

This Opinion is Not a
Precedent of the TTAB

Mailed: April 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Agadia Systems Inc.
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Serial No. 88943465
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Jayson M. Macyda, General Counsel
for Agadia Systems Inc.

Keri-Marie Cantone, Trademark Examining Attorney, Law Office 104,
Zach Cromer, Managing Attorney.

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Before Kuhlke, Wellington and Dunn,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Agadia Systems Inc. (“Applicant”) seeks registration on the Principal Register for the proposed mark FORMULARYHUB in standard characters for “Customizing computer software” in International Class 42.¹

The Trademark Examining Attorney has refused registration of Applicant’s proposed mark under: (i) Section 2(e)(1), 15 U.S.C. § 2(e)(1), on the basis that the

¹ Application Serial No. 88943465, filed on June 2, 2020, based on an allegation of first use and first use in commerce on May 29, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

proposed mark is merely descriptive of Applicant's services; and (ii) Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127 on the basis the specimen of use does not evidence an association between the mark and the services specified in the application.

After the Final Office Action, Applicant appealed and requested reconsideration. On July 12, 2022, the Examining Attorney denied the request and the Board resumed the appeal. The appeal is fully briefed. We affirm the refusal under Section 2(e)(1).²

I. Background/Waiver/Judicial and Equitable Estoppel

In addition to the use-based application for the mark FORMULARYHUB involved in this proceeding, Applicant filed an intent-to-use application for the mark FORMULARYHUB.COM for "Software design and development; Computer software design; Customizing computer software; Developing computer software" (International Class 42).³ During the prosecution of that second application, after Applicant appealed the refusal based on mere descriptiveness under Section 2(e)(1), the Examining Attorney withdrew the refusal. Upon withdrawal of the refusal, the appeal was terminated as moot. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1210 (June 2022) ("TBMP").

² As noted *infra*, we do not reach the specimen refusal. Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR).

³ Application Seral No. 90060221.

In view of the withdrawal of the mere descriptiveness refusal in that second application, Applicant argues that the doctrines of waiver, judicial estoppel and equitable estoppel preclude issuing the mere descriptiveness refusal here: “Having previously approved the mark for registration, the Examining Attorney has waived the government’s ability to challenge the mark anew in this proceeding.” App. Brief, 7 TTABVue 25. Waiver is “the ‘intentional relinquishment or abandonment of a known right.’” *In re Google Technology Holdings LLC*, 980 F.3d 858 (citing *United States v. Olano*, 507 U.S. 725 (1993)) (cleaned up). This relinquishment occurs within a proceeding, unlike the present situation where the action of purported waiver occurred in a different proceeding. The Examining Attorney’s decision to withdraw the mere descriptiveness refusal as to another application does not waive the USPTO’s right to maintain the mere descriptiveness refusal in this proceeding. It is well settled that each application must be decided on its own facts; the USPTO is not bound by prior decisions involving different records. *See In re Boulevard Ent., Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) §1209.03(a). Applicant argues that this “general rule” does not apply because the “rule” requires the earlier decision to publish or register a mark to be a mistake, and the Examining Attorney did not argue that FORMULARYHUB.COM was mistakenly approved. The requirement that the USPTO examine each application according to its own facts does not vary with perceived mistakes in examination. Whether or not the decision

to publish or register a mark in another application was mistaken does not impact the determination in this proceeding with a different record, different mark and different services.

Turning to judicial estoppel, “[a]s the label implies, judicial estoppel arises only from a position taken in an adjudicatory proceeding.” FEDERAL PRACTICE AND PROCEDURE (Wright & Miller) (“FPP”) § 4477 (April 2022 Update). Applicant contends that the “Board terminated the appeal based on the Examining Attorney’s approval of the mark on the principal register, and therefore ‘accepted’ the Examining Attorney’s position when it terminated the appeal.” App. Reply Brief, 10 TTABVUE 5. However, here there was no position taken by the Board in an adjudicatory proceeding. The termination was simply a ministerial act taken because the withdrawal by the USPTO mooted the proceeding. TBMP § 1210. At best, the purported inconsistent positions were taken by an Examining Attorney in ex parte examination of separate applications.⁴

With regard to equitable estoppel, in its reply brief Applicant asserts the USPTO’s appeal brief does not argue equitable estoppel, and so any opposition to its application is “deemed waived, abandoned, and the matter is conceded as a matter of law.” App. Reply Brief, 10 TTABVUE 4. Although the Examining Attorney may have argued collateral estoppel rather than addressing equitable estoppel, the application of

