

From: Milton, Priscilla

Sent: 6/22/2007 3:45:16 PM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 78602188 - HEALTHCARE
DISTRIBUTORS INTERNATIONAL - HEAL6002/TJM

Attachment Information:

Count: 1

Files: 78602188.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/602188

APPLICANT: Healthcare Distribution Management Assoc ETC.

CORRESPONDENT ADDRESS:
THOMAS J. MOORE
BACON & THOMAS, PLLC
625 SLATERS LN FL 4
ALEXANDRIA, VA 22314-1169



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: HEALTHCARE DISTRIBUTORS INTERNATIONAL

CORRESPONDENT'S REFERENCE/DOCKET NO: HEAL6002/TJM

CORRESPONDENT EMAIL ADDRESS:
mail@baconthomas.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Attorney's refusal to register the trademark HEALTHCARE DISTRIBUTORS INTERNATIONAL under Section 2(e)(1) of the Trademark Act on the ground that the mark merely describes the services and because the Section 2(f) evidence is insufficient.

FACTS

On 4/5/2005, applicant, Healthcare Distribution Management Association, a corporation, filed to

register the mark “HEALTHCARE DISTRIBUTORS INTERNATIONAL,” for “publications,

namely, magazines, reports and newsletters in the field of healthcare product distribution;

downloadable electronic publications in the nature of magazines, reports and newsletters in the

field of healthcare product distribution; electronic publications in the nature of magazines, reports

and newsletters in the field of healthcare product distribution recorded on electronic and optical

media; association services, namely, promoting the interests of the distributors of healthcare

products, creating and exchanging knowledge that affects the future of distribution management,

and influencing the standards and business processes that produce efficient healthcare commerce;

online business directories featuring products, services and businesses related the distribution of

healthcare products; arranging and conducting trade show exhibitions in the field of the distribution

of healthcare products and the management of healthcare product distribution businesses; arranging

and conducting educational conferences in the field of the distribution of healthcare products and

healthcare product distribution businesses; arranging and conducting trade show exhibitions in the

field of the distribution of healthcare products to hospitals. The applicant made a Section 2(f)

claim of acquired distinctiveness based on applicant’s ownership of U.S. Registration No.

2888102, the mark being “HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION,”

(based upon section 2(f) and association disclaimed) for “publications and other printed matter,

namely newsletters, books, guides, directories, and catalogs featuring information on the distribution of health care products and pharmaceuticals; providing business information in the

field of product information, marketing and operational supply chain efficiency for others;

providing business information relating to the distribution of healthcare products and pharmaceuticals on a global computer network; business research; public and media relations;

electronic mail services; providing on-line electronic bulletin boards for transmission of messages

among computer users concerning products, services, and issues pertinent to the healthcare and

pharmaceutical distribution industries; providing Internet access; educational services, namely,

arranging and conducting educational and training conferences and seminars concerning marketing, sales, distribution, accounting, finance, technology and information services, personnel,

and regulatory compliance in the area of the distribution of health care products and

pharmaceuticals; association services, namely, promoting the interests of the healthcare products

and pharmaceuticals distribution industry; political advocacy and lobbying services in the fields of

healthcare and pharmaceuticals via the Internet.” The applicant claimed a bona fide intention to use

or use through the applicant's related company or licensee the mark in commerce.

In Office Action No. 1, the examining attorney refused registration pursuant to Section 2(e)(1) of

the Trademark Act because the proposed mark merely describes the goods/services and because

the prior U.S. Registration claimed in this application is insufficient to establish distinctiveness.

The examining attorney advised applicant that an amendment to the Supplemental Register would

normally be an appropriate response to this refusal. However, such a response is not appropriate

because the case was filed under Trademark Act Section 1(b), 15 U.S.C. §1051(b), and is not

eligible for registration on the Supplemental Register until an acceptable amendment to allege use

under 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§815.02, 816.02 and

1102.03. The examining attorney also advised applicant that a disclaimer of HEALTHCARE

DISTRIBUTORS would be required if applicant amended the application to seek registration on

the Supplemental Register and requested reclassification of services from class 44 into class 35.

In response to Office action No. 1, the applicant made arguments in support of registration,

primarily that the mark is suggestive when considered as a whole, that the mark is unitary and

inherently distinctive, and should be approved for publication without a disclaimer.

In Office action No. 2, the refusal under Trademark Act Section 2(e) (1) was made final and the

advisory concerning the Supplemental Register and disclaimer was continued.¹

In response to Office action No. 2, the applicant filed a Notice of Appeal and made a request for

reconsideration. The applicant made arguments that acquired distinctiveness has been established,

and argues that a disclaimer should not be required.

In Office action No. 3, the request for reconsideration was denied the final refusal under Section

2(e)1 was continued. However, the advisory concerning the disclaimer requirement was

withdrawn and the file was returned to the Trademark Trial and Appeal Board for resumption of

the appeal.

