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Subject: U.S. Trademark Application Serial No. 90238722 - INSTITUTE ON AGING - 103758-6 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 90238722

Mark: INSTITUTE ON AGING

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Reference/Docket No. 103758-6

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the final refusal to register the mark INSTITUTE ON AGING (and design) without a disclaimer of the wording "INSTITUTE ON AGING", under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), because the wording is unregistrable, generic wording under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, and in the alternative, because the wording "INSTITUTE ON AGING" merely describes the services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and the proffered evidence is not sufficient to show acquired distinctiveness of the highly descriptive wording under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

STATEMENT OF FACTS

Applicant filed its application on October 6, 2020 for the mark INSTITUTE ON AGING (and design) for use with "referrals in the field of suicide intervention, elder abuse counseling, grief support, emotional assistance and reassurance; referrals in the field of providers of goods and services to enable the elderly to live independently" in International Class 35.

After attempts to resolve the disclaimer issue by examiner's amendment were not successful, the examining attorney issued a priority action on March 5, 2021, requiring disclaimer of the wording "INSTITUTE ON AGING" on the grounds that the wording at best merely described the services. The action included evidence showing third parties offering a continuum of services to assist the elderly and their families referred to as institutes on aging.

Applicant responded to the action on September 1, 2021, conceding the descriptive nature of the wording "INSTITUTE ON AGING" by arguing that it has acquired distinctiveness in the wording based on an allegation of at least five years of "substantially exclusive and continuous use."

On September 27, 2021, the examining attorney issued a new, non-final Office action in light of the new claim of acquired distinctiveness. The action maintained the disclaimer requirement, noting that the wording is generic. The action included a new issue, in the alternative, regarding the claim of acquired distinctiveness based only on five years of use being insufficient because the wording is highly descriptive due to the evidence of third-party use included in the first Office action.

Applicant responded to the subsequent action on March 28, 2022, contesting the generic nature of the phrase and providing new evidence in an attempt to support its claim of acquired distinctiveness.

The examining attorney issued a final action on May 6, 2022, making final the disclaimer requirement regarding the wording "INSTITUTE ON AGING" being generic and the requirement in the alternative regarding insufficient evidence of acquired distinctiveness. The action included evidence from applicant's website and companion applications showing the true scope of the services offered and therefore the appropriate genus of services to be considered. The action also included additional evidence of third parties offering a similar continuum of services to assist the elderly and their families referred to as institutes on aging.

On November 7, 2022, Applicant filed a request for reconsideration, contesting the generic nature of

the phrase, and simultaneously filed a notice of appeal with the Trademark Trial and Appeal Board. The request did not include any new evidence of acquired distinctiveness.

The examining attorney denied the request for reconsideration on November 23, 2022. The denial letter included additional examples of third parties using "institute on aging" as a generic term to refer to places offering a continuum of services to support the elderly and their families. The evidence also contained a sample of third-party registrations showing similar terms "HOSPITAL", "MEDICAL CENTER", and "UNIVERSITY" disclaimed on the Supplemental Register as generic for services in multiple classes.

The Board resumed the appeal proceedings on November 29, 2022. Applicant timely filed its appeal brief on January 26, 2023, which was forwarded to the examining attorney on January 30, 2023.

ISSUES PRESENTED

I. Whether a disclaimer of the wording "INSTITUTE ON AGING" is required under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), because the wording is generic for applicant's services under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, in light of the abundance of evidence of record showing the wording used by third parties to identify the same and similar continuum of services.

II. In the alternative, whether a disclaimer of the wording "INSTITUTE ON AGING" is required under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), because the wording is highly descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and applicant's proffered evidence of acquired distinctiveness is insufficient to show that consumers will understand the wording as identifying the source of applicant's services under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

ARGUMENT

I. THE WORDING "INSTITUTE ON AGING" IS GENERIC FOR APPLICANT'S SERVICES AND THEREFORE MUST BE DISCLAIMED.

Section 6(a) of the Trademark Act states that "[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." 15 U.S.C. §1056(a). Failure to comply with

a disclaimer requirement is grounds for refusing registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re UST Global (Sing.) Pte. Ltd.*, 2020 USPQ2d 10435, at *2 (TTAB 2020); *In re Nat'l Presto Indus., Inc.*, 197 USPQ 188 (TTAB 1977).

Marks containing in part matter that is generic must disclaim that matter to be registered on the Principal Register. TMEP §1213.03(b). No amount of evidence of acquired distinctiveness can render generic matter registrable. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370 (Fed. Cir. 2018) (quoting *Northland Aluminum*, 777 F.2d 1556, 1558 (Fed. Cir. 1985)). A mark is generic if its primary significance to the relevant public is the class or category of goods or services with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i). Determining whether a mark is generic requires a two-step inquiry: 1) determine the genus of goods and/or services at issue; 2) determine whether the relevant public understand the designation primarily to refer to that genus of goods and/or services. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d at 989-90, 228 USPQ at 530; *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1463 (TTAB 2015); TMEP §1209.01(c)(i).

