

This Opinion is Not a
Precedent of the TTAB

Mailed: July 10, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Chronix Biomedical, Inc.
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Serial No. 86612457
—————

Karen Frank of Coblenz Patch Duffy & Bass LLP
for Chronix Biomedical, Inc.

Thomas Young, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

—————
Before Kuczma, Adlin and Lynch,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Chronix Biomedical, Inc. seeks a Supplemental Register registration for the term SECOND OPINION, in standard characters, for “medical testing for diagnostic or treatment purposes in the field of cancer.”¹ The Examining Attorney finally refused registration under Section 23(c) of the Trademark Act on the ground that the proposed mark is a generic term for the identified services, and thus incapable of distinguishing them from those of others. Applicant then appealed and filed a request for reconsideration which was denied. The appeal is fully briefed.

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¹ Application Serial No. 86612457, filed April 28, 2015 under Section 1(a) of the Trademark Act.

I. The Evidence

The Examining Attorney relies on two dictionary definitions of the exact term for which Applicant seeks registration. The first is from the Collins Dictionary:

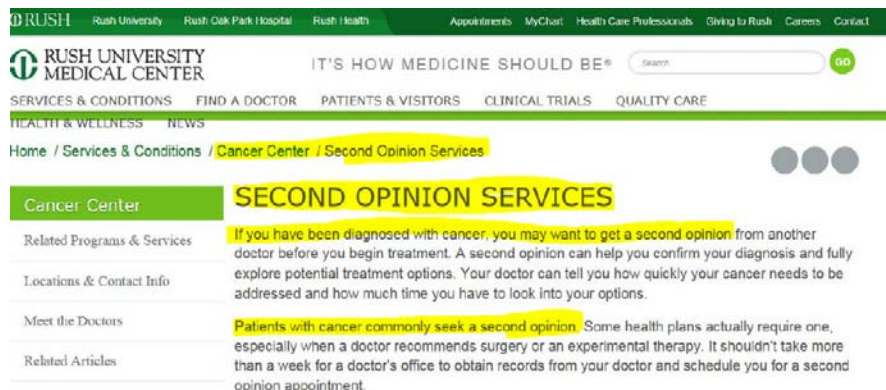
SECOND OPINION—“an opinion from a second qualified person on something such as a health or legal problem”²

The second is from the Free Dictionary’s Medical Dictionary:

SECOND OPINION—“a patient privilege of requesting an examination and evaluation of a health condition by a second physician to verify or challenge the diagnosis by a first physician. The situation is most likely to arise when an examination by a first physician results in a recommendation for surgery or experimental treatment”³

Office Action of August 11, 2015.

The record also establishes that healthcare providers commonly offer “second opinion” services, often in connection with cancer diagnoses, which typically include a review of a first doctor’s conclusions. The following examples are typical:



² <http://www.collinsdictionary.com/dictionary/english/second-opinion>.

³ <http://medical-dictionary.thefreedictionary.com/second+opinion>.

Cancer Treatment Centers of America®

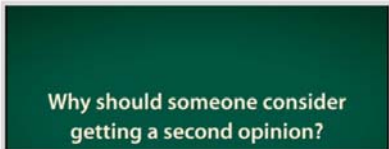
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WHY GET A **SECOND OPINION** | OUR TREATMENT APPROACH | A SECOND OPINION AT CTCA | PATIENTS' PERSPECTIVE | YOUR NEXT STEPS

Why Get a **Second Opinion**

Receiving a cancer diagnosis is a life-changing event. You may be experiencing many different emotions right now, including feeling overwhelmed with all of the decisions you need to make. We're here to help you through the process.

Exploring a **second opinion** can help you make a more informed decision about your cancer treatment. It can also introduce you to advanced treatment options. At Cancer Treatment Centers of America® (CTCA), we evaluate your type and stage of cancer, as well as needs like nutrition



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Facts and Circumstances Relating to the Individual

The purpose of this brochure is to address questions surrounding **Second Opinions: Knowing Your Rights and Options**. Making decisions about healthcare is one of the most important in a person's life. Many people are told that they have cancer or another life threatening illness and feel that they must make a decision and begin treatment as soon as possible. While this may be true in some instances, taking the time to learn about your disease, **getting a second opinion or perhaps even a third opinion** and weighing your options is a very reasonable approach. Proactive decision making will give you a greater degree of control over your treatment. Decisions regarding your health should be made after you have been thoroughly informed about your diagnosis, prognosis and available treatment options.

