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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Armadahealth, LLC

Serial Nos. 86713902; 86802355

Marsha G. Gentner of Dykema Gossett PLLC
for Armadahealth, LLC.

Michael Engel, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

Before Quinn, Kuczma, and Heasley,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Armadahealth, LLC (“Applicant”) filed applications to register on the Principal Register the mark **TopDoc Connect** (in standard characters), and the mark shown below

TopDocConnect

for the following services:

Physician referrals; appointment scheduling services; maintaining a registry and data base of physicians by specialty, sub specialty, and specific interest, for the purpose of assisting prospective patients in making physician and clinical selection decisions; clinical and

health concierge services, namely, appointment scheduling services that involve coordination of appointments; clinical and health concierge services, namely, referrals to a panel of experts for input and assistance and objective information and health care decision support, virtual expert second opinions, comprehensive physicals, and health care provider selections, and assistance in follow up care (in International Class 35);

Medical transport services in the nature of air medical evacuation and transport (in International Class 39); and

Health care services, namely, providing a data base of health care providers based on specialty, sub specialty and specific interest and featuring inputting and collection of data and information all for treatment and diagnostic purposes; internet-based health care information services; providing health care information by telephone and the internet; providing health information; providing information, news and commentary in the field of nutrition, health and wellness; consulting services in the field of health; health care; health care services, namely, disease management programs; making reservations and bookings for others for physician and clinical appointments; provision of health care and medical services by health care professionals via the internet or telecommunication networks; remote monitoring of data indicative of the health or condition of an individual for medical diagnosis and treatment purposes; wellness and health-related consulting services; emergency medical assistance; emergency medical response services; clinical and health concierge services, namely, appointment scheduling services that involve doctor's appointment reminder services (in International Class 44).¹

¹ Application Serial Nos. 86713902 and 86802355, filed August 4, 2015 and October 28, 2015, respectively. Both applications were filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intention to use the marks in commerce. Application Serial No. 86802355 to register the special form mark includes a description of the mark as follows: "The mark consists of the wording TOP DOC CONNECT. The 'O' in CONNECT contains a plus sign (+) and a spike at the bottom."

The Trademark Examining Attorney refused registration in each application on the ground that Applicant failed to comply with a requirement under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), to disclaim the wording TOPDOC apart from the respective marks on the basis that the wording is merely descriptive of Applicant's services.

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

The two appeals involve common issues of law and fact, and the evidentiary records are the same. Accordingly, we consider the merits in this single opinion.

The Examining Attorney maintains that a disclaimer is warranted due to the merely descriptive nature of the wording TOPDOC; more specifically, that the wording immediately describes a feature of Applicant's services, namely that the services assist prospective patients in selecting medical care provided by the best or "top" doctors in various medical specialties. The Examining Attorney submitted an excerpt from Applicant's website, as well as portions of third-party websites, dictionary definitions, a thesaurus entry, and third-party registrations.

Applicant argues that TOPDOC is just suggestive, which explains why hundreds of third-party registrations of TOP— formative marks (TOP plus a descriptive or generic term) issued on the Principal Register without either a disclaimer of TOP or resort to Section 2(f) acquired distinctiveness. In this regard, Applicant introduced copies of the third-party registrations (together with a summary chart of the registrations).

Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), reads, in relevant part, as follows: “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration. “The effect of a disclaimer is to disavow any exclusive right to the use of a specified word, phrase, or design outside of its use within a composite mark.” *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979). *See In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *Sprague Electric Co. v. Erie Resistor Corp.*, 101 USPQ 486, 486-87 (Comm’r Pats. 1954) (“As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, insofar as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.”).

“[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register.” *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986). Failure to comply with a requirement for a disclaimer is a basis on which to refuse registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *In re Omaha*

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Nat'l Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975); *In re Nat'l Presto Indus., Inc.*, 197 USPQ 188, 190 (TTAB 1977); *In re Pendleton Tool Indus., Inc.*, 157 USPQ 114, 115 (TTAB 1968).

