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

Ex Parte Appeal - Serial No.	90238742
Appellant	Institute on Aging
Applied for mark	INSTITUTE ON AGING
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Submission	Appeal brief
Attachments	Ex Parte Appeal Brief for IOA Class 44.pdf(364991 bytes)
Appealed class	Class 044. First Use: Sep 2013 First Use In Commerce: Sep 2013 All goods and services in the class are appealed, namely: Home health care services; health care services
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Date	01/26/2023

Trademark Law Office: 103
Serial No.: 90/238742
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.:	90/238742	Trademark Attorney: Jacob Vigil
Filed:	October 6, 2020	Law Office: 103
Mark:	INSTITUTE ON AGING & DESIGN	International Class: 44

APPLICANT'S APPEAL BRIEF

Seattle, Washington 98104

January 26, 2023

**DESCRIPTION OF THE RECORD -
STATEMENT OF FACTS**

1. Applicant Institute on Aging, a California non-profit benefit corporation, filed Application Serial No. 90/238742 (the “Application”) on October 6, 2020, seeking registration of the mark INSTITUTE ON AGING & Design for “Home health care services; health care services” in Class 44.
2. The first Office Action on the Application (a Priority Action) was mailed on March 5, 2021, requiring Applicant to disclaim the words INSTITUTE ON AGING on the grounds that the words were allegedly merely descriptive under Section 2(e)(1) of the Lanham Act, 15 USC § 1052(e)(1).
3. The Examining Attorney’s stated reason for requiring a disclaimer was due to evidence purportedly showing that the wording “is commonly used in connection with similar services to mean an organization offering a wide variety of medical and non-medical support services, education, training, and research regarding aging and the elderly.” *See* March 5, 2021 Priority Action, TSDR p. 1.
4. Applicant responded to the Office Action on September 1, 2021, (1) adding a claim that the wording “Institute on Aging” had acquired distinctiveness due to Applicant’s substantially exclusive and continuous use of the mark for more than 5 years, citing Section 2(f); and (2) arguing that the third-party uses cited by the Examiner failed to show that Applicant’s use of “Institute on Aging” was not substantially exclusive. *See* September 1, 2021 Office Action Response, TSDR.
5. By Office Action mailed September 27, 2021, the Examining Attorney raised two new issues. First, the Examiner took the position that a disclaimer of “Institute on Aging” is required because the wording is generic. Second, the Examiner rejected Applicant’s Section 2(f) claim because he claimed that use of the mark for 5 years is insufficient to prove that the mark has acquired distinctiveness. *See* September 27, 2021 Office Action, TSDR.
6. Applicant filed a response on March 28, 2022. Regarding the alleged genericness of the wording, Applicant accepted the Examiner’s position that the identification of services in the application

defines the relevant genus of services, but pointed out that the record contains zero evidence that the relevant public understands “Institute on Aging” to be the generic name for the home health care and health care services described in the Application. Regarding the Section 2(f) claim, Applicant argued that the wording “Institute on Aging” was not highly descriptive, and submitted voluminous evidence (verified by a declaration) of its widespread use and promotion of the mark, and evidence of third-party recognition of the mark. *See* March 28, 2022 Response to Office Action, TSDR.

7. The Examiner issued a Final Action on May 6, 2022. In the Final Action, the Examiner maintained his position that “Institute on Aging” is generic. In this action (and contrary to his previous analysis), the Examiner claimed that the services identified in the Application are no longer the relevant genus of services but rather the correct genus is “the broader genus of support and educational services related to aging and for assisting the elderly.” The Examiner also rejected Applicant’s evidence of acquired distinctiveness because (i) the evidence showed use of the wording combined with the logo, and (ii) the Examiner, without any reference to the actual provisions in the declaration Applicant submitted, claimed that the declaration belonged in the category of self-serving declarations that are sometimes deemed inadequate. *See* May 6, 2022 Final Action, TSDR.

8. On November 7, 2022, Applicant filed a Request for Reconsideration to address the new issues raised in the Final Action. Applicant argued (i) there was no case law supporting the Examiner’s broad expansion of the genus of services relevant to the genericness inquiry for this application; (ii) the dictionary evidence submitted by the Examiner does not demonstrate that the relevant public understands “institute on aging” to be the name for the relevant genus of services; (iii) the USPTO has granted many registrations for phrases containing “institute” or “aging” that recognize that these words, when part of a phrase, are not generic; (iv) the third-party usage evidence submitted by the Examiner does not show consumers using the wording to name to the genus of services; and (v) the declaration that Applicant

submitted is wholly different from the type of self-serving declarations rejected in the cases cited by the Examiner. *See* November 7, 2022 Request for Reconsideration, TSDR.

9. Applicant filed a Notice of Appeal with the Trademark Trial and Appeal Board on November 7, 2022. Applicant's Appeal was acknowledged and the case was remanded to the Examining Attorney the same day. *See* TTABVUE Entry Nos. 1-2.

10. On November 23, 2022 the Examiner denied the request for reconsideration, equating INSTITUTE ON AGING with terms like "hospital" and "medical center" and providing copies of registrations on the Supplemental Register for health care services where "hospital" and "medical center" have been disclaimed, providing a few web pages purporting to show third-party generic use of the phrase "institute on aging," and reiterating his previous arguments rejecting Applicant's claim of acquired distinctiveness. *See* November 23, 2022 Request for Reconsideration Denied, TSDR.

