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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allina Health System

Serial No. 75/866,749

Eric D. Paulsrud of Leonard, Street and Deinard for Allina Health Systems.

Gina M. Fink, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Walters, Bucher and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 8, 1999, Allina Health Systems (applicant) filed an intent-to-use application to register the mark AMERICAN HEART INSTITUTES (in typed form) on the Principal Register for "cardiovascular health care services" in International Class 42. The Examining Attorney ultimately refused to register applicant's mark on three grounds.

First, the Examiner Attorney held that applicant's mark so resembles the following four registrations owned by

the American Heart Association that there would be a likelihood of confusion if the marks were used on the respective goods and services in the application and registrations. 15 U.S.C. § 1052(d). The first two registrations are, respectively, for the marks AMERICAN HEART ASSOCIATION in typed form¹ and for the same words with the design shown below².



for "association services in the field of prevention and treatment of heart disease" in International Class 42.

The Examining Attorney cited two additional registrations also for the marks, respectively, AMERICAN HEART ASSOCIATION in typed form³ and AMERICAN HEART

¹ Registration No. 1,091,140 issued on May 9, 1978, and it contains a disclaimer of the words "Heart Association." The registration has been renewed.

² Registration No. 1,288,391 issued July 31, 1984, and it contains a disclaimer of the words "Heart Association." Affidavits under Sections 8 and 15 have been accepted and acknowledged, respectively.

³ Registration No. 2,072,127 issued June 17, 1997, under the provisions of Section 2(f) of the Trademark Act.

ASSOCIATION and the substantially similar design⁴ for the following goods and services:

Educational computer software in the field of cardiovascular health, fitness, nutrition, and/or prevention or reduction of cardiovascular disease and stroke. International Class 9

Printed pamphlets, brochures, manuals, books, cookbooks, booklets, leaflets, flyers, wallet cards, posters, informational sheets and newsletters, research monographs, journal reprints, charts, diagrams, posters, adhesive backed stickers, and kits comprising one or more of the foregoing materials, all relating to the promotion of cardiovascular health, fitness and nutrition, and/or the prevention or reduction of cardiovascular disease and stroke. International Class 16

Charitable fundraising services for promoting research, education and other activities relating to cardiovascular health, fitness and nutrition, and/or the prevention or reduction of cardiovascular disease and stroke; promoting memorial donations to cardiovascular charity. International Class 36

Educational services, namely, conducting seminars, courses, conferences and scientific session meetings, lectures and workshops, producing radio and television spots, relating to cardiovascular health, fitness and nutrition, and/or prevention or reduction of cardiovascular disease and stroke. International Class 41.

Promoting public awareness of cardiovascular health, fitness and nutrition, and/or prevention or reduction of cardiovascular disease and stroke. International Class 42.⁵

⁴ Registration No. 2,072,129 issued June 17, 1997, under the provisions of Section 2(f) in part for the words "American Heart Association."

⁵ Registration No. 2,072,127 also contains the following language, "Association services, research and community services, namely,...," at the beginning of the services identified in International Class 42.

Second, the Examining Attorney refused to register applicant's mark because it so resembles the mark MID AMERICA HEART INSTITUTE in typed form for "hospital and health care services," in International Class 42,⁶ that there would be a likelihood of confusion if the marks were used on the respective services in the application and registration. 15 U.S.C. § 1052(d).

Third, the Examining Attorney refused to register applicant's mark because she determined that the mark was primarily geographically descriptive of applicant's services under Section 2(e)(2) of the Trademark Act. 15 U.S.C. § 1052(2)(2).

After the Examining Attorney made the refusals final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Regarding the cited Registration Nos. 1,091,140; 1,288,391; 2,072,127; and 2,072,129, the Examining Attorney argues that these marks and applicant's mark begin with the same two words AMERICAN HEART; and that the only other words in the marks, INSTITUTES and ASSOCIATION, are highly descriptive and/or generic with respect to applicant's

⁶ Registration No. 1,843,298 issued July 5, 1994, and it contains a disclaimer of the words "Heart Institute." Affidavits under Sections 8 and 15 have been accepted and acknowledged, respectively.

and registrant's services. Furthermore, the Examining Attorney maintains that these words "are also close synonyms for each other, essentially meaning organization." Examining Attorney's Br. at 3. The Examining Attorney also argues that the services in the application and registrations are related and submitted examples of third-party registrations that contain services similar to those in the cited registrations and the application.

