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Subject: U.S. TRADEMARK APPLICATION NO. 85690501 - MEMORY CARE LIVING - 219-002 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 85690501

**MARK:** MEMORY CARE LIVING



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** PHNJ, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

219-002

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PHNJ, LLC : BEFORE THE

Trademark: MEMORY CARE LIVING : TRADEMARK TRIAL

Serial No.: 85690501 : AND

Attorney: LISA D. TAYLOR : APPEAL BOARD

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark MEMORY CARE LIVING for "management of health care clinics for others" in International Class 35 and "geriatric health care management services; health care; health care services, namely, disease management programs; managed health care services; nursing care; nursing homes; nursing services" in International Class 44 on the grounds of descriptiveness under Trademark Act Section 2(e)(1).

## FACTS

The applicant applied for registration on the Principal Register for the trademark MEMORY CARE LIVING for “management of health care clinics for others” in International Class 35 and “geriatric health care management services; health care; health care services, namely, disease management programs; managed health care services; nursing care; nursing homes; nursing services” in International Class 44 on July 30, 2012. The examining attorney issued an initial Office Action on November 14, 2012 refusing registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), based upon descriptiveness and requiring an amended color claim. In the response received on April 23, 2013, the applicant argued that the proposed mark is not descriptive of the relevant services and amended the color claim as required. A second Office action was issued on May 23, 2013 maintaining the refusal to register the applicant’s mark under Section 2(e)(1), noting that the applicant filed an identical co-pending application in Serial No. 85797720 which was approved for registration on the Supplemental Register. The second Office action advised the applicant that a duplicate registration of the mark for identical services would not be allowed on the Supplemental Register. The applicant filed a second response on July 26, 2013 maintaining the argument that the proposed mark is not descriptive of the identified services. A final Office action issued August 19, 2013 refusing registration of the proposed mark under Section 2(e)(1). On September 24, 2013, the applicant filed a Petition to the Director of the United States Patent and Trademark Office for review of the refusal to register the mark under Section 2(e)(1). The Petition was denied on October 30, 2013 based upon the Director’s finding that there was no clear procedural error or abuse of discretion on the part of the examining attorney. The applicant filed a notice of appeal and its appeal brief with Trademark Trial and Appeal Board on December 20, 2013.

## ARGUMENT

### **THE MARK OF THE APPLICANT MERELY DESCRIBES THE APPLICANT'S SERVICES**

The examining attorney refused registration on the Principal Register because the proposed mark merely describes the applicant's identified services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's services. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

In its brief, the applicant represents that its services extend to two separate classes of clientele. For its business clients, the applicant is "responsible for the business, asset, and operational management of these business-to-consumer real properties, which are re-deployed as boarding homes for seniors and individuals with dementia." And to its direct consumers, namely, individual residents of the boarding homes, the applicant "provides supervision to the actual residents of boarding homes with activities of daily living but does not provide health care or assisted living services." The applicant further states that "It does not provide medical treatment, not does it provide rehabilitation, skilled nursing, or licensed healthcare services to the residents." Rather the applicant's employees "help the boarding home residents with their daily routine by monitoring self-administered medication, preparing and serving food, and providing and arranging for entertainment and activities, among other services." This

representation of the applicant's services seemingly contradicts the services identified in the application. Specifically, the applicant is seeking registration of the proposed mark MEMORY CARE LIVING in connection with "management of health care clinics for others" in International Class 35 and "geriatric health care management services; health care; health care services, namely, disease management programs; managed health care services; nursing care; nursing homes; nursing services" in International Class 44. Furthermore, the specimens of use submitted by the applicant on July 30, 2012, clearly show use of the mark in conjunction with the following pertinent information:

"Residential Communities Dedicated to Memory Care"

"Our Montville home has 15 private bedrooms where the resident can relax and still be completely under the supervision of expert caregivers in dementia-related issues."

"With 12 locations in northern and central New Jersey neighborhoods, there is a memory care home near you."

