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

Proceeding	78796171
Applicant	U.S. Preventive Medicine, Inc.
Applied for Mark	THE PREVENTION CHANNEL
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Ex Parte Appeal of Application No. 78/796171

Filed: January 20, 2006

Mark: THE PREVENTION CHANNEL

Applicant: U.S. Preventive Medicine, Inc.

Notice of Appeal Filed: June 29, 2007

APPEAL BRIEF

Applicant appeals the Examining Attorney's refusal to register the present mark under Section 2(d) of the Trademark Act.

In the final Office Action dated January 1, 2007 in the present application, the Examining Attorney has maintained refusal to register the present mark under Section 2(d) based upon a perceived likelihood of confusion between the mark in the present application and the mark in U.S. Registration No. 2,643,325 (the '325 registration).

The present mark is THE PREVENTION CHANNEL and the mark in the '325 registration is PREVENTION.

The Examining Attorney follows a two-part analysis in determining whether there is a likelihood of confusion. In the first part, the Examining Attorney has compared the marks for similarity in appearance, sound, connotation and commercial impression. Notably, the Examining Attorney concludes that the marks are similar in *all four* of these areas by the simple fact that both marks include the term PREVENTION (see Final Office Action dated January 1, 2007, last sentence of first paragraph under heading "COMPARISON OF THE MARKS").

Applicant respectfully submits that the Examining Attorney reaches an erroneous conclusion by suggesting that the marks have the same appearance, sound, meaning and connotation merely because of a shared term. Such a conclusion is in direct contrast to the body of case law suggesting otherwise. The mere fact that marks share a term in common is not dispositive of the issue of likelihood of confusion. *See Clairol, Inc. v. Cosmair, Inc.*, 224 USPQ 229, 232 (SDNY 1984).

In considering the elements cited by the Examining Attorney individually, the mark in the '325 registration includes a single word term having three syllables – PREVENTION. The Applicant's Mark is a three-word term having six syllables. Thus, the marks have a different overall appearance and sound, even though they share a common term.

Additionally, the marks have a different meaning. The mark in the '325 registration is a noun. The term PREVENTION in Applicant's Mark is an adjective modifying the noun CHANNEL. Attached as Exhibit 1 are dictionary definitions for these terms. The noun PREVENTION refers to the act of preventing; a hindrance; obstacle. The term CHANNEL refers to a route of communication. Thus, the connotation of the mark in the '325 registration is that of an obstacle or hindrance. The connotation of the Applicant's mark is more of a communication or access route.

The '325 registration does not entitle its owner with a monopoly on the term PREVENTION. As discussed in Applicant's earlier response dated December 20, 2006, the U.S. Trademark Office has registered other marks that include the term PREVENTION, even in connection with medical and/or health information and related products and services. In the Final Office Action dated January 1, 2007, the Examining Attorney refused to consider Applicant's arguments concerning third party U.S. registrations for marks containing the term PREVENTION. The Examining Attorney indicated that Applicant had not properly submitted the evidence for consideration. So that this issue may be fully considered, Applicant hereby submits printouts of the electronic equivalents of the following registrations taken from the electronic search records of the U.S. Patent and Trademark Office:

U.S. Registration No. 1,925,401 for PREVENTION TAKES FLIGHT in connection with printed materials and educational services in the field of health and prevention;

U.S. Registration No. 2,335,568 for PREVENTION PLUS in connection with medical testing and screening services;

U.S. Registration No. 3,061,802 for PREVENTION AND A CURE IN OUR LIFETIME in connection with fundraising services for breast cancer research;

U.S. Registration No. 2,687,934 for PREVENTION WORKS in connection with educational services in the field of personal injury reduction;

U.S. Registration No. 2,871,812 for STROKE PREVENTION PLUS in connection with providing health care information and providing educational services in the fields of health care and prevention;

U.S. Registration No. 3,116,080 for AN OUNCE OF PREVENTION PM in connection with anti-aging cream;

U.S. Registration No. 3,119,931 for FALL PREVENTION CLINICS OF AMERICA in connection with medical diagnostic and rehabilitation services; and

U.S. Registration No. 2,384,744 for FOCUSED ON PREVENTION in connection with educational services in the field of oral hygiene and preventive oral health.


Such evidence is proper according to Trademark Manual of Examining Procedure §§ 710.03 and 1207.01(d)(iii). Applicant offers the evidence of these registrations to show that the term PREVENTION as a portion of Applicant's mark is so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 177 U.S.P.Q. 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541, 544 (TTAB 1983). *See also, Gruner + Jahr USA Publishing v. Meredith Corp.*, 26 U.S.P.Q.2d 1583 (2d Cir. 1993) (holding no confusion between PARENTS and PARENT'S DIGEST in connection with publications).

Contrary to the Examining Attorney's assertions, the Applicant's Mark and the mark in the '325 registration are not virtually identical, and are certainly no more identical than any of the above identified marks. Thus, Applicant submits that the Examining Attorney's conclusions regarding the first part of the likelihood of confusion test are in error.

As to the second part of the analysis concerning the similarity of Applicant's services with those in the '325 registration, Applicant again submits that Applicant's services are no more similar to those in the '325 registration than are the goods/services in the majority of the above cited registrations. The above cited registrations were all issued in connection with medical and/or health information and related products and services without apparent challenge or incident.

As indicated by the many registrations above, the field of marks including the term PREVENTION is crowded, particularly in connection with health care and medical related products and services. For these reasons, Applicant respectfully requests that the refusal to register the present mark be withdrawn.

Respectfully submitted,
U.S. Preventive Medicine, Inc.
By Counsel



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Filed: August 28, 2007

Attached: Exhibit 1 – copies of dictionary definitions
Exhibit 2 – copies of cited U.S. Registrations

Exhibit 1

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