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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/589558

MARK: HEALTH VILLAGE



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TTAB INFORMATION:

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APPLICANT: Adventist Health System/Sunbelt,
Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Adventist Health System/Sunbelt, Inc., has appealed the trademark examining attorney's final refusal to register the proposed mark HEALTH VILLAGE for use in conjunction with "Providing fitness and exercise facilities; education services, namely, providing courses of instruction, vocational training, seminars, and workshops in the field of medicine" in Class 41.

The examining attorney required a disclaimer of the merely descriptive wording HEALTH, and the applicant has failed to enter such a disclaimer. TMEP §1213; 15 U.S.C. §1056(a).

The examining attorney respectfully requests that the Trademark Trial and Appeal Board (hereinafter, "The Board") affirm the disclaimer requirement.

STATEMENT OF FACTS

On October 9, 2008, the applicant filed Application Serial No. 77/589558 to register the mark HEALTH VILLAGE on the Principal Register for services identified as "physical fitness centers and exercise rooms; spas; indoor recreation facilities; schools and colleges" in Class 41. The application was based on a bona fide intent to use the mark in commerce under Trademark Act Section 1(b).

In an Office Action dated October 15, 2009, the examining attorney required a disclaimer of the merely descriptive wording HEALTH, on the grounds that the wording merely described the services.

In its response dated January 30, 2009, applicant set forth reasons why the disclaimer requirement should be withdrawn.

In a final Office Action dated February 23, 2009, the examining attorney maintained and made final the disclaimer requirement.

Applicant requested reconsideration on June 12, 2009. The examining attorney denied reconsideration on June 15, 2009.

The applicant filed its Appeal Brief on July 30, 2009.

Upon preparing this appeal brief, the examining attorney noticed that part of the identification was indefinite. The portion of the identification that originally read as “school and colleges” needed further specification.

The applicant amended the identification of services by Examiner’s Amendment on November 12, 2009.

The identification of services now reads as follows: “Providing fitness and exercise facilities; education services, namely, providing courses of instruction, vocational training, seminars, and workshops in the field of medicine” in Class 41.

ISSUE ON APPEAL

The only issue to be decided by the Board is whether the wording HEALTH is merely descriptive of “Providing fitness and exercise facilities; education services, namely, providing courses of instruction, vocational training, seminars, and workshops in the field of medicine,” therefore necessitating a disclaimer of this term.

DISCLAIMER

ARGUMENT

The Office can require an applicant to disclaim an unregistrable component of a mark. 15 U.S.C. §1056(a). Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement in the record that an applicant does not claim exclusive rights to an unregistrable component of a mark; it does not affect the appearance of the mark. TMEP §1213. An unregistrable component can include wording or designs that are merely descriptive or generic, deceptively misdescriptive, or primarily geographically descriptive of an applicant’s goods and/or services. 15 U.S.C. §1052(e); *see* TMEP §§1213, 1213.03.

Two major reasons for not protecting descriptive terms are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

II. *HEALTH is Merely Descriptive as Applied to Applicant’s Services*

Applicant wishes to use the mark HEALTH VILLAGE in connection with “Providing fitness and exercise facilities; education services, namely, providing courses of instruction, vocational training, seminars, and workshops in the field of medicine” in Class 41. The examining attorney has required a disclaimer of the exclusive right to use the descriptive wording HEALTH as applied to these services.

The examining attorney asks that the Board take judicial notice of the following definition of “health”: “the condition of being sound in body, mind, or spirit, especially freedom from physical disease or pain.”¹

The examining attorney asks the Board to take judicial notice of the following definitions of each of applicant’s services or the subject matter of applicant’s services:

- “Fitness” refers to “the quality or state of being fit”² (“fit” means “sound physically and mentally”).³
- “Exercise” is “bodily exertion for the sake of developing and maintaining physical fitness.”⁴

¹ “health.” Merriam-Webster Collegiate Dictionary, Eleventh Edition. 2008. Merriam-Webster, Inc. 16 November 2009. <http://www.merriam-webster.com/dictionary/health>. *See attached*. The examining attorney requests that the Board take judicial notice of the definition of the term in accordance with the decisions in *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04.

² “fitness.” Merriam-Webster Collegiate Dictionary, Eleventh Edition. 2008. Merriam-Webster, Inc. 16 November 2009. <http://www.merriam-webster.com/dictionary/fitness>. *See attached*. The examining attorney requests that the Board take judicial notice of the definition of the term in accordance with the decisions in *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04.

³ “fit.” Merriam-Webster Collegiate Dictionary, Eleventh Edition. 2008. Merriam-Webster, Inc. 16 November 2009. <http://www.merriam-webster.com/dictionary/fit>. *See attached*. The examining attorney requests that the Board take judicial notice of the definition of the term in accordance with the decisions in *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04.

- Medicine is “the science and art dealing with the maintenance of health and the prevention, alleviation, or cure of disease.”⁵

It is clear that each of applicant’s services are related to maintaining good health, and thus the wording HEALTH is merely descriptive.

Applicant argues that the use of the term “HEALTH” does not describe the services to be offered and is merely suggestive of the services to be offered under the mark, because “Applicant intends to offer services that are mere factors or elements that when used may result in or impact good personal well-being” and that “the use of the term ‘HEALTH’ is suggestive of the outcome available by utilizing these services...and does not specifically describe the services themselves.” Applicant further argues that “[a]lthough Applicant intends to offer services that may be expected to result in ‘health,’ Applicant will not sell or offer ‘health.’” (Applicant’s Brief, Page 5.)