⁴ We further note, that although there are similarities in the applications, the marks are different. Even if the .com does not have source-identifying capability on its own, its presence does not foreclose consumer perception as trademark use for a mark in its entirety that incorporates .com. *USPTO v. Booking.com B.V.*, 591 U.S. ___, 2020 USPQ2d 10729 (2020).

estoppel is discretionary. *New Hampshire v. Maine*, 532 US 742, 750 (2001), *Data General Corp. v. Johnson*, 78 F.3d 1556, 1564-1565 (Fed. Cir. 1996). The elements of equitable estoppel are “(1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted.” *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). The application of equitable estoppel to the government has a high bar, *Robertson-Dewar v. Holder*, 646 F.3d 226, 229 (5th Cir. 2011), and requires a showing of affirmative misconduct. *Office of Personnel Management v. Richmond*, 496 U.S. 414 (1990); *Rumsfeld v. United Technologies Corp.*, 315 F.3d 1361, 1377 (Fed. Cir. 2003). One reason is that the application against the government must not damage the public interest. *U.S. v. Kim*, 806 F.3d 1161, 1168 (9th Cir. 2015). Here, the circumstances do not present a case for equitable estoppel because, at minimum, the underlying principle of Section 2(e)(1) of the Trademark Act is to protect all competitors’ ability to use descriptive terms for their business.⁵ In addition, the withdrawal of the mere descriptiveness refusal of a

⁵ Applicant also points to the Examining Attorney’s statement that there is “no restriction in the Trademark Act or Trademark Rules of Practice as to the period of time prior to registration when the USPTO may issue a new requirement or new refusal.” App. Brief, 7 TTABVUE 10. Applicant asserts application of such a rule would be unconstitutional. Applicant does not explain further (except for a reference to equal protection in its reply brief) but simply makes the assertion to preserve the issue for appeal. TBMP § 102.01 (“The Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. But this does not mean that parties who want to raise challenges to an act of Congress or other Constitutional claims should not include them in their pleadings. Like other claims, Constitutional claims should be raised before the

different mark could not reasonably lead Applicant to infer that no descriptiveness refusal would issue against this mark, and so there was no misleading conduct.

II. Evidentiary Objection

Applicant objects to the evidence attached to the Examining Attorney's December 9, 2021 Final Office Action and July 12, 2022 Reconsideration Letter because the "new evidence and new arguments" were not present in the prior Office Actions and with regard to the Reconsideration Letter the new evidence was not directed to the issue for which reconsideration was sought. Applicant's request for reconsideration challenged the final refusals on registration on the basis of both mere descriptiveness and the adequacy of the specimen; the Examining Attorney's response explained the denial of reconsideration and supplemented the evidence on descriptiveness. We disagree that the Examining Attorney's response exceeded the scope of the request for reconsideration. Applicant argues because the evidence and argument were not presented in the September 9, 2020 Office Action it is precluded "from having an opportunity to respond to the same." App. Brief, 7 TTABVUE 11. With regard to the Final Office Action, Applicant had an opportunity to respond through its request for reconsideration, and to respond to the request for reconsideration Applicant could

Board to consider in the first instance to avoid waiving them. Where a party raises a constitutional claim, the Board may address the claim or issues raised by the claim, including any factual or statutory premises underlying the claim." Cf. *BlackLight Power Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (affirming that USPTO officials acted with in their authority in a reasonable manner when withdrawing a patent from issuance in order to fulfill the USPTO's mission to issue valid patents, even after Notice of Allowance, payment of the issue fee, and notification of the issue date, and with publication of the drawing and claim in the *Official Gazette*).

have requested remand. Trademark Rule 2.142(d)(1), 37 C.F.R. § 2.142(d)(1). *Cf. In re Berkeley Lights, Inc.*, 2022 USPQ2d 1000, at *5 n.4 (TTAB 2022). The objection is denied on those grounds.

III. Is FORMULARYHUB Merely Descriptive of the Identified Services?

According to the Examining Attorney, FORMULARYHUB is merely descriptive because it “immediately informs consumers that the applicant customizes online software that creates a centralized location for a collection of formulas.” Ex. Att. Brief, 9 TTABVUE 6.

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the [services] of the applicant is merely descriptive . . . of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). A mark is “merely descriptive” within the meaning of Section 2(e)(1) if it conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017). “A mark need not immediately convey an idea of each and every specific feature of the [services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the [services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

Whether a mark is merely descriptive is “evaluated ‘in relation to the particular [services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the [services] because of the manner of its use or intended use,’” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)), and “not in the abstract or on the basis of guesswork.” *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). We ask “whether someone who knows what the [services] . . . are will understand the mark to convey information about them.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)).