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Home > Navigating Cancer Care > Cancer Basics > The Cancer Care Team > **Seeking a Second Opinion** | [REQUEST PERMISSIONS](#) | [PRINT TO PDF](#)

NAVIGATING CANCER CARE

More in this section

- 6 Cancer Basics
 - What is Cancer?
 - The Cancer Care Team**
 - The Oncology Team
 - Choosing a Doctor
 - Types of Oncologists
 - Seeking a Second Opinion**
 - Finding a New Doctor
 - Find an NCI-Designated Cancer Center
 - Doctor Stories
 - Understanding Statistics Used to Guide Prognosis and Evaluate Treatment
 - Genetics
 - Medical Illustrations Gallery
 - Cancer Terms: Cancer Basics
 - Cancer Terms: Research Statistics

Seeking a **Second Opinion**

Approved by the **Cancer.Net Editorial Board**, 09/2013

Listen to the Cancer.Net Podcast: *Seeking a Second Opinion*, adapted from this content

Key Messages

- Many people seek a **second opinion to confirm a cancer diagnosis, learn more about the cancer, and hear different opinions on the best treatment options.**
- Most doctors understand the importance of a **second opinion**, and your current doctor may even be able to recommend another doctor.
- Make sure the doctor you are visiting for a second opinion has access to all your records from your original diagnosis.**

Cancer is often a confusing and frightening diagnosis, and it may be hard to make decisions about treatment options. Because treatments are continually improving, it is **important to find someone who has experience with your type of cancer. Many people seek the knowledge and advice of more than one doctor to confirm a diagnosis and evaluate treatment options. This is called a second opinion.**

Asking for a second opinion is common practice. Gathering more knowledge about your diagnosis and the available treatment options may help you feel more comfortable with the health care decisions you make.



CLINICAL BREAST CANCER PROGRAM

← Breast Home	Second Opinion Services
← What Defines Us	The Department of Surgery welcomes the opportunity to provide medical second opinion consultations upon request. Our surgeons are committed to helping you make the best choices regarding your diagnosis or a recommended course of treatment.
Academic Excellence	Obtaining a second opinion from a qualified surgeon at one of the nation's leading medical centers may be instrumental in this process.
Clinical Research	
Outcomes/Quality Care	
Integrative Therapies	The Department of Surgery strives to accommodate patients with rapid access to appointments.
High Risk Program	
Second Opinion Services	To request an appointment at the Clinical Breast Cancer Program,

Home > Services > Cancer & Blood Disorders > Programs > **Second Opinions**

Second Opinion Services

Pediatric Cancer and Blood Disorders

At the [Aflac Cancer and Blood Disorders Center](#), we understand you want to be certain your child is receiving the best possible treatment available anywhere in the country. Second opinions can help provide the information you need to make an informed decision about the treatment for your child.

[Contact us.](#)



Second Opinion

- Diagnostic Imaging
- Genetic Risk Assessment
- Pathology
- Labwork and Bloodwork**
- Cancer Screenings

Requesting a **Second Opinion** at Moffitt Cancer Center

You may be thinking about getting a **second opinion if you've been diagnosed with cancer.** The news can be difficult to process, and requesting input from a second specialist can help ease your fears. In some cases, a secondary evaluation can also provide additional information that could ultimately change the direction of your treatment plan, resulting in better, more targeted care.

Id. (printouts from “cancercenter.com,” “patientadvocate.org” and “cancer.net”); Office Action of October 16, 2015 (printouts from “rush.edu,” “choa.org,” “moffitt.org” and “columbiasurgery.org”). According to these websites, second opinion services focus on verifying, challenging or supplementing a first diagnosis or recommendation, including assessing whether the first doctor’s evaluation was complete or accurate, and reviewing and perhaps revising treatment recommendations. *Id.* These uses of

“second opinion” are entirely consistent with the term’s dictionary definitions (including both the general and medical care-focused definitions), and reveal that a number of “second opinion” services or programs focus on cancer specifically. As the website printouts reproduced above and additional evidence of record also make clear, many health care providers use “second opinion” generically, in that they use “Second Opinion Services” or similar designations to refer to a class or type of healthcare services.

There is substantial evidence of record that “second opinions” focus in large part on, or involve, medical tests. Most commonly, “second opinion” services involve a review of medical tests performed by the patient’s first doctor. For example:

University of Florida Health’s Breast Center provides “a second opinion service to review original pathology slides or mammography films. Our team helps patients understand their diagnosis and treatment options to ensure they are making the best possible decisions for their care.”

