

From: Belzer, Lydia

Sent: 2/12/2010 9:54:55 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77589735 - HEALTH VILLAGE -
N/A

Attachment Information:

Count: 3

Files: Encarta-1.jpg, Encarta-2.jpg, 77589735.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/589735

MARK: HEALTH VILLAGE



CORRESPONDENT ADDRESS:

R. LEE BENNETT
GRAYROBINSON, P.A.
301 E PINE ST STE 1400
ORLANDO, FL 32801-2741

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Adventist Health System/Sunbelt,
Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

RBennett@gray-robinson.com

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 "real estate rental services, namely, rental and leasing of houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities; management of residential and commercial real estate" under Section 6(a) of the Trademark Act of 1946 (as amended), 15 U.S.C. §1056(a). The examining attorney required a disclaimer of the merely descriptive wording VILLAGE, and applicant has failed to enter such a disclaimer. 15 U.S.C. §1056(a); TMEP §§1213 *et seq.* The examining attorney respectfully requests that this disclaimer requirement be affirmed.¹

¹ Examining attorney Lydia M. Belzer replaces examining attorney Heather A. Sapp for the purposes of this brief.

FACTS

On October 9, 2008, an original application was filed under Trademark Act Section 1(b), 15 U.S.C. §1051(b), to register the mark HEALTH VILLAGE for “real estate rental services, namely, rental and leasing of houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities; management of residential and commercial real estate” in International Class 036.

On October 15, 2008, the examining attorney issued an Office action refusing registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), stating that the mark was merely descriptive in relation to the services. Applicant responded to the refusal advancing arguments in support of registration. Upon review of these arguments, the examining attorney withdrew the Section 2(e)(1) refusal, and instead issued a requirement for a disclaimer of the wording VILLAGE, finding that that portion of the mark was descriptive in relation to the identified services.

Again, applicant submitted arguments opposing the disclaimer requirement. On May 20, 2009, the examining attorney issued a final Office Action maintaining the disclaimer requirement. This appeal followed.²

ISSUE ON APPEAL

The sole issue on appeal is whether the wording VILLAGE is merely descriptive when used in connection with the identified services and thus properly subject to a disclaimer requirement.

² This application is one in a series of copending HEALTH VILLAGE applications, the following of which are currently also before the Board on appeal: Serial Nos. 77589572, 77589558, 77511647, and 77589737.

DISCLAIMER

ARGUMENT

I. General Rules of Analysis for Disclaimer Requirements

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.

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 mark, or term therein, is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Two major reasons for not protecting descriptive marks 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. VILLAGE is Merely Descriptive as Applied to Applicant's Services

Applicant seeks to register the mark HEALTH VILLAGE for “real estate rental services, namely, rental and leasing of houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities; management of residential and commercial real estate” in International Class 036. However, the term VILLAGE is merely descriptive in relation to these 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.

A. The Definitions of “Village” Support the Disclaimer Requirement

As noted by applicant, the term “village,” when applied to an incorporated area, can be defined as “a settlement usually larger than a hamlet and smaller than a town” or as “an incorporated minor municipality.” *Please see Applicant's Response to Action, 04/30/09, page 2.* However, these are not the only meanings. The examining attorney respectfully asks that the Board take judicial notice of the following definitions of

“village:” “a temporary community,” “a small incorporated community,” or “a group of houses and other buildings . . . smaller than a town.”³

All of these definitions imply a location involving residences and other buildings, all of which are properties that may be leased or rented, and that would likely require real estate management services. Additionally, the definition as “a group of houses and other buildings” indicates that a particular form or layout of a group of buildings may constitute a village, as well.

B. Applicant’s Identification Does Not Exclude Villages From Its Services, and Therefore is Presumed to Include Villages

Applicant’s identification of services includes no restrictions on the communities or locations that its services will involve, that is, in what types of areas it will be renting and leasing property, or managing residential and commercial real estate. Nor does the identification exclude any particular format or layout that its properties may form.

Generally, when an application describes goods and/or services broadly, and does not include restrictions on the nature or type of the goods and/or services, it is presumed that the application encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With

³ “village.” Encarta World English Dictionary. 2009. Microsoft Corporation. 4 February 2010. <http://encarta.ms.nc.om/encet/features/dictionary/DictionaryResults.aspx?refid=1861734143>. *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 Canon, Inc.*, 219 USPQ820 (TTAB 1983); TBMP §1208.04. The examining attorney also notes that these definitions were intended for inclusion with the Final Refusal of May 20, 2009, and were inadvertently not properly attached. The examining attorney included the definitions in the body of that action, and applicant’s appeal brief referenced those definitions without challenging their validity. *Please see Applicant’s Appeal Brief, 09/24/09, page 4.*

reference to the channels of trade, applicant's argument that its goods are sold only in its own retail stores is not persuasive There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold."); TMEP §1207.01(a)(iii).

Here, with no limitations included in applicant's identification, it is presumed that the application encompasses rental and leasing services, as well as real estate management services, pertaining to villages. Even if applicant's services involve other types of locations, as well, it does not obviate the requirement. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

Thus, if the application includes rental, leasing, and/or real estate management services that pertain to villages, the term VILLAGE is descriptive in relation to the services. Since the identification contains no limitations on the scope of the services, its inclusion of villages is presumed.

