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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 77589735 |
| Applicant | Adventist Health System/Sunbelt, Inc. |
| Applied for Mark | HEALTH VILLAGE |
| Correspondence Address | R. LEE BENNETT<br>GRAYROBINSON, P.A.<br>301 E PINE STREET, SUITE 1400<br>ORLANDO, FL 32801-2741<br>UNITED STATES<br>RBennett@gray-robinson.com |
| Submission | Reply Brief |
| Attachments | Health Village IC 36 Reply Brief.tif ( 4 pages )(194794 bytes ) |
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| Signature | /Lee Bennett/ |
| Date | 03/01/2010 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|---|---|---|
| In re Application for "HEALTH VILLAGE" | ) | Law Office 108 |
| | ) | |
| Serial No.: 77/589735 | ) | Trademark Attorney |
| | ) | Heather A. Sapp[1] |
| Filed: October 9, 2008 | ) | |
| | ) | |
| Applicant: Adventist Health System/Sunbelt, Inc. | ) | |
| | ) | |

**APPLICANT'S REPLY BRIEF**

I. Section A. of Examining Attorney's Appeal Brief

The Examining Attorney asks the Board to take judicial notice of the following additional definitions of "village:"

- temporary community;
- small incorporated community; or
- group of houses and other buildings . . . smaller than a town.

If the Board is to take judicial notice of additional definitions of "village," Applicant asks that the Board apply the entire definition as listed in the excerpt of the Encarta World English Dictionary that was attached to Examining Attorney's Appeal Brief:

- temporary community: in some U.S. states, a community that is smaller than a town but that is similarly incorporated;
- small incorporated 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; or
- rural community: a group of houses and other buildings in a rural area, smaller than a town

[1] Lydia M. Belzer signed the Examining Attorney's Appeal Brief and footnote 1 of the Examining Attorney's Appeal Brief states that Ms. Belzer is replacing Heather A. Sapp for purposes of the brief.

These definitions of "village" are either substantially similar to the definitions proffered by Applicant or are specific and narrow definitions that do not assist in determining the general meaning of the term.

The Examining Attorney's attempt at shortening the definitions to fit her argument demonstrates that the term "VILLAGE" is suggestive, not merely descriptive. To illustrate, the Examining Attorney argues that the phrase "a group of houses and buildings" indicates a particular form or layout, but she neglects to mention that this phrase is used only to describe a rural community. Such definition of the term "village" appears to be unnecessarily narrow and not relevant to this matter. Nevertheless, the Examining Attorney appears to agree that "VILLAGE" is suggestive by stating: "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." (emphasis added). Consequently, the requested disclaimer is unnecessary.

II. Section B. of Examining Attorney's Appeal Brief

The Examining Attorney appears to argue that Applicant's identification of services is presumed to include villages because villages were not expressly excluded from it services. The Examining Attorney appears to be missing the target by arguing that the term is merely descriptive even if the services involve other types of locations. The issue is whether the term "VILLAGE" is merely descriptive of the services to be offered by Applicant. Applicant agrees that a grouping of buildings and structures may resemble a village or other type of location. However, the term "VILLAGE" does not directly impart information about the rental services or management of real estate to be offered by Applicant. Although the term "VILLAGE" may describe different groupings of buildings and structures, it does not convey an immediate idea of

a function or feature with respect to real estate rental services or management of residential and commercial real estate. As a result, the required disclaimer is unnecessary because the use of the term "VILLAGE" in Applicant's mark is suggestive, not merely descriptive.

III. Section C. of Examining Attorney's Appeal Brief

The Examining Attorney identifies third party registrations disclaiming the term "VILLAGE" to demonstrate that it is merely descriptive. It is hard to measure the persuasiveness to be attributed to third party registrations because of the different circumstances surrounding how these other applicants came to their decisions that the disclaimer was necessary in their situation. Furthermore, Applicant provided the Examining Attorney other third party registrations that did not require a disclaimer for the term "VILLAGE." See Applicant's response to the second Office Action, filed on April 30, 2009. Applicant agrees with Examining Attorney's statement in her Final Office Action, dated May 20, 2009: "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)."

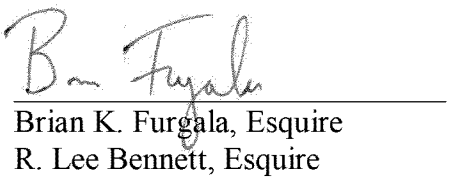
IV. Section D. of Examining Attorney's Appeal Brief

The Examining Attorney makes further conclusory statements without providing support. First, she concludes that, "[e]ven 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." Second, she concludes that, "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."

To the contrary, the term "VILLAGE" does not directly describe any aspect of real estate rental services or management. The term merely describes the organization or location of building or structures. The rental, leasing or management of those buildings or structures is one or more steps removed from that description. If one must follow a multi-stage reasoning process in order to determine what service characteristics are indicated by the term, the term is suggestive rather than merely descriptive. In re Tennis in the Round, Inc., 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978). As a result, the term "VILLAGE" is suggestive of the Applicant's real estate rental services or management and, therefore, no disclaimer is required.

For the reasons set forth above and in the previously filed Brief for Applicant, Applicant submits that that the Examining Attorney did not meet her burden of proof that the term "VILLAGE" in Applicant's mark is merely descriptive, because the term is, in fact, suggestive. Accordingly, Applicant respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney's decision requiring a disclaimer of the term "VILLAGE" prior to registration of Applicant's mark.

Respectfully submitted:



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