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

Proceeding	76077292
Applicant	Scripps Health
Applied for Mark	SCRIPPS
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Submission	Appeal Brief
Attachments	SCRIPPS Design - Applicant's Brief (200x200).pdf (33 pages)(1783722 bytes)
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Date	07/10/2006

SERVICE MARK

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

Registrant: Scripps Health
Mark: **SCRIPPS & Design**
Serial Number: 76/077,292
Filed: June 26, 2000
Notice of Appeal Resumed: May 9, 2006
Applicant's Brief Due: July 8, 2006

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S BRIEF

I. INTRODUCTION

Applicant hereby appeals from the Examining Attorney's refusal to register the above-identified mark as was set forth in Final Office Action dated September 15, 2005, and respectfully requests that the Trademark Trial Appeal Board reverse the Examining Attorney's decision.

II. MARK SOUGHT TO BE REGISTERED

Applicant seeks registration on the Principal Register of its mark:



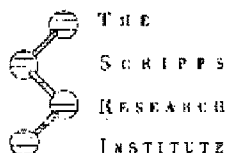
for Educational services, namely, conducting seminars, conferences and workshops in the field

of health care, in International Class 41; health care services in Class 42.

III. ISSUE

The Examining Attorney, in the Office Action dated September 15, 2005, made final refusal to register the present application on the basis that there is a likelihood of confusion between Applicant's mark and the following prior Registrations:

Registration No. 2,099,045 for the mark THE SCRIPPS RESEARCH INSTITUTE & Design



Registration No. 1,546,838 for the mark SCRIPPS IMMUNOLOGY REFERENCE LABORATORY.

The issue is whether there is a likelihood of confusion between Applicant's mark, SCRIPPS and Design and the two prior registrations, each owned by the same Registrant, The Scripps Research Institute of San Diego, California ("Registrant").

IV. BRIEF REVIEW OF RELEVANT HISTORY

Ellen Browning Scripps established applicant's parent organization, Scripps Memorial Hospital, in 1924. Throughout the subsequent 75 years, numerous entities and affiliates have been created by this parent not-for-profit organization, many of which incorporate the term "Scripps" into their trade names and trademarks. In 1977, the Research Institute of Scripps Clinic was established, which became a separate corporation under the Registrant's name in 1991. In 1993, the Applicant was established pursuant to a merger of various affiliates of the descendants of Scripps Memorial Hospital. See printout of relevant information from Applicant's website, accessible at www.scrippshealth.org, attached hereto as **Exhibit A**, and printout of relevant information from the website of Registrant, accessible at www.scripps.edu, attached hereto as **Exhibit B**.

The attached website pages of the parties demonstrate that the parties are clearly separate

entities, despite their common history, which came to a close in 1993. For at least 13 years, the parties have coexisted in the same city, without any challenge or dispute between them related to their respective marks. Applicant and Registrant have conducted their respective businesses and have resided in San Diego, California; the distinctly different nature of their services, as well as the distinctly separate channels of trade, has prevented the likelihood of consumer confusion for more than a decade.

V. APPLICABLE LAW - LIKELIHOOD OF CONFUSION

The standards for determining whether there is a likelihood of confusion are set forth in Application of E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). The following du Pont factors are relevant to the analysis of likelihood of confusion in this case:

1. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
2. The similarity or dissimilarity and nature of the services as described in an application or registration 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; and
5. The extent of potential confusion.

Although all of the above-referenced du Pont factors are relevant to the issue of likelihood of confusion, one factor can be so compelling that it alone can be dispositive of the issue of likelihood of confusion. Kellogg Co. v. Pack'em Enterprises, Inc., 21 USPQ2d 1142 (Fed. Cir. 1991).

A. Dissimilarity of the Marks

One important factor set forth by du Pont in determining likelihood of confusion is the similarity or dissimilarity of the marks in issue. "Similarity or dissimilarity" according to du Pont requires an analysis of the marks in their entirety, as to appearance, sound, connotation, and commercial impression. While it may be appropriate in some cases when determining the

question of likelihood of confusion to give greater weight to the important or “dominant” parts of a composite mark, “a disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks.” *See* T.M.E.P. 1213.10 (2002 rev.).

In this case, the additional descriptive and/or generic terms (“health,” “research institute” and “immunology reference laboratory”) added to each of the marks provide additional and valuable information to the consumer about the nature of the parties’ respective services. These terms should not be discarded when comparing the overall impressions of the marks.

Further, as shown in Exhibit A, the term “Scripps” is a family surname. Ellen Browning Scripps established Applicant’s parent organization, Scripps Memorial Hospital, in 1924. Surnames have been placed by the common law into that category of non-inherently distinctive terms that require proof of secondary meaning for protection. *See McCarthy on Trademarks*, Chapter 13, Personal Names as Marks (1997-2003). As a result, the term “Scripps” is not inherently distinctive, at not as strong and “dominant” as a trademark as the Examining Attorney concludes.

Viewed in their entireties, Applicant’s mark SCRIPPS & Design, when compared to the Registrant’s marks THE SCRIPPS RESEARCH INSTITUTE & Design and SCRIPPS IMMUNOLOGY REFERENCE LABORATORY, are clearly dissimilar in appearance, sound, and meaning. This factor alone weighs heavily against a finding of likelihood of confusion between the marks.

B. Dissimilarity of the Services

A significant factor set forth by du Pont in the likelihood of confusion analysis is the dissimilarity of services being provided in connection with the marks in question. Applicant has applied for SCRIPPS & Design in connection with “educational services, namely, conducting seminars, conferences and workshops in the field of health care,” in International Class 41, and “health care services,” in International Class 42. The Registrant’s marks cited in the Office Action have been registered for “scientific and medical research services,” in International Class

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