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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merem Capital, LLC

Serial No. 87817950

Michael S. Denniston of Bradley Arant Boult Cummings LLP,
for Merem Capital, LLC.

Odette Martins, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Shaw, Larkin, and Dunn,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Merem Capital, LLC ("Applicant") seeks registration on the Principal Register of the mark shown below (URGENT CARE disclaimed)

for services ultimately identified as "Medical services, namely, providing non-surgical treatment of acute muscle, tendon, bone, joint and soft tissue injuries requiring

immediate care on an outpatient basis from a walk-in clinic," in International Class 44.[1]

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the two registered marks show below, which are owned by different entities:

for a "Comprehensive group of services in the field of orthopedics, namely, providing post-operative rehabilitation services to patients and medical practitioners; providing information to medical practitioners in the field of prescribing orthopedic products to patients; rental of orthopedic products," in International Class 44,[2] and

[1] Application Serial No. 87817950 was filed on March 2, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce. Applicant describes its mark as consisting of "the design of a plus sign comprised of a horizontal and vertical rectangle. The middle of the vertical rectangle has two horizontal line spaces, one above and one below where it bisects the horizontal rectangle. Inside of the horizontal rectangle is a horizontal line. To the right of the design is the word 'ORTHOEXPRESS' above the words 'URGENT CARE.'" Color is not claimed as a feature of the mark.

[2] The cited Registration No. 3339532 issued on November 20, 2007 and has been renewed. The registrant describes its mark as consisting of "the letter 'R' in the word 'Ortho' and the letter 'X' in the word 'Xpress' [which] are red. All other letters are black. There are red and black swirls above the words 'Ortho" and 'Xpress'." The colors red and black are claimed as a feature of the mark and the registrant has disclaimed the exclusive right to the representation of the prescription symbol. The registration also covers services in Class 35 that are not discussed by the Examining Attorney.

(ORTHO and BONE & JOINT CENTER disclaimed) for "Orthopaedic surgery services," in International Class 44,[3] as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed.[4] We affirm the refusal to register.

I. Record on Appeal[5]

The record on appeal includes the following:

- USPTO electronic records regarding the cited registrations, made of record by the Examining Attorney;[6]

[3] The cited Registration No. 5511950 issued on July 10, 2018. The registrant describes its mark as consisting of "'ORTHO' (in powder blue), 'Xpress' (in red), and 'BONE & JOINT CENTER' (in black)." The colors powder blue, red, and black are claimed as features of the mark.

[4] Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

[5] Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

[6] June 21, 2018 Office Action at TSDR 2-4; February 19, 2019 Office Action at TSDR 2-7. The cited Registration No. 5511950 issued during prosecution of the application.

- A dictionary definition of the term "urgent care," and webpages regarding the meaning of the term, made of record by the Examining Attorney;[7]
- Webpages listing "rehabilitation services" as a subset of "medical services," made of record by the Examining Attorney;[8]
- Webpages offered to show that walk-in medical clinics offer rehabilitation services and/or orthopedic surgery services under the same mark, made of record by the Examining Attorney;[9]
- USPTO electronic records regarding third-party registrations offered to show that medical services, rehabilitation services, and orthopedic surgery services are offered under the same mark, made of record by the Examining Attorney;[10] and
- The declaration of Matthew Lemak ("Lemak Decl."), Managing Member of Applicant, and webpages of entities using marks containing the word ORTHOEXPRESS or a phonetic equivalent, or similar wording, for orthopedic urgent care walk-in clinics, made of record by Applicant.[11]

[7] June 21, 2018 Office Action at TSDR 10-13.

[8] *Id.* at TSDR 7-9.

[9] February 19, 2019 Office Action at TSDR 8-38; October 7, 2019 Final Office Action at TSDR 2-56; May 5, 2020 Denial of Request for Reconsideration at TSDR 2-35.

[10] October 7, 2019 Final Office Action at TSDR 57-81.

[11] April 7, 2020 Request for Reconsideration at TSDR 10-37. We will cite the Lemak Declaration by paragraph and exhibit number (e.g., "Lemak Decl. ¶ 9").

II. Analysis of Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.,* 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the "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). Applicant discusses these two key factors, 10 TTABVUE 11-16, 22-26; 13 TTABVUE 7-11, as well as record evidence bearing on the sixth *DuPont* factor, the "number and nature of similar marks in use on similar [services]." *DuPont*, 177 USPQ at 567. 10 TTABVUE 16-22; 13 TTABVUE 4-7. Applicant also notes Mr. Lemak's testimony regarding the absence of instances of actual confusion between the involved marks, 10 TTABVUE 9, which implicates the eighth *DuPont* factor, the

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