whether or not, based on the record before the examiner, the examiner's action was correct." *In re Bose Corp.*, 772 F.2d 866, 869 (Fed. Cir. 1985). See also *In re AFG Industries, Inc.*, 17 U.S.P.Q.2d 1162 (T.T.A.B. 1990) (In determining an ex parte appeal, the Appeal Board's sole task is "to determine if the refusal to register was correctly made." *Id.* at 1163).

II. AN INTENT TO USE MARK MAY HAVE ACQUIRED DISTINCTIVENESS.

An intent to use mark may be approved for publication based upon the acquired distinctiveness of a previously registered mark. *In re Dial-A-Mattress Operating Corporation*, 240 F.3d 1341, (Fed. Cir. 2001); accord, *Trademark Manual of Examining Procedure* (TMEP) §1212.09 (April, 2005). In the *Dial-A-Mattress* case, the Federal Circuit stated as follows:

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Dial-A-Mattress filed an intent-to-use application for the registration of the mark 1-888-M-A-T-R-E-S-S. ... Trademark Rule 2.41(b) provides that "in appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. 37 C.F.R. § 2.41(b) (2000).

A proposed mark is the "same mark" as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. Whether marks are legal equivalents is a question of law subject to our de novo review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. [Citation omitted]

Id. at 1347. In the *Dial-A-Mattress* case, the applicant did not rely on an identical earlier mark:

Dial-A-Mattress argues that its previously-registered marks, especially (212) M-A-T-T-R-E-S (registered for "retail outlet services and retail store services featuring mattresses") and the 1-800-MATTRES, AND LEAVE OFF THE LAST S THAT'S THE S FOR SAVINGS mark (registered for "retail outlet services and retail direct sale of mattresses" with "1-800" disclaimed), are the legal equivalents of 1-888-M-A-T-R-E-S-S.

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Id. The Federal Circuit was not persuaded by the Commissioner's arguments:

As the "same mark" or the "legal equivalent" of "(212) M-A-T-T-R-E-S," the "1-888-M-A-T-R-E-S-S" mark is entitled to rely on the former as *prima facie* evidence of acquired distinctiveness.

The services specified for the (212) mark, "retail outlet services and retail store services featuring mattresses," are closely related to those specified for the 1-888-M-A-T-R-E-S-S mark, "telephone shop-at-home retail services in the field of mattresses"; in fact, the latter can be considered a subset of the former.

Id. at 1348 (emphasis added). In the present case, Applicant relies on an earlier registration of a legally equivalent mark for closely related goods and services, just as in the *Dial-A-Mattress* case.

III. THERE IS ADEQUATE EVIDENCE OF ACQUIRED DISTINCTIVENESS.

Applicant has claimed ownership of Registration No. 2888102 which provides a *prima facie* evidence of acquired distinctiveness.

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A. THE MARKS ARE LEGAL EQUIVALENTS.

The earlier mark was registered under Section 2(f) based on acquired distinctiveness. Registration No. 2,888,102 was issued under Section 2(f). The registered mark is HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION. The registration includes a disclaimer of "ASSOCIATION." Thus, the registration was issued based upon the acquired distinctiveness of "HEALTHCARE DISTRIBUTION MANAGEMENT."

The first term of the registered mark is "HEALTHCARE" which is the same first term as the present mark, HEALTHCARE DISTRIBUTORS INTERNATIONAL. The second term of the registered mark is "DISTRIBUTION" which has a very similar appearance, pronunciation and meaning as compared to the second term of the present mark "DISTRIBUTORS." Thus, the primary impression of the present mark is almost identical to the primary impression of the registered mark.

The words by which the present mark differs from the registered mark, are each not highly distinctive, and are each related to the relevant goods and services. The present mark includes the word "INTERNATIONAL" which is not found in the registered mark. The word

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“INTERNATIONAL” is suggestive of the present goods and services, which all relate to healthcare product distribution. Healthcare products are an international business. The word “international” is also suggestive of the goods and services of the registration, which include “providing business information relating to the distribution of healthcare products and pharmaceuticals on a global computer network;” in Class 35. Global is certainly international.

The term “MANAGEMENT” in the registered mark is suggestive of the goods and services of the registration, which include “seminars concerning marketing, sales, distribution, accounting, finance, technology and information services,” in Class 41. The word “management” is also suggestive of the goods and services of the present application, which include “arranging and conducting trade show exhibitions in the field of the distribution of healthcare products and the management of healthcare product distribution businesses;” in Class 35.

Applicant’s members, and those familiar with Applicant, would immediately associate the present mark HEALTHCARE DISTRIBUTION INTERNATIONAL with the registered mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION because of the similarity between the two. The marks are legally equivalent for the purpose of 37 C.F.R. §2.41(b).

