

THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.

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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 Gateway Health Plan, L.P.

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Serial No. 77063878

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Paul D. Bangor, Jr. of Thorp Reed & Armstrong, LLP for  
Gateway Health Plan, L.P.

Steven Jackson, Trademark Examining Attorney, Law Office  
107 (J. Leslie Bishop, Managing Attorney).

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Before Walters, Holtzman and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Gateway Health Plan, L.P. has filed an application to register, on the Principal Register, BEEMSS in standard characters for services ultimately identified as "administration of Medicaid managed health care plans" in International Class 36. The application was filed on December 13, 2006, based upon an allegation of a bona fide intention to use the mark in commerce. The application was published for opposition on September 4, 2007 and a notice

of allowance subsequently issued on November 27, 2007. After securing extensions of time, applicant filed its statement of use and a specimen on November 25, 2008, alleging first use anywhere on October 1, 2001 and in commerce on August 1, 2002. The examining attorney issued a refusal to register under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the specimen "fails to show proper use of the applied-for mark in the sale or advertising of the recited services." First Office Action p. 1. In the Final Office Action, the examining attorney elaborated on his refusal stating that "[i]f the specimen does not show the mark with reference to, or association with, the services, the specimen fails to show service mark usage." Final Office Action p. 2.

When the refusal was made final, applicant appealed and filed a request for reconsideration. On January 5, 2010, the examining attorney denied the request for reconsideration. Thereafter, the Board resumed the appeal and briefs have been filed. We affirm the refusal to register.

The sole issue in this appeal is whether the applied-for mark is used as a service mark in connection with the services listed in the notice of allowance.

The starting point for our analysis is Section 45 of the Trademark Act, as amended, where "service mark" is defined as "any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. §1127. This section further provides that a mark shall be deemed to be in use in commerce on services when "it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." *Id.* Thus, the mark must be used in such a manner that it would be readily perceived as identifying the specified services and distinguishing a single source or origin for the services. In *re* Safariland Hunting Corp., 24 USPQ2d 1380 (TTAB 1992). The mere fact that a designation appears on the specimens of record does not make it a service mark. *Id.*

A critical element in determining whether matter sought to be registered is a service mark is the impression the matter makes on the relevant public. Thus, in a case such as this, the critical inquiry is whether the asserted mark would be perceived as a source indicator for the identified services. See *In re* Brass-Craft Mfg. Co., 49

USPQ2d 1849 (TTAB 1998); In re Volvo Cars of North America Inc., 46 USPQ2d 1455 (TTAB 1998). To be a mark, the term must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the services. In re Volvo, supra. The specimen must show a direct association between the mark and the actual services for which registration is sought. In re wTe Corp., 87 USPQ2d 1536, 1541 (TTAB 2008) citing In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application. In re Safariland, supra. Here, we have only the specimens of record, shown below, wherein the applied-for mark appears in the text of a fact sheet in the form of a brochure:



## Fact Sheet

### Mission and Values

The mission of Gateway Health Plan<sup>SM</sup> is to emphasize the development and delivery of innovative programs to positively affect the personal health of its members. Gateway maintains a healthcare delivery system that ensures the availability of high quality medical care for the Gateway member, based upon access, quality and financial soundness.

### Highlights

- 1992 – Gateway was established as an alternative to Pennsylvania's Department of Public Welfare's Medical Assistance Program
- 2000 – Gateway becomes the first Medicaid health plan to receive NCQA's 'Excellent' rating
- 2003 & 2006 – Gateway is again awarded NCQA's 'Excellent' rating
- 2004 – Gateway's Michael Blackwood, President and CEO, is selected as Pennsylvania State Rural Health Leader of the Year
- 2006 – Gateway launches Gateway Health Plan *Medicare Assured*<sup>SM</sup> to individuals in service areas in Pennsylvania who have both Medicare and Medicaid
- 2007 – Gateway expands *Medicare Assured*<sup>SM</sup> in Pennsylvania and launches in Ohio
- 2008 – Gateway expands *Medicare Assured*<sup>SM</sup> in three additional counties in Pennsylvania and eight additional counties in Ohio.

