

Mark: FROM HOSPITAL TO HOME
Ser. No.: 88/438,214
Applicant: Paratek Pharmaceuticals, Inc.

RESPONSE TO OFFICE ACTION

Applicant Paratek Pharmaceuticals, Inc. (“Paratek”) respectfully requests that the Examining Attorney withdraw the provisional refusal for FROM HOSPITAL TO HOME, App. No. 88/438,214, and approve the mark for publication. The Examining Attorney has provisionally refused registration of Paratek’s mark for use in connection with the Class 44 services of:

“Providing information in the fields of health, medicine, and pharmaceuticals for the treatment of infectious diseases; Medical information services, namely, providing information to physicians, healthcare professionals and patients on the topics of health issues, pharmaceutical products and health awareness in the field of infectious diseases,”

based on an alleged likelihood of confusion with THE SHORTEST PATHWAY FROM HOSPITAL TO HOME (Reg. No. 4,237,557), TRANSITIONING KIDS FROM HOSPITAL TO HOME (Reg. No. 4, 668,935), and YOUR BRIDGE FROM HOSPITAL TO HOME (Reg. No. 4,859,331). Paratek, however, respectfully submits that, when each cited mark is examined in its entirety, each mark carries specific elements that make it distinguishable from Paratek’s Mark. In addition, the likelihood of confusion is further mitigated because there is no actual overlap between the services being provided in connection with each mark. Finally, the fact that the three cited marks all co-exist with each other for identical and overlapping healthcare services indicates that they are weak marks that are only entitled to a narrow scope of protection, which is further evidence that Paratek’s Mark is not likely to cause confusion in the marketplace. Indeed,

if the cited marks can co-exist with each other for identical services, they can co-exist with Paratek's FROM HOSPITAL TO HOME mark.

I. THERE IS NO LIKELIHOOD OF CONFUSION

Paratek's FROM HOSPITAL TO HOME mark and the cited marks are sufficiently different in appearance, sound, meaning and overall commercial impression to differentiate Paratek's services of providing information on infectious diseases from the distinguishable healthcare related services specified in the cited marks. As a result, confusion between Paratek's Mark and the cited marks is not likely.

A. Paratek's Mark Is Not Likely To Be Confused With The Cited Marks Because The Overall Commercial Impression Is Different

The degree of similarity between conflicting marks is analyzed by a comparison of "the overall impression created by the designations; pronunciation; . . . suggestions, connotations or meanings of the designations." McCarthy, John A., 4 McCarthy on Trademarks and Unfair Competition ("McCarthy"), §23:21 (4th ed. 2017), citing Restatement (Third) of Unfair Competition § 21 (a) 1995. Where, as here, the marks are comprised of different words and have different overall appearances, sounds, meanings, and commercial impressions, consumer confusion is highly unlikely.

i. The Cited Marks Are Unitary And Must Be Considered As A Whole

As a preliminary matter, the cited marks are unitary and must be examined as they will be seen and interpreted by a consumer. Thus, consumers will not be analyzing each mark based on any shared similarities, but instead on the overall appearance, sound, meaning, or commercial impression of each mark. Without any punctuation or stylization that would represent a conceptual or verbal break, consumers will encounter each mark as a single designation, thought, or impression. A mark may be unitary where "the words which have been put together function

as a unit, each part relating to the other parts and not directly to the goods.” *In Re Kraft, Inc.*, 218 U.S.P.Q. 571, 572-73 (TTAB Mar. 28, 1983). Thus, the entirety of each cited mark creates a meaning and commercial impression that is separate and apart from any otherwise descriptive property of any element of the mark. *In Re Zico Beverage LLC*, App. No. 85284093, 2013 WL 3129906, at *3 (TTAB May 9, 2013) (descriptiveness of mark depends on whether combination of terms “evokes a new and unique commercial impression.”); *see also P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1919) (“the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”).

ii. Paratek’s Mark And The Cited Marks Have Distinguishable Commercial Impressions Based Upon Their Inclusion Of Different Additional Words

When each mark is properly considered as a unitary whole, Paratek’s Mark makes such a distinct commercial impression that confusion is unlikely. In particular, the beginning phrases of “THE SHORTEST PATHWAY,” “TRANSITIONING KIDS,” and “YOUR BRIDGE” not only make the entirety of the cited marks longer in appearance and different in pronunciation, but each beginning phrase also creates a different consumer impression and a distinct conceptual understanding.

For example, the cited mark TRANSITIONING KIDS FROM HOSPITAL TO HOME is not only visually and phonetically distinct, the strong focus on child transitions shapes the commercial impression created by the mark, which consumers will immediately understand. Likewise, YOUR BRIDGE FROM HOSPITAL TO HOME conveys a geographic transition to consumers, clearly indicating that the services provided under the mark will enable the consumer to physically move from the hospital to his or her home. Lastly, THE SHORTEST PATHWAY FROM HOSPITAL TO HOME provides the consumer with imagery indicating that the services

provided, namely the provision of nursing services, will allow the consumer to move from a hospital to his or her home. This is different from the meaning of Paratek's Mark, which, in the context of its services of providing information on infectious diseases, suggests a linkage of hospital and home to address the problem.