B. THE GOODS AND SERVICES ARE CLOSELY RELATED.

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The goods and services of the present application are closely related to the goods and services of the claimed registration, as is evident from a side by side comparison:

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Class 16: publications , namely, magazines, reports and newsletters in the field of healthcare product distribution ; downloadable electronic publications in the nature of magazines, reports and newsletters in the field of healthcare product distribution ; electronic publications in the nature of magazines, reports and newsletters in the field of healthcare product distribution recorded on electronic and optical media	Class 16: Publications and other printed matter, namely newsletters, books, guides, directories, and catalogs featuring information on the distribution of health care products and pharmaceuticals

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U.S. Application No. 78602188 Mark: HEALTHCARE DISTRIBUTORS INTERNATIONAL	U.S. Registration No. 2888102 Mark: HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION
Class 35: association services, namely, promoting the interests of the distributors of healthcare products , creating and exchanging knowledge that affects the future of distribution management, and influencing the standards and business processes that produce efficient healthcare commerce; online business directories featuring products, services and businesses related the distribution of healthcare products ; arranging and conducting trade show exhibitions in the field of the distribution of healthcare products and the management of healthcare product distribution businesses	Class 35: providing business information in the field of product information, marketing and operational supply chain efficiency for others; providing business information relating to the distribution of healthcare products and pharmaceuticals on a global computer network; business research; public and media relations

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U.S. Application No. 78602188 Mark: HEALTHCARE DISTRIBUTORS INTERNATIONAL	U.S. Registration No. 2888102 Mark: HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION
[no Class 38 services]	Class 38: electronic mail services; providing on-line electronic bulletin boards for transmission of messages among computer users concerning products, services, and issues pertinent to the healthcare and pharmaceutical distribution industries ; providing Internet access
Class 41: arranging and conducting educational conferences in the field of the distribution of healthcare products and healthcare product distribution businesses	Class 41: educational services, namely, arranging and conducting educational and training conferences and seminars concerning marketing, sales, distribution, accounting, finance, technology and information services, personnel, and regulatory compliance in the area of the distribution of health care products and pharmaceuticals

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U.S. Application No. 78602188 Mark: HEALTHCARE DISTRIBUTORS INTERNATIONAL	U.S. Registration No. 2888102 Mark: HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION
[no Class 42 services]	Class 42: association services, namely, promoting the interests of the healthcare products and pharmaceuticals distribution industry ; political advocacy and lobbying services in the fields of healthcare and pharmaceuticals via the Internet
Class 44: arranging and conducting trade show exhibitions in the field of the distribution of healthcare products to hospitals	[no Class 44 services]

Applicant’s goods and services all relate to “healthcare product distribution.” The goods and services of the registration relate to the “distribution of healthcare products and pharmaceuticals.” These terms have essentially the same meaning. The services of the registration also include “pharmaceutical distribution industries” which would be included within the broad term “healthcare product distribution.”

IV. THE PRESENT MARK IS UNITARY.

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Applicant maintains that the present mark is unitary. The present mark HEALTHCARE DISTRIBUTORS INTERNATIONAL should not be viewed standing alone and isolated, but in the context of Applicant's continuous use of the registered mark HEALTH DISTRIBUTION MANAGEMENT ASSOCIATION since at least as early as January 1, 2001 (the date of first use recited in the registration), which is after the registration's filing date, July 26, 2000. Applicant's members, and others familiar with Applicant, would not view the present mark HEALTHCARE DISTRIBUTORS INTERNATIONAL as a new mark, but rather as a continuation and expansion of the focus of the association as suggested by the registered mark HEALTH DISTRIBUTION MANAGEMENT ASSOCIATION. The present mark should be regarded as unitary, and no disclaimer should be required.

V. IN THE ALTERNATIVE, IF THE PRESENT MARK IS NOT UNITARY, THEN APPLICANT SHOULD BE ALLOWED TO ENTER A DISCLAIMER.

If this Board concludes that the mark is not unitary, then Applicant is entitled to the entry of a disclaimer:

(g) An application which has been considered and decided on appeal will not be reopened except for the *entry of a disclaimer* under §6 of the Act of 1946 [15 U.S.C. §1056 (1988)] or upon order of the Director, but a petition to the Director to reopen an application

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will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

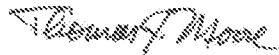
37 C.F.R. §2.142(g) (2003). Applicant should be allowed to disclaim either “DISTRIBUTORS” or “DISTRIBUTORS INTERNATIONAL” at Applicant’s discretion.

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CONCLUSION

Applicant respectfully submits that the application should be approved for publication because there is *prima facie* evidence of acquired distinctiveness.

Respectfully submitted,



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