Thus, the only issue on appeal is whether the 2(e)(1) refusal should be maintained because

applicant's showing of acquired distinctiveness is insufficient to allow registration pursuant to

Trademark Act Section 2(f).

¹The examining attorney inadvertently failed to issue a final classification requirement. However, the decision as to the proper classification of goods or services is a purely administrative matter within the sole discretion of the United States Patent and Trademark Office. *In re Tee-Pak inc.*, 164 USPQ 88 (TTAB 1969). Amendment or correction may be done through an examiner's amendment, without any prior authorization by applicant or the applicant's attorney. *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999). See TMEP §702.02.

ARGUMENTS

1. THE DESIGNATION “HEALTHCARE DISTRIBUTORS INTERNATIONAL” IS MERELY DESCRIPTIVE OF THE SERVICES.

A term is merely descriptive if as applied to the services, it conveys to prospective purchasers no

more than information as to the ingredients, qualities, functions or features of the services in

connection with which the term is used. *See In re American Greetings Corp.*, 226 USPQ 365

(TTAB 1985) and *In re Brite Crest. Ltd* 204 USPQ 591(TTAB 1979).

The applicant intends to offer a variety of healthcare publications and services to healthcare

distributors. Use of the designation HEALTHCARE DISTRIBUTORS INTERNATIONAL in

connection with these goods/services is merely descriptive. The designation healthcare distributors

describe the intended users of the goods/services.² A mark that describes an intended user or group

of users of a product or service is merely descriptive, within the meaning of Section 2(e)(1). *In re*

Planalytics, Inc., 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely describes intended user of

² The examining attorney refers to the excerpted articles from the examining attorney's search in a computerized data base in which references to healthcare distributors used as a term in the industry appeared in several stories. See attachments to Office Action No. 1, dated 11/02/05.

risk management services in the field of pricing and purchasing natural gas); *Hunter Publishing*

Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely

descriptive of a trade journal directed toward users of large data processing systems; evidence

sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031

(TTAB 1984) (MOUNTAIN CAMPER merely describes intended users of retail and mail order

services in the field of outdoor equipment and apparel); *In re Gentex Corp.*, 151 USPQ 435 (TTAB

1966) (PARADER merely describes intended users of protective helmets, namely, parade marchers).

The addition of the wording INTERNATIONAL to HEALTHCARE DISTRIBUTORS does not

make the mark as a whole any less descriptive. The term “international” is merely descriptive of

services that are international in scope. *In re Institutional Investor, Inc.*, 229 USPQ 614 (TTAB

1986) (INTERNATIONAL BANKING INSTITUTE for organizing seminars for bank leaders of

major countries held incapable); *In re Billfish International Corp.*, 229 USPQ 152 (TTAB 1986)

(BILLFISH INTERNATIONAL CORPORATION merely descriptive of corporation involved with

billfish on an international scale); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205

USPQ 1233 (TTAB 1979) (INTERNATIONAL TRAVELERS CHEQUE merely descriptive of

financial consulting services that are international in scope).

The designation HEALTHCARE DISTRIBUTORS INTERNATIONAL as applied to applicant's

goods /services merely indicates that the applicant's provision of healthcare publications and

services directed to healthcare distributors are international in scope. Functioning in this manner

the designation in its entirety is merely descriptive. More importantly, the applicant's Section 2(f)

claim of acquired distinctiveness, which applicant made in the original application, is a concession

that the mark is not inherently distinctive and that it therefore is not registrable on the Principal

Register absent a sufficient showing of acquired distinctiveness. *See Yamaha International Corp. v.*

Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988) ;*In re Cabot Corp.*, 15

USPQ2d 1224 (TTAB 1990); *see also* TMEP §1212.02(b).

2. THE APPLICANT'S SHOWING OF ACQUIRED DISTINCTIVENESS IS INSUFFICIENT TO ALLOW REGISTRATION PURSUANT TO TRADEMARK ACT SECTION 2(F).

The examining attorney has the discretion to determine whether a claim of ownership of a prior

registration for the same or similar goods or services is enough to establish acquired

distinctiveness. The examining attorney should determine whether the respective marks are the

same and whether the respective goods and/or services are the same or similar.

A proposed mark is the "same mark as a previously-registered mark for the purpose of 37 C.F.R.

§2.41(b) if it is the "legal equivalent" of such a mark. A mark is the legal equivalent of another if it

creates the same, continuing commercial impression such that the consumer would consider them

both the same mark. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d

1866 (Fed. Cir. 1991). See also *O-M Bread Inc. v. United States Olympic Committee*, 36 USPQ2d

1041(Fed. Cir. 1995) ("OLYMPIC KIDS," and "OLYMPIC" marks are different, based primarily

on their differing commercial impressions); *American Paging Inc. v. American Mobilphone Inc.*,

13 USPQ2d 2006 (TTAB 1989)("AMERICAN MOBILPHONE" and Design is not legal equivalent of "AMERICAN MOBILPHONE PAGING" and Design).