11. Applicant's Appeal was resumed by order mailed November 29, 2022. *See* TTABVUE Entry No. 5.

ISSUES ON APPEAL

(1) For the purposes of determining whether wording used in a mark is generic, can the correct genus of services include services that are not a subset of or intertwined with the category of services described in the application at issue, or even in the same Nice class?

(2) Has the Examiner satisfied his burden of providing clear evidence that a mark is generic where there is no record evidence demonstrating that the relevant portion of the public uses the mark to identify the genus of services, but merely thirteen examples of entities using the mark in their trademarks (and at most four of these thirteen trademarks are associated with services in the relevant genus)?

(3) Has an applicant adequately demonstrated that its mark has acquired distinctiveness under Section 2(f) where the evidence reflects that the applicant has made continuous and substantially

exclusive use of the mark for over 20 years, and engaged in substantial use and promotion of the mark, and there is evidence of third-party recognition of the mark as a source identifier?

ARGUMENT

I. The Phrase “Institute on Aging” is Not Generic.

As the Supreme Court recently recognized, “a ‘generic’ term names a ‘class’ of goods or services, rather than any particular feature or exemplification of the class.” *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 207 L. Ed. 2d 738, 2020 USPQ2d 10729 (2020) (using the word “wine” to provide an example of a generic term). Terms that are generic are “the common descriptive name of a class of goods or services.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986) (holding that FIRE CHIEF is not generic for a magazine directed to the field of firefighting).

To decide whether a term deserves to be characterized as generic, as opposed to descriptive or something else, tribunals must ascertain the meaning of the term to the relevant consumers. *Booking.com*, 140 S. Ct. at 2304; *see also Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118, 9 S. Ct. 109, 83 L. Ed. 73, 39 USPQ 296, 298 (1938) (“shredded wheat” is generic because it is “the term by which the biscuit in pillow-shaped form is generally known by the public”); *H. Marvin Ginn Corp.*, 228 USPQ at 530 (“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”). In the *Booking.com* decision, the Supreme Court recognized that if a term is generic, one could expect to see consumers already using the allegedly generic terminology to refer to the services described in the application. 140 S. Ct. at 2304-05. In other words, if the mark at issue, BOOKING.COM, were generic, the Court expected “consumers to understand Travelocity—another [online hotel reservation] service—to be a ‘Booking.com.’” We might similarly expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite ‘Booking.com’ provider.” *Id.*

The Federal Circuit has distilled these characteristics of generic marks into a test to determine whether a phrase is generic: (1) what is the genus or class of services at issue, and (2) does the relevant public understand the phrase at issue to name such class of services. *Marvin Ginn*, 228 USPQ at 530. Whether a mark is generic is a question of fact, and the Examiner must support its characterization of a mark as generic with “clear evidence of generic use.” *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014) (quoting *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)) (emphasis added). The burden of showing that a mark is generic rests with the PTO. *In re Merrill Lynch*, 4 USPQ2d at 1143. Any doubt as to whether wording is generic must be resolved in favor of the applicant. *See In re GJ & AM, LLC*, 2021 USPQ2d 617, at *33 (TTAB 2021).

In the matter at hand, the Board should reject the Examiner’s argument that “Institute on Aging” is generic. The Examiner has not provided clear evidence that the elderly and their families understand “Institute on Aging” to name the class of services described in the Application (or any class of services).

A. The genus of services is captured by those described in the Application.

The first prong of the test for genericness is to identify the genus of services at issue. “[A] proper genericness inquiry focuses on the description of services set forth in the [application].” *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (rejecting petition to cancel; evidence that “touchless” was generic for automobile washing equipment did not prove that the term was generic for the services listed in the registration, namely, automobile washing services). The Examiner recognized as much in the September 27, 2021 Office Action in which he stated that the description of services in the application, “Home health care services; health care services,” “adequately defines the genus at issue.” *See* September 27, 2021 Office Action, TSDR p. 2 (emphasis added). Applicant agrees that the relevant genus of services consists of those identified in the Application.

Despite previously acknowledging that the genus of services at issue consists of the health care

services described in the Application, the Examiner changed his view in the Final Action and argued that the broader genus of support and educational services related to aging and for assisting the elderly should be used. *See* May 6, 2022 Final Action, TSDR pp. 3-4. To support this expansion of the relevant genus of services, the Examiner claimed that “[w]here 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.” *Id.* p. 3.

Applicant is aware of no case law supporting the Examiner’s position that a broad genus of services – services that fall well outside the contours of the services described in the Application – should be used for the genericness inquiry. The three cases upon which the Examiner relies to argue for an expansive definition of the genus (*In re Greenliant Systems, Ltd.*, *In re DNI Holdings Ltd.* and *In re Reed Elsevier Props. Inc.*) do not support his position. In all three of the Examiner’s cases (and in contrast with the Application at issue), 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. For example, in *In re Greenliant Systems, Ltd.*, 97 USPQ2d 1078 (TTAB 2010), the Board held that “the question of registrability must be determined by considering any goods falling within the literal scope of an identification.” *Id.* at 1082 (NANDRIVE generic for the goods listed in the application (electronic integrated circuits) because NAND is a subset of such goods). In *In re Reed Elsevier*, the Federal Circuit affirmed the holding that LAWYERS.COM is generic for the Class 42 service of providing “online interactive database featuring information exchange in the fields of law, legal news, and legal services.” 482 F.3d 1376, 82 USPQ2d 1378, 1379 (Fed. Cir. 2007). According to the court, providing information about lawyers is not distinct from providing information about the law, legal news, and legal services, and as such was encompassed by such services and part of the same genus. *Id.* at 1380. Lastly, in *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005), the applicant for the mark SPORTSBETTING.COM described the services in its Class 41

application as the provision of casino games and the provision of information on gaming and athletic competitions, but the Board held that “the class or category of services described in the application still clearly includes that of providing information regarding sports and betting,” providing support for its decision to include sports betting in the genus of services. *Id.* at 1438.

