

ESTTA Tracking number: **ESTTA1278062**

Filing date: **04/12/2023**

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

Ex Parte Appeal - Serial No.	90238722
Appellant	Institute on Aging
Applied for mark	INSTITUTE ON AGING
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Submission	Reply brief
Attachments	Reply Ex Parte Appeal Brief IOA Class 35.pdf(426622 bytes)
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Date	04/12/2023

Trademark Law Office: 103
Serial No.: 90/238722
Mark: INSTITUTE ON AGING & DESIGN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	Institute on Aging.	Attorney Docket No. 00103758-00006
Serial No.:	90/238722	Trademark Attorney: Jacob Vigil
Filed:	October 6, 2020	Law Office: 103
Mark:	INSTITUTE ON AGING & DESIGN	International Class: 35

APPLICANT'S REPLY BRIEF

Seattle, Washington 98104

April 12, 2023

INTRODUCTION

Applicant seeks to register “Institute on Aging” & Design for referrals to the elderly for providers of goods and services to facilitate independent living, and referrals for emotional and psychological counseling in Class 35. The Examiner requires Applicant to disclaim “Institute on Aging” on the grounds that the wording is allegedly either generic or merely descriptive. In the brief submitted to the Board, the Examiner’s analysis suffers from the same flaws it has throughout the prosecution of the application, namely, inaccurate statements about the evidence in the record (particularly in relation to third-party use of the phrase “Institute on Aging”) and mischaracterizing and misapplying legal principles. As Applicant argued in its opening brief (and throughout the prosecution), the Examiner has failed to locate evidence demonstrating that the elderly and their families¹ primarily understand the phrase “Institute on Aging” to identify a genus of services, thus “Institute on Aging” is not generic. In addition, Applicant’s long-term, substantially exclusive use of the “Institute on Aging” mark in connection serving a large number of consumers, along with supportive advertising and other evidence, demonstrates that the phrase has acquired distinctiveness. Applicant requests that the application be allowed to proceed to publication.²

I. There is Zero Evidence that the Relevant Consumers Understand “Institute on Aging” to be a Generic Name for Any Service

A phrase is generic if it “names a ‘class’ of goods or services, rather than any particular feature of exemplification of the class.”³ It is the Examiner’s burden of proving by clear evidence that the relevant consumers primarily understand “Institute on Aging” to be a generic name for a genus of services.⁴

¹ Applicant and the Examiner agree that these are the relevant consumers for the genericness inquiry.

² Despite the Board’s consolidation, Applicant is exercising its right to submit separate briefs for each application. TBMP § 1214. In his brief, the Examiner has applied an incorrect genericness analysis that involves merging Applicant’s services that span 5 trademark classes into 1 genus; Applicant hopes that briefing the refusal for each application separately will mitigate the impact of the Examiner’s erroneous approach.

³ *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 207 L. Ed. 2d 738, 2020 USPQ2d 10729 (2020).

⁴ See, e.g., *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

Importantly, consumer perception determines whether a mark is generic.⁵ Here the record lacks any evidence that the elderly and their families primarily view “Institute on Aging” as the name for a category of services, much less the required clear evidence. And although the record does not support the Examiner’s genericness refusal whatsoever, any doubt as to whether consumers perceive “Institute on Aging” as identifying a class of services must be resolved in Applicant’s favor.⁶

A. The Evidence of Use of “Institute on Aging” in the Record Does Not Demonstrate that Consumers Primarily View the Phrase as Generic

Starting with his first review of the application at issue, the Examiner has largely based his position that “Institute on Aging” is generic on website evidence reflecting that some third parties include the phrase “Institute on Aging” in their trademark. Although the Examiner claims that there are as many as twenty-two other entities that use “Institute on Aging” in their trademark, the actual number is only thirteen,⁷ only five of which offer services to the same class of consumers as Applicant (and none of these offer overlapping or related Class 35 services), while the remaining eight are academic educational and training organizations serving a totally different class of consumers.⁸ In any event, even if the Examiner had correctly counted the number of relevant entities using “Institute on Aging” in their trademarks, use

⁵ *Booking.com*, 140 S. Ct. at 2304 (“[T]he relevant meaning of a term is its meaning to consumers.”).

