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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Clinical Research Management, Inc.

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Serial Nos. 85264433, 85264461 and 85264478

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John D. Gugliotta of Patent, Copyright & Trademark Law Group for Clinical Research Management, Inc.

Jeri Fickes, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Quinn, Adlin and Masiello,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Clinical Research Management, Inc. filed, on March 11, 2011, applications to register the following marks (respectively, serial nos. 85264433, 85264461 and 85264478):

The word "CLINICAL" is disclaimed. The application includes the following statements:

> The mark consists of the stylized wording "CLINICAL RM" in blue, with a double helix

> consisting of circles in shades of green and blue bonds separating the words "CLINICAL" and "RM." The colors blue and green are claimed as a feature of the mark.

ClinicalRM (in standard characters);

and

The word "CLINICAL" is disclaimed. The application includes the following statements:

> The mark consists of the stylized wording "CLINICAL RM" in blue and stylized wording "ADVANCE. ACCELERATE. ACHIEVE." in green below, with a double helix consisting of circles in shades of green and blue bonds separating the words "CLINICAL" and "RM." The colors blue and green are claimed as a feature of the mark.

Each of the applications includes the identical recitation of services as follows:

> medical and scientific research, namely, conducting clinical trials on behalf of medical, biopharmaceutical and biotechnology companies and government agencies to assist them with clinical research; providing medical and scientific research information in the field of pharmaceuticals and clinical trials on behalf of medical, biopharmaceutical and biotechnology companies and government agencies (in International Class 42).

Each of the applications sets forth dates of first use anywhere and in commerce of May 1, 2011.

The trademark examining attorney refused registration in each application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered marks shown below, owned by the same entity, as to be likely to cause confusion.

Registration No. 3533224, issued November 18, 2008, for:

> clerical services for export and import agencies (in International Class 35);
>
> equity or research financial investment in the field of pharmaceutical venture companies in the U.S. to facilitate product development (in International Class 36); and
>
> medical testing, medical research, inspection of medicines, providing medical information, namely, providing information about medicines, diagnostic preparations and pre-clinical compounds to assist in licensing-out activities of promising pre-clinical compounds and act as an intermediary between U.S. and Japanese pharmaceutical companies; providing research information on pre-clinical compounds for new drugs; co-development of candidate compounds for new drugs for others; medical and pharmaceutical research and development

consulting services (in International Class 42).

The registration includes the following statement: "The mark consists of 'RM' and design."[1]

Registration No. 3589769, issued March 17, 2009, for:

clerical services for export and import agencies; providing medical information, namely, providing information about medicines, diagnostic preparations and pre-clinical compounds to assist in licensing-out activities of promising pre-clinical compounds and act as an intermediary between U.S. and Japanese pharmaceutical companies (in International Class 35);

equity and research financial investment in the field of pharmaceutical venture companies in the U.S. to facilitate product development (in International Class 36); and

medical testing, medical research, inspection of medicines; providing research information on pre-clinical compounds for new drugs; co-development of candidate compounds for new drugs for others; medical and pharmaceutical research and development consulting services (in International Class 42).

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[1] It would appear to our eye that the intersection of the letters "R" and "M" may form the additional letter "X" in each of registrant's marks. However, this is not reflected in the marks' descriptions, notwithstanding that "RX" is a commonly accepted abbreviation for "medical prescription." The American Heritage Abbreviations Dictionary (3d ed. 2005) (of which we take judicial notice).

The registration includes the following statement: "The mark consists of 'RM REQMED' and design."

When the examining attorney issued a final refusal, applicant filed a request for reconsideration. Upon denial of the request, applicant filed an appeal in each application. Applicant and the examining attorney have filed briefs.

The three appeals involve common issues of law and fact, and the evidentiary records and arguments are essentially identical or otherwise very similar. Accordingly, the Board will decide the appeals in this single opinion.

Evidentiary Issue

Before turning to the merits of the appeal, we first direct our attention to an evidentiary matter. Applicant submitted for the first time with its appeal brief evidence identified as Exhibits A-F. The examining attorney, in her brief, objected to the untimely submission of this evidence.

Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal. The Board will ordinarily not consider additional evidence filed after the appeal is filed. *See* TBMP § 1207.01 (3d ed. rev. 2012) and cases cited therein. Accordingly, the examining attorney's objection is sustained, and we have not considered applicant's untimely evidence in reaching our decision.

Arguments

Applicant states that its marks are derived from its company name, Clinical Research Management, Inc., and that the only commonality between its marks and registrant's marks is the presence of the letters "RM." Applicant argues that this commonality is insufficient to cause a likelihood of confusion. As to the services, applicant states that it is solely involved in medical and scientific research activities for others, and that, unlike registrant, applicant has never been involved in raising venture capital or licensing products it develops. Applicant further states that "[w]hile there may be some similarity between the nature of the two businesses, there is a greatly different emphasis in terms of control and overall breadth of activities." (Brief, p. 7). Applicant goes on to argue that "[w]hile there may appear to be some similarity or overlap on first review, there is really quite a bit of difference between coordinating the development and licensing of drugs with money that one raised versus being solely in the market of providing contracted research staff and services in support of customer research activities." (Brief, p. 7). Applicant also contends that the relevant purchasers are sophisticated and, given the nature of the services, likely to exercise greater care in their purchasing decisions. As to actual confusion, applicant claims that it is unaware of any

instances thereof. Pursuant to the examining attorney's inquiry, applicant made the following statements (Response, 9/3/11): "Applicant does not believe that 'RM' has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, and that such wording is not a 'term of art' within applicant's industry. Further, applicant does not believe that 'RM' is a commonly recognized acronym for 'research management' within the medical, biomedical, or biopharmaceutical industries."[2] In urging reversal of the refusal, applicant timely submitted an excerpt from its website, and an Internet article about registrant and its business.

The examining attorney maintains that each of applicant's marks is similar to each of registrant's marks, and that the services overlap and/or are closely related. To show that some of the services are related the examining attorney relied on five third-party registrations.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357,

[2] To the extent that applicant argues that the letters "RM" in registrant's mark may be recognized as an abbreviation for "Required Medicine," there is little in the record to support this. (*See* evidentiary issue, *supra*).

177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("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"). We will consider these two factors, together with any other relevant *du Pont* factors, in making our decision.

We will confine our likelihood of confusion analysis to the refusal based on the mark shown in Registration No. 3533224, consisting of the stylized letters "RM" and a globe design because, in view of the similarity between this mark and that of each of applicant's marks, this cited registration presents the strongest case for each refusal. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the other cited mark which includes additional wording; while if there is no likelihood of confusion between each of applicant's marks and the cited mark comprising the letters "RM" and design, then there would be no likelihood of confusion with the other cited mark. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Services

We first turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the services. It is well settled that the involved services need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of applicant and registrant are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of the services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

We make our determination regarding the similarities between the services, channels of trade and classes of purchasers based on the services as they are identified in the application and registration, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16

USPQ2d 1783, 1787 (Fed. Cir. 1990). Where the services in a cited registration and/or application are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the recitation of services encompasses all the services of the nature and type described therein, that the identified services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

In the instant case, applicant's services are identified, in part, as "providing medical and scientific research information in the field of pharmaceuticals and clinical trials on behalf of medical, biopharmaceutical and biotechnology companies and government agencies" in Class 42; and registrant's services are identified, in part, as "providing research information on pre-clinical compounds for new drugs" in Class 42. In the context of likelihood of confusion in the present case, it is sufficient if likelihood of confusion is found with respect to use of the mark on any of the services that comes within the recitation of services in the applications. *Tuxedo*

Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant's and registrant's services overlap to the extent that both involve providing research information about drugs (i.e., pharmaceuticals). Applicant has not provided any evidence to establish a meaningful distinction between the services for purposes of the likelihood of confusion analysis. The fact that applicant's Class 42 information services focus on clinical pharmaceuticals whereas registrant's Class 42 information services focus on pre-clinical pharmaceuticals is an insufficient basis upon which to distinguish the services as they are worded in the applications and registration. Although applicant and registrant may render the services at different stages of drug development, the services are complementary and otherwise closely related, with both being types of services that are part of the same process in bringing a pharmaceutical to the market. Further, registrant's specific services of "providing research information on pre-clinical compounds for new drugs" are not restricted as to prospective purchasers (unlike some of registrant's other services), so we must presume that the relevant purchasing classes include medical, biopharmaceutical and biotechnology companies and government agencies, that is, the same purchasers of applicant's services.