A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the services are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what characteristics the term identifies, the term is suggestive rather than merely descriptive.

In re Tennis in the Round, Inc., 199 USPQ 496, 497 (TTAB 1978).

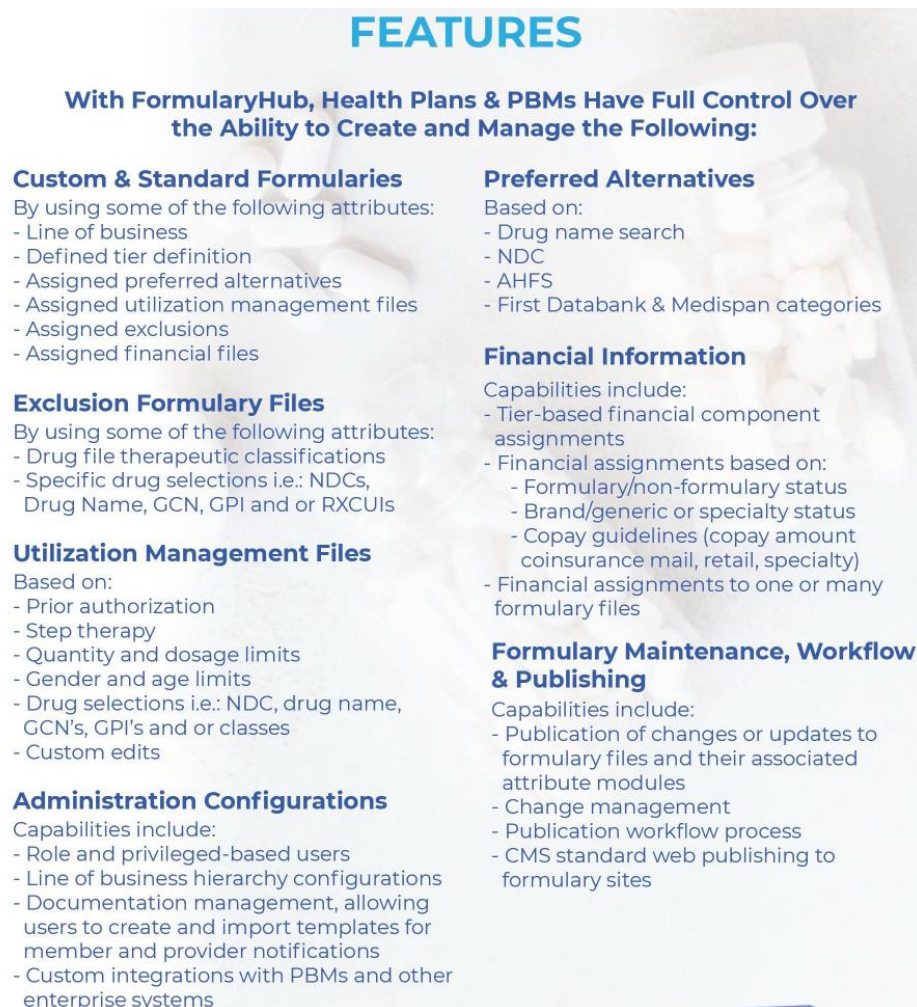
“We must ‘consider the **commercial impression** of a mark as a whole.’” *Fat Boys*, 118 USPQ2d at 1515 (quoting *Real Foods*, 128 USPQ2d at 1374). “In considering [the] mark as a whole, [we] ‘may not dissect the mark into isolated elements,’ without

consider[ing] . . . the entire mark,” *id.* (quoting *Real Foods*, 128 USPQ2d at 1374) (internal quotation omitted), “but we ‘may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.’” *Id.* (quoting *Real Foods*, 128 USPQ2d at 1374) (internal quotation omitted)). “Indeed, we are ‘required to examine the meaning of each component individually, and then determine whether the mark as a whole is merely descriptive.’” *Id.* (quoting *DuoProSS*, 103 USPQ2d at 1758).

“Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a non-descriptive word or phrase.” *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2019). “If the words in the proposed mark are individually descriptive of the identified goods, we must determine whether their combination ‘conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.’” *Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (quoting *Fat Boys*, 118 USPQ2d at 1515-16) (internal quotation omitted). “If each word instead ‘retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive.’” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1516) (internal quotation omitted). “A mark comprising a combination of merely descriptive components is registrable only if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services.” *Omniome, Inc.*, 2020 USPQ2d 3222, at *4.