⁶ *See In re GJ & AM, LLC*, 2021 USPQ2d 617, at *33 (TTAB 2021).

⁷ Opening Br. 12-13, 6 TTABVUE 13-14. The Examiner has included inaccurate evidence regarding third party use, for example: the “LeVine Institute on Aging” does not appear to exist at all, *compare* March 5, 2021 Priority Action, TSDR 8 *with* March 28, 2022 Office Action Resp., TSDR 22-27; the University of Pittsburgh uses the phrase “Aging Institute” not “Institute on Aging,” contrary to the third-party directory webpage submitted by the Examiner, *compare* March 28, 2022 Office Action Resp., TSDR 29-30 *with* March 5, 2021 Priority Action, TSDR 9; “Donald W. Reynolds Institute on Aging” is double counted, *compare* May 6, 2022 Final Action, TSDR 27 *with* Nov. 23, 2022 Denial of Request for Recon., TSDR 165; and “Garrison Institute on Aging” is double counted, *compare* March 5, 2021 Priority Action, TSDR 7 *with* Nov. 23, 2022 Denial of Recon., TSDR 170.

⁸ Benjamin Rose Institute on Aging, Institute on Aging Services at Jewish Senior Life, South Florida Institute on Aging, Institute on Aging at the University of Florida, and Donald W. Reynolds Institute on Aging deliver other services to the elderly. March 5, 2021 Priority Action, TSDR 6; March 28, 2022 Office Action Resp., TSDR 14-15, 22-38; May 6, 2022 Final Action, TSDR 24-25, 27-29. The Examiner used a carefully placed cursor to misleadingly suggest that the “Phoebe Institute on Aging” mark is associated with a broader array of services than in fact are offered, and the Examiner misrepresents the scope of the University of Pittsburgh’s Aging Institute, which are in fact academic research services. March 28, 2022 Office Action Resp., TSDR 29-38; Appeal Br. 12-13, 6 TTABVUE 13-14.

in a trademark is very different from the kind of evidence the case law recognizes as relevant to show that consumers understand a phrase to identify a genus of services, and the record lacks such evidence.

a. Use of a Phrase in a Trademark Does not Demonstrate that the Phrase is Primarily Understood to be Generic

As the Supreme Court has recognized, when a term is generic one would expect to find examples of consumers already using the allegedly generic terminology to refer to the services described in the application. For example, if “Booking.com” were the generic name for travel services, there likely would be evidence of consumers searching for a “favorite ‘Booking.com’ provider.”⁹ In *Sheetz of DE, Inc. v. Doctor’s Assocs.*, the Board drew a distinction between the kind of evidence that would reflect consumer recognition of a term as a generic versus use of a term as a trademark. In *Sheetz*, the Board held that “Footlong” was a generic term for “sandwiches,” pointing to multiple examples of third parties using “footlong” (or “foot-long”) to “denote a type of sandwich,” consumers in restaurant reviews using “footlong” to name a sandwich, and articles with “footlong” functioning as a noun to denote a sandwich. The Board distinguished this evidence from use of a term to indicate “the source of the user’s goods,” i.e., as a trademark.¹⁰ Similarly, in *In re The Consumer Protection Firm PLLC*, the Board held that “Consumer Protection Firm” was generic for legal services where the record contained “a plethora of explanatory uses of ‘consumer protection,’ ‘consumer protection firm’ and ‘consumer protection law firm’ by Applicant and competitor law firms that practice ‘consumer protection law.’”¹¹

The evidence of competitors, consumers, and the applicants using the allegedly generic wording that is described in *Booking.com*, *Sheetz*, and *The Consumer Protection Firm* is wholly unlike the evidence in the record here. The evidence of use of “Institute on Aging” by third parties (most of whom are not even competitors of Applicant) largely reflects use of the phrase as part of a trademark and not as

⁹ *Booking.com*, 140 S. Ct. at 2304-05.

