

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78632158
LAW OFFICE ASSIGNED	LAW OFFICE 101
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>Serial No.: 78/632158            Applicant: OpFree Licensing LP            Mark: FIRST CHOICE EMERGENCY ROOM            Docket No: OPFR-27138</p> <p><b>REQUEST FOR RECONSIDERATION</b></p> <p>Applicant responds to the Office Action mailed August 3, 2006.</p> <p>Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because, in the Examiner's view, the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2894892 as to be likely, when used on the identified goods/services, to cause confusion, or to cause mistake, or to deceive. The refusal under Section 2(d) has been made <b>FINAL</b>. Applicant hereby renews the arguments and evidence previously submitted, and in addition, herewith submits additional arguments and evidence relevant to the application, and respectfully requests reconsideration and withdrawal of the refusal. Applicant has concurrently filed a Notice of Appeal with the TTAB.</p> <p><b><u>Likelihood of Confusion</u></b></p> <p>The examining attorney has refused registration because the examining attorney believes the mark is confusingly similar to prior U.S. Registration No. 2894892 for the mark 1ST CHOICE MEDICAL CENTER &amp; Design. In support of the refusal the examining attorney has submitted the following evidence: a database abstract of the cited registration. In addition the examining attorney has reviewed selected <i>Du Pont</i> factors. Applicant has reviewed the evidence and arguments presented and believes that the examining attorney has failed to consider additional <i>Du Pont</i> factors relevant to the likelihood of confusion. Applicant therefore submits additional evidence and arguments, and respectfully requests reconsideration and withdrawal of the refusal.</p> <p><b>Overview</b></p>	

In comparing the marks for similarities in appearance, sound, connotation and commercial impression, the examining attorney has focused primarily on the phonetically equivalent wording FIRST CHOICE and 1ST CHOICE, asserting that these word portions are the dominant portions of the mark.

Applicant submits herewith evidence that the term "first choice" is in widespread, unrestrained use by third parties for related services, and thus is relatively weak. Similarly, the terms "emergency room" and "medical center" are relatively weak. Since applicant's proposed mark has both word or words and a design, and since the word portions of both marks are weak, the design portion of the mark must dominate. Applicant's design portion clearly distinguishes the proposed mark from the cited registration. Thus, registration should be allowed.

### Evidence and Arguments

One of the relevant *Du Pont* factors is "the number and nature of similar marks in use on similar goods." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Accordingly, the TTAB has given weight to credible and probative evidence of widespread, significant, and unrestrained use by third parties of marks containing elements in common to demonstrate that confusion is not, in fact, likely. *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB 1986). Such evidence of widespread third-party use in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996); See also *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911 n1912 (TTAB 1988); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 867-869 (TTAB 1985); *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986).

Applicant herewith submits the following evidence showing widespread, significant and unrestrained use by third party use of marks containing the element "first choice" in the field of medical services:

- 1) opf27120 First Choice Medical Center.jpg: Internet advertisement showing use of mark FIRST CHOICE MEDICAL CENTER & Design (Alamonte Springs, FL);
- 2) opf27120 First Choice Home Medical.jpg: Internet advertisement showing use of mark FIRST CHOICE MEDICAL CENTER & Design (Bowling Green, KY);
- 3) opf27120 Methodist First Choice.jpg: Internet advertisement showing use of mark METHODIST FIRST CHOICE (Peoria, IL);
- 4) opf27120 First Choice Health Medical Management.jpg: Internet advertisement showing use of mark FIRST CHOICE HEALTH MEDICAL MANAGEMENT & Design;
- 5) opf27120 First Choice Medical Supply Page 1.jpg: Internet advertisement showing use of mark FIRST CHOICE MEDICAL SUPPLY & Design;
- 6) opf27120 First Choice Cooperative Page 1.jpg: Internet advertisement showing use of mark FIRST CHOICE COOPERATIVE & Design (Tyler, TX);
- 7) opf27120 First Choice Healthcare - Omaha Page 1.jpg: Internet advertisement showing use of mark FIRST CHOICE HEALTHCARE (Omaha, NE); and

8) opf27120 First Choice Home Services\_Page\_1.jpg: Internet advertisement showing use of mark FIRST CHOICE HOME SERVICES (Harrisonburg, VA).

This evidence demonstrates that the element "first choice / 1st choice" in both marks is weak in the field. It will be appreciated that the elements "emergency room" and "medical center" are descriptive of the services and/or location of services, and thus are also weak.

If the mark has both word or words and a design, greater weight is often given to the word which would be used by the purchaser in requesting the goods or services. On the other hand, if the words are merely descriptive or generic, the design portion of the mark would dominate. Each mark must be viewed as a whole, and each case turns on its own facts. T.M.E.P. §1207.01(b).