Here, the record shows that the genus of services consists of a continuum of services focused on serving aging adults and their families through a continuum of services including "health services, day care services, social and emotional support services, referral services for providers of goods and services to support independent living, financial management and fiduciary services, and personal care assistance of activities and daily living, such as bathing, grooming, and personal mobility."^[1] The evidence of record also shows that the relevant consumers understand the wording "INSTITUTE ON AGING" as referring to such a continuum of support services for aging adults because there are numerous parties using the wording to refer to such services. Thus, the refusal to register the mark INSTITUTE ON AGING (and design) without a disclaimer of the generic wording "INSTITUTE ON AGING" should be affirmed.

A. The genus of services consists of a continuum of services for caring for and supporting elderly adults.

Regarding the first part of the inquiry, the genus of goods and/or services is often defined by an applicant's identification of goods and/or services. *In re Meridian Rack & Pinion*, 114 USPQ2d at 1463. However, the fact that the genus is often derived from the identification of the goods and/or services in the application is based on the premise that the identification accurately reflects the true scope of the goods and/or services with which the applied-for mark is used. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437-38 (TTAB 2005) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)). Where an applicant's website or other competent evidence shows that applicant's goods and/or services are offered in connection with other interrelated goods and/or services not in the identification, those goods and/or services should also be considered when determining the particular genus. *See In re Reed Elsevier Props. Inc.*, 482 F.2d 1376, 1379-80, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007); *In re DNI Holdings Ltd.*, 77 USPQ2d at 1438.

Applicant's website states that they "serve as an essential partner in the continuum of care by providing health services, social and emotional support, and education and advocacy."^[2] Additionally, applicant provided a declaration from its president and CEO confirming this scope of services. The declaration states:

In the thirty-plus years since IOA's founding, IOA has expanded the scope of its services to include health services, day care services, social and emotional support services, referral services for providers of goods and services to support independent living, financial management and fiduciary services, and personal care assistance of activities and daily living, such as bathing, grooming, and personal mobility, all for the disabled and elderly.^[3]

Moreover, considering the five companion applications together, applicant has applied for "Referrals in the field of suicide intervention, elder abuse counseling, grief support, emotional assistance and reassurance; referrals in the field of providers of goods and services to enable the elderly to live independently" in International Class 35, "Bill payment and financial management assistance for elderly and disabled adults" in International Class 36, "Day care centers for the elderly" in International Class 43, "Home health care services; health care services" in International Class 44, and "Emotional counseling and emotional support services for the elderly and disabled in the fields of suicide

intervention, elder abuse counseling, grief support, and emotional assistance and reassurance; providing emotional support services for the elderly by engaging in outreach activities in the nature of regularly calling and conversing with lonely older adults; in-home support services to senior persons, namely, geriatric care management services in the nature of the coordination of necessary services and personal care for older individuals; social services for the elderly and disabled, namely, companionship, and personal care assistance of activities of daily living, such as bathing, grooming, and personal mobility" in International Class 45.^[4] Thus, applicant's website, declaration, and companion trademark applications show that the true genus of the services offered under the INSTITUTE ON AGING (and design) mark exceeds merely the services identified in this application and covers, as applicant describes, a "continuum of care" consisting of "health services, day care services, social and emotional support services, referral services for providers of goods and services to support independent living, financial management and fiduciary services, and personal care assistance of activities and daily living, such as bathing, grooming, and personal mobility," including the identified "referrals in the field of suicide intervention, elder abuse counseling, grief support, emotional assistance and reassurance; referrals in the field of providers of goods and services to enable the elderly to live independently." This evidence, consisting of statements and filings by applicant itself, show that the true genus is a continuum of services for assisting elderly and disabled individuals.

Applicant insists, without support, that the genus cannot be broader than the identification of services. Particularly, applicant fixates on language from the September 27, 2021 Office action stating that the identification of services "adequately" defines the genus at issue. And that is true. However, the term "adequately" does not mean the identification of services is the only characterization of the genus, the perfect characterization of the genus, the best characterization of the genus, or the broadest characterization of the genus.

The flaw in applicant's reasoning is demonstrated with a simple example. Under applicant's reasoning, if an application for the mark UNIVERSITY identifies "providing classes in the field of mathematics" in International Class 41, the mark could not be considered generic because universities offer more than just math classes, including services classified in other classes. To go a step further, applicant believes that if the same entity filed numerous companion applications for the same mark for classes in other subjects in International Class 41, career services in International Class 35, and

research services in International Class 42, the mark UNIVERSITY still could not be considered generic in any such application because applicant believes the consideration of the relevant genus must be limited to the identification of services in each separate application. This of course is not a viable standard because it would allow clever drafting of identifications of goods and services and/or strategic filing practices to render generic terms registrable.