Notably, the applicants in both *Reed Elsevier* and *DNI Holdings* had plainly manipulated the descriptions used in their respective applications to try to avoid a genericness refusal, with the *Reed Elsevier* applicant deleting “lawyers” from the description (82 USPQ2d at 1378), and the *DNI Holdings* applicant making the tactical decision not to include the Class 41 services “sports betting” in its Class 41 application, despite it being one of the applicant’s core services. 77 USPQ2d at 1437.

There can be no question that the support and educational services that the Examiner claims are part of the relevant genus at issue here are not a subset of or intertwined with the health care services listed in the Application. Indeed, the expansive services the Examiner claims are part of the relevant genus fall in Classes 45 and 41, not Class 44. Plainly Applicant has not made the tactical decision to avoid including support and educational services in the Application to avoid a genericness refusal as Applicant could not have included such services given the different Nice classifications. The Examiner offers no authority for the proposition that the genus of services relevant to a genericness inquiry for a Class 44 application can include services that fall into other Nice classes, nor is Applicant aware of any such authority. In short, the relevant genus of services is home health care and health care services.

B. The relevant public does not understand “Institute on Aging” to identify the relevant genus of services.

The second part of the genericness inquiry asks whether the consumers of Applicant’s services (the elderly and their families¹) predominantly understand “Institute on Aging” to identify or name the type of

¹ Applicant agrees with the Examiner’s view that the elderly and their families are the relevant purchasers. *See* May 6, 2022 Final Action, TSDR p. 4.

health care services that Applicant provides. In an attempt to prove that “Institute on Aging” is the common generic term for Applicant’s services, the Examiner submitted (1) dictionary definitions and (2) third-party websites. Neither category of evidence satisfies the Examiner’s burden of providing clear evidence that “Institute on Aging” is recognized by the elderly or their families as the common name for the class of health care services described in the Application (or indeed any services).

1. The dictionary definitions do not prove that “Institute on Aging” identifies the services described in the Application.

The Examiner submitted dictionary definitions for “institute” (an organization founded to promote a cause) and “aging” (the process of growing old) in an attempt to prove that “Institute on Aging” is a generic term. *See* May 6, 2022, Final Action, TSDR pp. 19-20. According to the Examiner, these definitions show that “Institute on Aging” means “an organization founded to promote causes relating to aging.” *Id.*, TSDR p. 4. However, the dictionary evidence does not prove that the phrase “Institute on Aging” as a whole is the generic name for Applicant’s services but rather at most show that Applicant chose an apt name for itself, as the Examiner himself concedes when he states that the meaning of the phrase is to identify an “organization” (as opposed to identifying a class of services). *Id.* (emphasis added).

The Federal Circuit rejected a line of reasoning similar to the Examiner’s in *In re American Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). In that case, the Board held that the applicant had to disclaim the words “Society for Reproductive Medicine” in order to register its mark AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE. *Id.* at 1832-33. The Federal Circuit vacated the Board’s decision, holding that the Board wrongly assumed that evidence demonstrating that individual words are generic is sufficient to show that a phrase using such words is generic. *Id.* at 1833. Although dictionary evidence that individual words are generic can prove that a compound term comprised of words is also generic, such evidence is insufficient by itself to prove that a phrase in which such words are used is generic. *Id.* at 1837. Dictionary definitions can show that the wording used in a phrase is “apt” but that does not prove that the phrase is generic. *Id.* at 1836. As the court noted, phrases like “American Bar Association”

are an apt name for an association of lawyers, but that does not mean that AMERICAN BAR ASSOCIATION is a generic name. *Id.*

Similarly, evidence of the generic meaning of “institute” and “aging” does not prove that the phrase “Institute on Aging” is generic. Applicant’s mark is not merely “institute” or “aging” or even “instituteaging.” Rather, the mark is the phrase “Institute on Aging” (and a design). Notably, the USPTO has registered many phrases containing “institute” or “aging,” which demonstrate that these words, when part of a phrase, are not generic: PHARMACEUTICAL SECURITY INSTITUTE, MARKETING ARTIFICIAL INTELLIGENCE INSTITUTE, INTERNATIONAL INSTITUTE AGAINST VIOLENCE, INSTITUTE OF DIVINE METAPHYSICAL RESEARCH, INSTITUTE FOR WORLD EVANGELISATION, BIODEGRADABLE PRODUCTS INSTITUTE, THE INSTITUTE FOR DIVERSITY AND ETHICS IN SPORT, INSTITUTE FOR COACHING MASTERY, THE INSTITUTE FOR BRAND MARKETING, RECOVERY EDUCATION INSTITUTE, RESHORING INSTITUTE, STRATEGIC COMMUNICATIONS INSTITUTE FOR PREPAREDNESS, NEW YORK INSTITUTE OF PET GROOMING, DIGITAL HEALTH INSTITUTE FOR TRANSFORMATION, ADVANCING SUCCESSFUL AGING AT HOME, AGING WITH GRACE AGING IN PLACE, AGING IN PLACE STARTS WITH THE HOME, EXPERTS IN AGING, EMPOWERING PHARMACISTS. TRANSFORMING AGING, AGING WITH FREEDOM, THE POETRY OF AGING, AGING IS AN ACHIEVEMENT, KNOWLEDGEABLE AGING, AGING BEST. *See* March 28, 2022 Response to Office Action, TSDR pp. 40-46 & November 7, 2022 Request for Reconsideration, TSDR pp. 9-30. These third-party marks are analogous to Applicant’s mark: every one of these marks containing “Institute” is registered for services offered by an organization, and every one of these marks containing “Aging” is registered in connection with various services provided to the elderly. As the USPTO has recognized by issuing the registrations, consumers do not understand phrases containing either “institute” or “aging” as functioning as the name for a category of services, nor is there any reason to believe that consumers understand

“Institute on Aging” to function as the generic name for the genus of services.