Regarding the cited Registration No. 1,843,298, the Examining Attorney contends that the only differences in the marks are applicant's deletion of the word "mid" and the use of slightly different endings for America[n] and Institute[s]. The Examining Attorney also concluded that the applicant's and registrant's health care services are the same.

Regarding the geographically descriptive refusal, the Examining Attorney's position is that "America" and "American" "denotes the United States origin or the scope of the goods or services." Examining Attorney's Br. at 7. The addition of generic or highly descriptive matter to this geographic term did not persuade the Examining Attorney that the term is not primarily geographically descriptive.

Applicant argues that there are registered marks that share the term AMERICA and AMERICAN; and that other marks include the term HEART and INSTITUTE. Applicant refers to the other cited registration MID AMERICA HEART INSTITUTE as evidence that its mark can co-exist with the registered marks. Applicant also maintains that the American Heart Association marks "identify a public charity through which the public is educated as to issues related to the heart and through which funds are raised to further such public awareness." Applicant's Br. at 6. In regard to the relatedness of its services and the American Heart Association services, applicant argues that "physicians generally make specific referrals to specific service providers." Applicant's Br. at 7 (emphasis in original). Applicant's conclusion is that there is no likelihood of confusion because medical practitioners "are highly educated, highly sophisticated consumers" who can "recognize even slight differences between marks used to identify competing organizations." Id. Applicant asserts that the same sophisticated purchasers argument supports a finding of no likelihood of confusion with the mark MID AMERICA HEART INSTITUTE. It also argues that other entities use the term "heart institute" with a geographic indicator. Finally, applicant submits that the "term

AMERICAN is more than just a geographical term in relation to its services.

After considering the record and the positions of the Examining Attorney and the applicant, we affirm each of the refusals.

I. Refusal based on American Heart Association marks

In likelihood of confusion cases, we must consider the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), keeping in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is whether the marks are similar in sound, appearance, meaning or commercial impression. du Pont, 476 F.2d at 1361, 177 USPQ at 567. Applicant has applied to register the mark AMERICAN HEART INSTITUTES in typed form while the cited marks are for the words AMERICAN HEART ASSOCIATION, both in typed form and with a design. Registrant's and applicant's marks begin with the same two words, "American" and "Heart," in the same order. The Examining Attorney has also submitted dictionary definitions to show that the terms "association"

and "institute" can have similar meanings. An "association" is defined as "an organized body of people who have an interest, an activity, or a purpose in common," while an "institute" is defined as an organization founded to promote a cause: *a cancer research institute.*"

American Heritage Dictionary of the English Language, Third Edition (1992). We agree with the Examining Attorney that these words can have related meanings.

We must compare the marks in their entireties to determine if the marks are similar. It is well settled that it is improper to dissect a mark. In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In a similar case, the Court of Appeals for the Federal Circuit held that the marks CASH MANAGEMENT ACCOUNT and CASH MANAGEMENT EXCHANGE were confusingly similar.

CASH MANAGEMENT ACCOUNT and THE CASH MANAGEMENT EXCHANGE are, in large part, identical in sound and appearance and have a general similarity in cadence. In addition, the words ACCOUNT and EXCHANGE, while not synonyms, both have the connotation of monetary transactions, so that the marks carry the same overall connotation. The sole feature in National's mark which is different from the registered mark, in our

view, is not sufficiently different to distinguish the marks to the public.

National Data, 224 USPQ at 752.

In that case, the Court noted that confusion was likely even assuming that the term "cash management" was generic or at least highly descriptive. Id. Similarly, applicant's and the American Heart Association's marks include identical initial words and third words with similar connotations. To the extent that two of the American Heart Association's registrations include a heart design with a torch, it is clearly not sufficient to distinguish these registrations from applicant's mark. The overall impression created by applicant's and registrant's marks is substantially similar.