As applicant notes, this kind of tactical cleverness appeared to occur in the *Reed Elsevier* and *DNI Holdings* cases.^[5] Applicant claims, unprompted, that it filed five one-class applications rather than one five-class application because applicant was unaware that an application could include goods or services in multiple classes and not because it was a tactical decision to disguise the true scope of the services offered. Ultimately, whether applicant was unaware or making a tactical decision is irrelevant. In either case, there is competent evidence of record consisting of applicant's website, declaration, and co-pending applications showing that the genus of services is a "continuum of care" consisting of "health services, day care services, social and emotional support services, referral services for providers of goods and services to support independent living, financial management and fiduciary services, and personal care assistance of activities and daily living, such as bathing, grooming, and personal mobility, all for the disabled and elderly."

B. The evidence of record consisting of extensive third-party use of the term shows that the relevant consumers will understand “INSTITUTE ON AGING” as referring to the genus of services.

Any term that the relevant public understands as referring to a particular genus of goods and/or services is generic; thus there can be more than one generic term for a particular genus. *In re 1800Mattress.com IP, LLC*, 586 F. 3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1464 (TTAB 2015).

Evidence showing the relevant consumers' understanding of the term may come in many forms, including dictionary definitions, websites and other publications showing usage by consumers and competitors. *See USPTO v. Booking.com B.V.*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6 ("Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning."); *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *8-

12 (TTAB 2021) (THE CONSUMER PROTECTION FIRM held generic for legal services, where the examining attorney cited examples of webpages of third party consumer protection law firms and three different lawyer search sites where "consumer protection" could be selected as a search term for consumers to find attorneys in that practice area); *Cont'l Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999) (use of term "e-ticket" by media and competitors indicates term is generic for electronic tickets); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 176 (TTAB 1986) (evidence that competitors have used a particular word as the name of their goods is persuasive evidence of genericness)).

The evidence of record consists of dictionary definitions of "INSTITUTE" and "AGING". The evidence defines "INSTITUTE" as "an organization founded to promote a cause,"^[6] and it defines "AGING" as "the process of growing or maturing."^[7] Thus, the plain meaning of the combination "INSTITUTE ON AGING" in the context of the services is an organization promoting causes relating to maturing individuals, such as the identified referral services.

Applicant correctly notes that the Supreme Court in *Booking.com* explained that evidence for genericness might be expected to include competitors being referred to as the generic term. 140 S. Ct. at 2304-05. Contrary to applicant's claim that the record contains "zero evidence" of such use, the large majority of the evidence of record consists of marketplace evidence showing others in applicant's industry being referred to as institutes on aging. A sample of the evidence includes:

- The webpage for the Phoebe Institute on Aging showing that they provide services in independent living, medical and mental health care, IT consulting, adult day care, spiritual support, education, pharmacy services, and affordable housing. March 5, 2021 Priority Action, TSDR 2-3.
- The webpage for the Benjamin Rose Institute on Aging showing that they provide financial health and wellness services, health and wellness services, help at home, housing services, and a resource library. March 5, 2021 Priority Action, TSDR 4.
- A webpage with information regarding Institute on Aging - University of Pittsburgh showing that the institute offers information and resources for helping older adults and their families with advance planning, care management, caregiving and work, elder abuse and neglect, financial planning, insurance, legal rights, and respite. March 5, 2021 Priority Action, TSDR 7.
- The webpage for the University of Florida Institute on Aging showing that the institute "promote[s] the health, independence, and quality of life of older adults by means of interdisciplinary teams in the areas of research, education, and health care." May 6, 2022 Final

Action, TSDR 1, Pg. 24.

- The webpage for the South Florida Institute on Aging showing that the services offered include friendly visits, rapid response support, technology classes, job training, and caregiver respite. May 6, 2022 Final Action, TSDR 1, Pgs. 28-29.
- A webpage from the website StartUpBizHub titled "Starting an Institute on Aging" explaining that knowledge of several areas is necessary, such as care coordination, healing and counseling, day programs, in-home care, money management, memory loss, household or personal support, prevention of elderly abuse, and long term care planning. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pg. 162.
- The website for CFM Advocates explaining that "CFM helped a nonprofit dedicated to helping underserved older adults to rebrand and assisted an institute on aging to sharpen its data presentation and messaging." November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pg. 166.
- An obituary noting that the deceased "was one of the founders of a school, a nursing program, a psychological training institute, an urban commune, and an institute on aging." November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pg. 169.