In determining how the relevant consuming public perceives Applicant's proposed mark in connection with its identified services, we may consider any competent source, including dictionary definitions and Applicant's own advertising material and explanatory text. *See N.C. Lottery*, 123 USPQ2d at 1709-10; *Bayer*, 82 USPQ2d at 1831.

Applicant submitted as a specimen to show use of its mark an excerpt from a brochure, reproduced below:



The brochure shows the software functions for users as a centralized location for a collection of formularies.

Applicant's proposed mark FORMULARYHUB is a compound word consisting of the words FORMULARY and HUB. The Examining Attorney submitted dictionary definitions for FORMULARY including "a collection of formulas for the compounding of medicinal preparations..." December 9, 2021 Office Action, TSDR 42-43 (medical-dictionary.thefreedictionary.com). In addition, the Examining Attorney submitted excerpts from various third-party websites showing "formulary" as a term of art within Applicant's industry. For example this excerpt from healthcarevaluehub.org includes the following: "The Department of Health & Human Services requires health plans to use pharmacy and therapeutics (P&T) committees to ensure that formulary lists sufficiently cover prescription drugs...". December 9, 2021 Office Action, TSDR 51-54. Applicant points to the definition for FORMULARY as "[a] list of prescription drugs covered by a prescription drug plan or another insurance plan offering prescription drug benefits. Also called a drug list." App. Brief, 10 TTABVUE 13; March 8, 2021 Response, TSDR 41 (healthcare.gov). This definition is the most relevant in the context of the services. As Sri Swarna, Applicant's CEO, explains:

4. The following is a general background to assist in the review of Agadia's Application: Health insurance companies and pharmacy benefit managers across the country utilize formularies to manage their drug spend. A formulary is a list of drugs that are covered by a health plan. Multiple formularies are managed by the health plan based on the line of business (Commercial, Medicaid, Medicare etc.). Formularies must be constantly updated based on availability/non-availability of drugs and regulatory changes imposed by the state and federal government. Moreover, these formularies need to be integrated with third party systems such as claims engines and member/patient outreach programs. Managing all of

this is a very time consuming and complex job for health insurance companies and pharmacy benefit managers.

5. FormularyHub is a software-as-a-service solution that automates and streamlines the creation and management of these formularies. FormularyHub is licensed to customers and is hosted by Agadia on its infrastructure (Firewalls, servers, databases, etc.) which is accessed by customers on-line.

September 10, 2021 Response, TSDR 15 (Swarna Decl. ¶¶ 4, 5).

Applicant further explains that “FormularyHub ‘simplifies formulary management by enabling Health Plans and PMBs to create, administer, manage and publish both pharmacy and medical benefit formularies through a centralized solution in an automated fashion.” March 8, 2021 Response, TSDR 3 (quoting Exh. A excerpt from Applicant’s website).

The word FORMULARY is merely descriptive of a feature and purpose of Applicant’s software customization services because the purpose of the services is to keep track of formularies. This brings us to the second part of the mark, the word HUB. As Applicant explains the purpose of the software services is to manage the formularies “through a centralized solution.” HUB is defined as “the effective center of an activity, region, or network.” September 9, 2020 Office Action, TSDR 6 (www.lexico.com). In addition, an excerpt from Netlingo describes HUB as follows:

In computer terminology, a “hub” is a common connection point for devices in a network. For example, hubs are used to connect segments of a LAN. A hub has multiple ports so that when a packet arrives at one port, it is copied to the others so that all segments of the LAN can see all of the packets. Therefore, in data communications, a hub is a place of convergence, where data arrives from one or more directions and is forwarded out in one or more other directions.

The word “hub” was also used as one of the initial names for what is now known as a “portal.” It came from the idea of producing a Web site that would contain many different “portal spots” (small boxes that looked like ads and linked to other people’s content). Access to this content, combined with Internet technology, made the hub a milestone in the development and appearance of many Web sites. It was possible to display a lot of useful information without having to develop it all yourself. Despite its pioneering role, the term hub was later ditched for portal.

December 9, 2021 Office Action, TSDR 40 (www.netlingo.com).