¹⁰ 108 USPQ2d 1341, 1354-59 (TTAB 2013).

¹¹ 2021 USPQ2d 238, at *17 (TTAB 2021).

a noun; however, use in a trademark does not, by itself, provide any evidence that the elderly and their families understand “Institute on Aging” to name a service. It is axiomatic that a trademark identifies a source of goods or services,¹² thus it is not surprising that the Examiner has cited no case where the only or even primary evidence relied on to prove that a term is generic consisted of third parties using the term in their trademark. In the cases the Examiner does cite where third-party trademark use is mentioned, the record contained ample other evidence demonstrating that the wording is generic.¹³

Although the Examiner included pages from Applicant’s website in the record supposedly in support of his position, in fact all such pages demonstrate that Applicant uses “Institute on Aging” as a trademark and not as a noun identifying its services, and thus do not demonstrate that “Institute on Aging” is generic.¹⁴ Equally bizarrely, the Examiner devotes 154 pages to third-party USPTO records where generic terms like “hospital,” “medical center,” and “university” are disclaimed from registrations on the Supplemental Register, which makes the irrelevant point that these terms are viewed as generic.¹⁵ Notably, the record contains zero equivalent evidence from the Supplemental Register regarding “Institute on Aging” (or even “Institute” or “Aging”); to the contrary, the record reflects that “Institute” and “Aging” are included in many third-party registrations, often without a 2(f) claim, which supports the view that consumers do not primarily understand “Institute on Aging” to name a type of service.¹⁶

b. None of the other use of “Institute on Aging” in the record demonstrates that the phrase is a generic name

¹² 15 USC § 1127.

¹³ Examiner’s Br. 11, 8 TTABVUE 11; *see In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2021-24 (TTAB 2010) (record contained evidence of the applicant and third parties using “electric candle” to name a type of lighting fixture, and the USPTO Acceptable Identification manual included “electric candles”); *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1865 (TTAB 1988) (the record consisted of 7 articles referencing “paint products” as a noun); *In re E. I. Kane, Inc.*, 221 USPQ 1203, 1205 (TTAB 1984) (record reflected several pages of third-party ads from the Yellow Pages referencing “movers” and “office moves”).

¹⁴ May 6, 2022 Final Action, TSDR 9, 18; March 28, 2022 Office Action Resp., TSDR 76-149, 201-02, 213-35.

¹⁵ Nov. 23, 2022 Denial of Recon., TSDR 7-161.

¹⁶ March 28, 2022 Office Action Resp., TSDR 40-46; Nov. 7, 2022 Request for Recon., TSDR 9-30.

In the Denial of Applicant's Request of Reconsideration, the Examiner added nine websites to the record where an "an" is put before the phrase "Institute on Aging" or "institute on aging."¹⁷ However, such evidence fails to prove that the elderly and their families primarily understand the phrase "Institute on Aging" to name a category of services. First, the evidence does not reflect use by or directed at the relevant consumers, such as use by a competitor of Applicant in a website promoting their "institute on aging" services for the elderly. Rather, the websites are directed at consumers of academic/education/training services¹⁸; people who may want to start a business¹⁹; advocates, state officials, and legislators²⁰; or institutional foodservice directors.²¹ Second, in five of the nine websites, "Institute on Aging" is presented as a proper noun with capital letters and therefore not a generic term identifying a category of services.²²

B. The Dictionary Evidence does not Prove that "Institute on Aging" is Generic

The Examiner submitted the definitions of "institute" and "aging" from the dictionary, but this fails to prove that the phrase "Institute on Aging" is primarily understood by the elderly and their families to identify a type of service. As the Federal Circuit held in *In re American Fertility Soc'y*, dictionary evidence demonstrating that the individual words in AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE are generic was not enough to show that a phrase using such words is generic. Dictionary definitions can show that the wording used in a phrase is "apt" but that does not prove that a phrase containing those words

¹⁷ Nov. 23, 2022 Denial of Recon., TSDR 162-170.