In the case of weak marks, even slight differences between the marks may be deemed sufficient to avoid a finding that confusion is likely. *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1912 (TTAB 1988) ("As such, we find the term to be a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); see also *In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994). In the current case, the applicant's mark includes design

That matter has been disclaimed from a mark does not bear on a likelihood of confusion determination. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("The marks must be considered in the way in which they are perceived by the relevant public."); *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.").

#### Further Comments

The examining attorney contends that the matter at hand involves marks with *identical commercial impression for identical services*.

Applicant does not agree that the commercial impression is identical. An evaluation of the commercial impression must consider the marks as a whole, including any disclaimed portion. In the case at hand, the common public impression of "medical center" is one of a place that is large, stately, and multi-purpose, whereas the impression of "emergency room" is one of a place that is small, fast-acting, and specialized for one purpose. Thus, the commercial impression of the two marks is thus far from identical.

Further, applicant does not agree that the services offered are identical. Applicant's identification of services expressly indicates that the services are emergency medical services provided to persons at a free-standing emergency room facility not located at a hospital. The public understands that the nature of services expected at a hospital/medical center is different from the nature of services provided in a walk-in facility. The services must be characterized by their entire nature, not just by physician care, but also by timeliness of intake processing and treatment, by convenience of insurance and payment processing, locations within neighborhoods, etc., since these are all part of the services offered. Thus, the services offered at a hospital are very different from the services offered at a walk-in facility not located at a hospital.

**Summary**

The evidence submitted demonstrates that the element "first choice" is weak. The remaining word elements in both marks are similarly weak. There are significant differences in the visual appearance of applicant's mark and registrant's cited mark. The marks have different commercial impressions and cover different services. The public is conditioned to look at all elements of the marks as a means of distinguishing the source of goods or services in the field. Thus, the differences in applicant's mark and the cited mark are sufficient to leave no doubt that there is no material likelihood of confusion. Accordingly, the examining attorney is respectfully requested to reconsider and withdraw the refusal to register.

**SIGNATURE SECTION**

RESPONSE SIGNATURE	/jja/
SIGNATORY'S NAME	John J. Arnott
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	02/02/2007
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Fri Feb 02 19:45:44 EST 2007
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OMB No. 0651-0050 (Exp. 04/2009)

**Response to Office Action****To the Commissioner for Trademarks:**

Application serial no. **78632158** has been amended as follows:

**Argument(s)**

In response to the substantive refusal(s), please note the following:

Serial No.: 78/632158

Applicant: OpFree Licensing LP

Mark: FIRST CHOICE EMERGENCY ROOM

Docket No: OPFR-27138

**REQUEST FOR RECONSIDERATION**

Applicant responds to the Office Action mailed August 3, 2006.

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because, in the Examiner's view, the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2894892 as to be likely, when used on the identified goods/services, to cause confusion, or to cause mistake, or to deceive. The refusal under Section 2(d) has been made FINAL. Applicant hereby renews the arguments and evidence previously submitted, and in addition, herewith submits additional arguments and evidence relevant to the application, and respectfully requests reconsideration and withdrawal of the refusal. Applicant has concurrently filed a Notice of Appeal with the TTAB.

### Likelihood of Confusion

The examining attorney has refused registration because the examining attorney believes the mark is confusingly similar to prior U.S. Registration No. 2894892 for the mark 1ST CHOICE MEDICAL CENTER & Design. In support of the refusal the examining attorney has submitted the following evidence: a database abstract of the cited registration. In addition the examining attorney has reviewed selected *Du Pont* factors. Applicant has reviewed the evidence and arguments presented and believes that the examining attorney has failed to consider additional *Du Pont* factors relevant to the likelihood of confusion. Applicant therefore submits additional evidence and arguments, and respectfully requests reconsideration and withdrawal of the refusal.

### Overview

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Applicant submits herewith evidence that the term "first choice" is in widespread, unrestrained use by third parties for related services, and thus is relatively weak. Similarly, the terms "emergency room" and "medical center" are relatively weak. Since applicant's proposed mark has both word or words and a design, and since the word portions of both marks are weak, the design portion of the mark must dominate. Applicant's design portion clearly distinguishes the proposed mark from the cited registration. Thus, registration should be allowed.

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### Response Signature

Signature: /jja/ Date: 02/02/2007

Signatory's Name: John J. Arnott

Signatory's Position: Attorney for Applicant

Serial Number: 78632158

Internet Transmission Date: Fri Feb 02 19:45:44 EST 2007

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