Applicant contends that in the context of computers “[a] hub is the least intelligent of the tree hardware devices. It serves as a connection point for the computers (and other divides such as printers) in a network ... They are passive devices, they don’t have any software associated with it.” App. Brief, 7 TTABVUE 14; March 8, 2021 Response and Exhs. F, G, TSDR 3, 33 (www.themillergroup.com), 40 (www.tutorialspoint.com). Applicant concludes that FORMULARYHUB “means a physical piece of computer hardware (a connection point) named drug list.” App. Brief, 7 TTABVUE 16.

Applicant does not explain why a hardware meaning would be applied to customizing software services. In any event, Applicant’s website makes clear that it is providing a hub (or center) where formularies may be managed. As noted above, it is entirely acceptable to consider the component parts of a composite mark when divining the likely perception of the composite. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1336-37 (TTAB 2009) (“First, we examine the evidence concerning the meanings that would be ascribed to the term BATTLECAM and the separate terms BATTLE and CAM, when used with applicant’s goods.”) (citing *In re Zanova Inc.*, 59

USPQ2d 1300, 1302 (TTAB 2001) (ITool would be perceived as short for “internet tools” and was refused as descriptive for goods and services including software for creating Web pages); *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999) (DOC-CONTROL for document management software is merely descriptive because DOC-CONTROL is not incongruous, creates no double entendre, and does not create or present a commercial impression or meaning other than “document control.”); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991) (MULTI-VIS for multiple viscosity motor oil is merely descriptive because the plain meaning of the components comprising the term MULTI-VIS as confirmed by dictionary definitions, other evidence, and applicant’s specimens when considered in the context of applicant’s goods demonstrate there is nothing incongruous about the term MULTI-VIS or requires the exercise of mental processing to perceive the descriptive significance of such term as it relates to multiple viscosity motor oil)). *See also, In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1051 (TTAB 2006) (“Nor has the examining attorney engaged in impermissible dissection of a mark by determining that one term in the mark is descriptive and another generic. This is all part and parcel of routine examination of a multiword mark.”).

Having determined that each word is merely descriptive of Applicant’s services we look at FORMULARYHUB in its entirety. Viewed in its entirety, FORMULARYHUB does not present an incongruity or lose its descriptive meaning, rather it immediately informs the consumer that the customizing software services are to provide an “effective center of an activity, region, or network” for managing

formularies. The absence of a space between FORMULARY and HUB does not serve to remove the mere descriptiveness of the overall term. *In re 3Com Corp.*, 56 USPQ2d 1060, 1062 (TTAB 2000) (ATMLINK: the deletion of a space between the terms ATM and LINK does not transform the otherwise generic term into a trademark or change the commonly understood meaning of the term); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ 1628, 1631 (TTAB 1998) (the fact that MASSFLO is a telescoped, slightly misspelled version of “mass flow” does not transform a generic term into a trademark)). Prospective purchasers will not pause or cogitate on the possible meaning of FORMULARYHUB when used in connection with customizing computer software because it immediately describes the services as offering a hub for formularies. There is nothing incongruous about the term FORMULARYHUB. Each component retains its descriptive meaning in the combination. *See Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519, 19 USPQ2d 1056, 1059 (11th Cir. 1991) (the composite term INVESTACORP “literally convey[s] to the observer that [plaintiff] is in the business of investing in corporations.”); *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (FirsTier is merely descriptive of banking services because banks can be ranked in tiers “and that large high-quality banks whose client base includes large corporate accounts are referred to as ‘first tier banks.’”); *Greenliant Sys. Ltd.*, 97 USPQ2d at 1083 (NANDRIVE for “electronic integrated circuits” is generic because consumers will perceive the telescoped term as a stylized version of the generic term “nand drive”); *In re Petroglyph Games*, 91 USPQ2d at 1341-42 (BATTLECAM for computer game

software is merely descriptive because “the relevant class of purchasers will immediately understand BATTLECAM to describe a feature of computer game software.”).

We find that FORMULARYHUB used in connection with “Customizing computer software” is merely descriptive.⁶

Decision: We affirm the refusal to register Applicant’s proposed mark on the ground that it is merely descriptive of the services.

⁶ In view of our decision on the refusal based on mere descriptiveness we do not reach the specimen refusal. *In re SIPCA Holding SA*, 2021 USPQ2d 613, at *10-11 (TTAB 2021) (affirming refusal to register for failing to provide a definite identification and to respond to information requirements, but declining to reach likelihood of confusion refusal where applicant “was not sufficiently forthcoming, making a fair and complete consideration of the substantive issue (likelihood of confusion) impossible”); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (Board determined likelihood of confusion with respect to only one of the two cited registrations).