

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
March 5, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Adventist Health System/Sunbelt, Inc.

Serial Nos. 77511647, 77589558, 77589572¹

R. Lee Bennett and Brian K. Furgala of GrayRobinson, P.A.
for Adventist Health System/Sunbelt, Inc.

Heather A. Sapp, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Holtzman, Kuhlke and Ritchie, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Adventist Health System/Sunbelt, Inc., has
filed applications to register as a trademark on the
Principal Register the standard character mark HEALTH
VILLAGE for "retail store services featuring medical
supplies, flowers, drugs, and gifts" in International Class

¹ Inasmuch as the issues raised by these appeals are similar, the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 77511642, unless otherwise noted; however, we have of course, considered all arguments and evidence filed in each case.

Serial Nos. 77511647, 77589558, 77589572

35,² "providing fitness and exercise facilities; education services, namely, providing courses of instruction, vocational training, seminars, and workshops in the field of medicine" in International Class 41,³ and "skilled nursing facilities and services; hospital services; physical occupational and rehabilitative services; medical services; medical diagnostic services; radiology services; surgery services; ambulatory emergency services; outpatient medical and surgical services; psychiatric services; genetic testing services; medical laboratory services; diagnostic laboratory services; long-term care services; acute care services; spa services, namely, cosmetic and body fitness therapies" International Class 44.⁴

The examining attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the descriptive word HEALTH on the ground that it is merely descriptive of applicant's services within the

² Application Serial No. 77511647, filed on June 30, 2008, based on an allegation of an intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

³ Application Serial No. 77589558, filed on October 9, 2008, based on an allegation of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

⁴ Application Serial No. 77589572, filed on October 9, 2008, based on an allegation of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Serial Nos. 77511647, 77589558, 77589572

meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

We affirm the refusal of registration in the absence of a disclaimer in each application.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Serial Nos. 77511647, 77589558, 77589572

A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

The examining attorney argues that "applicant's retail store services are of the type that sell health-related products (medical supplies and drugs), as well as items that you would commonly find in a hospital gift shop (flowers and gifts)...[t]herefore, the wording HEALTH is merely descriptive of applicant's services." Br. p. 5. With regard to application Serial Nos. 77589558 and 77589572, the examining attorney contends that "applicant's services are related to maintaining good health and, thus, the wording HEALTH is merely descriptive." '558 Br. p. 7 and '574 Br. p. 10.

In support of the refusals, the examining attorney requests that the Board take judicial notice of, *inter alia*, the following dictionary definition for the word HEALTH:⁵

⁵ The Board may take judicial notice of dictionary definitions, including online dictionaries, which exist in printed format.

Serial Nos. 77511647, 77589558, 77589572

[T]he condition of being sound in body, mind, or spirit, especially freedom from physical disease or pain. Merriam-Webster Collegiate Dictionary (11th ed. 2008) retrieved from www.merriam-webster.com/dictionary/health.

We find that the examining attorney has made a prima facie case that the word HEALTH used in connection with applicant's services is descriptive. In the case of the retail services in application Serial No. 77511647, the word HEALTH clearly and unambiguously describes a significant feature of the category of goods featured in its stores, namely, health products. With regard to the fitness and exercise facilities, and educational services in the field of medicine, the word HEALTH is clearly descriptive of a significant feature of the subject matter of the educational services in the field of medicine and a significant feature of the fitness facilities in application Serial No. 77589558. Finally, HEALTH is clearly descriptive of a significant feature of the health services, i.e., the nursing, hospital and other medical services listed in application Serial No. 77589572. We

See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Therefore, we consider this definition also to be of record in support of the refusals. The examining attorney also included dictionary definitions for various items and services in the identifications, e.g., drug, medical, medicine, nursing, hospital, spa, fitness and exercise.

also find that the word HEALTH when combined with the word VILLAGE does not lose its descriptive significance.

Applicant argues that the term HEALTH indicates "a condition or outcome to be achieved" and "[a]pplicant will not sell or provide 'health,' which is defined as the state of optimal physical, mental, and social well-being...[a]pplicant uses the term suggestively to evoke the intended condition or outcome from using its retail services." Br. pp. 3-4. That the word HEALTH describes the desired outcome from the services does not make it less descriptive. By this argument, applicant essentially concedes that the word HEALTH is descriptive of the services. Moreover, it is more than simply describing the outcome, the word HEALTH designates the field or category of these services.

In addition, applicant contends that the word HEALTH "includes many different attributes, but does not convey an immediate idea of the qualities or characteristics of any related goods or services...[s]imply put, the term 'HEALTH' is a very broad term that connotes many categories of physical, mental, and social attributes without conveying an immediate idea of the qualities or characteristics of any one of the attributes with respect to Applicant's listed goods." Br. p. 5. Applicant concludes that, "the

term 'HEALTH' is one step removed from being merely descriptive because it only suggests the result to be achieved by the consumer through the goods to be sold by Applicant."⁶ Br. p. 5.

In the context of applicant's respective services, contrary to applicant's argument, we find the term HEALTH to be sufficiently specific as to be descriptive rather than one step removed and suggestive. The word HEALTH in the mark simply describes a significant feature of the services as discussed above.⁷

⁶ Applicant relies on *In re Hutchinson Technology Inc.*, 7 USPQ2d 1490, 1492, n.5 (Fed. Cir. 1988) in support of its position that broad terms are not descriptive. However, that case concerned a refusal based on the determination that the mark HUTCHINSON TECHNOLOGY was primarily merely a surname. While the Court reversed the determination that the mark was primarily merely a surname, it acknowledged the affirmance of the disclaimer requirement and applicant's offer to disclaim the word TECHNOLOGY made in its appeal brief and remanded the case for entry of that disclaimer. Accordingly, that case is not useful to applicant's argument.

⁷ Applicant's argument regarding its other applications for the mark HEALTH VILLAGE for other types of services including "adult and child day care services; assisted living facility; community residential home services; restaurant and cafe services; hotel and motel services; convention, exhibition and meeting facilities services" are not persuasive. Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). Moreover, each case must be determined on its own facts and the USPTO's allowance of prior applications or registrations does not bind the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Serial Nos. 77511647, 77589558, 77589572

Finally, both applicant and the examining attorney submitted third-party registrations to show that the USPTO has alternatively treated the word HEALTH as descriptive or not descriptive by sometimes requiring a disclaimer of the term and sometimes not requiring a disclaimer. The most that can be said of this evidence is that it is inconclusive. In fact, these registrations highlight why prior decisions in other applications are not binding on the Board and underscore the need to evaluate each case on its own record. In re Nett Designs Inc., 57 USPQ2d 1564.

Applicant correctly states that in cases of refusals under Section 2(e)(1) we must resolve doubt in favor of applicant; however, we have no such doubt in this case.

Thus, the disclaimer requirement is appropriate. In view of the above, the requirement to provide a disclaimer for the word HEALTH is affirmed in each application.

Decision: The refusal to register based on the requirement for a disclaimer of HEALTH is affirmed in each application. However, if applicant submits the required disclaimer of HEALTH in each application to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer

Serial Nos. 77511647, 77589558, 77589572

requirement.⁸ See Trademark Rule 2.142(g), 37 C.F.R.
§2.142.

⁸ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use HEALTH is claimed apart from the mark as shown." TMEP 1213.08(a) (5th ed. 2007).