Next, we turn to the issue of whether applicant's services and registrant's goods and services are related. Relatedness may exist even if the products and services are not competitive "if they could come to the attention of the same types of customers suggesting a common origin." MSI Data Corp. v. Microprocessor Systems, Inc., 220 USPQ 655, 658 (TTAB 1983) See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (Grocery and general merchandise store services found related to furniture). Safety-Kleen Corp. v. Dresser

Industries, 518 F.2d 1399, 186 USPQ 476 (CCPA 1975)

(Maintenance services found related to parts for cleaning units).

We must consider the goods and services as they are described in the identification of goods and services in the applications and registration. "'Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be.'" In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997)(punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987). See also Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed").

Applicant submits that the registrant uses its mark "to identify a public charity through which the public is educated as to issues related to the heart and though which are raised to further such public awareness." Applicant's Br. at 6. However, while two of the registrations contain charitable fund raising services in the identification of goods and services, the fact that registrant may be a charity dose not mean that we do not also consider the other goods and services recited in the cited registrations.

The goods and services in two of the cited registrations (Nos. 2,072,127 and 2,072,129) are associated with preventing or reducing heart disease and promoting cardiovascular health, for example, "educational services, namely, promoting seminars ... relating to cardiovascular health, fitness and nutrition, and/or prevention or reduction of cardiovascular disease and stroke," "educational computer software in the field of cardiovascular health," and "promoting public awareness of cardiovascular health, fitness and nutrition, and/or prevention or reduction of cardiovascular disease and stroke." Applicant's services are also related to the heart, i.e., cardiovascular health care services. In addition, "health care" is defined as "the prevention,

treatment, and management of illness and the preservation of mental and physical well-being through the services offered by the medical and allied health professions." *The American Heritage of the English Language, Third Edition* (1992).⁷ Registrant's services and goods are in the area of preventing or reducing cardiovascular diseases and stroke and applicant's cardiovascular health care services would also logically include services involving the prevention or reduction of cardiovascular diseases and stroke. Therefore, these services are related.

In addition, the Examining Attorney submitted evidence to establish a relationship between applicant's cardiovascular health care services and registrant's association services in the field of prevention of heart disease in Registration Nos. 1,091,140 and 1,288,391. The evidence consists of registrations to show that the same mark is used to indicate the source of health care and/or medical services and association services. See Registration No. 2,396,165 (Association services and health care services in the field of smoking cessation); No. 2,390,236 (health care services and association services

⁷ As requested by the Examining Attorney, we take notice of this dictionary definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

providing health and medical information); and No. 2,264,613 (association services and health care services for the foot and ankle). See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). These registrations support the Examining Attorney's position that association services and health care services in the cardiovascular field may emanate from the same source.

Applicant argues that the true consumers of its cardiovascular health care services are highly educated, highly sophisticated professionals. However, the class of purchasers of its services, as defined in the application, is not limited to medical practitioners either explicitly or implicitly. Nor is there any evidence that supports applicant's assertion. Prospective purchasers or users of cardiovascular health care services would include those individuals seeking care for existing conditions and preventive health care. These purchasers and users would overlap with purchasers or users of registrant's services

directed to the promotion of cardiovascular health, and they would not be limited to sophisticated purchasers. Canadian Imperial Bank, 1 USPQ2d at 1816 (Board properly considered "whether, in the entire market for that service (banking services), there was a likelihood of confusion").

When the confusingly similar marks AMERICAN HEART ASSOCIATION, AMERICAN HEART ASSOCIATION and design, and AMERICAN HEART INSTITUTES would be used on the related and similar goods and services identified in the respective application and registrations, there is a likelihood of confusion because they could be encountered by the same persons in a manner or under circumstances suggesting a common source.

II. Refusal based on MID AMERICA HEART INSTITUTE mark

The Examining Attorney also refused registration in view of a prior registration of the mark MID AMERICA HEART INSTITUTE for hospital and health care services. We agree with the Examining Attorney that registrant's "health care services" would encompass "cardiovascular health care services." Therefore, applicant's and registrant's services include the same services. Examining Attorney's Br. at 7.