This evidence of competitor and consumer use of the phrase is paramount in determining the consumer perception of the wording "INSTITUTE ON AGING" because it shows how consumers encounter and use the phrase themselves. The use by numerous third-parties combined with other matter in their marks shows that consumers commonly encounter the wording as indicating a type of business and service. Furthermore, evidence showing non-competitor use of the phrase as a noun shows that the wording is understood as indicating a type of business and service.

Applicant argues that the wording merely identifies a type of organization, not a genus of services. However, this overlooks the possibility that consumers recognize the name of a type of business, entity, organization, or institution as also being the name of the services offered, especially when the institution provides a continuum of various services, as is the case here. The evidence of record includes a sample of third-party registrations showing three terms, "hospital," "medical center," and "university," that are names of types of businesses, entities, organizations, or institutions disclaimed on the Supplemental Register as generic terms for services classified in multiple international classes.^[8] The registrations show "hospital" and "medical center" treated as generic for health and medical services in International Class 44 as well as services in classes 41 and 42 and "university" treated as generic for education services in International Class 41 as well as services in classes 35, 36, and 44. A sample of those registrations includes:

- Reg. No. 2629543 for HEART HOSPITAL OF NEW MEXICO ("HEART HOSPITAL" disclaimed) for use with "Educational services, namely, conducting classes, programs, seminars, conferences and workshops relating to diseases and disease prevention measures and distributing course materials in connection therewith" in International Class 41 and "Hospital, medical clinic and health care services, namely, preventive, diagnostic, therapeutic and surgical services" in International Class 44. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 13-14.
- Reg. No. 3038538 for THE CANCER HOSPITAL OF NEW JERSEY ("CANCER HOSPITAL" disclaimed) for use with "Cancer research services" in International Class 42, "medical services for cancer treatment, namely, cancer diagnosis, pathology, surgery, oncology, chemotherapy, bone marrow transplant, chemoembolization, and pain management" in International Class 44, and "providing emotional support and counseling to people with cancer and their families" in International Class 45. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 17-18.
- Reg. No. 4876211 for WEXNER MEDICAL CENTER ("MEDICAL CENTER" disclaimed) for use with "Educational services, namely, providing undergraduate and graduate courses of instruction in general medicine, diagnosis, treatment and care in connection with a medical school; providing continuing medical education in the nature of workshops, seminars and educational conferences for professionals in the field of general medicine, diagnosis, treatment and care; conducting seminars and workshops for volunteers, patients and their families in the fields of medical treatment and wellness; distributing course materials in connection therewith" in International Class 41, "Medical research services" in International Class 42, and "Medical center services, namely, providing hospital, clinical, surgical and non-surgical medical and health care services on in-patient and out-patient basis; providing medical testing for diagnostic and treatment purposes, providing medical imaging and radiology services; providing general health, wellness, and medical information to the public" in International Class 44. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 85-86.
- Reg. No. 5552643 for DEDICATED SENIOR MEDICAL CENTER ("MEDICAL CENTER" disclaimed) for use with "Medical services" in International Class 44 and "Case management services, namely, coordination of legal, social and psychological services for elderly persons" in International Class 45. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 93-94.
- Reg. No. 4527271 for LLC UNIVERSITY ("UNIVERSITY" disclaimed) for use with "Providing on-line information in the field of business formations, namely, relating to limited liability companies, C corporations, S corporations, and limited partnerships via a website and database featuring articles and videos; Business assistance, education and consulting services in the field of business formations and filing business formation documents, namely, relating to limited liability companies" in International Class 35 and "On-line, video based instructional courses pertaining to business formations, namely, relating to limited liability companies" in International Class 41. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 105-06.
- Reg. No. 4838568 for CALIFORNIA HEALTH SCIENCES UNIVERSITY ("HEALTH SCIENCES UNIVERSITY" disclaimed) for use with "Charitable fundraising services for promoting research, education and other activities relating to health sciences" in International

Class 36. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pg. 113-14.

- Reg. No. 5047243 for MIND UNIVERSITY ("UNIVERSITY" disclaimed) for use with "Wellness and health-related consulting services" in International Class 44. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 121-22.

This evidence shows that wording which serves as the name of a type of business, entity, organization, or institution can also be understood as the name of a genus of services, including services in multiple-classes. Indeed, these registrations are consistent with decisions of the Board recognizing that terms identifying the provider of a product or service may also be generic of the product and/or service. *See In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for lighting fixtures); *In re Paint Prods. Co.*, 8 USPQ2d 1863, 1865 (TTAB 1988) (holding PAINT PRODUCTS CO. generic for paint); *In re E. I. Kane, Inc.*, 221 USPQ 1203, 1205 (TTAB 1984) (holding OFFICE MOVERS, INC. generic for moving services). Thus, applicant's argument is unpersuasive.