The final refusal to register the proposed mark under Section 2(e)(1) is based upon the services identified in the application. In addition to the applicant's descriptive use of the wording "memory care" in its specimens of use, the evidence of record establishes that the wording "memory care" is a common descriptive term used in the relevant trade and/or industry to identify and characterize services identical and related to those specified by the applicant. For example, attached to the August 19, 2013 final Office action are numerous web pages which show use of the descriptive wording "memory care" and "memory care living". Specifically, on Page 2 of the attachments Senior Vice President of Operations at Memory Care Living states, "At Memory Care Living, specialized **memory care** is at the heart of everything we do." Page 6 of the attachments includes the following statements: "GracePoint Assisted Living & Memory Care Suites" and "Your answer for warm, comfortable and compassionate assisted living, with specialized services for individuals in need of **memory care**." On Page 8, Waterford Senior Living makes the following representation: "Our new, specially designed, 29-unit complex offers a complete solution for **memory care living** and treatment." Page 10 identifies "Memory Care Articles and Resources," in addition to "Sarasota Memory Care Facilities" and "Nearby

Memory Care Facilities.” The nearby memory care facilities referenced on Pages 10 and 11 offer the following: “A caring and compassionate experience is what residents enjoy when they choose Summerfield Retirement as their assisted living or **memory care** community”; “At Village Place Retirement, seniors needing assisted living and **memory care** services will find many amenities and health care services that provide for their every need”; and “Bayside Terrace is a warm, safe and friendly community providing seniors a premier assisted living and **memory care living** experience in beautiful, sunny Florida.” On Page 13, Oak Meadows describes “The Woods” as “a secure, home-like environment where dedicated staff provides 24/7 personalized **memory care** assisted living.” CarDon & Associates Inc. on Page 16 represents: “CarDon communities offer memory-impaired residents with outstanding **memory care** support in specially designed centers at our communities,” “Safety, stability, and comfort in the **memory care living** environment are critical to providing quality care,” and “Special efforts are taken to know each **memory care** resident, their history, life experiences, desires, and needs.” Ecumen Meadows on Page 18 states: “Ecumen is a leader in **memory care**. We currently offer **memory care living** options in 20 communities, including Ecumen Meadows in Worthington.” On Page 20 of the attachments, it is apparent that “Arbor Lakes Senior Living provides seniors with arrangements for independent, assisted or **memory care living**.” Furthermore, on Page 22 Arbor Lakes Senior Living specifies that its memory care living includes “exclusive **memory care** suites”, “**memory care** apartments,” and a “**memory care** program” designed to engage “**memory care** residents”. Minneapolis Memory Care on Page 24 defines a “memory care living environment” as follows: “A **memory care living** environment is designed for people who suffer from some form of memory loss that ultimately makes it unsafe for them to continue to stay at home without any kind of assistance.” On Page 27, Ivy Ridge Living Memory Care characterizes its services as: “Every detail designed to create the ideal **memory care living** environment” and “Come discover elegant and opulent living while receiving the optimum **memory care** available.” Texas State Veterans Homes on Page 29 represents: “The **memory care** program at our Texas State Veterans Homes provide safety and security for veterans experiencing memory loss” and “The **memory care living** areas are bright and cheery, with soothing music playing throughout the day.” (Emphasis has been added to each of the referenced quotes). Additional descriptive references to “memory care living” appear on Pages 33, 35, 45, 48, and 57 of the attachments.