The “cancer.net” webpage entitled “Seeking a Second Opinion” (a portion of which is reproduced above) states that patients should “[g]ather all of your relevant medical records – including test results, such as blood work or imaging tests – to bring to the appointment. Often, the doctor providing a second opinion will request the results of any tests or procedures you have already undergone, eliminating repeat testing.”

The Johns Hopkins Medicine “Medical Second Opinion Program” webpage states “[a]fter completing required forms, you will mail us copies of pertinent diagnostic imaging tests.”

The Rush University Medical Center “Second Opinion Services” webpage states “You’ll want to bring your lab results, test results, and scans (such as original X-rays or

MRI or CT scans) with you to your appointment.”

Penn Global Medicine’s “Remote Medical Second Opinion Service” webpage states that “Penn Medicine offers second opinion services for referring physicians and insurers which include: Review patients’ medical records and health history.”

Massachusetts General Hospital Imaging’s “Second Opinion Service” website states that the hospital’s “specialty-trained radiologists provide a written second opinion on your diagnostic imaging tests, including X-ray, CT, MRI, PET, and ultrasound examinations.”

Oncology Hematology Associates of Southwest Indiana’s “Newly Diagnosed—Second Opinion” webpage states “[i]t is best to involve your doctor in the process of getting a second opinion, because your doctor will need to make your medical records (such as your test results and x-rays) available to the specialist.”

The American Thyroid Clinic’s “Second Opinion” webpage states “[i]f you have any testing done, be sure to have those test results with you when you call.”

An article in Fierce Healthcare entitled “Hospitals offer second opinions to enhance cancer care” states “Edward Hospital & Health Services in Illinois is referring cancer patients who want a second look at their tests and diagnosis to the system’s Second Opinion Clinic.”

The Children’s Oncology Group’s “Second Opinions” webpage states “... most consider second opinions a part of this difficult journey. The ideal way to do this is with the full cooperation of your child’s primary oncologist. This assures that any consulting doctor gains quick and full access [sic] your child’s latest tests, scans and prior medical history, and helps your child avoid unnecessary second scans and tests (and more radiation exposure, possible sedation and procedures).”

Office Action of October 16, 2015 (printouts from “cancer.net,” “ufhealthjax.org,”

“hopkinsmedicine.org,” “rush.edu,” “pennmedicine.org,” “massgeneral.org,”

“ohaev.com,” “thyroidcancer.com,” “fiercehealthcare” and “childrensoncologygroup.org”).

While “second opinions” appear to most often focus on tests performed in connection with the patient’s original diagnosis by a first doctor, it is not uncommon for “second opinions” to be based on new or follow-up tests conducted or ordered by a second doctor in connection with providing a “second opinion.” For example:

The Patient Advocate Foundation website (a portion of which is reproduced above) states: “Call your insurance provider before going for any treatment or second opinion to prevent any confusion or denial of the bill ... Diagnostic tests can be very costly and many insurance providers will not pay for them if they were completed for the initial diagnosis.”

The Cancer Treatment Centers of America “Why to Get a Second Opinion” webpage states “During a second opinion, a physician will perform a comprehensive evaluation of your current and past medical history, your type and stage of cancer and make treatment recommendation. A physician may also recommend additional diagnostic testing to confirm the type and stage of your cancer.”

The “Second Opinion” section of Moffitt Cancer Center’s website, a subcategory of the “Tests” section, states: “Our multispecialty team will review your records and diagnostic work, and then order any additional tests that might be necessary to achieve a better understanding of your situation. From there, we’ll be able to confirm – or rule out – your initial diagnosis, and make a tailored recommendation for your treatment.”

