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This Opinion Is Not a Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Doctors Making Housecalls, LLC

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Serial No. 85324528

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Eric P. Stevens, Esq. of Poyner Spruil LLP for Doctors Making Housecalls, LLC.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Zervas, Wellington, and Gorowitz, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Doctors Making Housecalls, LLC (applicant) applied to register DOCTORS MAKING HOUSECALLS, in standard character form, on the Principal Register as a mark for "providing on-site medical services to patients at their homes, apartments, senior communities, offices, or other designated locations" in International Class 44.[1] The application is based on Section 1(a) of the Trademark Act (use in commerce) with a claim of first use anywhere and in

commerce on January 1, 2004. The application also contains a claim that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act.

The examining attorney ultimately refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because the proposed mark is generic for the identified services. In the event that the mark is not found to be generic, the examining attorney alternatively refused registration because applicant has not demonstrated that the proposed mark has acquired distinctiveness.

Genericness

"Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold. They are by definition incapable of indicating a particular source of the goods or services." *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2011) (citations omitted).

The ultimate test for determining whether a term is generic is the primary significance of the term to the relevant public. *See* Section 14(3) of the Act. As explained by the Court of Appeals for the Federal Circuit in *H. Marvin Ginn Corp. v. International Ass'n of Fire*

[1] Application Serial No. 85324528 was filed on May 19, 2011.

Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), "[T]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Deciding this issue essentially involves a two-step analysis:

> First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id. See also, In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB, Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). Finally, in making our determination, we keep in mind that the burden rests with the examining attorney to prove genericness by "clear evidence." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).*

The Genus of Services

Applicant and the examining attorney disagree with respect to the relevant genus of services.

Applicant asserts that the genus of services should be simply and broadly construed as "medical services."

Applicant's brief, p. 6. Applicant contends that while it does indeed perform services in the nature of medical visits to homes and offices of patients, this is not the 'genus' because its services also "consist of numerous procedures, including, but not limited to, X-rays, medical imaging studies, electrocardiograms, and blood drawing, and they also extend to clerical services, such as the filing of private insurance claims and Medicare claims." *Id.* at 7. In other words, applicant believes that "the entire breadth of [its] services extends far beyond a mere 'visit' to a home or office, the genus of [its] services is [therefore] properly defined as 'medical services.'" *Id.*

The examining attorney, on the other hand, argues the relevant genus of services is adequately set forth in the application, namely, "providing on-site medical services to patients at their homes, apartments ..." and sees no merit in utilizing a different genus merely because applicant's medical services are more varied in scope. He rebuts that "[t]he fact that the applicant provides other services has no bearing [on] the issue of genericness, since that determination is based on the services in question." Brief, p. 4.

Here, we agree with the examining attorney and find that the genus of services is adequately defined by the

application's recitation of services, again, "providing on-site medical services to patients at their homes, apartments ... ." See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration."); see also, *Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007). This is not to say we have ignored or somehow discounted the holding in *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005). In *Steelbuilding.com*, the Court of Appeals for the Federal Circuit found the Board misunderstood the proper genus by limiting the recited services ("computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems") and not taking into consideration evidence of applicant's website. The Federal Circuit found that applicant's website were "more than an on-line catalogue" and the Board failed to appreciate evidence displaying the "interactive design feature of the applicant's goods and services." *Id.* at 1298. Indeed, the reasoning in *Steelbuilding.com* may be viewed as supporting, or validating, that the genus is appropriately set forth in the application's recitation of services. That is, the

evidence of record reflects that applicant renders primary care medical services to patients "aged 5 to 105" and "across the entire socioeconomic spectrum," and that these services are provided as "We Come to You!" or "We Do It All – In Your Own Environment" and "Never Wait In a Doctor's Office Again." See specimen of use (a brochure) submitted with application. Based on the evidence, "providing on-site medical services to patients at their homes, apartments, senior communities, offices, or other designated locations" is the apt genus of services for purposes of our genericness analysis.

Is the Proposed Mark Understood by the Relevant Consumer to Refer to That Genus of Services?

