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

Proceeding	85495793
Applicant	Schwarz, Jacob
Applied for Mark	MANAGE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Serial No.:** 85/495,793  
**Filing Date:** December 15, 2011  
**Mark:** MANAGE  
**Applicant:** Jacob Schwarz  
**Examining Attorney:** Florentina Blandu  
Law Office 117

**EX PARTE APPEAL**

**APPLICANT'S BRIEF**

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The Applicant, Jacob Schwarz, by Counsel, hereby respectfully appeals the Examining Attorney's refusal to register the mark MANAGE in standard characters.

### **SUMMARY OF ARGUMENT**

Applicant seeks registration of the mark MANAGE used in connection with downloadable and on-line scheduling software and related services. It is inconceivable that a person presented with this mark would understand that it is anything more than an aspirational and highly amorphous statement of a beneficial state or action. The mark is at most suggestive, not descriptive, of a generalized goal and is plainly registrable.

The Examining Attorney's Final Office Action fails to address the distinction between a suggestive and descriptive mark. It fails to accord Applicant the principle that doubt regarding descriptiveness should be resolved in favor of the Applicant. And, most importantly, it does not apply the settled principle that a mark such as MANAGE that merely states an aspirational goal, or that conveys a nebulous or amorphous concept, is inherently suggestive and registrable. For all these reasons the Final Office Action must be reversed and an order entered allowing Applicant's mark MANAGE to proceed to publication and registration.

## **DESCRIPTION OF RECORD**

### **A. PROSECUTION HISTORY**

The MANAGE application was initially refused on May 23, 2012 in a Non-Final Office Action. Applicant filed a response to the Office Action on November 23, 2012. A Final Office action refusing registration for the mark MANAGE was issued by the Examining Attorney on December 17, 2012, based on the Examining Attorney's conclusion that the mark MANAGE is descriptive of the goods and services. Applicant filed a timely Notice of Appeal on June 12, 2013.

### **B. EXAMINING ATTORNEY'S EVIDENCE AND ARGUMENTS**

#### **May 23, 2012 and December 17, 2012 Office Actions**

The evidence attached to the May 23, 2012 Office Action consists of screen shots of web pages from the following web sites: [www.appointment-plus.com](http://www.appointment-plus.com), [www.scheduleview.com](http://www.scheduleview.com), [www.appointmentquest.com](http://www.appointmentquest.com), and [www.bmscentral.com](http://www.bmscentral.com). The December 17, 2012 Office Action adds screen shots (some of which are blank) from another nine web sites. In every case, the Examining Attorney seems to believe that if the word "manage," "management" or "managed" can be found in a website for a somewhat similar product, then the word "manage" must be descriptive and unregistrable.

This is an error that must be reversed. The fact that other businesses in the same or similar fields may use the word "manage" in its ordinary English sense in their advertisements has nothing to do with the question whether the Applicant's mark MANAGE is registrable with respect to Applicant's goods and

services. If this were the case, then EXCEL would be unregistrable for spreadsheet software if software manufacturers other than Microsoft claimed that their products would allow purchasers to “excel” in what they do. Just as EXCEL suggests a vague aspirational goal that might be achieved through the use of Microsoft’s famous product, so MANAGE suggests, but does not describe, a vague aspirational goal that might be achieved through the use of Applicant’s software and service.

The Examining Attorney’s evidence demonstrates why this must be the case. The screen shot from [www.appointment-plus.com](http://www.appointment-plus.com) contains the statement, “Manage your appointment on the go with our mobile apps.” This ordinary, English use of the word as a verb, not as a proper adjective, which is the touchstone for trademark use, has no bearing on the question whether MANAGE, when properly used as a trademark, describes a feature of Applicant’s software. Similarly, the screen shots of web pages from the [www.healthinformatics.uic.edu/ehr-health-informatics-software/](http://www.healthinformatics.uic.edu/ehr-health-informatics-software/) site include a reference to “medical practice management software” that is used to “manage the everyday activities in a hospital or other such institution.” This reference is irrelevant for the simple reason that Applicant is not seeking to register the mark MANAGE as a mark for “medical practice management software” that, according to the referenced website, performs a wide variety of management functions, including maintaining patient records, writing prescriptions, generating reports, and providing insurance details. Similarly, the screen shots of web pages from the [www.quick-charts.com/practice-management-software.php](http://www.quick-charts.com/practice-management-software.php) site discuss Chiro QuickCharts Practice Management software as software that connects the areas of billing, scheduling, office management, marketing, EMR/HER, communication, collections, and employee management. Whether Chiro QuickCharts could register its product name, Practice Management Software, for an office management product, is irrelevant to the question whether Applicant can register MANAGE for a product that does not conduct office management. In the same vein, the screen shots of web pages from the