### Fast Facts

- More than 263,000 members
- Headquartered in Pittsburgh, Pennsylvania
- Recognized as one of "America's Best Health Plan 2007" by *US News & World Report/NCQA*; three consecutive years
- #1 Medicaid health plan in Pennsylvania
- #12 Medicaid health plan in America
- Expansive network includes more than 6,000 health care providers and 110 hospitals in addition to pharmacies and other medical services

### Plans At A Glance

- Gateway Health Plan<sup>SM</sup> is a Medicaid HMO serving the Medical Assistance population in Pennsylvania.
- Gateway Health Plan *Medicare Assured*<sup>SM</sup> is a Medicare approved Special Needs Plan.
  - Serves 25,000+ members living in Pennsylvania and Ohio

### An Innovative Approach to Healthcare

Gateway Health Plan<sup>SM</sup> has designed a program that addresses the unique challenges faced by the most vulnerable citizens in accessing medical and social support services. Prospective Care Management (PCM<sup>SM</sup>) is a proactive holistic approach to health care that goes beyond disease management. PCM<sup>SM</sup> examines all the different aspects of a person's life – Behavioral, Environmental, Economic, Medical, Social and Spiritual (BEEMSS<sup>SM</sup>) – and defines the barriers to care. Cutting-edge software is used to detect high-risk medical and social issues, and primary care physicians and specialists design a holistic treatment plan that addresses them.

The examining attorney argues that the applied-for mark, "appears to be only a feature in its 'PCM' program ... [and] is not being used as an indicator of source for administering Medicaid managed health care plans." Br. pp. 3-4. Further, the examining attorney contends that "the proposed mark is buried in the text of the page to such a

degree that it would not be perceived as indicating the source of applicant's services and therefore, fails to show the applied-for mark in the sale or advertising of the services. ... The letters 'BEEMSS' appear solely to identify an acronym for different aspects of a person's life: Behavioral, Environmental, Economic, Medical, Social and Spiritual. The impression made by the term on the purchasing public is simply that of an informational or descriptive statement and thus, it would not be perceived as an indicator of source." Br. p. 4.

Applicant argues that "[t]he specimen provides more than the requisite association between the mark and the services. The mark BEEMSS with a superscript 'SM' is used on this one page 'Fact Sheet' brochure which clearly describes at least (5) times Applicant's services of 'Administration of Medicaid managed health care plans'." Further, applicant argues that "the mark BEEMSS is used on the specimen in the midst of a description of a unique and innovative approach used by Applicant in providing the services." Br. pp. 2-3.

In this case, we find that the manner in which the applied-for mark is used on the specimen of use is not indicative of service mark use. First, the use of the SM symbol does not change the commercial impression of the

applied-for mark, which as used in the specimen only informs the consumer of a feature of a personalized health care treatment plan. As stated by the examining attorney, "[t]he use of the symbol SM next to the mark on the specimen merely shows applicant's intent to claim the applied-for mark as a service mark and is not an indicator of whether a mark is actually perceived by the public as a source-indicator." Br. p. 4. See *In re Remington Products, Inc.*, 3 USPQ2d 1714 (TTAB 1987). See also *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) ("mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark").

Second, applicant points to excerpts from its brochure that arguably show "administration of Medicaid managed health care plan" services; however, the letters BEEMSS are not associated with this service. As they appear in the specimen of use, BEEMSS simply is the abbreviation of a group of attributes applicant measures in evaluating a member's access to health care. While this may be a feature of applicant's administration services it is not the applied-for service. Inasmuch as BEEMSS is not directly associated with the applied-for services it does not serve as a source identifier for those services. Thus,

the applied-for mark, as used, would not be perceived as a service mark, and the mere addition of the service mark symbol is not sufficient to transform the non-service mark use into service mark use. At most, the manner in which the applied-for mark is used on the specimen presents the applied-for mark as a feature of the service and not as a service mark. Even an inherently distinctive designation is not a service mark if it is not used in a service mark manner.

In summary, the manner in which the applied-for mark is being used does not support a finding that potential consumers would perceive it as a service mark. As used in the specimen of record, the applied-for mark does not convey the commercial impression of a mark identifying the source of origin of applicant's applied-for services. This conclusion is not altered by the fact that a SM symbol is displayed adjacent to the letters BEEMSS. See *In re B.C. Switzer & Co.*, 211 USPQ 644 (TTAB 1981).

**Decision:** The refusal to register under Sections 1 and 45 of the Act is affirmed.