The fact that the cited marks each encompass the words FROM HOSPITAL TO HOME is not dispositive, as mark similarity is based on the total effect of the marks, rather than a comparison of individual features. *See In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (holding that the marks VARGA GIRL and VARGAS were not confusingly similar when viewed in their entirety); *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 203 (Fed. Cir. 1992) (finding no likelihood of confusion between OLD TIME and YE OLDE TYME despite phonetic similarity).

Viewing the cited marks in their entirety is especially important when the marks in question are unitary slogans, which consumers are unlikely to parse into their individual elements for comparison to Paratek's Mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“marks must be viewed ‘in their entireties, and it is improper to dissect a mark when engaging in this analysis’”); *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1341 (Fed. Cir. 2015) (ordering TTAB to consider PEACE LOVE AND JUICE in its entirety in likelihood of confusion analysis because there was no “consideration of how the three-word phrase in Juice Generation's mark may convey a distinct meaning—including by having different connotations in consumers' minds—from the two-word phrase used by GS.”); TMEP § 1305(b) (identifying slogans as unitary marks). Here, the overall appearances and sounds of the marks are dissimilar because not only do each of the cited marks include at least two

additional terms, these additional terms are also the first words in the mark which have the strongest impact on forming the commercial impression created by the mark.

In any event, even were the cited marks considered for their constituent parts, the beginning phrases of “THE SHORTEST PATHWAY,” “YOUR BRIDGE,” or “TRANSITIONING KIDS” would be considered the respective dominant portions of the cited marks. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1351 (Fed. Cir. 2011) (finding that the first word of the mark was the dominant element, as it gave a distinct look and impression from the cited marks). Indeed, if each of the cited marks can co-exist with each other for overlapping services related to the provision of healthcare, they can likewise co-exist with Paratek’s FROM HOSPITAL TO HOME mark, which includes none of these dominant portions.

B. The Services Associated With Paratek’s Mark Are Different From The Services Covered By The Cited Marks

Given the significant differences in sound, appearance, and commercial impression, Paratek’s and Registrants’ services are sufficiently distinct to avoid a likelihood of confusion in the marketplace. *See Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (affirming Board’s finding that the marks and the associated goods were sufficiently different to avoid a finding of likely confusion). The three Registrants’ services are all directed to the *provision* of healthcare services, namely “nursing services” (Reg. No. 4,237,657), medical services and therapeutic services (Reg. No. 4,668,935), and health care and skilled nursing services (Reg. No. 4,859,331). Paratek’s services, in contrast, do not encompass the provision of healthcare, but rather are limited to providing information in the field of the treatment of infectious diseases.

Paratek’s services are not sufficiently related to the services covered by the cited marks for confusion to be likely or possible. Consumers using the services of the cited marks are

seeking the provision of services by a third party, such as nursing services or therapeutic services. Thus, these consumers will be actively seeking a specialized service, *i.e.* nursing services or physical therapy, and are therefore extremely unlikely to be at risk of purchasing a good or service that falls outside the scope of their needs. In addition, because Paratek's Mark is not being used in connection with the *provision* of medical services, consumers would quickly be aware of the differences in services and react accordingly. Based upon the practical and recognizable differences in the services and the significant differences in overall commercial impressions of the marks, confusion is unlikely. Thus, Paratek respectfully requests that the Examining Attorney withdraw the refusal based on Reg. Nos. 4,237,657, 4,668,935, and 4,859,331.

II. The Cited Marks Are Weak For The Specified Goods And Services

The commonalities between the marks — namely, the words FROM HOSPITAL TO HOME — are weak for the Cited Marks' specified Class 44 nursing and therapy services, and thus the cited marks are only entitled to a narrow scope of protection. "It is well settled that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term." *Bass Pro Trademarks, L.L.C. v. Sportsmans Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, at *14 (TTAB 2008); TMEP § 1207.01(b)(viii) ("If the common element of two marks is 'weak' in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality."); *see also, Citigroup Inc.*, 637 F.3d at 1356 (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK

marks for banking and financial services, is not likely to cause confusion, based, in part, on findings that the phrase “City Bank” is frequently used in the banking industry and that “CAPITAL” is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks). Indeed, Reg. No. 4,668,935 is on the Supplemental Register, which is a clear indication that it is a weak mark. The remaining two cited marks, THE SHORTEST PATHWAY FROM HOSPITAL TO HOME and YOUR BRIDGE FROM HOSPITAL TO HOME, coexist despite the close conceptual similarity between “the shortest pathway” and a “bridge” (which is typically built to be the shortest pathway), which evidences just how narrow each of these marks are.

Paratek’s Mark does not incorporate the dominant features of the cited marks, nor does it invoke the commercial impressions of the cited marks. There is no evidence that consumers will believe that Paratek’s Mark is merely an abbreviated version of any of the cited marks. Because both the applied for and cited marks create different commercial impressions and have distinctive phonetic, visual, and conceptual differences that set them apart from one another, consumers are not likely to infer a connection or affiliation from the mere fact that Paratek is offering medical information under the mark FROM HOSPITAL TO HOME.

III. Conclusion

For the foregoing reasons, Paratek respectfully submits that the present application for FROM HOSPITAL TO HOME is not likely to cause confusion with the cited marks and thus respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal and approve the mark for publication.

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Paratek Pharmaceuticals, Inc.

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