2. None of the website evidence regarding use of “Institute on Aging” demonstrates that the relevant consumers recognize the phrase as naming a class of services.

As the Supreme Court noted in *Booking.com*, if a term or phrase is generic, one could expect to see consumers using the allegedly generic terminology to refer to the services described in the application. 140 S. Ct. at 2304-05 (if *Booking.com* were generic, “we might expect consumers to understand Travelocity—another [online hotel reservation] service—to be a ‘Booking.com’”). In *Marvin Ginn*, the Federal Circuit reversed the decision holding that FIRE CHIEF is a generic term for a magazine about firefighting because there was “no record evidence which suggests that the relevant portion of the public refers to a class of fire fighting publications as ‘Fire Chief.’” 228 USPQ at 532; *see also In re Dock Blocks of North America, LLC*, Serial No. 88320379 (September 8, 2022) (“The limited record evidence of genericness of the proposed mark as a whole is ‘sufficient to create doubt about whether consumers would perceive [DOCK BLOCKS] as a whole as generic.’”) (quoting *In re GJ & AM, LLC*, 2021 USPQ2d 617, at *33 (TTAB 2021)).

The record here contains zero evidence of generic usage of “institute on aging” by the relevant consumers to name Applicant’s services, which demonstrates that the phrase is not the generic name for such services. *In re American Fertility*, 51 USPQ2d at 1837. The Examiner instead relies on evidence that allegedly shows that “Institute on Aging” is “commonly used to identify entities offering a wide variety of services to support and assist the elderly.” *See* September 27, 2021 Office Action, TSDR p.2. The evidence consists of the following:

	URL	Associated Mark	Goods/services
1	https://phoebe.org/phoebe-institute-on-aging/	Phoebe Institute on Aging	Organization that offers a conference series and academic research directed at professionals (not the elderly), and fundraising. <i>See</i> March 28, 2022

			Office Action Response, TSDR pp. 32-38. ² No evidence that any health care services are offered.
2	https://benrose.org/about-us	Benjamin Rose Institute on Aging	Organization that provides wellness services, research services, and financial counseling.
3	https://www.ttuhs.edu/centers-institutes/garrison-aging	Garrison Institute on Aging	An academic department at a research university (Texas Tech University) focusing on research and education regarding neurodegenerative diseases. No evidence that any health care services are offered.
4	https://www.nih.gov/about-nih/what-we-do/nih-almanac/national-institute-aging-nia	National Institute on Aging	A department within the National Institutes of Health that conducts and supports scientific research. No evidence that any health care services are offered.
5	https://pepperinstitute.fsu.edu/about-us	Pepper Institute on Aging and Public Policy	An academic department at Florida State University that engages in research activities. No evidence that any health care services are offered.
6	https://www.leadingage.org/institute-on-aging	Georgia Institute on Aging	Entity that provides professional development educational courses. No evidence that any health care services are offered.
7	https://aging.ufl.edu/about/	Institute on Aging	A department at the University of Florida College of Medicine engaged in research, education, and health care.
8	https://www.jseniors.org/services/advocacy-education/institute-on-aging	Institute on Aging Services	Organization that engages in advocacy and education, and consulting and care services for the health and support of the elderly and their caregivers.
9	https://aging.wisc.edu/mission-vision/	University of Wisconsin-Madison Institute on Aging	Academic research department at the University of Wisconsin-Madison. No evidence that any health care services are offered.
10	https://aging.uams.edu/about-us/	Donald W. Reynolds Institute on Aging	Department at the University of Arkansas for Medical Sciences that provides health care, fitness, and education services to the elderly.
11	https://www.thesofia.org/programs-cover	South Florida Institute on Aging	Entity that offers technology courses, job training, and caregiver respite services. No evidence that any health care services are offered.
12	https://www.startupbizhub.com/	StartUpBizHub	Website that claims to provide information for those who may want to start an “institute on aging” to provide care to the elderly but in fact provides no substantive information and seems solely to serve the purpose of generating ad

² Due to hovering the cursor during the screenshot, the screenshot submitted by the Examiner misleadingly suggests that a broader array of services (e.g., memory support) is offered; however, close examination of the screen shot demonstrates that such services are only associated with the mark PHOEBE or PHOEBE MINISTRIES.

			revenues. No evidence that any health care services are offered.
13	https://www.wichita.edu/academics/academic_affairs/ria/about.php	Regional Institute on Aging	Academic research department in Wichita State University. The “About us” page references earlier discussions about establishing an “institute on aging” at the University. No evidence that any health care services are offered.
14	https://sc.edu/study/colleges_schools/public_health/about/news/2016/arnold_institute_update.php#.Y89fI3bMK3A	Arnold Institute on Aging	Department at the School of Public Health at the University of South Carolina dedicated to scholarly research and information. Press release from 2016 discussed a gift to establish an “Institute on Aging.” No evidence that any health care services are offered.
15	https://cfmadvocates.com/case_studies/highlighting-challenges-of-an-aging-population/	CFM Advocates	Communications strategy firm helped an “institute on aging” sharpen its data presentation and messaging. No evidence that any health care services are offered.