Next we look at whether the marks MID AMERICA HEART INSTITUTE and AMERICAN HEART INSTITUTES are substantially

similar so that confusion is likely. Because the marks would be used, at least in part, on virtually identical services, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

Both marks include the same three core words, "America[n] Heart Institute[s]." Applicant uses the word "American" while the registrant uses the term "Mid America." While there are differences, we find that they are not sufficient to distinguish the marks when the marks are compared in their entirety. AMERICAN HEART INSTITUTES and MID AMERICA HEART INSTITUTE would look and sound similar and they would have similar commercial impressions. The differences between a plural and singular ending for the word "institute" and the presence of absence of the letter "n" in the word "America" would escape most people's attention, and they do not significantly affect the commercial impression, appearance or sound of the marks. Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 342 (CCPA 1957) ("There is no material difference in the

trademark sense between the singular and plural form of the word 'Zombie' and they will therefore be regarded as the same mark"). The terms "America" and "American" are virtually synonymous, one being the noun form and the other the adjective form of the same word. In re BankAmerica Corp., 231 USPQ 873, 875 (TTAB 1986) (BANK OF AMERICA primarily signifies an American bank).

The only significant difference in the marks is the applicant's deletion of the term "mid" in registrant's mark. We cannot find that the absence of the term "mid" changes the sight, sound, and commercial impression of applicant's mark so that there would be no likelihood of confusion with registrant's mark. The term "mid" can mean "middle" or "central." *Webster's II New Riverside University Dictionary* (1984).⁸ To the extent that "mid America" can refer to the central or middle part of the United States, it refers to an area that encompasses a large percentage of America. Both marks prominently feature the word "America[n]" and combine the word with the nearly identical words "Heart Institute[s]." Bank of America National Trust and Savings Association v. American National Bank of St. Joseph, 201 USPQ 842 (TTAB 1978)

⁸ We take judicial notice of this definition.

(AMERIBANC and design and AN AMERIBANC BANK so resembles BANK AMERICA and BANK OF AMERICA so as to be likely to cause confusion). Our determination is reinforced by the fact that the services are identical and that we must resolve any doubt about the likelihood of confusion in favor of the registrant. Shell Oil, 26 USPQ2d at 1691.

Applicant relies heavily on a list of federal and state trademark registrations to show that "marks that differ only slightly in that they identify different geographic areas are sufficiently different for the consumers of the services to distinguish one source from another." Applicant's Br. at 7-8 (emphasis added). The Examining Attorney has not objected to this list of federal and state⁹ trademark registrations and applications. Examining Attorney's Br. at 4 n.1. We certainly cannot disagree with applicant's basic proposition that there are significant differences between TEXAS HEART INSTITUTE and PHILADELPHIA HEART INSTITUTE. However, the list of registrations in applicant's briefs does not provide any support for the proposition that when virtually the same

⁹ The state registrations are not helpful in making a determination as to whether a mark is entitled to federal trademark registration. Kraft, Inc. v. Balin, 209 USPQ 877, 880 (TTAB 1981) ("Applicants have included in the stipulated facts its Nevada state registration, but this is incompetent to prove anything material to this proceeding").

geographic term is used with the phrase "heart institute[s]" the deletion of the word "mid" is enough to avoid confusion. Even if consumers would notice the difference, it is likely that they would assume that there was some association or relationship between these health care services. In response to applicant's argument that the cited registrations owned by two different parties co-exist, we do not have before us the records in those cases, and we note that applicant's mark and services are more closely related to each of these marks than the registrations are to each other.

III. Geographically Descriptive Refusal

The Board has set out the following test to use in determining whether a mark is primarily geographically descriptive:

[T]he Trademark Examining attorney would need to submit evidence to establish a public association of the goods with that place if, the place named in the mark may be so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied or (2) an admitted well-recognized term may have other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. Where, on the other hand, there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's goods come from the geographical place named in the mark.

In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849-50 (TTAB 1982).