The examining attorney submitted, in an attempt to show that the services are related, five use-based third-party registrations showing that the same entity has registered the same mark for various services rendered at both the pre-clinical and clinical trial phases. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Given the relatedness of the services, we expect them to move in similar if not identical drug research trade channels, and be rendered to the same classes of purchasers, including biopharmaceutical, biotechnical and governmental entities. The extrinsic evidence relied upon by applicant (the properly introduced portions of applicant's and registrant's websites) does not serve to limit the recitations of services in the applications and registration upon which we have focused. *See In re Bercut-Vandervoort & Co.,* 229 USPQ 763, 764 (TTAB 1986)

(evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

Thus, the factors of the similarity between the services, and the overlap in trade channels and classes of purchasers weigh in favor of a finding of likelihood of confusion. If these services were rendered under similar marks, confusion would be likely to occur among purchasers.

The Marks

We next direct our attention to the *du Pont* factor of the similarity/dissimilarity between each of the applied-for marks and the registered mark shown in Registration No. 3533224. We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005), *quoting In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. Moreover, in comparing the marks, we are

mindful that where, as here, the services are closely related in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1108 (TTAB 2007); and *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang,* 84 USPQ2d 1323, 1325 (TTAB 2007).

Registrant's mark comprises the stylized letters "RM" accompanied by a globe background design. It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

Where both words/letters and a design comprise the mark (as in registrant's mark), then the words/letters are normally accorded greater weight because the words/letters are likely to make an impression upon purchasers, would be remembered by them,

and would be used by them to request the services. *CBS, Inc. v. Morrow,* 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985). *See also Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In registrant's mark, the literal portion of the mark, namely the letters "RM," is the dominant portion, and is accorded greater weight over the background globe design feature when comparing this mark to each of applicant's marks.

We now turn to compare each of applicant's marks individually with registrant's mark.

Application Serial No. 85264433

Applicant's mark "consists of the stylized wording 'CLINICAL RM' in blue, with a double helix consisting of circles in shades of green and blue bonds separating the words 'CLINICAL' and 'RM.'. The colors blue and green are claimed as a feature of the mark." The word "CLINICAL" is disclaimed.

As in registrant's mark, applicant's mark likewise is dominated by the literal portion, in this case "CLINICAL RM." This portion is likely to make an impression upon purchasers,

would be remembered by them, and would be used by them to request the services. In turn, the literal portion is dominated by the letters "RM." The word "CLINICAL" is disclaimed and, given the nature of the services, the word lacks source-indicating significance. Consumers are more likely to perceive the letters "RM," which are emphasized by thicker letters in a dark color, as the source-indicating feature of the mark, rather than the descriptive word "CLINICAL." *See, e.g., In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming Board's finding that "DELTA," not the disclaimed generic term "CAFÉ," is the dominant portion of the mark THE DELTA CAFÉ); and *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). The dominant portion of applicant's mark, "RM," is identical to the literal portion of registrant's mark. In discussing the dominant portion of the marks, we recognize, of course, that the marks ultimately must be compared in their entireties. When this comparison is made, we find that the marks are similar in sound, appearance and meaning. Because of the similarities between the marks, applicant's and registrant's marks engender similar overall commercial impressions. The presence of the stylized lettering and designs in both marks, and the color features and additional word

"CLINICAL" in applicant's mark, are insufficient to distinguish the marks when they are used in connection with related services.

The similarity between the marks weighs in favor of a finding of likelihood of confusion.