[www.salontoday.com/features/salon-management/2012-Tech-Guide-161218445.html](http://www.salontoday.com/features/salon-management/2012-Tech-Guide-161218445.html) site list numerous software products, some of which are referred to as “Management Software,” but such software provides overall management-type capabilities, such as commission reports and credit card integrations. The “Manage Queue” feature of the KLINIK SUITE (and Design) software discussed on the web pages located at [www.kliniksuite.com/to-use-the-software-appointments-manage-queue.aspx](http://www.kliniksuite.com/to-use-the-software-appointments-manage-queue.aspx) appears to be a feature specific to the Professional and Enterprise editions of Klinik Suite 2012 and is “used to rearrange the daily patient list to the order on entering to consultation and notifying the doctor by the receptionist what patients have arrived.” The use of “manage” in the title of this feature (which is in any event not found in Applicant’s product) may establish that “manage” is capable of a descriptive use for the Klinik Suite product, but fails to establish that as proposed for use by Applicant the mark is descriptive of Applicant’s goods and services.

As the Examining Attorney states in the December 17, 2012 Office Action, “Descriptiveness is considered in relation to the relevant goods and/or services. DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., \_\_\_ F.3d \_\_\_, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).” As shown above, the web site references included by the Examining Attorney as evidence support the unsurprising conclusion that the word “manage” is capable of descriptive use in connection with business management products, but provide no support for the proposition that MANAGE, when properly used as a trademark for Applicant’s scheduling software, would have any more than a vague aspirational significance. Simply put, the Examining Attorney’s references relate to goods and/or services that differ from Applicant’s goods and services, and relate to ordinary English uses of the word “manage,” but do not successfully support the conclusion that MANAGE, when used as a trademark for Applicant’s goods and services, would be descriptive.

The Examining Attorney also indulges in fantasies regarding the definition of the word “manage.” In the December 17, 2012 Office Action, after acknowledging Applicant’s argument that Applicant’s use of the word does not meet the Webster’s definition, the Examining Attorney announces that she “believes that the software manages, because the ‘recording’ function meets the definition.” How she goes from “recording” to “managing” without any support, whether in Webster’s or elsewhere, is a puzzle and completely unacceptable as an application of established law or principles. A descriptiveness refusal must be based on more than just a “belief.” The Examining Attorney did not provide any evidence to support her belief that the “recording” function raised by Applicant in Applicant’s November 23, 2012 Response to the Non-Final Office Action meets a definition of “manages.”

### **C. APPLICANT’S EVIDENCE AND ARGUMENTS**

#### **November 23, 2012 Response to Non-Final Office Action**

Applicant provided a comprehensive response to the Examining Attorney’s arguments in Applicant’s November 23, 2012 response to the Non-Final Office Action. After reviewing black-letter law establishing the distinction between descriptive and suggestive marks, Applicant cited Merriam-Webster’s on-line dictionary definitions of the term “Manage” and correctly concluded that it takes “imagination, thought and perception” to reach a conclusion about the nature of Applicant’s goods or services. Applicant argued there, and repeats here, that at most MANAGE vaguely suggests an aspirational goal, placing it squarely within the definition of a suggestive mark.

Applicant concluded its response to the Office Action with the established principle that doubt as to descriptiveness should be settled in favor of the Applicant.

