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Subject: U.S. TRADEMARK APPLICATION NO. 86871517 - HEALTH NEW ENGLAND | BE HEALTHY - 5022-0057 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86871517

MARK: HEALTH NEW ENGLAND | BE HEALTHY



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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: Health New England, Inc.

CORRESPONDENT'S REFERENCE/ DOCKET NO:

5022-0057

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's refusal to register the applied-for mark, HEALTH NEW ENGLAND | BE HEALTHY (design) for "underwriting insurance for prepaid health care" in International Class 36. Registration was refused under Sections 1 and 45 of the Trademark Act for failure to show use of the mark in commerce in connection with the applied-for services.

It is respectfully requested that the refusal be affirmed.

FACTS

On January 11, 2016, applicant filed an intent-to-use application seeking registration on the Principal Register for the mark HEALTH NEW ENGLAND | BE HEALTHY (design) for use in connection with “underwriting insurance for prepaid health care” in International Class 36 and “health care in the nature of health maintenance organizations” in International Class 44. The application was approved for publication on June 16, 2017.

On March 22, 2018, applicant filed a statement of use. The examining attorney issued an Office action on April 11, 2018 refusing registration under Sections 1 and 45 of the Trademark Act because the specimens failed to reference insurance underwriting services or health care services in International Classes 36 and 44, respectively.

On April 16, 2018, applicant responded by providing substitute specimens that failed to show acceptable use of the applied-for mark in commerce. Accordingly, a Final Office action issued on April 26, 2018 refusing registration under Sections 1 and 45.

On October 26, 2018, applicant filed a Request for Reconsideration along with additional substitute specimens and a Notice of Appeal.

On November 19, 2018, the Request for Reconsideration was denied in part as to International Class 36 because the substitute specimens failed to show use of the mark in connection with the relevant services.

Applicant filed an appeal brief on March 29, 2019.

ISSUE

The issue on appeal is whether the specimens submitted by applicant demonstrate acceptable use of the applied-for mark, HEALTH NEW ENGLAND | BE HEALTHY (design) in connection with “insurance underwriting for prepaid health care.”

OBJECTION

Applicant has submitted new evidence with its appeal brief. Specifically, applicant has provided exhibits consisting of screenshots from its website.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

Applicant's specimens fail to show use of the mark in commerce in connection with insurance underwriting services for prepaid health care.

I. APPLICANT'S SPECIMENS DO NOT SHOW USE OF THE MARK IN CONNECTION WITH THE RELEVANT SERVICES

Registration is refused because the specimens do not show the applied-for mark in use in commerce in connection with the services specified in International Class 36 in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017); *In re Graystone Consulting Assocs., Inc.*, 115 USPQ2d 2035, 2037-38 (TTAB 2015); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). Specifically, the specimens provided failed to demonstrate a direct association between the mark and "underwriting insurance for prepaid health care." *See* TMEP § 1301.04(f).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C). Specimens comprising advertising and promotional materials must show a direct association between the mark and the services. TMEP §1301.04(f)(ii).

The mark must be used “in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.” *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008); see *In re JobDiva, Inc.*, 843 F.3d 936, 941, 121 USPQ2d 1122, 1126 (Fed. Cir.2016) (“To determine whether a mark is used in connection with the services . . . a key consideration is the perception of the user.”). As explained below, none of the specimens provided clearly indicate HEALTH NEW ENGLAND | BE HEALTHY (design) as the source of insurance underwriting services for prepaid health care.

The original specimen filed March 22, 2018 is a screenshot from applicant’s website with the mark referenced as follows:

“HEALTH NEW ENGLAND | BE HEALTHY is becoming BeHealthy
Partnership effective March 1, 2018.”

Assuming arguendo that insurance underwriting services were referenced, the manner in which the mark is displayed would inform the consumer that the service mark is no longer in use, or that the relevant services are no longer provided under the service mark. Rather than showing use, the specimen shows nonuse. Applicant is advertising that it no longer uses the mark. Furthermore, the specimen fails to directly reference any services. March 22, 2018 Specimen, TSDR pp. 1-2.

The first substitute specimens filed include a paper pamphlet and cover of an online newsletter. Neither of the specimens display the applied-for mark HEALTH NEW ENGLAND | BE HEALTHY (design) itself, or in connection with insurance underwriting services. April 16, 2018 Specimen, TSDR pp. 1-2.

The Request for Reconsideration includes four screenshots from applicant’s website. Two screenshots reference the mark and state that it is no longer in use effective March 1, 2018. October 26, 2018 Specimen, TSDR pp. 3-4. The other two screenshots fail to show use of the applied-for mark in connection with the relevant services. October 26, 2018 Specimen, TSDR pp. 1-2.

For the foregoing reasons, applicant has failed to demonstrate acceptable use of the applied-for mark HEALTH NEW ENGLAND | BE HEALTHY (design) in commerce in connection with “underwriting insurance for prepaid health care.”

II. APPLICANT’S ARGUMENTS ARE UNPERSUASIVE

Applicant’s arguments are unpersuasive for the reasons listed below.

Applicant argues that the substitute specimen filed October 26, 2018 “clearly shows the mark ‘HEALTH NEW ENGLAND | BE HEALTHY’ prominently, in large font, on the home page of the applicant’s publicly available website.” March 29, 2019 Appeal Brief, p. 1. However, directly below the applied-for mark it states: “HEALTH NEW ENGLAND BE HEALTHY is becoming BeHealthy Partnership effective March 1, 2018.” October 26, 2018 Specimen, TSDR pp. 3-4. Applicant has repeatedly submitted evidence of discontinued use of the applied-for mark. March 22, 2018 Specimen, TSDR pp. 1-2; October 26, 2018 Specimen, TSDR pp. 3-4.

Applicant’s argument that the BROKER link provides sufficient connection to the relevant services is unconvincing because “broker” is a general term that refers to any individual who buys or sells assets for others and the specimen fails to indicate specifically what is being brokered. Moreover, the evidence of discontinued use shows the applied-for mark is no longer in use.

Applicant goes on to argue that “there is no requirement that a specimen show the exact language used in the description of the goods or services section of an application.” March 29, 2019 Appeal Brief, p. 3. The examiner agrees and submits that the specimens were unacceptable because they either failed to reference any services whatsoever, as was the case with the original specimen, or failed to establish a clear connection between the mark and the applied-for services, as was the case with the substitute specimens. Moreover, four screenshots provided by the applicant stated that the applied-for mark is no longer in use.

Finally, applicant asserts that “there is no requirement that a single webpage of a multi-page website show the mark used in connection with each term of the description, nor has the Office cited the requirement.” March 29, 2019 Appeal Brief, p. 3. Again, the examiner agrees and restates that the specimens were unacceptable because they failed to establish a clear connection between the applied-for mark and relevant services, not because of their multi-page format.

CONCLUSION

For the reasons stated above, the applicant’s specimens have failed to demonstrate acceptable use of the mark HEALTH NEW ENGLAND | BE HEALTHY (design) in connection with “insurance underwriting for prepaid health care.”

Accordingly, it is respectfully requested that the refusal to register be affirmed.

Respectfully submitted,

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