Relying on *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, (Fed. Cir. 2001), the applicant

argues that the proposed mark HEALTHCARE DISTRIBUTORS INTERNATIONAL and

applicant's prior U.S. Registration HEALTHCARE DISTRUBUTION MANAGEMENT

ASSOCIATION are legal equivalents. The applicant contends that the first terms of the respective

marks, HEALTHCARE, are the same and because DISTRIBUTION and DISTRIBUTORS has a

very similar appearance, pronunciation and meaning, the primary impression of the present mark is

almost identical to the primary impression of the registered mark. The applicant further argues that

the words by which the present mark differs from the registered mark are not highly distinctive,

and are each related to the relevant goods and services. The applicant contends that

INTERNATIONAL is suggestive of an “international business.” MANAGEMENT is suggestive

of goods/services which include “seminars concerning marketing, sales, distribution, accounting,

finance, technology, information services, arranging and conducting tradeshow exhibitions in the

field of the distribution of healthcare products and the management of healthcare product

distribution. The applicant concludes that because applicant’s members, and those familiar with

applicant would immediately associate the present mark with the registered mark because of the

similarity between the two, the marks are legally equivalent.

Unlike the respective marks in *In re Dial-A-Mattress Operating Corp*, the applicant’s marks are

not legal equivalents. The two marks, HEALTHCARE DISTRIBUTORS INTERNATIONAL and

HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION, are not indistinguishable

and certainly do not create the same, continuing commercial impression such that the consumer

would consider them both the same mark. On its face the mark HEALTHCARE DISTRIBUTORS

INTERNATIONAL does not include DISTRIBUTION MANAGEMENT ASSOCIATION and it

adds DISTRIBUTORS INTERNATIONAL. In this regard, the designation, distributor is defined

in relevant part as “one that sells merchandise, especially a wholesale.” The designation

distribution is defined as “the act of distributing or the condition of being distributed.”³ The

applicant’s proposed mark when used in connection with the identified goods/services describes

the intended users, healthcare distributors and the scope of the services, international in scope.

This mark does not identify the subject matter of the services, but merely indicate that the

goods and services that are international in scope are directed toward a specific group. Whereas

the registered mark describes the subject matter, management in the field of healthcare distribution

and an entity type designation, an association. Use of HEALTHCARE DISTRIBUTION

MANAGEMENT ASSOCIATION in connection with applicant’s goods and services conveys to

the consumer that a trade association is offering goods and services whose subject matter is

management in the field of healthcare distribution.

The marks, HEALTHCARE DISTRIBUTORS INTERNATIONAL and HEALTHCARE

³*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved. The dictionary definitions can be found within the body of the Office action mailed 1/31/2007. Further, the examining attorney attached the dictionary definition of “management,” “international, and “association to that same office action.

DISTRIBUTION MANAGEMENT ASSOCIATION, are not similar in sound, appearance,

connotation or commercial impression. Here, the only similar element in the respective marks is

the highly descriptive wording HEALTHCARE and the remaining elements in each mark is

sufficiently distinguishing as demonstrated above. Thus, the prior U.S. Registration claimed in

this application is not the legal equivalent of applicant's proposed mark; it is not prima facie

evidence of acquired distinctiveness and therefore insufficient to establish distinctiveness as to the

proposed mark.

The applicant argues that the goods and services of the present application are closely related to the

goods and services of the claimed registration. However, the fact that the respective goods and

services of the marks in question are related is not material in this case because the marks are not

the same.

The applicant also argues that a disclaimer is not required. In this regard, the applicant should

note that the examining attorney withdrew the advisory concerning the disclaimer requirement in

the Office action dated 1/31/07.

CONCLUSION

For the foregoing reasons, the refusal to register the applicant's mark on the Principal Register

under Section 2(e)(1) of the Trademark Act on the ground that the mark merely describes the

services and because the evidence of acquired distinctiveness pursuant to Section 2(f) is insufficient should be affirmed.

Respectfully submitted,

/Priscilla Milton/
Examining Attorney
Law Office 110
(571) 272-9199

Chris A. F. Pedersen
Managing Attorney
Law Office - 110

NOTICE OF NEW PROCEDURE FOR E-MAILED OFFICE ACTIONS: In late spring 2007, for any applicant who authorizes e-mail communication with the USPTO, the USPTO will no longer directly e-mail the actual Office action to the applicant. Instead, upon issuance of an Office action, the USPTO will e-mail the applicant a notice with a link/web address to access the Office action using Trademark Document Retrieval (TDR), which is located on the USPTO website at <http://portal.uspto.gov/external/portal/tow>. The Office action will not be attached to the e-mail notice. Upon receipt of the notice, the applicant can then view and print the actual Office action and any evidentiary attachments using the provided link/web address. TDR is available 24 hours a day, seven days a week, including holidays and weekends. This new process is intended to eliminate problems associated with e-mailed Office actions that contain numerous attachments.