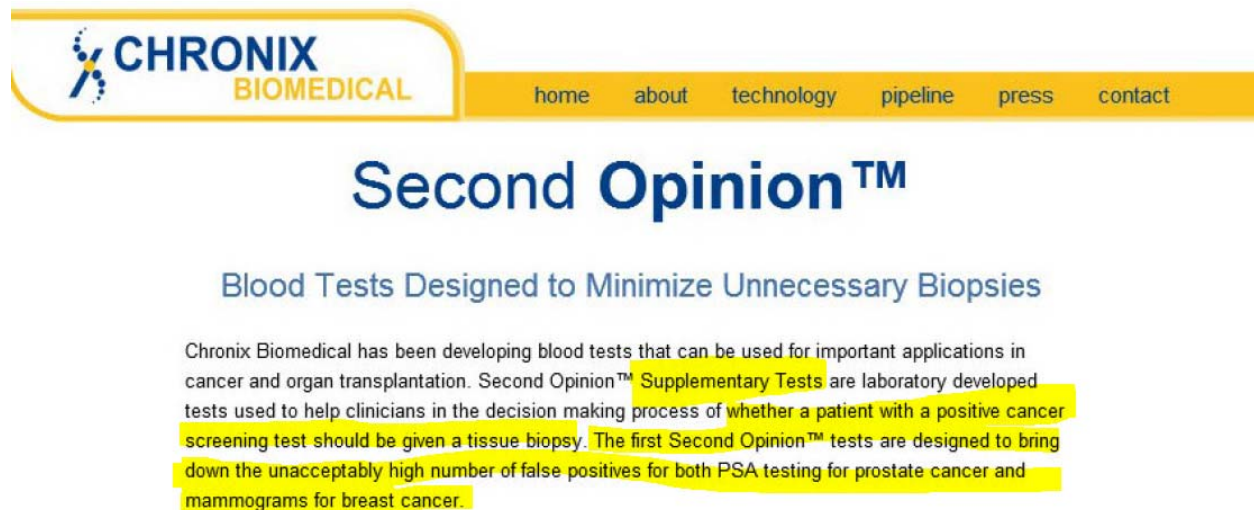
The “Getting a Second Opinion” section of the Living Beyond Breast Cancer website states “[t]he second opinion doctor will review your medical records, examine you and may suggest additional testing.”

The “Second Opinions” page of the Children’s Oncology Group website indicates that the first step is a review of

“your child’s latest tests, scans and prior medical history,” but “[a]dditional tests may be necessary in the long run if tests have been inconclusive or subject to interpretation”

Office Actions of August 11, 2015 (printouts from “patientadvocate.org” and “cancercenter.com”) and October 16, 2015 (printout from “moffitt.org,” “lbcc.org” and “childrensoncologygroup.org”).

In fact, Applicant’s medical testing services are among those offered in connection with “second opinions.” In a July 15, 2015 press release, Applicant cites its “Second Opinion™ test to help doctors decide whether to send men with elevated PSAs or women with suspicious M3 or M4 screening mammograms for a biopsy based on a Chronix [Applicant’s] blood test.” Office Action October 16, 2015 (printout from “reuters.com”). Applicant’s website includes this page about Applicant’s Second Opinion tests:



Id. (printout from “chronixbiomedical.com”). As the webpage indicates, Applicant’s Second Opinion test is “supplementary,” conducted after a patient has a “positive cancer screening test,” and intended to reduce errors from prior tests (“false

positives”).

II. Analysis

The proposed mark is eligible for the Supplemental Register only if it is capable of distinguishing Applicant’s services from those of others. 15 U.S.C. § 1091(c); *Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1089 (TTAB 2017). Here, the Examining Attorney contends that the term “second opinion” is incapable of distinguishing Applicant’s services because it is generic. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2011) (“Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold. They are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks.”) (citations omitted).

The ultimate test for determining whether a term is generic is its primary significance to the relevant public. *See* Section 14(3) of the Act. *See also, In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The Examining Attorney bears the burden of making a “strong” showing, with “clear evidence,” that Applicant’s mark is generic. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). *See In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). “[D]oubt on the issue of genericness is resolved in favor of the applicant.” *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

We must make a two-step inquiry to determine whether “second opinion” is generic: First, what is the genus of goods and services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

A. The Appropriate Genus

As for the first question, in this case there is no dispute that the genus is essentially as described in Applicant’s identification of services: “medical testing services for diagnostic or treatment purposes.” 7 TTABVUE 7 (Applicant’s Appeal Brief at 6); 9 TTABVUE 4 (Examining Attorney’s Appeal Brief at 3); *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1636 (Fed. Cir. 2016); *Magic Wand*, 19 USPQ2d at 1551.⁴

B. The Relevant Public

With respect to the second part of the genericness inquiry, the record establishes that the relevant purchasing public consists of both patients seeking medical testing for diagnostic or treatment purposes, and the doctors or other health care providers who order or purchase the tests.⁵ Applicant’s argument that the relevant public

⁴ The agreed-upon genus does not include the limitation “in the field of cancer,” which is how Applicant identifies its services in the involved application. Our analysis would be no different if this limitation was included in the agreed-upon genus, and in any event most of the evidence of record specifically relates to medical testing in the field of cancer.