The Examining Attorney submits that "American" is a geographic term and the addition of the generic or highly descriptive term "Heart Institutes" does not convert the mark into a non-geographically descriptive term. "The word AMERICA is obviously well known to the United States public as the name of a geographic location. The question is whether the primary significance of the term AMERICAN as used in applicant's mark would be this geographic location or whether the term would possess some other, at least equally significant connotation." In re Monograms America Inc., 51 USPQ2d 1317, 1319 (TTAB 1999) (MONOGRAMS AMERICA for consultation services for owners of monogramming shops simply signifies United States origin and/or geographical scope). See also BankAmerica, 231 USPQ at 875 ("BANK OF AMERICA primarily signifies an American Bank and that, with respect to computerized data processing services which admittedly emanate from this country, a public association of those services with the place named in applicant's mark (i.e. America) may be presumed"); American Diabetes Association v. National Diabetes Association, 533 F. Supp. 16, 214 USPQ 231, 233 (E.D. Pa. 1981) ("The term American

is geographically descriptive of the market within which the American Diabetes Association functions"); Finance Company of America v. BankAmerica Corp., 205 USPQ 1016 (TTAB 1979, amended 1980) (FINANCE COMPANY OF AMERICA held primarily geographically descriptive).

We agree with the Examining Attorney's conclusion that the geographically descriptive term AMERICAN remains a primarily geographic term when it is combined with the generic or highly descriptive term "HEART INSTITUTES." Monograms America, 51 USPQ2d at 1319 ("Moreover, the addition of highly descriptive matter to a geographic term does not detract from the mark's primary significance as being geographically descriptive"). The Examining Attorney has submitted evidence that shows that the term "heart institute" is a generic or highly descriptive term in the field of health care services.

The organization applied for state approval to expand Inova Fairfax Hospital by 177 beds, including a 156-bed tower which would house a world-class **heart institute**.

Washington Post, April 24, 2000, p. F57.

In 1998, LRMC opened a **heart institute**, and a major part of the expansion is related to plans to bring neurosurgery to the hospital.

Orlando Sentinel, April 1, 2000, p. 1.

Indeed, fund raising seems to have been Kaplan's hallmark in Columbus. Chapman recalls one story of Kaplan's tenacious work at Riverside to help secure a

\$7.5 million donation for a new \$15 million **heart institute**.

Nashville Business Journal, February 4, 2000, p. 3.

His group had hoped to use the cash from the sale to finance a **heart institute**, but complications with Methodist squashed those plans.

Modern Physician, February 1, 2000, p. 60.

The volunteer groups and the thrift store aim to raise another \$3 million by 2002 to create a cardiology endowment for the hospital's **heart institute**.

Los Angeles Times, December 27, 1999, p. B1.

Applicant argues that while the term "AMERICAN may be a geographical indicator, it is much more in the context of the Subject Mark." Applicant's Br. at 12. Applicant goes on to state:

The term AMERICAN in the context of the Subject Mark is used to convey the ideas associated with the term. The term AMERICAN does not mean "highest and best in the world," "state of the art" "modern and well-equipped" or highly trained." The term is used, however, because such ideas are associated with the term.

Id. (emphasis added).

While it is not entirely clear what applicant submits that the term "American" in its mark means, it is also clear that whatever ideas may be associated with applicant's use of the term "American," the meaning for a heart institute located in America would still be primarily geographically. Compare In re Midwest Nut & Seed Co., 214 USPQ 852 (TTAB 1982) (Board rejected applicant's argument that the term California was not geographically descriptive

because it signifies "a sunny pleasant climate") with In re
Jim Crockett Promotions Inc., 5 USPQ2d 1455 (TTAB 1987)
("GREAT AMERICAN BASH suggestive for promoting, producing
and presenting professional wrestling matches").

Here, we agree with the Examining Attorney that the
term AMERICAN HEART INSTITUTES is primarily geographically
descriptive.

Decision: The refusals to register applicant's mark
under Section 2(d) on the grounds that applicant's mark is
confusingly similar to the marks for AMERICAN HEART
ASSOCIATION and MID AMERICA HEART INSTITUTE are affirmed.
The refusal to register applicant's mark on the ground that
the mark is primarily geographically descriptive is also
affirmed.