See March 5, 2021 Priority Action, TSDR pp. 3-7;³ May 6, 2022 Final Action, TSDR pp. 21-29; November 23, 2022 Denial of Request for Reconsideration, TSDR pp. 162-172.

These websites, particularly when coupled with the utter lack of any evidence of consumers using “institute on aging” as a noun, do not amount to the “clear evidence of generic use” that is required in order to hold that “Institute on Aging” is understood by the elderly and their families as the name for the relevant genus of services. *See In re Nordic Naturals, Inc.*, 111 USPQ2d at 1497 (quoting *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)) (emphasis added); *see also In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005). Rather, the evidence merely shows the following: (1) the predominant use of “Institute on Aging” is as part of the name and trademark for organizations (all but one within academic institutions or the

³ The Examiner submitted a screenshot purportedly showing use of “LeVine Institute on Aging” by an organization called Jewish Senior Life. *See* March 5, 2021 Priority Action, TSDR p.8. However, Applicant has never been able to locate any such use of “LeVine Institute on Aging” thus the Examiner’s “evidence” should be ignored. *See* March 28, 2022 Office Action Response, TSDR pp. 22-27. The Examiner also submitted a webpage from a third-party directory, caregiver.org, referring to an “Institute on Aging” at the University of Pittsburgh. March 5, 2021 Priority Action, TSDR p.9. As demonstrated by the University of Pittsburgh’s own website, the actual mark used by the University of Pittsburgh is “Aging Institute,” and the site does not reference “Institute on Aging” at all, and moreover “Aging Institute” is associated with research in a university setting and not the delivery of services to the elderly. *See* March 28, 2022 Office Action Response, TSDR pp. 29-30.

National Institutes of Health) that conduct research relating to the elderly (services not offered by Applicant⁴), and there are only eight such organizations (see Nos. 1, 3, 4, 5, 7, 9, 13, and 14 in the chart above); (2) five entities use “Institute on Aging” in their name and trademark associated with providing services to the elderly services (see Nos. 2, 7, 8, 10, and 11 in the chart), and at most four of these organizations provide health care; and (3) two organizations use “Institute on Aging” as part of their name and trademark in connection with offering professional education courses or conferences (but not health care services like Applicant’s) (see Nos. 1 and 6 in the chart). That thirteen entities incorporate “Institute on Aging” into their trademarks fails to provide clear evidence that “Institute on Aging” is understood to be a generic term by the relevant consumers, particularly since at most four of these entities offer services similar to the health care services described in the Application.

Although the Examiner found four (arguable) examples of use of “institute on aging” as a noun (see Nos. 12-15 in the chart), this website evidence does not constitute “clear evidence” that “Institute on Aging” is generic. Importantly, as noted, not one of these examples reflects use of “institute on aging” by the relevant public to identify the relevant genus of services. *See Marvin Ginn*, 228 USPQ at 532. Furthermore, these four examples are hardly compelling: there is good reason to think that at least one of them is simply computer-generated text (see No. 12) and the others are vague and could simply be the result of sloppiness.

Further still, even if there were four relevant instances of generic usage of “institute on aging” in the record (and there are not), that would still not provide clear evidence that the phrase is generic. In *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987), the Federal Circuit held that the phrase “Cash Management Account” was not a generic term for brokerage services. Even though the record contained evidence of third parties using “cash management account” as

⁴ See May 6, 2022 Final Action, TSDR pp. 9-10.

the name for a particular type of investment vehicle, this was not sufficient to enable the USPTO to meet its burden of providing clear evidence that the term was generic in light of the contrary evidence demonstrating that the investment community associated the phrase “cash management account” with the applicant’s services. *Id.* at 1143-44. As will be discussed in the following section, there is ample evidence that the public associates “Institute on Aging” with Applicant and its services.

Any doubt as to whether wording is generic must be resolved in favor of the applicant. *See In re GJ & AM, LLC*, 2021 USPQ2d 617, at *33 (TTAB 2021). Here, given that there is no evidence that the elderly or their families primarily understand “Institute on Aging” to be the generic name for health care services, and there is evidence that third parties recognize “Institute on Aging” as a source identifier for Applicant’s services (*see infra*), the Examiner has not met his burden of providing clear evidence that “Institute on Aging” is generic and the Board should reject the Examiner’s position that the phrase is generic.

II. The wording “Institute on Aging” has acquired distinctiveness and need not be disclaimed.

As is described in greater detail below, “Institute on Aging” has become distinctive due to (1) the several decades of continuous and substantially exclusive use of the mark by Applicant; (2) the widespread use and promotion of the “Institute on Aging” mark; and (3) third party recognition of the “Institute on Aging” mark.

A. “Institute on Aging” has acquired distinctiveness due to the long duration of Applicant’s continuous and substantially exclusive use of the phrase.