⁵ While the record makes clear that medical tests are often covered by insurance, and that insurers may pre-approve (or pre-disapprove) coverage for recommended tests, there is no evidence that insurers choose specific tests for specific conditions or purposes, or whether to conduct medical tests in the first instance. That is, doctors and patients choose which tests to conduct.

consists only of “medical professionals,” 7 TTABVUE 7, is not well taken. As the Examining Attorney points out, Applicant’s identification of services is not so limited and the evidence of record reveals that medical testing services are directly marketed to patients as well as medical professionals. In any event, the record would not yield a different ultimate conclusion on genericness if the relevant public were limited to medical professionals, especially given the essential congruence of the lay and medical definitions (and uses) of “second opinion.”

C. The Relevant Public’s Understanding of the Term

Evidence of this relevant public’s understanding of SECOND OPINION may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). “[E]vidence of competitors’ use of particular words as the name of their goods or services is, of course, persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods and services.” *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999).⁶

We start with the dictionary definitions of “second opinion” and Applicant’s own use of the term, and find that Applicant’s use of “second opinion” in its July 15, 2015

⁶ Because the dictionary and other evidence establishes that “second opinion” is a known, defined and commonly-used term in the healthcare field, we consider it in its entirety and there is no reason to evaluate the words “second” or “opinion” individually. *See In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (finding, in descriptiveness case, that “because the NEXIS evidence clearly demonstrates that the phrase ‘tariff management’ has been frequently used to identify a key feature or function of the computer hardware and computer programs set forth in applicant’s application, we simply need not dwell on considering the individual meanings of the words ‘tariff’ and ‘management’”).

press release and its website is consistent with both the lay and medical definitions of “second opinion.” See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (“Gould’s own submissions provided the most damaging evidence that its alleged mark is generic and would be perceived by the purchasing public as merely a common name for its goods rather than a mark identifying the good’s source.”); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 218 (CCPA 1978) (“Evidence of the context in which a mark is used on labels, packages, or in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark.”). In fact, Applicant’s press release promotes the fact that its Second Opinion test is intended to “help doctors” (or, as the website states “clinicians”) decide what to do in response to prior medical tests or examinations. Applicant’s website cites the “supplementary” nature of the test and its goal of reducing potential errors, specifically those arising out of “false positives.” In other words, these materials reveal that Applicant’s “second opinion” test is conducted by or at the direction of a physician/clinician in order to provide an opinion, examination or evaluation to verify or challenge another physician’s diagnosis or recommendation, or to better understand the results of a first medical test.

While most of the third-party evidence of record reflects use of “second opinion” in connection with a collection of healthcare services, as opposed to Applicant’s use of the term in connection with “medical testing” specifically, this does not make the term less generic for Applicant’s testing services, which are an integral part of providing “second opinions.” *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1656 (TTAB

2005) (“ ... the likelihood that some members of the relevant public would think of a web site providing online access to lawyers while others might think of a web site providing online information about lawyers does not render LAWYERS.COM non-generic. Either understanding of the term would be generic ...”), *aff’d* 482 F.2d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (“However, as Reed and Martindale-Hubbard should know, for better or worse, lawyers are necessarily an integral part of the information exchange about legal services.”). In fact, a term “is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *Royal Crown Co., Inc. v. The Coca-Cola Co.*, ___ F.3d ___, 127 USPQ2d 1041 (Fed. Cir. 2018) (term is generic if it refers to a “key aspect” or part of a genus); *In re Cordua Rests.*, 118 USPQ2d at 1638. *See also; In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1438 (TTAB 2005) (“the class or category of services described in the application still clearly includes that of providing information regarding sports and betting”). Indeed, the record reveals that medical testing is not only an integral part of making original diagnoses or recommendations, but also of evaluating prior diagnoses or recommendations, whether the “second opinion” is based on medical tests ordered by the first doctor or the second. The primary significance of “second opinion” to those seeking medical tests for themselves or their patients thus encompasses medical testing for the purpose of verifying or challenging a first diagnosis or recommendation, i.e. providing a “second opinion.”