C. Prior Registrations of the Office for Similar Services Have Probative Value in Showing That "Village" is Descriptive of the Services

In support of the finding of VILLAGE as descriptive in relation to the identified services, the examining attorney submitted to applicant a representative sample of 18 third-party registrations (out of a total of 57 registrations) in which the wording

VILLAGE was disclaimed for the same or similar services as those of applicant in this case. *Please see attachments to Office Action, 02/23/09, pages 2-50.*

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).

Those attached third party registrations show real estate services, and particularly leasing, renting, and real estate management services, and all registered within the last eight years or less; all but five of them registered within the last four years or less. In each case, the registration includes a disclaimer of VILLAGE apart from the mark as shown, demonstrating that the Office found the term VILLAGE to be descriptive when used in connection to the types of services listed in the present application.

D. Applicant's Arguments Do Not Support Registration Without a Disclaimer

Applicant claims that the term VILLAGE in the mark "does not directly impart information about real estate rental services or management of residential and commercial real estate." *Please see Applicant's Appeal Brief, 09/24/09, page 4.* In support of this claim, applicant included dictionary definitions of "village" as "a settlement usually larger than a hamlet and smaller than a town" or as "an incorporated

minor municipality,” and indicating that these definitions did not relate to rental services or the management of real property. *Id.* Rather, applicant continued, “village” is a broad term with a variety of definitions. *Id.*

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). And, as previously indicated, it is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

Here, applicant’s services involve real estate management, as well as renting and leasing of “houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities.” These are the types of residential and commercial homes and buildings that one would expect to find in a village or in a layout of buildings organized as a village. Even though the definitions of “village” do not use the terms “renting,” “leasing,” or “real estate management,” this

wording is still descriptive in relation to applicant's services which pertain to properties found in villages or organized as villages.

It should also be noted that descriptiveness is considered in relation to the relevant goods and/or services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

Thus, even if VILLAGE is "a very broad term," as applicant claims, both the definitions listed by applicant and those listed above in Section II.A clearly indicate that VILLAGE is descriptive in relation to these particular services, and the disclaimer requirement is therefore appropriate.

Applicant next claims that VILLAGE is suggestive because it requires thought or imagination to connect it to applicant's particular services.

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. In contrast, 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); TMEP §1209.01(a); see *In re Shutts*, 217 USPQ 363, 364 (TTAB 1983).

In this instance, the term VILLAGE immediately conveys the idea that the properties that applicant is renting, leasing, or managing are located in a village, or are organized in such a manner as to resemble or form a village. No imagination or further thought process is necessary to connect the concept of what a village is to applicant's use of the term VILLAGE for such basic real estate services.

Finally, applicant contends that a number of third party registrations for services similar to its own did not require a disclaimer for VILLAGE, and that this would show that a disclaimer should not be required here, either. *Please see Applicant's Response to Action, 04/30/09, page 3 and Applicant's Appeal Brief, 09/24/09, pages 5-6.* To substantiate this claim, applicant stated that it had found "105 live records of third-party registrations" with similar services and no disclaimer of VILLAGE, and attached 10 examples for illustrative purposes. *Please see Applicant's Response to Action, 04/30/09, pages 3, 5-7, and 10-20.* However, applicant's TESS printout list of the 105 marks shows that a number of the listed entries are only applications, and had not yet matured to registration, and thus are not probative on the question of what is required for registration. *See Zappia-Paradiso, S.A. v. Cojeva Inc.*, 144 USPQ 101, 102 n.4 (TTAB 1964) (Board noted that a pending application "is incompetent as proof of anything other than the fact that such an application for registration was filed in the Patent Office)." *See also Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981) ("Introduction of the record of a pending application is competent to prove only the filing thereof") and *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1050 n.4 (TTAB 2002) ("While applicant also submitted a copy of a third party application ... such has no probative value other than as evidence that the application was filed").

Additionally, although applicant later indicated in its Appeal Brief that the 105 marks were all for the Principal Register, no such claim was made in the original response that included the list. Further, there is no indication as to whether any of the marks listed include a Section 2(f) claim of acquired distinctiveness in place of a disclaimer on VILLAGE.

Accordingly, applicant's arguments in favor of registration of its mark without a disclaimer of VILLAGE fail to support its claim that VILLAGE is suggestive, and do not obviate the need for the disclaimer requirement.

CONCLUSION

The wording VILLAGE is merely descriptive in relation to "real estate rental services, namely, rental and leasing of houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities; management of residential and commercial real estate," and exclusive rights to this term must be disclaimed. Therefore, the Board is respectfully requested to affirm the requirement to disclaim the term VILLAGE under 15 U.S.C. §1056(a); TMEP §1213.

Respectfully submitted,

/Lydia M. Belzer/
Trademark Examining Attorney
Law Office 108
571-272-5594
Lydia.Belzer@uspto.gov (informal
responses only)
Andrew Lawrence
Managing Attorney
Law Office - 108