¹⁸ *Id.* 163-165, 167, 169-70. One of the educational organizations, the Donald W. Reynolds Institute on Aging, appears to also offer healthcare services, but not the referral services described in this application. *See id.* 165; May 6, 2022 Final Action, TSDR 27. Contrary to the suggestion in the TV station website included in the record, *see* Nov. 23, 2022 Denial of Recon., TSDR 170, the Garrison Institute on Aging referenced on the website does not provide services to the elderly and their families, but rather is an academic research and education organization. March 5, 2021 Priority Action, TSDR 7.

¹⁹ Nov. 23, 2022 Denial of Recon., TSDR 162.

²⁰ *Id.* 166.

²¹ *Id.* 168.

²² *Id.* 164-65, 167-68, 170.

is generic.²³ Rather, to prove that a phrase is generic, the evidence must reflect the relevant consumers' understanding of the phrase as a whole,²⁴ and as discussed *supra*, there is zero evidence (much less clear evidence) demonstrating that the elderly and their families primarily understand "Institute on Aging" to identify a genus of services, thus "Institute on Aging" is not generic but rather is descriptive.

II. The Description in the Application Identifies the Relevant Genus of Services

Given that the record does not reflect that the elderly or their families primarily understand "Institute on Aging" to name any services, the question of how to correctly define the genus should be moot. However, if the Board has a different view of the record, it should not adopt the Examiner's broad description of the relevant genus.

As the Federal Circuit held in *In re Cordua Restaurants, Inc.*, "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."²⁵ Consequently, the relevant genus of services are those described in the application, i.e., the referral services described in the Class 35 application at issue.

Against the "legion" of authority to the contrary, the Examiner argues – without authority – that the relevant services for the genericness inquiry is the broad category of "a continuum of services focused on serving aging adults and their families through a continuum of services" that fall into at least five different trademark classes.²⁶ According to the Examiner, because Applicant offers services in more than

²³ 188 F.3d 1341, 51 USPQ2d 1832, 1836-37 (Fed. Cir. 1999) (phrases like "American Bar Association" are an apt name for an association of lawyers, but that does not mean that it is a generic name).

²⁴ *Id.* at 1837.

²⁵ 118 USPQ2d 1632, 1636 (Fed. Cir. 2016) (quoting *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir.1990)).

²⁶ Examiner's Br. 4, 8 TTABVUE 4. The genericness analysis should be done class-by-class even if Applicant had filed a multi-class application; Applicant is aware that multi-class applications are an option. *Id.* 8 TTABVUE 7.

one trademark class, that fact necessarily means that the relevant genus must encompass all of Applicant's services.²⁷ The Examiner cites two cases where the genus of services was expanded beyond those described in the application, but in those cases there was evidence that the applicants had manipulated their descriptions to try to avoid a descriptiveness refusal, and moreover the genus was ultimately defined to include goods or services that were subsets of the listed goods/services or arguably encompassed by the listed services.²⁸ Here, Applicant has not manipulated the description of services in its application, and the Examiner is trying to define the genus to include services outside the scope of services that are or even could be listed in the application. The Board should reject the Examiner's unsupported approach and hold that the relevant genus of services consists of the referral services described in the application.

III. The Record Demonstrates that "Institute on Aging" has Acquired Distinctiveness

Applicant has been prominently using "Institute on Aging" as its trademark for over 20 years, and has submitted voluminous evidence demonstrating consumer exposure to its trademark, how it promotes the mark in advertisements, and consumer and third-party recognition of "Institute on Aging" as a source identifier.²⁹ Against this mountain of evidence demonstrating that "Institute on Aging" has acquired distinctiveness, the Examiner raises four arguments. First, the Examiner argues that the evidence is not sufficient because "Institute on Aging" is allegedly in the "highly descriptive" category, an argument based solely on his (inaccurate) view of the number of third parties using "Institute on Aging" in their trademarks,³⁰ as opposed to looking at the inherent nature of the mark itself.³¹ The fact that many third

²⁷ *Id.* 5-6. The fact that some terms like "university" can be the generic name for services in more than one trademark class does not shed any light on whether the elderly and the aging primarily understand the "Institute on Aging" to name services identified in the relevant trademark classes. *Id.* 7-8.

