

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NUMBER: 77/638426

MARK: CommCare (standard character mark)

APPLICANT: CommCare Corporation

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RESPONSE TO OFFICE ACTION

Applicant CommCare Corporation makes the following response to the office action issued with respect to the above-referenced application.

RESPONDING TO SECTION 2(d) REFUSAL

On March 16 2009, the Examiner issued an office action determining that the proposed mark should be “refused because of a likelihood of confusion with the mark in U.S. Registration No. 3,281,526. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see* TMEP §§ 1207.01 *et seq.*”

The cited registration is for a design mark consisting of “a green and white Rx logo and the green lettering “Commcare Pharmacy.” The “Rx logo” part of the cited mark consists of square background for a stylized house design with the “Rx” symbol in the center. The colors green and white are claimed as features of the mark. The owner and registrant of the mark is a Florida limited liability company, NS3 Health, LLC. The services covered by the cited registration are: “retail pharmacy services” in International Class 035. Registrant has been using this mark since 1996 (with the first use in commerce occurring in January 1997).

The applicant’s registration is for the word mark, CommCare (all one word with a capital “C” in the middle for Care). The owner of, and applicant for, this mark is CommCare

Corporation, a Louisiana corporation. Applicant seeks to register CommCare for “nursing homes and providing long term and senior care facilities.” These services fall within International Class 044. Applicant has been providing these services since at least 1993 (with first use in commerce occurring in April 1994).

The governing authority with respect to the Examiner’s refusal is, of course, the venerable case of *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), which lists the factors to be considered when testing for likelihood of confusion under Section 2(d) of the Trademark Act:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark: (a) a mere “consent” to register or use. (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party. (c) assignment of mark, application, registration and good will of the related business. (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

476 F.2d at 1361.

Applicant disagrees with both of the Examiner’s conclusions – (1) that applicant’s CommCare word mark is “similar to the registrant’s mark” and will lead to consumer confusion” and (2) that “pharmacy services and nursing care are of a kind that may emanate from a single source” and thus “confusion as to source is likely.”

The applicant’s proposed mark differs in many different features from the mark cited by the Examiner and yields a very different commercial impression. The registrant has a color design mark with a logo on the left-hand side and two words stacked over each other on the right hand side -- in which the word “PHARMACY” is just as large as the word “COMMCARE.”

In contrast, applicant's proposed mark consists of a word mark alone: CommCare.

The two marks create a different commercial impression. The Examiner did not acknowledge this difference between the two marks nor assess its impact. Clearly the "pharmacy" aspects of the registrant's mark – the "Rx" logo on the left-hand side of the mark and the word PHARMACY on the right-hand side are more dominant in appearance than the word that the two marks have in common, COMMCARE.

The dominance of the "pharmacy" aspect of the registrant's mark takes on greater importance in the examination of the relationship between the goods and services of the respective parties.

Under the Office's examination procedures, the Examiner "must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion." TMEP 1207.01(a)(vi). The evidence may include news articles, evidence from data bases, and advertisements showing that the relevant goods or services are offered by the same source. *Id.* The TMEP allows the examiner to consider prior registrations; however, the TMEP also makes clear that this type of evidence is very weak: "Third-party registrations that cover a number of different goods or services have *some* probative value to the extent that they *may* serve to suggest that goods or services are of a type that may emanate from a single source." TMEP 1207.01(d)(iii) (emphasis added).

Here, the only evidence cited by the Examiner consisted of these lesser-value, third-party registrations. Much stronger evidence shows that retail pharmacy services (as offered by the registrant) differ quite significantly from the services offered in nursing homes and long-term and senior care facilities.

First, the two services are in different classes of trade. Retail pharmacy services fall under Class 35 while nursing home and long-term care falls under class 44.

Second, strong evidence of the differences in services is found in the North American Industry Classification System (NAICS) used by the U.S. Census Bureau. The NAICS groups "Nursing Care Facilities" in industry 62 – health care and social assistance – and more specifically NAICS 623110 which is described as follows:

This industry comprises establishments primarily engaged in providing inpatient nursing and rehabilitative services. The care is generally provided for an extended period of time to individuals requiring nursing care. These establishments have a permanent core staff of registered or licensed practical nurses who, along with other staff, provide nursing and continuous personal care services.

The NAICS groups retail pharmacy services in section 44 covering "Retail Trade" -- a completely different category from health care where physician, hospital, and nursing

services are located. The Census Bureau describes the pharmacy and drug store industry as follows:

This industry comprises establishments known as pharmacies and drug stores engaged in retailing prescription or nonprescription drugs and medicines.

The 2007 NAICS is available on-line at www.census.gov. The relevant pages are attached as **EXHIBIT 1**.

Third, the pharmacy industry itself does not see nursing homes as offering a competitive service. The National Association of Chain Drug Stores offers a set of industry “facts at a glance” which lists data for total prescription drug sales (some \$253 billion and some 3.5 billion scripts). Those sales are broken down by:

- Traditional chain pharmacies
- Mass market stores (with pharmacies)
- Supermarkets with pharmacies
- Independent pharmacies
- Mail order pharmacies

What is significant is that these sales data do not include nursing homes or any other providers classified by the Census Bureau in Class 62. In other words, businesses such as registrant, who offer retail pharmacy services, do not consider businesses such as applicant, who operate a nursing home or long term care/senior facility, to be offering the same or similar services. The relevant pages of the NACD “facts at a glance” are attached as **EXHIBIT 2**.

Fourth, the Examiner’s refusal of applicant’s mark does not indicate any consideration of whether there is a similarity of channels of trade between the “retail pharmacy services” covered by the cited registration and Applicant’s nursing homes services or the conditions in which a consumer selects a pharmacy or nursing homes. These are two very important *DuPont* factors.

Neither the filling of prescriptions at a retail pharmacy nor the selection of a nursing home is an action made in haste or impulsively so as to create a situation in which consumers are likely to be prone to error. For one thing, the provider must be located in a geographic area where the consumer can use the services. For another, selection of a pharmacy or a nursing home is often dependent on personal recommendations (and payor considerations). As noted in the TMEP, “circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.” TMEP 1207.01(d)(vii).

Moreover, the selection of both nursing home services and pharmacy services is very personal in nature and the two services are simply not interchangeable. A patient in need of long-term/nursing home care cannot be dropped off at a pharmacy, nor can a member of the public walk into a nursing home to have a prescription filled as can be done at a

retail pharmacy. The regulatory system in place for dispensing drugs will simply not allow nursing homes to serve the public at large the way retail pharmacies do. This common life experience does not support the Examiner's conclusion that consumers expect to find retail pharmacy services and nursing home/long term care services from the same source.

Finally, there is no indication that the cited registration is famous or that there has ever been any instance of confusion between registrant's and applicant's services or any of the other *DuPont* factors.

In these circumstances, the Examiner was wrong to conclude that there was sufficient similarity between the registrant's and applicant's services to find a likelihood of confusion. As the court pointedly noted in the *DuPont* case, "The fact that the goods of one party 'could be used' in the field of the other is too conjectural and too widely applicable to form the sole basis of decision." 476 F.2d at 1363. The Examiner's "evidence" here is exactly the type of tenuous conjecture rejected in *DuPont*.

For the foregoing reasons, Applicant respectfully requests that the Examiner find the proposed word mark "CommCare" proper for registration on the Principal Register for "nursing homes and providing long term and senior care facilities."

Respectfully submitted,

 /MBreaux/
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