Otherwise, applicant's arguments appear to be a contradiction of denying that the evidence of record exists and acknowledging that it exists but claiming it is not sufficiently clear in indicating consumer perception of the wording "INSTITUTE ON AGING". The evidence of record does include instances of non-competitors using the wording as a noun, such as the StartUpBizHub, CFM Advocates, and obituary evidence detailed above. The evidence of record does include an abundance of competitors using the wording as a noun to identify their services, such as the Phoebe Institute on Aging, Benjamin Rose Institute on Aging, Institute on Aging - University of Pittsburgh, University of Florida Institute on Aging, and South Florida Institute on Aging. Applicant's arguments contesting the existence and sufficiency of the evidence are also unpersuasive.

Applicant also criticizes the evidence for not explicitly referencing referral services. However, as explained above, the correct genus is a continuum of services for supporting elderly adults, and the evidence of record shows that the continuum includes services for directly assisting or referring customers to other resources for health, mental health, counseling, and independent living. Of course, it is to be expected that not every institute on aging will offer the identical collection of services. The question is whether the referral services are of the kind consumers would expect to be included in the continuum of services offered by an institute of aging. The evidence showing the scope of applicant's

service offerings and the offerings of other institutes on aging shows referral services in suicide intervention, elder abuse counseling, grief support, emotional assistance, and services to enable the elderly to live independently are of the kind consumers expect to be included in the continuum of services offered by an institute on aging. Thus, the evidence shows that the identified "referrals in the field of suicide intervention, elder abuse counseling, grief support, emotional assistance and reassurance; referrals in the field of providers of goods and services to enable the elderly to live independently" are the kinds of services consumers would expect to be provided by an institute on aging.

Finally, applicant argues that third-party registrations, containing the terms "INSTITUTE" or "AGING" separately, preclude finding the combined phrase "INSTITUTE ON AGING" generic. However, an applied-for mark that is merely descriptive or generic does not become registrable simply because other seemingly similar marks appear on the register. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (citing *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977)); TMEP §1209.03(a). It is well settled that each application must be decided on its own facts; the USPTO is not bound by prior decisions involving different records. *See In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive or generic is determined based on the evidence of record at the time each registration is sought. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (citing *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064, 1067 (TTAB 2011)); TMEP §1209.03(a). These registrations of different phrases have no bearing on the combined phrase "INSTITUTE ON AGING". The evidence of record showing generic use of "INSTITUTE ON AGING" by competitors and non-competitors establishes the understanding of the relevant consumers as the generic name for the relevant genus of services.

In conclusion, the record shows that the genus at issue is a continuum of services for supporting elderly adults, including the identified referral services for elderly and disabled adults, and that consumers understand the wording "INSTITUTE ON AGING" as referring to that genus of services. Thus, the refusal to register the applied-for mark without a disclaimer of the generic wording "INSTITUTE ON AGING" should be affirmed.

II. THE WORDING "INSTITUTE ON AGING" MUST BE DISCLAIMED BECAUSE THE PROFFERED EVIDENCE IS NOT SUFFICIENT TO SHOW ACQUIRED DISTINCTIVENESS OF THE HIGHLY DESCRIPTIVE WORDING.

Registration may be refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), for failure to disclaim merely descriptive wording. *In re Hercules Fasteners, Inc.*, 203 F.2d 753, 756-57 (CCPA 1953). Applicant's claim of acquired distinctiveness is a concession that the wording "INSTITUTE ON AGING" merely describes the services. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive.").

Descriptive wording may only be registered on the Principal Register with proof that the wording has acquired distinctiveness as applied to applicant's goods or services. 15 U.S.C. §1052(f). Proof of acquired distinctiveness must establish that the primary meaning of the wording in the minds of the consumers is not to describe the goods or services but to identify the source of the goods or services. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938). The burden of proving that a mark has acquired distinctiveness is on the applicant. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005)).

Here, the extensive evidence of third-party use shows that the wording is highly descriptive and that applicant's use is not substantially exclusive. Applicant's evidence supporting its claim is insufficient to satisfy its burden of showing that the primary meaning of the highly descriptive wording is to identify applicant rather than to describe the services. Therefore, the refusal to register the applied-for mark without a disclaimer of the highly descriptive wording "INSTITUTE ON AGING" should be affirmed.

A. The evidence of record shows that applicant's use is not substantially exclusive and that the wording is highly descriptive of the services.

The amount and character of evidence required to establish acquired distinctiveness under Trademark Act Section 2(f) depends on the facts of each case and particularly on the nature of the mark sought to be registered. *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re*

Hehr Mfg. Co., 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960)); TMEP §1212.01. An applicant's evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)). If an applicant's proposed mark is highly descriptive of applicants goods and/or services, then the applicant's burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See In re GJ & AM, LLC*, 2021 USPQ2d 617, at *37-38 (TTAB 2021) (citing *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010)). Therefore, the first step in the inquiry is to determine the degree of descriptiveness conveyed by the wording "INSTITUTE ON AGING". *See Royal Crown Co.*, 892 F.3d at 1369.

