

ESTTA Tracking number: **ESTTA406704**

Filing date: **05/02/2011**

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

Proceeding	77813409
Applicant	Integrated Prescription Solutions, Inc.
Applied for Mark	INTEGRATED PRESCRIPTION SOLUTIONS
Correspondence Address	DOUGLAS Q HAHN ESQ STRADLING YOCCA CARLSON & RAUTH 660 NEWPORT CENTER DRIVE, SUITE 1600 NEWPORT BEACH, CA 92660-6458 UNITED STATES dhahn@sycr.com
Submission	Appeal Brief
Attachments	Appeal Brief re INTEGRATED PRESCRIPTION SOLUTIONS and Design.pdf (16 pages)(66480 bytes) Attachment A.pdf (10 pages)(1969329 bytes) Attachment B.pdf (3 pages)(616514 bytes) Attachment C.pdf (2 pages)(487243 bytes) Attachment D.pdf (2 pages)(1893727 bytes) Attachment E.pdf (5 pages)(2884348 bytes) Attachment F.pdf (10 pages)(1571158 bytes)
Filer's Name	Douglas Q. Hahn
Filer's e-mail	dhahn@sycr.com, jmellema@sycr.com
Signature	/Douglas Q. Hahn/
Date	05/02/2011

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

In re Application of
Integrated Prescription Solutions, Inc.

Application Serial No. 77/813409
Filed: August 26, 2009
For: INTEGRATED
PRESCRIPTION SOLUTIONS

Trademark Attorney: Carol Spils

Trademark Law Office: 104

BOX TTAB/NO FEE
COMMISSIONER FOR TRADEMARKS
P.O. Box 1451
ALEXANDRIA, VA 22313-1451

BRIEF FOR APPLICANT

I. INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on January 3, 2011 and denial of the Request for Reexamination on March 1, 2011, Applicant hereby appeals from the Examining Attorney's final refusal to register Applicant's INTEGRATED PRESCRIPTION SOLUTIONS & Design mark, dated July 2, 2010, and respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney's decision on the ground that the Applicant's mark does not create a likelihood of confusion with the marks cited by the Examining Attorney and is not "merely descriptive."

II. STATEMENT OF FACTS

Applicant seeks registration on the Principal Register of its INTEGRATED PRESCRIPTION SOLUTIONS & Design mark for "arranging of managed care contractual services in the fields of pharmacy benefit management, durable medical equipment, home health equipment, home therapy services, translation and transportation services" in International Class No. 35, and "administration of pre-paid healthcare plans; administration of preferred provider plans in the field of healthcare insurance; claims administration services in the fields of workers'

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compensation and automobile personal injury protection coverage; providing information in the field of workers' compensation and automobile personal injury protection coverage" in International Class No. 36. The trademark application was filed on August 26, 2009, and received U.S. Trademark Application Serial No. 77/813,409.

The Examining Attorney refused registration of Appellant's INTEGRATED PRESCRIPTION SOLUTIONS & Design mark in an Office Action, dated December 9, 2009, contending (1) that the applied-for mark so resembles various registered marks (the "cited marks") that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of Applicant and the registrants, and (2) that the applied-for mark describes features of Applicant's services. Specifically, the cited marks are:

PRESCRIPTIONSOLUTIONS (word mark) - Registration No. 3,709,895
(hereinafter '895);
PRESCRIPTION SOLUTIONS (word mark) - Registration No. 3,543,198 ('198);
RX PRESCRIPTION SOLUTIONS & Design – Registration No. 2,832,357
(‘357);
PRESCRIPTION SOLUTIONS (word mark) – Registration No. 1,917,044 ('044);
PRESCRIPTION SOLUTIONS (word mark) – Registration No. 1,888,829 ('829).

In Applicant's response to the initial refusal to register, filed on June 9, 2010, Applicant argued that the INTEGRATED PRESCRIPTION SOLUTIONS & Design word mark is substantially different from the cited marks, in that the term "integrated" added to "prescription solutions" significantly distinguishes Applicant's mark from the cited marks, the terms "prescription" and "solutions" are diluted, and the services and channels of trade are dissimilar as between Applicant's mark and the cited marks, so that there would not be a likelihood of confusion between the marks. Applicant further argued that Applicant's mark is suggestive, not merely descriptive, as it requires a consumer to make an imaginative leap from the mark to the services for which the mark is used.