Applicant further argues that because the examining attorney allowed registration of applicant copending mark HEALTH VILLAGE (Serial No. 77/589,566) for “adult and child day care services; assisted living facility; community residential home services; restaurant and café services; hotel and motel services; convention, exhibition and meeting facilities services” without requiring a disclaimer of HEALTH, that this is evidence that

⁴ “exercise.” Merriam-Webster Collegiate Dictionary, Eleventh Edition. 2008. Merriam-Webster, Inc. 16 November 2009. <http://www.merriam-webster.com/dictionary/exercise>. *See attached*. The examining attorney requests that the Board take judicial notice of the definition of the term in accordance with the decisions in *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04.

⁵ “medicine.” Merriam-Webster Collegiate Dictionary, Eleventh Edition. 2008. Merriam-Webster Online. 16 November 2009. <http://www.merriam-webster.com/dictionary/medicine>. *See attached*. The examining attorney requests that the Board take judicial notice of the definition of the term in accordance with the decisions in *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04.

HEALTH is not descriptive for the services in this application. This argument is without relevance to the issue at hand, however, because the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant’s argument that registration of HEALTH VILLAGE without a disclaimer for completely different services means that HEALTH is not merely descriptive for any services is without merit. The services identified in the ‘566 application are not related in any manner to the health care industry, whereas Applicant’s services in the instant appeal are related to maintaining optimum health.

Applicant argues that the word HEALTH is suggestive of applicant’s services, rather than descriptive because “the term ‘HEALTH,’ similar to ‘technology,’ ‘intelligent,’ or ‘emotional,’ includes many different attributes, but does not convey an immediate idea of

the qualities or characteristics of any related goods or services.” (Applicant’s Brief, Page 5.)

To the contrary, a mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys **some information** about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (emphasis added); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983).

Here, it is quite apparent that the applicant’s educational and fitness-type services feature and/or are for the purpose of health. The applicant does not need to provide “health,” so to speak, but simply feature services that are for one’s health.⁶

Please note that the test is not that the descriptive term conveys all information, but merely that it convey some information. Likewise, the fact that a term has multiple meanings does not obviate the descriptive nature of that term. The applicant seems to argue that because “health” has multiple meanings and it’s possible that a consumer might interpret the wording HEALTH VILLAGE to be one of a few possible things related to health, that the term HEALTH is not descriptive. By that logic, the only terms that could ever be descriptive (and thus either refused or disclaimed) would be only those words in the English language that only have one accepted official definition.

⁶ It appears that the applicant is making some type of genericness argument. The examining attorney is not arguing that the term HEALTH is generic, only descriptive in regard to the services recited.

In fact, the USPTO has found the wording HEALTH to be descriptive of the services at issue. In the Final Action, the examining attorney attached eight representative sample third-party registrations that disclaimed the term “HEALTH” and listed services similar or identical to the applicant’s. Third-party registrations featuring the same or similar goods and/or services as applicant’s goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

The applicant countered by finding “272 live records on the Principal Register of third-party registrations featuring similar services in the same classification that have not been required to disclaim the term ‘health.’” Applicant attached the TESS printout of a search, which included both registrations and pending applications in the relevant 272 count, and then proceeded to attach ten representative samples of this group. Applicant argued that the existence of these “registrations” demonstrated a lack of conclusive evidence that the term “health” is merely descriptive.

To the contrary, third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. Wording that is merely

descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a). Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Furthermore, even if the Office was bound to allow registration of HEALTH VILLAGE without a disclaimer of HEALTH simply because some examining attorneys allowed registration of a mark including HEALTH for related services without this disclaimer, attached evidence does not support this contention.

Applicant contends that the Office allowed registration without a disclaimer of the Principal Register 272 times for related services. However, this is not correct. The TESS printout attached to applicant's Request for Reconsideration (Exhibit 1) clearly shows both registrations and applications. In fact, some of applicant's representative samples (Exhibit 3) are actually relatively newly-filed applications. The examining attorney strongly surmises that by the time prosecution is complete for these applications, there will be disclaimers entered, the marks will register on the Principal Register under Section 2(f) or on the Supplemental Register, and/or the applications will have abandoned entirely. Of the representative samples attached to the Request for

Reconsideration and cited in Applicant's Brief (as well as the marks listed on the TESS printout) that are actually registrations, several of the marks are slogans for which no disclaimer of HEALTH would be necessary due to the unitary nature of the mark.

Applicant argues that because "several third-party" registrants were not required to disclaim the term HEALTH, there is no conclusive evidence that the term HEALTH is merely descriptive. However, each case must be decided on its own merits, and, the existence of third-party registrations is not dispositive where, as here, the evidence shows that the word is merely descriptive. Applicant offers health care services, therefore, HEALTH is merely descriptive, and the wording must be disclaimed.

CONCLUSION

Because the wording HEALTH is merely descriptive of applicant's "providing physical fitness centers, exercise facilities, and indoor recreation facilities; medical schools; educating at university or colleges," exclusive rights to this term must be disclaimed.

Therefore, the Board is respectfully requested to affirm the requirement to disclaim the term HEALTH under 15 U.S.C. §1056(a); TMEP §1213.

Respectfully submitted,

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