A term or wording is merely descriptive of services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of a 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). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a term is merely descriptive is determined in relation to the services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term 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 feature of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 (TTAB 2015). The analysis requires consideration of the possible significance that the term would have to the average purchaser of the services in the relevant marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the term could guess

the services listed in the identification. Rather, the question is whether someone who knows what the services are will understand the term to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002)). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The Examining Attorney bears the burden of showing that a term is merely descriptive of the relevant services. *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

“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). See *In re Shutts*, 217 USPQ at 364-365; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, “is often made on an intuitive basis rather than as a result of logical analysis susceptible of articulation.” See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985). When the question is mere descriptiveness, to the

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extent that there is doubt, that doubt is resolved in favor of the applicant. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994); *see also In re Merrill Lynch*, 4 USPQ2d at 1144 (citing *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972)).

The term “top” is a synonym for words such as “excellent,” “preeminent,” “superior,” “five-star,” “best,” and “greatest.” (thesaurus.com) (Nov. 23, 2015 Office Action). The term “doc” is defined as follows: “*n. Informal* A person with an advanced degree licensed to practice in a medical field, such as a physician.” (thefreedictionary.com). (June 23, 2016 Office Action).

Applicant’s website includes the following description of its services: “TopDoc Connect offers personalized access to the country’s top physicians and serves as a guide for those who need specialty care.” (June 23, 2016 Office Action).

The Examining Attorney submitted five third-party registrations that include TOP DOCTORS or variations thereof. Three of the registrations are owned by the same entity: Reg. No. 3375239 (AMERICA’S TOP DOCTORS) for “providing online doctor and medical referrals” issued under Section 2(f); Reg. No. 3989296 (CASTLE CONNOLLY TOP DOCTORS) for “providing medical information and information on physicians via the internet” with a disclaimer of TOP DOCTORS; and Reg. No. 4136014 (ASK AMERICA’S TOP DOCTORS) for “providing medical information via the Internet” issued under Section 2(f) as to AMERICA’S TOP DOCTORS. A second unrelated entity owns the other two registrations, namely Reg. Nos. 4020888 (TOP HEART DOCS) and 4020889 (TOP HEART DOCTORS) for “heart and vascular

treatment, consultancy and surgery,” both issued on the Supplemental Register with disclaimers of HEART DOCS. (Nov. 23, 2015 Office Action).

The record also include two third-party uses of “Top Doctor(s)”:

Find a Castle Connolly Top Doctor
How Castle Connolly Identifies Top Doctors
The doctors included in Castle Connolly’s Top Doctor listings were selected after peer nomination, extensive research and careful review and screening by our doctor-directed team.
Hospitals participating in Castle Connolly’s Partnership for Excellence, a print and online sponsored advertorial program, are underwriting your ability to search doctors for free and identify nearly 5,300 Castle Connolly top doctors affiliated with their hospitals.
(castleconnolly.com)² (March 23, 2016 Office Action)

INDY’S TOP DOCTORS
(indianapolismonthly.com) *Id.*

The entirety of Applicant’s evidence to support a reversal of the refusal comprises hundreds of third-party registrations for marks including the term TOP, but with no disclaimer of that term or resort to a Section 2(f) claim. (May 23, 2016 Response to Office Action).³ The registrations cover a wide range of services, which consistently relate to the noun portion of the marks (with a few registrations covering goods relating to the noun portion of the marks). The Examining Attorney discounted this evidence by asserting that none of the third-party TOP— marks are used with DOC. As Applicant responds, however, the registrations “were submitted for the

² This is the same entity that owns the three registrations referred to above.

³ Applicant’s evidence also included third-party applications, which, of course, have no probative value to the issue under consideration except to show that the application has been filed. *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011).

proposition that the word **'top'** when combined with a noun that is descriptive/generic as to the goods/services identified in the registration/application consistently has been treated as a suggestive term, which would render a requirement for disclaimer of a unitary term containing 'top' inappropriate. . . ." (emphasis in original). 9 TTABVUE 11-12. In this connection, Applicant introduced hundreds of third-party registrations by way of TESS printouts. A representative sample of the live marks registered on the Principal Register includes the following (none of which include a disclaimer of TOP or a Section 2(f) claim)⁴: TOPDOCTORS LABS and design (Reg. No. 4080838); AMERICA'S NEXT TOP MODEL (Reg. No. 3154101); AMERICA'S TOP TRIAL LAWYERS (Reg. No. 4723017); TOP CHEF (Reg. No. 3759407); TOP COP (Reg. No. 4858865); TOP DRIVER (Reg. No. 1959267); NEXT TOP ATHLETE (Reg. No. 4837993); NEXT TOP PRODUCT (Reg. No. 4290308); TOP MEDIA TALENT (Reg. No. 4469517); TOP PROMOTER (Reg. No. 4639566); TOP RECRUIT (Reg. No. 4044991); TOP RX (Reg. No. 2812886); TOP SOCCER (Reg. No. 2490733); TOP TUTORS (Reg. No. 4055892); TOPCOPS DRIVING SCHOOL (Reg. No. 4494205); TOPHEALTH (Reg. No. 4236395); TOPSCHOLAR (Reg. No. 3524873); TOP IDOC (Reg. No. 4373506); TOP IP RETREAT (Reg. No. 4294644); TOP BAR ENTERTAINMENT (Reg. No. 4703420); TOPFITPROS (Reg. No. 4758988); TOPKIDS (Reg. No. 3456078); YOUR TOP SALESPERSON (Reg. No. 4236283); and TOPVETS and design (Reg. No. 4748475).