Application Serial No. 85264461

Applicant's mark consists of ClinicalRM in standard characters; given the absence of the additional words and/or design features in applicant's other marks, this presents the strongest case for affirmance. Again, due to the highly descriptive nature of the word "CLINICAL," this mark is dominated by the letters "RM." These letters are identical to the literal dominant portion of registrant's mark. The stylization of the letters and the globe design in registrant's mark are insufficient to distinguish the marks.

When the marks are compared in their entireties, they are similar in sound, appearance, meaning and overall commercial impression. Thus, the similarity between the marks weighs in favor of a finding of likelihood of confusion.

Application Serial No. 85264478

Applicant's mark "consists of the stylized wording 'CLINICAL RM' in blue and stylized wording 'ADVANCE. ACCELERATE. ACHIEVE.' in green below, with a double helix consisting of circles in shades of green and blue bonds separating the words

'CLINICAL' and 'RM.' The colors blue and green are claimed as a feature of the mark." The word "CLINICAL" is disclaimed.

The literal portion of applicant's mark dominates over the design portion. In turn, the "CLINICAL RM" portion dominates the literal portion inasmuch as the wording "ADVANCE. ACCELERATE. ACHIEVE." is in much smaller font, appearing below "CLINICAL RM." And, as is the case explained above, the word "CLINICAL" is disclaimed, leaving the letters "RM" as the dominant portion.

Once again, the dominant portion of applicant's mark is similar to the dominant portion of registrant's mark. In discussing the dominant portion of the marks, we again recognize that the marks ultimately must be compared in their entireties. When this comparison is made, we find that the marks are similar in sound, appearance, meaning and overall commercial impression. The additional elements in the marks are insufficient to distinguish the marks when used in connection with similar services. The similarity between the marks weighs in favor of a finding of likelihood of confusion.

Other Factors

The sixth *du Pont* factor focuses on the number and nature of similar marks in use on similar goods and/or services. Although hardly the most probative factor in this case, the absence in the record before us of any third-party uses or

registrations of "RM" marks in the pharmaceutical research information field tends to show that registrant's mark is unique or at least not coexisting with similar marks in the field. Thus, there is no evidence to indicate that relevant purchasers who may avail themselves of the involved services are accustomed to distinguishing between marks based on other differences between the marks. *See Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652 (CCPA 1975) ("Since the record is devoid of any evidence that any other merchant of any product has used or is using [opposer's design mark] as a trademark, we feel it most likely that its appearance on such products as are here involved would be taken as an indication of common origin.").

Given the nature of the services at issue, even in the absence of any evidence on the point, it is reasonable for us to assume that the relevant purchasers are likely to exercise some degree of care when it comes to buying the pharmaceutical research information services. It is settled, however, that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and closely related services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA

1970) ("Human memories even of discriminating purchasers...are not infallible."). *See also Kos Pharmaceuticals Inc. v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874, 1887-88 (3d Cir. 2004). We find that the similarities between the marks and the services sold thereunder outweigh any sophisticated purchasing decision, especially in the absence of evidence relating to the degree of care in making the decision. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd, Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Thus, this factor is given less weight in view of the similarities between the marks and the services.

Applicant's assertion, in an ex parte proceeding, of the contemporaneous use of applicant's and registrant's marks since May 2011 without actual confusion is entitled to little weight. *See In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). *In re Binion*, 93 USPQ2d at 1536;

In re 1st USA Realty Professionals Inc., 84 USPQ2d 1581, 1588 (TTAB 2007); and *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, the record is devoid of probative evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1847; and *In re Wilson*, 57 USPQ2d 1863, 1869 (TTAB 2001) ("[I]nasmuch as we have heard from neither registrant nor the Highland Orange Association in this appeal, we cannot conclude that, in fact, no instances of actual confusion ever occurred."). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Many of applicant's arguments are based on the evidence attached to its appeal brief. So as to be clear, we have decided this case on the evidence *properly* made of record, which does *not* include any of the evidence untimely submitted with applicant's appeal brief. Based on the record before us, we find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion between each of applicant's marks and the mark shown in registrant's Registration No. 3533224. The factors involving the services, namely the

similarity between the services, and the overlap in trade channels and classes of purchasers, tip the scales in favor of affirming the refusals.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register in each application is affirmed.