²⁸ *Id.* 5; see *In re Reed Elsevier*, 482 F.3d 1376, 82 USPQ2d 1378, 1378-80 (Fed. Cir. 2007); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437-38 (TTAB 2005).

²⁹ Applicant's Br. 18-24, 6 TTABUVE 19-25.

³⁰ Examiner's Br. 14-15, 8 TTABVUE 14-15.

³¹ See *In re Steelbuilding.com*, 75 USPQ2d at 1424 (steelbuilding.com in the highly descriptive category).

parties that have registered analogous marks containing “Institute” and “Aging” on the Principal Register supports Applicant’s view that “Institute on Aging” does not belong in the highly descriptive category.³²

Second, the Examiner claims that the Declaration from Applicant’s President and CEO, J. Thomas Briody, should not be considered because it is allegedly “conclusory,”³³ but then fails to point to any portion of the declaration containing the kind of conclusory statements that can make declarations less persuasive because there are none. The Examiner believes that all declarations submitted by staff of an applicant must be deemed conclusory and rejected, an argument wholly without merit.

Third, the Examiner asserts that Applicant’s use of “Institute on Aging” has not acquired distinctiveness because its use of the phrase is not substantially exclusive. Applicant’s claim of acquired distinctiveness would be only undercut if there were evidence of numerous third parties using the same terminology in connection with the same services as Applicant and directed at the same consumer class, but there is no such evidence.³⁴ Here, there are only thirteen third parties using “Institute on Aging” in their trademark, and of these thirteen none provides the referral services described in this application,³⁵ and only five total provide services to the same class of consumers that Applicant serves, namely the elderly and families.³⁶ The other third parties who use “Institute on Aging” in their trademarks are academic research and training entities, which serve a different class of consumers. Moreover, the third-party uses are, with one exception, not for “Institute on Aging” but rather longer phrases like “Benjamin Rose Institute on Aging.” Because there are no directly relevant examples of other entities using

³² March 28, 2022 Office Action Resp., TSDR 40-46; November 7, 2022 Request for Recon., TSDR 9-11, 21-30.

³³ Examiner’s Br. 17, 8 TTABVUE 17.

³⁴ See *Royal Palm Properties, LLC v. Pink Palm Properties, LLC*, 950 F.3d 776, 2020 USPQ2d 10053 (11th Cir. 2020).

³⁵ Benjamin Rose Institute on Aging, Institute on Aging Services, and South Florida Institute on Aging appear to offer the relevant Class 45 services. The Examiner’s claim that there are more entities offering the Class 45 services or even services to the relevant consumers is not correct. See fn. 7 & 8, *supra*.

³⁶ The three previously cited entities plus Institute on Aging (associated with the University of Florida College of Medicine) and Donald W. Reynolds Institute on Aging. See fn. 7 & 8, *supra*.

“Institute on Aging” in their trademarks (or even if the Board were to consider the five uses directed at the same class of consumers), the third-party uses are not sufficiently numerous to undercut Applicant’s claim that its use is substantially exclusive.

Fourth, the Examiner makes an assortment of attacks on Applicant’s evidence, all of which should be rejected. Applicant has submitted 171 pages of evidence (including advertisements) where “Institute on Aging” is presented as an independent trademark, or separable element when displayed with a logo; “Institute on Aging” is not an inseparable portion of a word mark, for example. The Examiner cites no support for his argument that because a logo appears in the vicinity of a word mark, the word mark is therefore not perceived by consumers as a trademark. To the contrary, the Examiner is requiring a disclaimer of the wording portion of Applicant’s compound Institute on Aging & Design mark, which recognizes that “Institute on Aging” is a separable element in such compound mark. For the same reason that “Institute on Aging” is a separable disclaimable element (if it were generic or merely descriptive, which it is not) so too can the phrase acquire distinctiveness from use as part of a compound mark.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the disclaimer requirement be lifted and the Application be allowed to proceed to publication.

Respectfully submitted,

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