⁴ In many of the registrations, if appropriate, there is a disclaimer of the noun following TOP.

The dictionary definitions, Applicant's one descriptive use, the two third-party uses, and the five third-party registrations are probative to show that TOPDOC is merely descriptive. However, the weight of Applicant's voluminous third-party registration evidence is significant in showing that the terminology is just suggestive and, at the very least, raises a doubt about mere descriptiveness.

Generally, "dueling" third-party registrations are entitled to limited probative value; many times, the duel is fairly even, with similar numbers in support of the respective positions of the applicant and the examining attorney, which shows a general inconsistency. In the present case, however, the Office has been quite consistent in dealing with the registrability of TOP— formative marks. In all but the five registrations highlighted by the Examining Attorney, it appears that the Office considers TOP— marks to be suggestive, as evidenced by the numerous registrations submitted by Applicant.

We find that the TOPDOC portion of Applicant's mark falls on the suggestive side of the thin line between suggestive terms and merely descriptive terms. The wording TOPDOC does not immediately describe any specific characteristic or feature of Applicant's services with any degree of particularity. At worst, TOPDOC is highly suggestive of Applicant's services, which provide information about and referrals to leading or highly rated physicians, but falls short of being merely descriptive as articulated by the Examining Attorney.⁵

⁵ We find this especially to be the case with respect to Applicant's "medical transport services in the nature of air medical evacuation and transport" in Class 39.

It is not fatal that a term conveys information. One may be informed by suggestion as well as by description. *In re Reynolds Metals Company*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973). That is to say, the terms “descriptive” and “suggestive” are not mutually exclusive. There is some description in any suggestion or the suggestive process does not occur. The term TOPDOC in Applicant’s mark, in suggesting that Applicant’s services assist prospective patients in selecting the best physicians, fits this mold.

Applicant’s mark is typical of many marks that consumers encounter in the marketplace, a point shown by the third-party registration evidence of TOP—formative marks: a suggestive mark that tells consumers something general about the services (or goods), without being specific or immediately telling consumers anything with a degree of particularity. The information given is somewhat vague and indirect. *See In re George Weston Ltd.*, 228 USPQ at 58 (“‘SPEEDI BAKE’ only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread”).

As stated earlier, the third-party registrations comprise the bulk of the evidentiary record. Case law recognizes that registrations can be used as a form of a dictionary definition to illustrate how a term is perceived in the trade or industry. *See In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (“Said third-party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods . . . Used in this limited manner, ‘third-party registrations are similar to dictionaries showing how language is

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generally used.”). While third-party registrations are not conclusive on the question of mere descriptiveness, this registration evidence decidedly favors Applicant’s position that TOPDOC is suggestive. *See In re Waverly Inc.*, 27 USPQ2d 1620, 1623 (TTAB 1993) (quoting *In re Women’s Publishing Co., Inc.*, 23 USPQ2d 1876, 1878 (TTAB 1992) (“While superficially it may be easy to dismiss these [similar third-party] registrations, as we often do, on the basis that the records of these registrations are not before us and that each case must be decided on its own merits, it certainly does appear that the Office has in the past taken a different position with respect to marks of the nature of applicant’s.”)).

In view of the above, we conclude that TOPDOC is suggestive, and no disclaimer is required. The doubt raised by the numerous third-party registrations of TOP—formative marks has been resolved in Applicant’s favor. Thus, the application is passed to publication and, in this way, anyone who believes that the wording TOPDOC is, in fact, merely descriptive, may oppose and present a more complete record on this issue to the Board.

Decision: The refusal to register is reversed.