The evidence of third-party use of the wording "INSTITUTE ON AGING" to describe similar services for supporting the elderly shows that the wording is highly descriptive of the services. The record includes a sample of twenty-two examples of competitors and non-competitors using the wording "institute on aging" to describe entities offering services for the care and support of the elderly.^[9] This evidence is not an exhaustive accounting of all uses of the wording "institute on aging," and an exhaustive accounting is not required. The evidence is sufficient to show that consumers of applicant's services are familiar with numerous entities referred to or described as institutes on aging. Thus, the record shows that the applied-for wording "INSTITUTE ON AGING" is highly descriptive of the services because the common usage of the wording by numerous parties indicates that consumers are less likely to understand the wording as identifying a single source.

Applicant argues that the evidence of record is inconsequential and only shows that applicant's use is not "totally exclusive." Again, the evidence of record includes a sample of twenty-two third parties using the wording "institute on aging" to describe the same or similar type of continuum of care services for elderly adults. This extensive third-party use is not inconsequential and is more than sufficient to show that applicant's use is not "substantially exclusive."

Moreover, applicant attempts to narrow the scope of its offered services to only referral services. Applicant's own evidence in support of its claim of acquired distinctiveness betrays this argument. The

identical collection of evidence was submitted in all five companion applications. Much of the evidence does not reference specific services. If the services truly must be limited to only the identification of services in this application, applicant would be required to provide evidence specific to referrals. That did not occur because, as applicant's website, declaration, and companion applications establish, the true scope of applicant's services extend beyond merely referral services to cover a continuum of services for supporting the elderly.

Thus, the record shows that the wording is highly descriptive, meaning the burden for establishing acquired distinctiveness is commensurately high.

B. Applicant's evidence does not meet its burden of establishing that consumers will understand the highly descriptive wording "INSTITUTE ON AGING" as identifying the source of applicant's services.

Evidence of acquired distinctiveness is considered as a whole, guided by the following factors: 1) association of the applied-for mark with a particular source by actual purchasers, typically measured by consumer surveys; 2) length, degree and exclusivity of use; 3) amount and manner of advertising; 4) amount of sales and number of customers; 5) intentional copying; and 6) unsolicited media coverage of the product embodying the mark. *Converse, Inc. v. ITC*, 909 F.3d 1110, 1120 (Fed. Cir. 2018). All factors are weighed together in light of all the circumstances to determine the primary meaning of the wording in the minds of the relevant consumers. *In re Steelbuilding.com*, 415 F.3d at 1300.

Applicant first provided a claim of five-plus years of use in support of its claim of acquired distinctiveness. After the length of use alone was found to be insufficient, applicant provided additional evidence consisting of a declaration, articles of incorporation, news articles, images from social media, images from applicant's website, a cease-and-desist letter, and examples of advertisements. Taken as a whole, the evidence is insufficient to meet applicant's high burden in light of the extensive third-party use of the wording "INSTITUTE ON AGING".

Association of the Applied-For Mark with a Single Source by Consumers

Applicant did not provide surveys or any other evidence to show that actual consumers associate the wording "INSTITUTE ON AGING" with a single source - applicant. Thus, this factor does not favor finding acquired distinctiveness.

Length of Use

Applicant argues that its length of use of the mark alone is sufficient to establish acquired distinctiveness. However, the record shows that applicant's use of the wording "INSTITUTE ON AGING" has not been substantially exclusive, meaning the wording is considered highly descriptive. Twelve of the examples of third-party use show use as part of the name or service mark for the services:

- Phoebe Institute on Aging. March 5, 2021 Priority Action, TSDR 2-3.
- Benjamin Rose Institute on Aging. March 5, 2021 Priority Action, TSDR 4.
- Garrison Institute on Aging. March 5, 2021 Priority Action, TSDR 5.
- Levine Institute on Aging. March 5, 2021 Priority Action, TSDR 6.
- Institute on Aging - University of Pittsburgh. March 5, 2021 Priority Action, TSDR 7.
- National Institute on Aging. May 6, 2022 Final Action, TSDR 1, Pg. 10.
- Pepper Institute on Aging and Public Policy. May 6, 2022 Final Action, TSDR 1, Pg. 11.
- LeadingAge Georgia Institute on Aging. May 6, 2022 Final Action, TSDR 1, Pg. 12.
- Institute on Aging (University of Florida College of Medicine). May 6, 2022 Final Action, TSDR 1, Pg. 13.
- Institute on Aging (University of Wisconsin-Madison). May 6, 2022 Final Action, TSDR 1, Pg. 15.
- UAMS Donald W. Reynolds Institute on Aging. May 6, 2022 Final Action, TSDR 1, Pg. 16.
- South Florida Institute on Aging. May 6, 2022 Final Action, TSDR 1, Pgs. 17-18.