"Next, we must determine the relevant public for applicant's [services]." *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1536 (TTAB 2007). In this case and, again, as exemplified by the specimen of use in the application, applicant's medical services are offered on-site to patients of nearly all ages and all socio-economic levels. In other words, the relevant public is the general public or, more specifically, anyone in need of medical care. The question now is whether members of the relevant public would understand the term DOCTORS MAKING HOUSECALLS to refer to the recited services. *Marvin Ginn*, 228 USPQ at

530. "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." *In re Merrill Lynch, Fenner and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

The record created by the examining attorney in this case clearly and convincingly shows that the public would understand DOCTORS MAKING HOUSECALLS to be the name used for the recited services. The dictionary definitions for the terms "doctor" and "housecall" were attached to the first Office action.[2] The latter term is defined as "[a] professional visit made to a home, especially by a physician." Thus, for purposes of showing the plain meaning of the combination of terms comprising the proposed mark, the mark clearly means physicians (or "doctors") making professional visits to a home.

We are well aware that when a proposed mark is a phrase, as in this proceeding with DOCTORS MAKING HOUSECALLS, it is not enough to "simply cite definitions and generic uses of the constituent terms" of the proposed mark "in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole." *In re American Fertility*,

188 F.3d at 1347, 51 USPQ2d at 1836. The evidence must show "that the phrase as whole...has acquired no additional meaning to the relevant public than the terms...have individually." *Id.* at 1349.

With this in mind, we note the examining attorney submitted, inter alia, the following evidence:

1. Copy of a New York Times Article "Retro Medicine: Doctors Making House Calls (for a Price)." The article contains the following relevant excerpts:

   "some of the doctors are in private practice or work in hospitals, and they make house calls during their time off"

   "But most health maintenance organizations would not typically cover any out-of-network house calls"

   "When making house calls, 'you get paid,' said Dr. Steven Meed, one of eight New York physicians working for Sickday Medical House Calls, which started last year and serves patients in Manhattan."

2. Twelve (12) LEXIS-NEXIS articles, each containing the phrase "doctors making housecalls" in the text of the article. Excerpts include:

   "Many in town remember the Smith doctors making housecalls to deliver babies..." (from Times Record Arkansas, July 10, 2011);

   "...this personalization of health care hearkens to days of doctors making housecalls 'when they became part of your family' and could be a key component to the primary care preventive approach to medicine" (from Targeted News Service, November 15, 2010);

   "There are clear healthcare benefits here – doctors making housecalls in remote areas can transmit images

[2] Issued September 16, 2011.

to their laptops via Bluetooth...” (from Newstex Web Blogs, March 21, 2008);

“In Paris, Moore rides shotgun with a doctor making housecalls for emergencies and not-quite emergencies...” (from The Denver Post, June 29, 2007);

“It’s not quite the same as doctors making housecalls, but it is community outreach of the best kind” (from Fort Wayne News Sentinel, June 27, 2003);

“The days of the family doctor making housecalls to a patient who has been in his care since childhood are long gone” (from The Boston Globe, September 22, 2002);

“There’s a swing back to personal care, like home visits, only instead of doctors making housecalls, the norm is for community and private health-care providers like nurses to pay visits to the incapacitated.” (from The Leader-Post, January 1, 2000); and

“Why Doctors are Making Housecalls. ...house calls are making a modest comeback, driven not by nostalgia, but by the desire to cut hospital bills over the long term...Dr. Joe Rossini is making a house call to a critically ill 59-year-old woman...Caremore Medical started sending doctors on house calls three months ago… (from transcript of CNN Moneyline News Hour with Lou Dobbs, May 14, 1999).

3. Printout of article “UW Family Medicine Doctors Making House Calls” from University of Wisconsin Department of Family Medicine website (www.fammed.wisc.edu), an excerpt from the article provides:

“Dr. Melissa Stiles includes house calls as part of her practice at the University of Wisconsin Belleville Clinic. ‘I think it’s important, especially in a rural community, to offer this service,’ said Stiles, a family physician. Stiles said a typical visit can feel cold, sterile and impersonal, while house calls are a service moving toward more personalized health care.”