## **ARGUMENT**

### **A. LEGAL STANDARD**

Section (2)(e)(1) of the Trademark Act, 15. U.S.C. §1052(e)(1), precludes registration of a mark which is “merely descriptive” of the goods or services to which it relates. As mentioned in the May 23, 2012 Office Action, a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); see *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3USPQ2d 1009, 1009-10 (Fed. Cir. 1987). Similarly, if a mark immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant’s goods or services, then it is considered to be merely descriptive. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

On the other hand, a mark is not merely descriptive if the information it conveys is “indirect and vague,” and the connection between the mark and a characteristic or feature of the product is neither “immediate nor direct.” *Oreck Holdings LLC v. Bissell Homecare, Inc.*, Opposition No. 9117831 (February 16, 2010). If imagination or perception is required to reach a conclusion about the nature of the goods or services, the mark is suggestive and registrable. *Manpower, Inc. v. Driving Force, Inc.*, 212 USPQ 961, 962-63 (TTAB 1981).

If there is any doubt as to descriptiveness, the issue should be resolved in favor of the applicant. See *In re Noble Co.*, 225 USPQ 749 (TTAB 1985); *In re American Hosp. Supply Corp.*, 219 USPQ 949 (TTAB 1983); *In re Micro Instruments Corp.*, 222 USPQ252 (TTAB 1984).

Each case must be decided on its own merits, due to the variation in facts from case to case. See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977). The determination of whether a mark is merely descriptive must not be made in the abstract. It must be made in relation to the goods or services for which registration is sought. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 963-64, 82 USPQ2d at 1831 (Fed. Cir. 2007); TMEP §1209.01(b). The context in which the mark is used or intended to be used in connection with the goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace must be taken into consideration. See *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985).

## **B. ANALYSIS**

The MANAGE mark at issue here is not merely descriptive of, “downloadable software for professional scheduling and appointment-keeping” in Class 9 and “providing on-line, non-downloadable software for professional scheduling and appointment keeping” in Class 42. As the TTAB stated in *Manpower, Inc. v. Driving Force, Inc.*, 212 USPQ 961, 962-3 (TTAB 1981) (emphasis added):

For a term to be considered merely descriptive...it must immediately convey to one seeing or hearing it knowledge of the ingredients, qualities or other characteristics of the goods or services in connection with which it is used. If imagination or perception

is required for one to reach a conclusion about the nature of the goods or services, the mark may be suggestive, but it is not descriptive.

If one applies the Manpower test to the mark MANAGE, the inevitable conclusion is that the mark is suggestive rather than merely descriptive. According to Merriam-Webster, “manage” means “to handle or direct with a degree of skill... to work upon or try to alter for a purpose ... to succeed in accomplishing ... to direct the professional career of ... to direct or carry on business or affairs ... to achieve one’s purpose.” None of these meanings immediately convey any idea of the ingredients, qualities or other characteristics of Applicant’s appointment-keeping and scheduling software product and service. On the contrary, the mark MANAGE merely suggests, without describing, a vague aspirational goal that might be achieved through the use of the product.

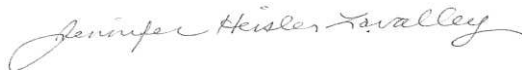
The Examining Attorney’s evidence is inapposite because it relates to goods and services that provide management functions not present in Applicant’s scheduling software. The Examining Attorney’s “belief” that “recording” meets the definition of “manage” is completely unfounded and unsupported by any evidence. In short, the Examining Attorney’s arguments are insufficient to overcome the presumption that doubts about descriptiveness should be resolved in favor of the Applicant. See *In re Noble Co.*, 225 USPQ 749 (TTAB 1985); *In re American Hosp. Supply Corp.*, 219 USPQ 949 (TTAB 1983); *In re Micro Instruments Corp.*, 222 USPQ252 (TTAB 1984).

## CONCLUSION

Applicant's MANAGE mark is not merely descriptive of the applied-for goods and services because the mark does not immediately convey to the prospective purchaser or user knowledge of the qualities or characteristics of the software. A potential purchaser or user must use his/her imagination and perception to determine how the mark relates to professional scheduling and appointment-keeping.

In light of the above, Applicant respectfully requests that the Board grant this Ex Parte Appeal, reverse the refusal based on descriptiveness, and allow for the publication of the application for the registration of the MANAGE mark.

Dated this 11<sup>th</sup> day of August, 2013



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