The allegation of five-plus years of use alone is insufficient to show acquired distinctiveness when the term is highly descriptive because the extensive third-party use of the wording makes it less likely consumers will understand the wording as identifying a single source. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336-37, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *11-12 (TTAB 2019). Thus, although applicant alleges use of the wording alone for over 20 years, the significant third-party use shows that the length and exclusivity of use factor weighs against finding acquired distinctiveness.

Amount and Manner of Advertising

Second, applicant provided a declaration of applicant's president and CEO as evidence of the amount and manner of advertising and amount of sales and number of customers.^[10] Although consumer affidavits and declarations that assert recognition of a mark as an indicator of source are relevant in establishing acquired distinctiveness, affidavits and declarations of an applicant's employees, officers, and attorneys are usually self-serving and entitled to little weight. *See In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c).

Applicant does include examples of advertisements; however, the content of the advertisements does not try to draw attention to the wording alone or try to establish that the wording identifies applicant and only applicant. Rather, the advertisements merely indicate that applicant offers services for supporting the elderly. *See In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *25 (TTAB 2019) (holding Section 2(f) evidence including significant sales and advertising figures deficient in part because the advertisements "do little more than show the products" and fail to establish that consumers associate the claimed matter with applicant). Thus, while the evidence shows that applicant has advertised its services, the advertisements do little to show that the primary meaning of "INSTITUTE ON AGING" in the minds of consumers is to identify applicant rather than to describe the services.

Moreover, as the Section 2(f) claim is in part, the evidence must establish that the wording "INSTITUTE ON AGING" alone has acquired distinctiveness. *See* TMEP §1212.02(f)(i) ("[E]xamining attorneys must focus their review of the evidence submitted on the portion of the mark for which acquired distinctiveness is claimed, rather than on the entire mark."). However, much of the advertising features the wording in combination with distinctive design elements. For example:

- Applicant's webpage and social media page show use of the wording with a distinctive square design. March 28, 2022 Office Action Response, TSDR 182-83.
- Applicant's advertising samples show use with a distinctive square design or a distinctive stylized IOA design. March 28, 2022 Office Action Response, TSDR 194-99, 203-16.
- Applicant's Facebook and Google advertisements show use with a distinctive square design. March 28, 2022 Office Action Response, TSDR 218-22.

Because these types of advertisements do not use the wording alone, they are of little weight in indicating that consumers understand the wording "INSTITUTE ON AGING" alone as identifying a

single source - applicant. Finally, the problem with applicant's declaration is that many of the other types of advertising mentioned are not supported with examples in evidence. The declaration is entitled to little weight because it may be the case that those advertisements are also deficient because they use the wording "INSTITUTE ON AGING" in connection with other wording and/or designs.

Thus, the evidence of amount and manner of advertising does not favor finding acquired distinctiveness of the wording "INSTITUTE ON AGING" alone.

Amount and Number of Consumers

The only information of record relevant to this factor is provided in applicant's self-serving declaration and therefore is of little weight. Thus, this factor does not favor finding acquired distinctiveness.

Intentional Copying

The only evidence relevant to this factor is a single cease-and-desist letter. However, a single attempt to enforce rights is not a significant showing of enforcement. Moreover, the letter is not an indication that the other party's use was "intentional copying," especially given the highly descriptive nature of the wording "INSTITUTE ON AGING". Thus, this factor does not favor finding acquired distinctiveness.

Unsolicited Media Coverage

Applicant provided seven articles referencing applicant to support its claim of acquired distinctiveness.

- New York Times article titled "Researchers Confront an Epidemic of Loneliness" discussing programs to mitigate loneliness. "She hopes to study The Friendship Line, a 24-hour, toll-free, loneliness call-in line run by the Institute on Aging in San Francisco that is also a suicide prevention hotline." March 28, 2022 Office Action Response, TSDR 134.
- MarketWatch article titled "We want to move to a 55+ community - how do we find the best one?" including a quote from a director from applicant. "'Wi-Fi and phone are not usually included,' said Ashley Hill, senior director of home care at the Institute on Aging in San Francisco." March 28, 2022 Office Action Response, TSDR 139.
- KALW (San Francisco local public radio) article titled "Seniors Combat Loneliness While Sheltering In Place In Bay Area" discussing loneliness. "He says calls to the Institute on Aging's Friendship Line for elders have doubled since the shelter in place order came down." March 28, 2022 Office Action Response, TSDR 142.
- KQED (San Francisco local public TV) article titled "Kamala Harris Speaks Out Against Republican Health Care Plan" discussing Vice President Harris's visit to California. "She then

flew to San Francisco to meet with Seniors at the Institute on Aging." March 28, 2022 Office Action Response, TSDR 144.