Applicant Institute on Aging was founded as an independent 501(c)(3) organization in 1985. But Applicant can trace its roots even earlier, to 1975 when Mt. Zion Hospital, in San Francisco, California, established an adult day health center that provided an alternative to nursing home placement for elderly individuals. The Jewish community’s traditional sense of family and its commitment to caring for elders with dignity inspired Mt. Zion to start the adult day health center and to found Institute on Aging to provide

these services. Institute on Aging was originally known as “San Francisco Institute on Aging”; this later evolved to “Mount Zion Institute on Aging” in 1993, then to “Goldman Mount Zion Institute on Aging” in 1996, and finally to “Institute on Aging” in 2002. *See* Briody Decl.⁵ ¶¶ 2-3 & Exs. A-D, P (March 28, 2022 Response to Office Action, TSDR pp. 48, 54-58, 206-211)⁶. Applicant has been using the “Institute on Aging” trademark in some form continuously since 1985, and as “Institute on Aging” (without other wording) since 2002. *See* Briody Decl. ¶ 4 (TSDR p. 48). Applicant’s use of the trademark is substantially exclusive, as is discussed further below, and Applicant has successfully enforced against third parties who used confusingly similar marks. *See id.* & Ex. U (TSDR pp. 48-49, 247-49).

Under the Lanham Act, the USPTO may accept as “prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” 15 USC § 1052(f). Applicant’s 20 years of using the “Institute on Aging” mark (which use may be extended to 30-plus years by tacking on the rights built up in marks like “San Francisco Institute on Aging”) plainly exceeds the five-year period that gives rise to the presumption of acquired distinctiveness, and thus demonstrates that Applicant has acquired distinctiveness in the “Institute on Aging” trademark. The record demonstrates that the USPTO has issued many registrations for phrases containing “Institute” or “Aging” (with no disclaimers of these terms), thereby demonstrating that these terms are regularly recognized as distinctive terms in trademarks. *See* March 28, 2022 Response to Office Action, TSDR pp. 40-46 & November 7, 2022 Request for Reconsideration, TSDR

⁵ The Examiner argues that the Briody Declaration should be ignored because some applicants submit declarations that merely contain conclusory, self-serving statements. *See* May 6, 2022 Final Action, TSDR p. 6. The Examiner points to no part of the Briody Declaration that is conclusory. To the contrary, the Declaration provides factual evidence and statements to support the veracity of the evidence, and thus should be accepted.

⁶ The Briody Declaration and Exhibits were included in the March 28, 2022 Response to Office Action; from here on out Applicant will just list the TSDR cites and not restate that the Declaration was included in the Response.

pp. 9-30.

The Examiner dismisses the weight of Applicant's long-standing use of the "Institute on Aging" trademark because he claims that the use is not substantially exclusive. *See* November 29, 2022 Denial of Request for Reconsideration, TSDR p. 5. The Examiner's position is mistaken for several reasons. First, the Lanham Act only requires "substantially exclusive" use, not "totally exclusive." The Board has acknowledged that "acquired distinctiveness allows for use by others." *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009) (precedential). Use by others that is inconsequential or infringing does not invalidate a claim of acquired distinctiveness. *See L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999).

Second, Applicant's claim of acquired distinctiveness due to its decades of using the "Institute on Aging" mark would only be undercut if there were evidence of a large number of third parties using the same terminology in connection with the same services as Applicant and directed at the same consumer class, but there is (at most) four examples in the record. *See Royal Palm Properties, LLC v. Pink Palm Properties, LLC*, 950 F.3d 776, 2020 USPQ2d 10053 (11th Cir. 2020). In *Royal Palm*, the evidence showed that some third parties used the name "Royal Palm Properties" for their real estate businesses, but because the evidence did not demonstrate that the third parties offered services that competed with plaintiff's services, or that they used "Royal Palm Properties" as a trademark, the court held that the evidence failed to prove that plaintiff's use of the "Royal Palm Properties" mark was not substantially exclusive. 950 F.3d at 785-86. *Cf. Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1010 (Fed. Cir. 1988) (evidence that four other companies made products similar to the one in which an applicant claimed acquired distinctiveness for its product configuration trade dress did not mean that the applicant's use was not substantially exclusive). The record contains (at most) evidence of four other entities using a trademark containing "Institute on Aging" in connection with health care services similar to those described in the Application, and therefore fails to prove that Applicant's use is not substantially exclusive. *Cf. Target*

Brands, Inc. v. Shaun N.G. Hughes, 85 USPQ2d 1676, 1682 (TTAB 2007) (rejecting a claim of acquired distinctiveness where the record identified 31 uses of the identical “Ultimate Polo” mark in connection with identical goods).

B. Applicant has acquired distinctiveness in the “Institute on Aging” mark due to its widespread use and promotion of the mark.

Although Applicant’s continuous and substantially exclusive use of “Institute on Aging” for over 20 years is sufficient to prove that the mark has acquired distinctiveness, the strength of the mark has been buttressed by Applicant’s use and promotion of the “Institute on Aging” mark. In the thirty-plus years since the founding of the organization that evolved into Applicant, Applicant has expanded the scope of its services to include health services, day care centers, 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 of daily living, such as bathing, grooming, and personal mobility, all for the disabled and elderly. Briody Decl. ¶ 5 (TSDR, p. 49). Across its programs and services associated with the “Institute on Aging” trademark, Applicant delivers services to 385,000 people annually. Applicant’s revenues have grown from \$21 million in 2002, to \$65 million in 2022. *Id.* ¶ 10 (TSDR, p. 50).

To increase Applicant’s ability to reach people who could benefit from its services, Applicant has acted as a trusted partner to several governmental and non-profit organizations, for example Applicant: coordinated the Elder Abuse Prevention Program for the City of San Francisco; operated neighborhood resource centers for the San Francisco Department of Aging and Adult Services; and offered PACE centers and day treatment centers for those with dementia and cognitive challenges in connection with California Pacific Medical Center and On Lok Lifeways. Since 2018, Applicant has been a service provider in partnership with Inland Empire Health Plan and the Department of Health Care Services in San Bernardino and Riverside Counties, a growing geographic area in California with 4.6 million residents. *Id.* at ¶ 6 (TSDR, p. 49).