4. Printout of article "Local Doctors Making House Calls" (from local Cleveland television news channel website, www.newsnet5.com)

5. A printout from the York Daily Record/ York Sunday News article "Remember: Doctors making house calls" (November 19, 2010, www.ydr.com); and

6. A printout from the TribLIVE News (Pittsburgh Tribune-Review) website article "Doctors making house calls are making a comeback" (July 29, 2010, www.pittsburghlive.com).

Based on the entire record, we find the examining attorney has shown by clear and compelling evidence that the phrase "doctors making housecalls" is used by the general public, including those seeking medical attention, and would thus be readily understood by the relevant consumer, to refer to medical services rendered on-site in the patient's home, office, etc. While it is also evident that the term "housecalls" may nostalgically conjure a once-common service offered by doctors, this does not detract from the primary significance of the proposed mark to the relevant public. As the evidence clearly shows, the practice of doctors visiting patients in their home continues and the phrase "doctors making housecalls" is used and understood as a common reference for this type of service.

Applicant's arguments are unpersuasive in the face of the record we have before us. In particular, going back to

applicant's assertion that the genus of services is more appropriately construed as "medical services," this would not change matters. That is, even if we were to accept such a construction of the relevant genus of services, and we do not, it would simply mean that applicant's proposed mark identifies a subgenus, namely, providing medical services on-site. It is settled law that registration will be refused for a term that is generic of a category or class of products (or services) where some but not all of the goods (or services) identified fall within that category. *See In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988); affirmed unpublished at 10 USPQ2d 1879 (Fed. Cir. 1989).

Further, it would be nonsensical to construe *Steelbuilding.com* or any other decision as permitting a party to obtain a registration of generic term for one type of service simply based on evidence showing that said applicant renders a broader range of services than those it seeks to register. Simply put, the fact that applicant may render a wide-range of medical services, including related clerical services, is irrelevant to our determination that DOCTORS MAKING HOUSECALLS is a term that will be primarily understood by the relevant purchasing public as the common name for the services recited in the application.

In conclusion, there is ample evidence of record and the examining attorney has sufficiently made out a prima facie case that DOCTORS MAKING HOUSECALLS is generic for the recited services. We have no doubt that consumers, upon viewing this term in connection with the recited services, will clearly understand this term as a generic reference to a doctors visiting patients in their homes. The term is thus incapable of functioning as a registrable trademark denoting the source of the recited services.

Applicant also cites to third party registrations for marks containing the term HOUSECALLS or HOUSE CALL(S) and argues these support its position that DOCTORS MAKING HOUSECALLS is not generic. In particular, it points to the following:

1. CORPORATE HOUSE CALLS (the term HOUSE CALLS is disclaimed) for "physician services, medical testing, and medical counseling" services;[3]

2. THE PHARMACY THAT MAKES HOUSE CALLS (the term PHARMACY is disclaimed) for "home delivery of pharmacy products and medicines" services;[4]

3. HOUSE CALL RADIOLOGY (the term RADIOLOGY is disclaimed)[5] for "medical radiology services"; and

4. AM/PM HOUSE CALLS for "medical services."[6]

[3] Registration No. 3064439 issued February 28, 2006.
[4] Registration No. 3530334 issue November 11, 2008.
[5] Registration No. 3902611 issued on July 11, 2011.
[6] Registration No. 3429826 issued on May 20, 2008.

We do not ignore these four registrations and, as applicant points out, the Office should strive for consistency in examination. However, we see little significance in the existence of these third-party registrations vis-à-vis the issue of whether applicant's proposed mark is generic. In all but one of these registrations, the term "house call(s)" was held to be at least descriptive for the recited services. Presumably the wording of the mark HOUSE CALL RADIOLOGY, as a whole, was decided not to be merely descriptive in connection with "medical radiology services." We note all four registrations feature marks that are quite different from what applicant proposes, especially when considered in the context of the respective services. Moreover, we are not privy to the evidence of record that may have supported a finding that the entire mark is not merely descriptive or even generic. In any event, we can hardly base a decision of genericness on these four registrations nor are we bound by the prior decisions of examining attorneys. *In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) ("the PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the agency or this court,") citing *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed.

Cir. 2001). Rather, focusing on this proceeding and the record before us, we find the examining attorney has presented clear and convincing evidence that DOCTORS MAKING HOUSECALLS would be primarily understood by as a generic reference to the services recited in the application.