While Applicant is correct that there is no evidence showing use of “second

opinion” solely for medical testing services (other than by Applicant), that does not mean that the term is not generic for Applicant’s services. For example, ATTIC was found generic for automatic sprinklers for fire protection despite the lack of evidence that the public refers to these types of sprinklers as “attic,” and even though “applicant’s sprinklers may be used in other locations of a structure.” *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1197 (TTAB 1998). In that case the term ATTIC was found to be “more in the nature of a type of sprinkler than of a source identifier,” just as here the evidence reveals that “second opinion” is a type or purpose of medical testing: “second opinion medical testing.” *Id.* at 1198. In another analogous case, BUNDT was found generic for a “ring cake mix,” even though the record showed that the term was generic for a type of cake. *In re Northland Aluminum Prods.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). In that case, the Court agreed with the Board that “it is not of trademark significance to differentiate a cake made from a cake mix from a cake made from a recipe.” *Id.* at 964. Similarly, here there is no trademark basis upon which to differentiate a “second opinion” deriving from a physical examination from a “second opinion” deriving from a medical test.

In this case, Applicant’s own materials establish that its medical testing services are used and intended for healthcare providers seeking to provide, or patients seeking to receive, “second opinions,” and the genus “medical testing services for diagnostic or treatment purposes” encompasses medical testing services that are part of providing a “second opinion.” *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 (TTAB 2002) (finding BONDS.COM generic for providing information regarding

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financial products and services via a global computer network and providing electronic commerce services via a global computer network). *See also, In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for art dealership services); *In re Web Commc'ns.*, 49 USPQ2d 1478, 1479 (TTAB 1998) (finding WEB COMMUNICATIONS generic for consulting services to businesses and individuals who want to establish a site on a global computing network, because “[t]he services are consulting services in the field of ‘Web communications’”); *In re Ricci-Italian Silversmiths Inc.*, 16 USPQ2d 1727 (ART DECO generic for silver and silver coated flatware namely, knives, forks and spoons); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988) (ANALOG DEVICES generic for electronic devices with analog capabilities); *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 821 (TTAB 1984) (LAW & BUSINESS generic for arranging and conducting seminars in the field of business).

III. Conclusion

The record as a whole leaves no doubt that SECOND OPINION is generic for a type of medical testing, especially because “the determination of whether a proposed mark is capable of achieving significance as a source identifier must be made in relation to the goods and services for which registration is sought, not in the abstract.” *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1587 (TTAB 2014). Here, medical testing is commonly used to verify, challenge or shed additional light on a medical diagnosis, recommendation or finding. Moreover, the record reveals that others have a competitive need to, and do, use the term “second opinion” in connection with

reviewing or providing medical testing. Therefore, “second opinion” is generic and incapable of functioning as a mark.

Decision: The refusal to register is affirmed.

Kuczma, dissent

The majority affirmed the refusal of registration from which I respectfully dissent. With respect to the first step of the two-step genericness test, identifying the genus of the services, *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), I agree with the majority that the genus described in Applicant’s identification of services is “medical testing services for diagnostic or treatment purposes.” Turning to the second step, I also agree that the relevant public includes patients as well as medical professionals.¹ Where I reach a different outcome is the second-half of the second step, i.e., is SECOND OPINION understood by the relevant public primarily to refer to that genus of services. *Id.* While SECOND OPINION may be merely descriptive of the end purpose for which the testing is used, i.e., to render “second opinions,” it does not refer to any class or type of medical tests and is not generic for “medical testing services for diagnostic or treatment purposes.”

Although the case law recognizes that a term which is the generic name of a

¹ Applicant’s Appeal Brief p. 6 (7 TTABVUE 7); Examining Attorney’s Appeal Brief p. 3 (9 TTABVUE 4).

particular category of goods is likewise generic for any services which are directed to or focused on that class of goods,² that is not the situation present in this case. Rather, the issue is whether the generic name for a type of medical service, i.e., a “second opinion,” is also generic for medical testing for diagnostic or treatment purposes. “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d

