

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Res-Care, Inc.

SERIAL NO.: 88/124,840

MARK: GATEWAY (word mark)

OFFICE ACTION MAILING DATE: 12/31/2018

RESPONSE

I. Amended Identification of Services

Applicant amends its identification of services to “Behavioral health services in the nature of behavioral therapy services for children with autism spectrum disorders and related developmental disabilities.”

II. No Likelihood of Confusion

As noted in the Office Action, a likelihood of confusion analysis considers various factors including: (i) “[t]he similarity or dissimilarity of the marks”; (ii) “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration”; and (iii) “[t]he conditions under which and buyers to whom sales are made, *i.e.*, ‘impulse’ vs. careful, sophisticated purchasing.” *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Any one of these factors may play a dominant role in the likelihood of confusion analysis. *Id.* at 1362. Here, the dominant factors of the dissimilarities of the services together with sophisticated purchasers weigh against any likelihood of confusion.

A. Applicant’s and Registrant’s Services are Dissimilar

“The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration.” TMEP §1207.01(a)(iii). The Office Action incorrectly claims Registrant’s identification of services uses “broad wording” such that it is presumed to encompass Applicant’s more narrow identification of services.

To the contrary, the cited registrations also contain narrow identifications for services that are dissimilar from Applicant’s services. Registrant’s “managed health care services for members” is a specialized service that is substantially distinct from and non-competing with Applicant’s provision of specialized therapies directed to a particular subset of patients.



It is relevant and not taken into consideration by the Examining Attorney that the wording in Registrant’s identification of services has a specific and specialized meaning in the relevant field.

In cases where the terminology in an identification is unclear or undefined, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 & n.10 (TTAB 2009) (noting that, although extrinsic evidence may not be used to limit or restrict the identified goods, it is nonetheless proper to consider extrinsic evidence in the nature of dictionary entries to define the terminology used to describe the goods); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (noting that, "when the description of goods for a cited registration is somewhat unclear . . . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.")

TMEP §1207.01(a)(iii). Applicant offers the following extrinsic evidence in support of its arguments.

Registrant's "managed health care services for members" specifically refers to a type of health insurance service. See Exhibit A, "Managed Care," MedlinePlus, *available at* <https://medlineplus.gov/managedcare.html> (last visited Feb. 27, 2019) ("Managed care plans are a type of health insurance."); National Center for Biotechnology Information, U.S. National Library of Medicine, "Managed Care Programs," *available at* <https://www.ncbi.nlm.nih.gov/mesh/68008329> (last visited Feb. 27, 2019). This meaning is corroborated by Registrant's own marketing materials, including its specimens of use submitted in connection with the registrations which state: "Named One of America's Best Health Insurance Plans." See Exhibit B, Specimen of Use for U.S. Reg. No. 4,517,134 for GATEWAY HEALTH. Further, Registrant stated during prosecution of its mark that "the word 'plan' is **generic** for [Registrant's] services." See Exhibit C, Dec. 2, 2013 Response to Office Action for U.S. Reg. No. 4,517,134 ("Managed care plans are a type of health insurance.") (quoting U.S. National Library of Medicine at the National Institutes of Health).

These materials demonstrate the narrow category of services offered by Registrant, namely, providing managed health care insurance plans to a set of enrolled members. These services are dissimilar from Applicant's "behavioral health services in the nature of behavioral therapy services for children with autism spectrum disorders and related developmental disabilities" which are clinical services offered to a specialized subset of patients on an out-patient basis. Contrary to the assumption made in the Office Action that these two sets of services are "legally identical," the Trademark Office has recognized no such *per se* similarity between managed health care plans offered through subscription and direct health services provided to patients. For example, the following U.S. trademark registrations exist together on the Principal Register with no likelihood of consumer confusion. (Copies attached as Exhibit D.)