If a term is generic, no amount of evidence of acquired distinctiveness can establish that the mark is registrable. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985). On the other hand, if applicant's term is ultimately determined to not be generic, we now consider the alternative ground for refusal registration involving acquired distinctiveness.

Acquired Distinctiveness

Inasmuch as applicant is seeking registration under Section 2(f), there is no issue that its mark is merely descriptive. *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). In order to register its mark under Section 2(f), applicant bears the burden of

proving that its mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). The amount and character of such evidence depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha Int'l*, 6 USPQ2d at 1008. *See also, In re Bongrain*, 13 USPQ2d 1727 (Fed. Cir. 1990). This evidence can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition.

As far as evidence, applicant relies heavily on an affidavit signed by its president, Dr. Alan Kronhaus, who avers that, *inter alia*, applicant has:

- Used the proposed mark for nearly ten years;
- Spent between $100,000 to $200,000 annually during these years advertising its services using the mark in print and radio advertising, listings in white pages and display advertisements in yellow pages, online

Google advertisements, its own website and "hundreds of thousands of pieces of direct mail."

- Received "extensive" unsolicited coverage, including "numerous" newspaper and magazine articles regarding applicant's business and a forty-five minute radio interview on a local National Public Radio (NPR) station; and

- Offered numerous presentations, given by Dr. Kronhaus, in which the proposed mark is used "to indicate to [Dr. Kronhaus'] professional peers the name in which [applicant] provides services to consumers."

Applicant also submitted exhibits with the affidavit that includes copies of approximately nine newspaper and magazine articles featuring applicant and its services, including reference to "Doctors Making Housecalls" being the name of the service. Applicant also submitted a CD-ROM (and MP3 files) containing portions of the NPR "State of Things" segment interview.

Based on the entire record, we find that applicant has not made a showing that its mark has acquired distinctiveness. We do not hesitate to point out that applicant's burden is great in light of our finding that the mark is, at a minimum, highly descriptive. In other words, should the mark be found not to be generic, it is at least so highly descriptive thus necessitating a greater amount of evidence establishing acquired distinctiveness.

With respect to applicant's length of use, it is true that evidence of substantially exclusive use for a number

of years may be considered as evidence of acquired distinctiveness. However, the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case. *See Yamaha*, 840 F.2d at 1576, 6 USPQ2d at 1004. Here, we find applicant's ten years of use to be simply insufficient, in itself or in conjunction with the other evidence of record, to show that DOCTORS MAKING HOUSECALLS has acquired distinctiveness. In addition, the examining attorney has shown that the phrase "doctors making housecalls" being used to reference the type of services described in the application without any clear reference to applicant.

As far as advertising, applicant's stated expenditures in this regard are not insubstantial. Nevertheless, as often stated, a fruitful or robust advertising campaign is not in itself necessarily enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark). Here, the advertising figures fail to reflect consumer or public reaction to applicant's use of DOCTORS

MAKING HOUSECALLS. Moreover, it is telling that in the State of the Nation radio segment submitted by applicant, the phrase "doctors making housecalls" is used by the radio host repeatedly to merely describe the type of practice of doctors visiting patients in their homes and not as a specific reference to applicant's business.

Finally, while the Board does not require any specific type of evidence to show acquired distinctiveness, we would be remiss if we did not point out the lack of evidence reflecting how many consumers have actually been exposed to applicant's use of this phrase in connection with the services being rendered, *e.g.*, the number of patients who have received on-site medical services from applicant in their homes. In a similar vein, the record does not include declarations from persons stating that they actually view the term "doctors making housecalls" as a specific reference to applicant in lieu of any highly descriptive meaning that can be attributed to this phrase.

Accordingly, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the DOCTORS MAKING HOUSECALLS has acquired distinctiveness. Thus, even if the mark were ultimately determined to not be generic, the alternative

ground that the mark is merely descriptive and has not acquired distinctiveness is likewise affirmed.

Conclusion

Applicant's term is generic in connection with the services recited in the application and thus incapable of distinguishing the services. In the event that the term is ultimately decided on appeal to not be generic for the recited services, applicant has not demonstrated that its mark has acquired distinctiveness.

Decision: The refusals to register is affirmed.