² See also, e.g., *In re 1800Mattress.com*, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (MATTRESS.COM generic and unregistrable under § 23(c) for “online retail store services in the field of mattresses, beds, and bedding”); *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1537 (Fed. Cir. 2009) (HOTELS.COM generic for “providing information for others about temporary lodging; ... making reservations and bookings for temporary lodging for others by means of ... global computer network”); *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (LAWYERS.COM generic where lawyers were an “integral, if not the paramount, aspect” of the information services provided on the website); *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (“Because the term ‘tires’ identifies a key aspect of applicant’s services, i.e., the goods sold in applicant’s retail store, and the recitation of services specifically uses the term ‘tires’ to name the subject matter of applicant’s retail services, the term is generic for the retail sales of tires.”); *In re Lens.com Inc.*, 83 USPQ2d 1444, 1447 (TTAB 2007) (“Because ‘lens’ is a name for the contact eyewear which comprises the subject matter of applicant’s services, the term is likewise a generic name for the retail Internet store services themselves.”); *In re Eddie Z’s Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1041 (TTAB 2005) (generic terms for products equally generic for a retailer of such products); *In re Candy Bouquet Int’l Inc.*, 73 USPQ2d 1883, 1888 (TTAB 2004) (because CANDY BOUQUET is generic for gift packages of candy, it also is generic for applicant’s retail, mail and computer ordering services therefor); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206, 1210 (TTAB 1999) (because LOG CABIN HOMES is generic for a particular type of building, it is also generic for architectural design services directed to that type of building, and for retail outlets featuring log cabin construction kits); *In re Web Communications*, 49 USPQ2d 1478, 1479 (TTAB 1998) (because WEB COMMUNICATIONS is generic for publication and communication via the World Wide Web, it is also generic for consulting services directed to assisting customers in setting up their own websites for such publication and communication); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1630 (TTAB 1998) (because the term MASSFLO directly names the most important or central aspect or purpose of applicant’s goods, that is that the meters are mass flowmeters (meters that measure mass flow), this term is generic).

1632, 1634 (Fed. Cir. 2016) citing *Marvin Ginn*, 228 USPQ2d at 530.

As noted in the majority opinion, Applicant’s press release materials and website “...reveal that Applicant’s ‘second opinion’ test is conducted by or at the direction of a physician/clinician in order to provide an opinion, examination or evaluation to verify or challenge another physician’s diagnosis or recommendation, or to better understand the results of a first medical test.”³ Inasmuch as Applicant’s services are medical testing for diagnostic or treatment purposes, Applicant’s mark SECOND OPINION is not generic for such services even if such services are used in connection with providing second opinions on a patient’s medical condition.

The cases cited above establish that matter which names a central focus of a service or the goods to be sold in connection with a service are regarded as “generic.” *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 2027 n.2 (TTAB 2010). In other words, a term that names the central focus or subject matter of the services is generic for the services themselves. However, that is not what we have here. According to the definition of “second opinion” cited in the majority opinion, SECOND OPINION is “an opinion from a second qualified person . . . on a health . . . problem.”⁴ Under this definition, Applicant’s applied-for mark does not identify, nor is it generic for, medical testing services.⁵ At most, Applicant’s applied-for mark SECOND OPINION is merely

³ Decision p. 12.

⁴ Decision p. 2.

⁵ This is consistent with Applicant’s observation that other than its use of SECOND OPINION there is no evidence showing third-party uses of “second opinion” for medical testing services. Applicant’s Appeal Brief p. 7 (7 TTABVUE 8); Applicant’s Reply Brief p. 2 (10 TTABVUE 3).

descriptive of the medical testing services for diagnostic or treatment purposes which may be considered by doctors when providing a “second opinion.” “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)). Marks, such as Applicant’s mark, that are merely descriptive may be entitled to registration on the Supplemental Register. *In re Future Ads LLC*, 103 USPQ2d 1571, 1574 (TTAB 2012); *see also In re Central Soya Co., Inc.*, 220 USPQ 914, 917 (TTAB 1984) (citing *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (registration on the Supplemental Register is prima facie evidence that, at least at the time of registration, the registered mark was merely descriptive)).

The burden of showing that a proposed trademark is generic is with the USPTO. It is incumbent upon the examining attorney to make a “substantial showing . . . that the matter is in fact generic” which “must be based on clear evidence of generic use.” *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Thus, “a strong showing is required when the Office seeks to establish that a [mark] is generic.” *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). As explained by Judge Rich, “a term that immediately and unequivocally describes the purpose and function of appellant’s goods is a name for those goods, for [t]hat is what *names* do. They tell you what the

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thing *is.*” *In re Merrill Lynch*, 4 USPQ2d at 1144 (citing *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (emphasis in original)). Based on the evidence presented, there has not been a substantial showing of the genericness of the applied-for mark.

Accordingly, I would reverse the refusal to register and allow the mark to proceed to registration on the Supplemental Register.