- SFGate (San Francisco local news) article titled "Seniors tell Harris how GOP health plan will hurt them" discussing Vice President Harris's visit to California. "She got a briefcase full during a stop Monday at the Institute on Aging in San Francisco's Richmond District." March 28, 2022 Office Action Response, TSDR 146.
- McKnights Home Care article titled "Impact of chronic loneliness similar to 'smoking a half-pack of cigarettes a day for many years'" discussing loneliness. "Walker's one lifeline to the outside world is the Institute on Aging's Friendship Line, which connects homebound seniors via telephone to volunteers." March 28, 2022 Office Action Response, TSDR 160.
- NextAvenue article titled "Looking Back Doesn't Mean I'm Old, But I Thought It Might" discussing aging. "'Reminiscence is a great tool,' said Alison Moritz, program director at San Francisco Institute on Aging's (IOA) Enrichment Center where adults with dementia come for day activities." March 28, 2022 Office Action Response, TSDR 164.

Five of the articles specify applicant's location as part of the name or way they identify them, such as "Institute on Aging in San Francisco" in the New York Times and MarketWatch articles. If this evidence is to support that the wording "INSTITUTE ON AGING" alone identifies applicant, why do these media outlets find it necessary to specify applicant's location? The evidence of record showing third-party use of the wording, indicates that specifying the location would be helpful in avoiding reader confusion as to which institute on aging the article is referring - the one in San Francisco. Similarly, the NextAvenue article refers to applicant as "SAN FRANCISCO INSTITUTE ON AGING", which does not support that consumers understand "INSTITUTE ON AGING" alone as referring to applicant. Finally, the KALW, KQED, and SFGate articles are local media sources and thus do not support the understanding of consumers outside the San Francisco Bay Area.

This small collection of articles does little to support that consumers understand the wording "INSTITUTE ON AGING" alone as referring to one source - applicant. Thus, this factor does not favor finding acquired distinctiveness.

Balancing the Factors

To recap the factors: 1) applicant did not provide evidence of actual consumer understanding of the wording as referring to the source of services; 2) the extensive third-party use of the wording outweighs applicant's length of use; 3) the evidence of advertisements do not support that the wording alone is understood as referring to applicant because the advertisements use the wording with other matter and

because the amount does not outweigh the third-party use; 4) the evidence of number of customers does not outweigh the third-party use because the only evidence regarding is provided in a self-serving declaration with no additional support; 5) the one cease-and-desist letter does not show intentional copying; and 6) the media coverage does not establish that the relevant consumers understand "INSTITUTE ON AGING" alone as referring to one source.

On balance, the proffered evidence is not sufficient to satisfy applicant's commensurately-high burden to prove that the primary meaning of "INSTITUTE ON AGING" in the minds of the relevant consumers is to refer to applicant rather than to merely describe the services. Thus, the refusal to register the applied-for mark without a disclaimer of the wording "INSTITUTE ON AGING" should be affirmed.

CONCLUSION

Because the record shows that "INSTITUTE ON AGING" refers to a genus of services consisting of a continuum of services for supporting the elderly, that the identified services are of the kind that would be included in such a continuum, and that consumers understand the wording as referring to such a continuum of services, the refusal to register the applied-for mark without a disclaimer of the wording "INSTITUTE ON AGING" under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), because the wording is unregistrable, generic wording under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, should be affirmed.

In the alternative, because the proffered evidence is not sufficient to satisfy the burden for proving acquired distinctiveness of the highly descriptive wording under Section 2(f), 15 U.S.C. §1052(f), the refusal to register the applied-for mark without a disclaimer of the wording "INSTITUTE ON AGING" under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), because the wording merely describes the services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), should be affirmed.

Respectfully submitted,

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End Notes

1. March 28, 2022 Office Action Response, TSDR 30.
2. May 6, 2022 Final Action, TSDR 1, Pg. 18.
3. March 28, 2022 Office Action Response, TSDR 30.
4. May 6, 2022 Final Action, TSDR 1, Pg. 10-17.
5. Appeal Brief, 6 TTABVUE 7-8.
6. May 6, 2022 Final Action, TSDR 1, Pg. 19.
7. May 6, 2022 Final Action, TSDR 1, Pg. 20.
8. November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 7-161.
9. March 5, 2021 Priority Action, TSDR 2-7; May 6, 2022 Final Action, TSDR 1, Pgs. 21-29;
November 23, 2022 Denial of Request for Reconsideration, TSDR 1, Pgs. 162-70.
10. March 28, 2022 Office Action Response, TSDR 29-34.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on March 23, 2023 for
U.S. Trademark Application Serial No. 90238722

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of March 23, 2023**, if you wish to do so. If submitted, a reply brief must be submitted using the **[Electronic System for Trademark Trials and Appeals \(ESTTA\)](#)** and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or **TTABInfo@uspto.gov**.