U.S. Reg. No.	Mark	Services
4,585,562	SUNSHINE HEALTH (with "HEALTH" disclaimed)	IC 044: Managed health care services
5,106,001	SUNSHINE CENTER (with "CENTER" disclaimed)	IC 044: Providing facilities for therapeutic services for children with developmental delays or autism and their families in the fields of behavioral health, occupational therapy services, and speech and language therapy services.
3,161,043	<i>LifeCare</i>	IC 044: Managed health care services
5,662,831	LIFECARE CONNECT	IC 044: Home health care services
4,281,784	 Valley Health Plan (with "HEALTH PLAN" disclaimed)	IC 044: Providing comprehensive health care services in the nature of a health maintenance organization; managed health care services.
4,742,107	VALLEY	IC 044: Mental health services.
5,008,501	BUCKEYE HEALTH PLAN (with "HEALTH PLAN" disclaimed)	IC 044: Managed health care services.
3,931,963	BUCKEYE ORAL AND MAXILLOFACIAL SURGERY (with "ORAL AND MAXILLOFACIAL SURGERY" disclaimed)	IC 044: Oral and maxillofacial surgical services, specializing in surgery to the hard and soft tissues of the mouth and face.
4,944,510	MAGNOLIA HEALTH (with "HEALTH" disclaimed)	IC 044: Managed health care services.
5,140,961	MAGNOLIA MEDSPA (with "MEDSPA" disclaimed)	IC 044: Medical spa services, namely, minimal and non-invasive cosmetic and body fitness therapies
88/066,864 (published for opposition on Jan. 29, 2019)	 MAGNOLIA RECOVERY CENTER (with "RECOVERY CENTER" disclaimed)	IC 044: Mental health services; behavioral health services; addiction treatment services; chemical dependency and substance abuse treatment services; Mental health services and behavioral health services, namely, detoxification and treatment for alcohol and drug dependency and related behavioral health conditions.

Moreover, contrary to the assertions in the Office Action, the respective services of both Registrant and Applicant do have restrictions as to classes of purchasers. Registrant's services are limited to its "members," whereas Applicant's services are provided specifically to "children."

Applicant is not a healthcare insurance provider and does not sell or provide insurance plans. Registrant offers only “managed health care services for members” – a health plan only for members enrolled in their program. Registrant does not provide any direct medical or health care services, let alone Applicant’s direct health care services, namely, behavioral therapy directed not only to children, but only to those children with autism spectrum disorders and related developmental disabilities. Providing managed health care services is a specialized service that is substantially distinct and dissimilar from providing specialized therapies directly to a particular subset of patients.

B. Sophisticated Purchasing Conditions Weigh Against Any Likelihood of Confusion Between the Marks

The dissimilar services are particularly significant when considered in connection with the relative sophistication of the purchasers. Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law* §4.8 (2d ed. 2014); *see also Astra Pharm. Prod. v. Beckman Instruments*, 718 F.2d 1201, 1206 (1st Cir. 1983) (“[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.”); TMEP §1207.01(d)(vii) (“[C]ircumstances suggesting care in purchasing may tend to minimize the likelihood of confusion.”).

The conditions under which sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing, favor registration of Applicant’s mark. Neither health insurance nor behavioral therapy services for children are impulse purchases. Insurance consumers typically research their options to make informed decisions before enrolling in a health insurance policy. Consumers of Applicant’s services are parents of minors with special needs. Treatment requires parental consent and involvement on an ongoing basis. Treatment itself typically involves family involvement and requires consideration and coordination of absence from school and other activities. Guardians of minors, particularly those who may require specialized services due to developmental delays, carefully consider treatment options in connection with behavioral therapy services for children. The cost and importance of outcomes associated with selecting either an insurance policy or behavioral therapy services for children mandate careful, sophisticated purchasing, and confusion between the two under these conditions is highly unlikely. Therefore, this factor strongly favors registration of Applicant’s GATEWAY mark.

C. Conclusion

For all of the foregoing reasons, there is no likelihood of confusion between Applicant’s mark GATEWAY for “behavioral health services in the nature of behavioral therapy services for children with autism spectrum disorders and related developmental disabilities,” and the registered marks GATEWAY HEALTH for “providing managed health care services for members.” Accordingly, Applicant requests the registration refusal based on U.S. Registration Nos. 4,517,134 and 4,749,114 be withdrawn and Applicant’s mark be permitted to move to publication.