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Subject: U.S. TRADEMARK APPLICATION NO. 85495793 - MANAGE - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85495793

MARK: MANAGE



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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: Schwarz, Jacob

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant has appealed the trademark examining attorney's final refusal to register

the mark MANAGE for downloadable software for professional scheduling and appointment-keeping and for providing on-line, non-downloadable software for professional scheduling and appointment-keeping, in International Classes 9 and 42. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) because the proposed mark merely describes a feature of applicant's goods and services.

FACTS

On December 15, 2011, applicant filed Application Serial No. 85495793, under filing basis 1(b) (intent to use), to register the mark MANAGE for goods and services in International Classes 9 and 42 as listed above.

On May 23, 2012, an office action was issued refusing registration of the proposed mark under Trademark Act Section 2(e)(1) because the proposed mark merely describes a feature

of applicant's goods and services, namely, for downloadable software for professional scheduling and appointment-keeping and for providing on-line, non-downloadable software for professional scheduling and appointment-keeping, in International Classes 9 and 42.

On December 17, 2012 a final action was issued continuing and making final the refusal under Trademark Act Section 2(e)(1).

On June 12, 2013 the applicant filed its appeal brief.

ARGUMENTS

THE PROPOSED MARK IS MERELY DESCRIPTIVE OF THE USE OF FUNCTION OF THE APPLICANT'S SOFTWARE, AND THEREFORE, REGISTRATION IS PROPERLY REFUSED UNDER TRADEMARK ACT SECTION 2(e)(1).

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*,

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)).

The proposed mark merely describes a feature of applicant’s goods and services, namely, downloadable software for professional scheduling and appointment keeping and for providing on-line, non-downloadable software for professional scheduling and appointment keeping.

A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See*

DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251-52, 103 USPQ2d

1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215,

218 (C.C.P.A. 1978)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed.

Cir. 2005); TMEP §1209.01(a). In this case there is nothing suggestive of applicant's mark.

Applicant's mark MANAGE merely describes a feature or characteristic of its goods, namely that

MANAGE is a characteristic of software that is used to schedule appointments.

The examining attorney notes that the applicant's mark is descriptive of the goods

and services of the applicant because the software is used to manage schedules and appointments.

Along with her office action dated May 23, 2012, the examining attorney attached evidence in the

nature of excerpts from the Internet to support her argument listed above.

- See www.appoinmtne-plus.com which shows use of online schedule maker to manage client sessions. "Many personal fitness trainers, health clubs and gyms nationwide are turning to our online schedule maker software to streamline the way they book and **manage** client sessions."

- See www.scheduleview.com which shows how one manages staff appointment schedules. “You’ll get more productivity out of each day by **managing** your staff appointment schedules with much higher efficiency.”
- See www.appointmentquest.com which shows how a software is used to manager customer relationship. “Online scheduling software for service businesses, schools and universities. Since 2001, Appointment Quest makes it easy to **manage** your appointment scheduling on the web.”

In her final refusal dated 12/17/2012 the examining attorney also attached ample Internet

evidence which supports her argument that the mark is descriptive of the goods and services. For

example:

- See www.healthinformatics.uic.edu/ehr-health-informatics-software/ which shows how software is used to manage medical practice. “Medical practice management software is used to **manage** the everyday activities in a hospital or other such institutions. This software helps to maintain patient records, schedule appointments, write prescriptions, generate reports, and some even provide insurance details.”
- See www.timecenter.com which shows that software manages schedules. “Your staff can devote their entire attention to the customers while Time Center **manages** your schedules.”
- See www.scheduleview.com which shows that there is a scheduling software that is used to manage staff appointment schedules. “You’ll get more productivity of each day by **managing** your staff appointment schedules with much higher efficiency.”

Applicant’s identification makes clear the software is used to manage schedules and

appointments. Therefore, the mark immediately informs the consumers what it is used for and leaves no room for doubt. Contrary to applicant's argument, the term MANAGE does not suggest a vague aspirational goal, but rather, when used in the context of time management software, immediately describes the use and function of the software using a term that applicant's competitors commonly use – manage.

Applicant goes on to say that the examining attorney's evidence is irrelevant because it is used to show how the term MANAGE is descriptive when used in connection with medical practice management software which is not what the applicant does. The examining attorney disagrees. Managing schedules is a common task within offices of all types, and this task is accomplished by use of software such as that of the applicant. The examining attorney's evidence shows general purpose usage that includes use by medical practices, but also small business and health clubs. Therefore, applicant's argument is without merit.

CONCLUSION

For the reasons listed above, the examining attorney submits that the mark MANAGE is descriptive of the goods and services of the applicant because the software is used to manage schedules and appointments. The mark is not suggestive and it describes a feature of applicant's goods and services. The examining attorney respectfully requests that the refusal to register applicant's mark be Affirmed.

Respectfully submitted,

/Florentina Blandu/

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