Furthermore, the registered marks attached to the November 14, 2012 and March 23, 2013 Office actions also indicate that the terms “memory care” and “living” are commonly used in connection with services that are the same as and/or related to those identified in the current application. For example, in U.S. Registration No. 4336304, the wording “Memory Care” is disclaimed apart from the mark as shown for “providing assisted living facilities.” In U.S. Registration No. 4241935, the wording “Memory Care” is disclaimed for “providing assisted living facilities.” In U.S. Registration No. 4233404, the wording “Living” is disclaimed for “providing assisted living facilities,” “providing respite care and memory care facilities,” and “providing long-term care facilities.” In U.S. Registration No. 4078120, the wording “Assisted Living & Memory Care Center” is disclaimed for “health-care services for individuals afflicted with dementia” and “personal care assistance of daily living, such as bathing, grooming and personal mobility for individuals afflicted with dementia.” In U.S. Registration No. 4005876, the wording “Memory Care Assisted ‘Living’ Neighborhoods” is disclaimed for “providing assisted living facilities for Alzheimer’s and dementia patients.” In U.S. Registration No. 3991043, the wording “Living” is disclaimed for “life care retirement home services.” In U.S. Registration No. 3880927, the wording “Senior Memory Care” is disclaimed for “providing long-term care facilities,” “providing memory care services,” and “skilled nursing care.” In U.S. Registration No. 3772478, the wording “Living” is disclaimed for “retirement housing and assisted living facilities” and “nursing homes, home health care, skilled nursing care, and providing outpatient rehabilitation facilities.” In U.S. Registration No. 3571022, the wording “Village Premier Memory Care” is disclaimed for “providing assisted living facilities to Alzheimer and dementia patients.” In U.S. Registration No. 3141348, the wording “Living” is disclaimed for “providing living services to the elderly, namely, personal care assistance of activities of daily living, such as bathing, grooming and personal mobility for mentally or physically challenged people” and providing living services to the elderly, namely, nursing care.”

Subsequent to filing the current application, the applicant filed application Serial No. 85/797720 on December 7, 2012 for registration of the exact same mark for identical services on the Supplemental Register. The mark in this second application registered on the Supplemental Register on May 28, 2013 as U.S. Registration No. 4344541 with a disclaimer of “Memory Care” apart from the mark as shown. The examining attorney notes that had this identical mark been eligible to register on the Principal Register, it would not have been allowed on the Supplemental Register. Pursuant to the Trademark Manual of Examining Procedure § 815.01, “[a]n application requesting registration on the Supplemental

Register must be amended to the Principal Register, or refused registration, if the mark is registrable on the Principal Register.” See *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 115 USPQ 96 (Comm’r Pats. 1957). The examining attorney maintains that there is no additional information or evidence in the current application which alters the previous finding that the mark is only eligible for registration on the Supplemental Register. The applicant’s offer to disclaim either “Memory Care” or “Living” apart from the mark as shown does not render the mark registrable on the Principal Register since all the wording in the mark has been found to be descriptive of the services identified in the application. Please note that if the applied-for mark is not registrable as a whole, a disclaimer will not make it registrable. TMEP §1213.06.

In response to the applicant’s argument that the wording in the mark does not immediately identify the applicant’s services of “re-deploying of distressed and/or underutilized real estate into operational boarding homes for seniors and individuals with dementia,” the examining attorney asserts that these particular services were not identified in the application as filed. The services in International Class 35, to which the applicant keeps referring to in its brief, encompass the management of health care clinics for others. From the specimens of use received on July 30, 2012, it is apparent that the primary focus of these health care clinics (as well as the applicant’s geriatric health care management services, health care, health care services, namely, disease management programs, managed health care services, nursing care, nursing homes, and nursing services) is “memory care living” for those residents experiencing or living with Alzheimer’s and dementia. The fact that a mark may not be descriptive of all the services specified in an application does not render it eligible for registration on the Principal Register. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1089 (TTAB 2012). “A descriptiveness refusal is proper ‘if the mark is descriptive of **any** of the [goods or] services for which registration is sought.’” (emphasis added). *In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). Furthermore, “[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the services are, but “**whether someone who knows what the goods and[/or] services are will understand the mark to convey information about them.**” (emphasis added). *DuoProSS Meditech Corp. v. Inviro*

*Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012). In this case, the evidence of record establishes the descriptiveness of the wording in the mark as applied to the identified services and shows that this wording is commonly used in the relevant trade and/or industry to identify and describe such services.

Although the applicant argues that any doubt regarding the mark’s descriptiveness should be resolved on applicant’s behalf, the evidence of record leaves no doubt that the mark is merely descriptive. *E.g.*, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006).

Based upon these findings, the information in the application, and the evidence in the record, the examining attorney maintains that the mark is merely descriptive of the identified services.

### **CONCLUSION**

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register the applicant’s mark under Section 2(e)(1) of the Trademark Act be affirmed.

Respectfully submitted,

/Tina L. Snapp/

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