Applicant's "Friendship Line" service, a national toll-free phone line for older adults and adults with disabilities to call for crisis intervention and a "warm" line for routine, even daily, phone calls that provide emotional support, medication reminders and well-being check-ins, is one of Applicant's successful services. Applicant has been offering its "Friendship Line" service since its founding; calls made and received in connection with the "Friendship Line" are associated with the "Institute on Aging" brand. In 2021, 325,000 calls associated with the "Friendship Line" services were made. *Id.* at ¶ 7 (TSDR, p. 49).

Applicant has acted as a trusted partner with other organizations to increase the reach of the "Friendship Line" services (and consequently, the reach of the "Institute on Aging" trademark). For example, as a result of a partnership with Humana, inbound and outbound "Friendship Line" calls were made to aging adult members throughout Kentucky, Louisiana, and California. Applicant also has a standing contract with the California Department of Aging to reach isolated seniors across California. This partnership with the California Department of Aging has resulted in the exposure of the "Institute on Aging" mark to over 5,000,000 Californians via print, broadcast, and digital advertising, as well as the mention of the "Institute on Aging" trademark during the broadcasted Governor's address to the State of California at its launch. *Id.* at ¶ 8 & Exhibit V (TSDR, pp. 49, 251-53).

Applicant has undertaken substantial efforts to make the public aware of the many services it has to offer and the "Institute on Aging" trademark. These efforts including the following:

- Applicant's website, located at ioaging.org and prominently displaying the "Institute on Aging" trademark. From January 1, 2013 through March 21, 2022, Applicant's website received 2,294,432 unique visitors. The website visitors came from all 50 states, with the most visitors coming from California, Texas, New York, Virginia, and Florida (in decreasing order). Briody Decl. ¶ 11 & Ex. E (TSDR, pp. 50, 71-74).
- Applicant maintains active pages on social media. For example, Applicant has pages on Facebook and LinkedIn.

- Applicant established its Facebook page in 2019. As of March 22, 2022, 11,067 people had “liked” the page and the page has 12,663 followers. Notably, since its launch, the “Institute on Aging”-branded Facebook page has had over 4,348,490 unique visitors resulting from unpaid outreach, i.e., individuals who consumed content offered under the “Institute on Aging” trademark without being served an ad. These visitors include individuals who may actively follow the “Institute on Aging”-branded page, or saw content as a result of sharing by a friend, a search, or a Facebook recommendation. An additional 5,635,993 unique visitors have arrived at the “Institute on Aging”-branded page through paid advertising, i.e., an individual was served an ad on the Facebook platform and clicked on it. In short, approximately 10 million unique users have visited the Applicant’s “Institute on Aging”-branded Facebook page. Briody Decl. ¶ 12 & Ex. F (TSDR, pp. 50, 75-146).
- Applicant established its LinkedIn page bearing the “Institute on Aging” trademark in 2018. The account has 4,929 followers as of March 23, 2022, and the top locations of visitors are from California (primarily San Francisco, Los Angeles, San Diego, and Sacramento); the Greater New York Area; Washington D.C.; the Greater Chicago Area; the Greater Boston Area; and the Greater Denver Area. Briody Decl. ¶ 12 & Ex. H (TSDR, pp 50, 147-49).
- Applicant has also run digital advertisements that display the “Institute on Aging” trademark. Notably, the Facebook ads have had 21,061,813 impressions, the Google ads have had 37,590,427 impressions, and the Bing ads have had 4,048,880 impressions. See ¶ 15 & Ex. S (TSDR, pp. 52, 236-43).
- Since 2013, Applicant has sent over 2.6 million informative emails bearing the “Institute on Aging” trademark. Briody Decl. ¶ 13 (TSDR, p. 50).

- In 2021, Applicant spent \$644,000 on advertisements containing the “Institute on Aging” trademark, which is comparable to the amount spent by other organizations of a similar size and operating in the same field. *Id.* ¶ 14 (TSDR, p. 50); *see also* Exs. J, K, L, N, Q, R (examples of some of the ads) (TSDR, pp. 186-92, 200-02, 212-35).
- The Olympic gold-medal winning figure skater Kristi Yamaguchi has appeared in advertisements for Applicant featuring the “Institute on Aging” trademark. Ms. Yamaguchi served as the emcee for a fundraiser for Applicant on February 8, 2022, an event that raised \$300,000 and had 400 attendees/participants. The “Institute on Aging” trademark was prominently displayed at the event and in advertisements for the event. *Id.* ¶ 15 & Ex. N (TSDR, pp. 51, 200-02).
- The Hall of Fame baseball player Willie Mays appeared in advertisements and at an event displaying the “Institute on Aging” trademark. Briody Decl. ¶ 15 & Ex. J (TSDR, pp. 51, 186-88).
- Annually since 2014 Applicant has participated in San Francisco’s popular Gay Pride Parade with a vehicle and team shirts displaying the “Institute on Aging” trademark. Briody Decl. ¶ 15 & Ex. O (TSDR, pp. 51, 203-05).
- Applicant owns 8 buses that it uses to transport its clients and these buses prominently display the “Institute on Aging” trademark. The buses run throughout San Francisco 5 days a week, covering approximately 1,000 miles a week. Briody Decl. ¶ 15 & Ex. K (TSDR, pp. 51, 189-90).
- Applicant has placed advertisements bearing the “Institute on Aging” trademark on mass transit. For example, Applicant placed advertisements in San Francisco’s Muni bus system. The ads ran for 18 weeks on 4 of the 36 routes, and approximately 2.3 million riders viewed the ads each week. Briody Decl. ¶ 15 (TSDR, p. 51).

