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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Adventist Health System/Sunbelt, Inc.

Serial Nos. 77589735 and 77589737¹

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

Lydia M. Belzer, 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 "real estate rental services, namely, rental
and leasing of houses, accessory apartments, cottages,
townhouses, multi-family apartments, condominiums and

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. 77511735, unless otherwise noted; however, we have of course, considered all arguments and evidence filed in each case.

commercial buildings, offices and facilities; management of residential and commercial real estate" in International Class 36,² and "real estate development; real estate services, namely sales of residential and commercial properties" in International Class 37.³ 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 word VILLAGE on the ground that it is merely descriptive of applicant's services within the 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

² Application Serial No. 77589735, filed on October 9, 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. 77589737, 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).

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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). 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 "the term VILLAGE is merely descriptive in relation to [applicant's] services, as it identifies a feature or characteristic of the services, namely, that applicant's real estate services

pertain to villages and/or to buildings set up in such a manner as to form villages." Br. p. 5. Further, she argues that because the identification contains no limitations on the scope of the services "it is presumed that the application[s]" encompass real estate services "pertaining to villages." Br. p. 7.

In support of the refusals, the examining attorney requests that the Board take judicial notice of the following dictionary definitions for the word VILLAGE:⁴

rural community: a group of houses and other buildings in a rural area, smaller than a town

small incorporated community: in some U.S. states, a community that is smaller than a town but that is similarly incorporated

temporary community: a place where people live temporarily as a community, e.g. an apartment complex for the use of athletes taking part in the Olympic Games

Encarta World English Dictionary (North American Edition 2009) retrieved from <http://encarta.msn.com>.

We find that the examining attorney has made a prima facie case that the word VILLAGE used in connection with

⁴ The Board may take judicial notice of information from the Encarta Dictionary even though it is not available in print format because it is a widely known reference that is readily available in specific denoted editions online and in a CD-Rom format. In re Red Bull GmbH, 78 USPQ2d 1375, 1378 (TTAB 2006). Therefore, we consider these definitions in their entirety, as discussed by applicant, also to be of record in support of the refusals.

applicant's services is descriptive. The word VILLAGE clearly and unambiguously describes a significant feature of the real estate services in that it clearly denotes a particular location involving a grouping of residences and other buildings in the immediate vicinity of each other, which is directly pertinent to the rental and leasing, management, development and sales of real estate. We also find that the word VILLAGE when combined with the word HEALTH does not lose its descriptive significance.

We do not agree with applicant's analysis that the word VILLAGE "merely describes the organization or location of building or structures [and t]he rental, leasing or management of those buildings or structures is one or more steps removed from that description." Reply Br. p. 4. For a term to be descriptive of a service, it is not necessary to show that it names the service, which is essentially applicant's argument. By indicating the feature or subject matter of a service, a term is descriptive. Here, the term VILLAGE, as applicant apparently acknowledges, immediately conveys the information that the properties that applicant is renting, leasing, managing, developing or selling are located in a village, or are organized in such a manner as to resemble the form of a village.

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

Finally, both applicant and the examining attorney submitted third-party registrations to show that the USPTO has alternatively treated the word VILLAGE 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., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

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 VILLAGE is affirmed in each application.

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Decision: The refusal to register based on the requirement for a disclaimer of VILLAGE is affirmed in each application. However, if applicant submits the required disclaimer of VILLAGE in each application to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement.⁵ See Trademark Rule 2.142(g), 37 C.F.R. §2.142.

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