The Examining Attorney expounded her position in a Final Office Action, dated July 2, 2010, maintaining that the applied-for mark so resembles various registered marks (*see* June 9, 2010 Final Office Action, identifying the "cited marks") that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the

Applicant and the registrants, and that Applicant's mark merely describes a feature of Applicant's services. The Examining Attorney supported her refusal by citing to registered marks and Internet evidence showing third-party use of the terms "prescription solutions" and "integrated prescription."

In response thereto, Applicant requested reconsideration of the Examining Attorney's final refusal on January 3, 2011, further arguing that the marks are distinguishable, the services are only tangentially related and the purchasers are sophisticated. Applicant also argued that the phrase "prescription solutions" should be afforded less weight in the *DuPont* analysis because it has been diluted through pervasive use in the healthcare industry. Finally, Applicant argued that Applicant's mark is suggestive, not merely descriptive, as it requires a consumer to make an imaginative leap from the mark to the services for which the mark is used. Applicant concurrently filed a Notice of Appeal on January 3, 2011.

The Examining Attorney denied Applicant's request for reconsideration on March 1, 2011, maintaining her earlier rejections on the same bases.

On March 1, 2011, the Trademark Trial and Appeal Board ("TTAB") mailed a letter resuming the appeal and allowing Applicant sixty days from the mailing date in which to file its Appeal Brief. Accordingly, Applicant hereby files its Appeal Brief in compliance with the TTAB's letter of March 1, 2011.

III. ARGUMENT

A. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The ultimate question for determining the issue of likelihood of confusion is "whether the marks will confuse [relevant consumers] into believing that the goods [or services] they identify come from the same source." *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 U.S.P.Q. 558 (C.C.P.A. 1972).

1. EACH OF THE DUPONT FACTORS SUPPORT A FINDING OF NO CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARKS

The test to determine whether there is a likelihood of confusion is set forth in *In re E.I. DuPont de Nemours & Co.*, 476, F.2d 1367 (C.C.P.A. 1973). Out of the several factors in the so-called *DuPont* test, (1) the similarity of the marks, (2) the similarity of the goods and/or

services and (3) the similarity of trade channels of the goods and/or services are the most important factors to consider. See *In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812 (T.T.A.B. 2001); T.M.E.P. §§ 1207.01 *et seq.* Here, the cited marks are distinguishable, the services only tangentially related and the purchasers are sophisticated. In addition, the “prescription solutions” portion of Applicant’s mark in common with the cited PRESCRIPTION SOLUTIONS mark should be afforded less weight in the *DuPont* analysis because it has been diluted through pervasive use in the healthcare industry. Applicant addresses these points in greater detail below.

a. The Integrated Prescription Solutions Mark Is Significantly Different From The Cited Marks As To Sight, Sound And Connotation

The first step of the *DuPont* analysis favors Applicant because the marks are distinguishable. Applicant’s mark greatly differs from the cited registered marks. Here, the differences between the cited marks and applicant’s marks are more than enough to prevent consumer confusion. In making a comparison between marks, the Restatement of Torts § 729 notes that the marks are to be compared in sound, sight and meaning. However, even similarity as to one aspect of the sound, sight and meaning trilogy does not automatically result in a finding of a likelihood confusion. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, n.4 (TTAB 1987).

First, Applicant’s mark does not sound like PRESCRIPTIONSOLUTIONS, RX PRESCRIPTION SOLUTIONS or PRESCRIPTION SOLUTIONS. Applicant’s mark consists of three words and a design element. On the other hand, the mark in the ’895 registration consists of one word, the marks in the ’198, ’044 and ’829 registrations consist of two words, and lastly, the mark in the ’357 registration consist of three words.

Second, the word portion of the marks obviously differ phonetically. The word portion of Applicant’s mark consists of ten (10) syllables, whereas the cited marks ranges from six to eight syllables. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1145 (9th Cir. 2002) (where both marks were used in connection with publications directed to small businesses and their owners, the Court pointed out that the defendant’s mark contained “an entire four-syllable word” that plaintiff’s mark did not and the additional word “makes the mark ‘Entrepreneur Illustrated’ almost twice as long—to the eye and the ear—as the mark ‘Entrepreneur,’” calling these “noticeable” differences).

Third, the mark INTEGRATED PRESCRIPTION SOLUTIONS & Design differs in

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