- Since 2018, Applicant has had paid sponsorship referencing the “Institute on Aging” trademark on KQED, a major NPR station in the Bay Area. The sponsorship announcement runs 10 times every week during drive time, reaching 759,000 unique listeners each week. Applicant also is identified by its ‘Institute on Aging’ trademark as a sponsor of a KQED podcast, reaching 20,000 unique listeners each week. Briody Decl. ¶ 15 (TSDR, p. 51).
- Applicant had a team that participated in an Alzheimer’s walk in October 2019 in San Francisco. The team identified themselves by displaying the “Institute on Aging” trademark. Briody Decl. ¶ 15 (TSDR, p. 51).
- In 2010, Applicant displayed 30 banners that included the “Institute on Aging” trademark on major streets in San Francisco. The banner hung on such streets as Geary Boulevard (a major east-west thoroughfare that is a signalized expressway for a stretch), Stanyan Street (which forms one side of the popular Golden Gate Park), and Hayes Street (a street with many stores and restaurants) in San Francisco. Briody Decl. ¶ 15 & Ex. L (TSDR, pp. 51, 191-92).
- Applicant engages in outreach bearing the “Institute on Aging” mark to non-English speakers in an effort to reach a broad array of members of the elderly and disabled populations. Briody Decl. ¶ 15 & Ex. Q (TSDR, pp. 51, 212-20).
- Applicant’s advertisements bearing the “Institute on Aging” trademark were displayed on pharmacy bags that were used throughout the Bay Area from 2002-2005. Briody Decl. ¶ 15 & Ex. R (TSDR, pp. 51, 232).

As a result of such extensive and widespread use, advertising, and promotion of the “Institute on Aging” mark, Applicant’s “Institute on Aging” mark has become widely recognized as a source of its health care services.

C. Third-party recognition demonstrates that the “Institute on Aging” mark functions as a source identifier.

Third party references to, and recognition of, the “Institute on Aging” mark demonstrate that this

phrase functions as Applicant's trademark. For example, Applicant's employees are routinely invited to give presentations across the United States, including presentations at very large industry conferences. The "Institute on Aging" trademark is always associated with these presentations. Briody Decl. ¶ 16 (TSDR, p. 52). Applicant has been given awards by its peers in recognition of its high-quality services and leadership in care for the elderly and disabled. For example, in 2019, Applicant won the John A. Hartford Foundation Business Innovation Award. This award is made by the Aging and Disability Business Institute to recognize the successes of community-based organizations that are partnering and contracting with health care entities, such as hospitals, health plans and accountable care organizations, to reduce health care costs and improve the well-being of older adults and people with disabilities in their communities. The award is presented at the USAging Annual Conference and Tradeshow each year, the country's largest gathering of leaders in the field of services for the elderly, at which more than 100 sessions are held across four days. *See* Briody Decl. ¶ 18 & Ex. T (TSDR, pp. 52, 244-45).

Applicant has also won recognition as a "Provider of Choice" by Home Care Pulse in 2018-19. This award reflects Applicant's high satisfaction scores from clients and caregivers, and demonstrates the public recognition of the "Institute on Aging" brand. *See* Briody Decl. ¶ 18 (TSDR, p. 52). In addition, Applicant's "Friendship Line" services are accredited by the American Association of Suicidology. *Id.* ¶ 9 (TSDR, p. 49).

Third parties have independently written about or otherwise recognized Applicant by its "Institute on Aging" trademark in media publications, and such unsolicited media coverage provides strong evidence that the mark serves as a source identifier for Applicant's services. Briody Decl. ¶ 17 & Ex. I (TSDR, pp. 52, 153, 158, 161, 163, 165, 179, 183). Applicant's social media following also reflects public recognition of the "Institute on Aging" trademark. *Id.* ¶ 12 (TSDR, p. 50). Applicant's ability to get third-parties to cease using trademarks that contain "Institute on Aging" provides further evidence that "Institute on Aging" is recognized as a trademark. *Id.* ¶ 4 (TSDR, pp. 48-49). Last but not least, California State and federal

legislators (including Senator Dianne Feinstein) and legislative and governmental bodies (including the California Senate) have recognized the “Institute on Aging” for the important work it has done for decades, and continues to do, in helping the elderly and disabled. *Id.* 19 & Ex. M (TSDR, pp. 52, 193-99).

The Examiner attempts to undercut the significance of this substantial evidence on the grounds that the “Institute on Aging” mark is allegedly “highly descriptive” due to the alleged use by many third parties. *See* May 6, 2022 Final Action, TSDR p. 6. But as discussed previously, the Examiner has presented very little evidence that third parties use “Institute on Aging” as a trademark for health care services.

The Examiner also tries to undercut the weight of Applicant’s evidence on the grounds that it does not show use of the wording “Institute on Aging” apart from the logo mark. *See* November 29, 2022 Denial of Request for Reconsideration, TSDR p. 5. First, the Examiner is incorrect that the evidence does not reflect that the “Institute on Aging” wording has acquired distinctiveness on its own. To give but one example, the evidence of third-party recognition of “Institute on Aging” is for the wording by itself, without the logo. *See* Briody Decl. ¶¶ 4, 16-17, 19 & Exs. I, M (TSDR, pp. 48-49, 52, 153, 158, 161, 163, 165, 179, 183, 193-99). Moreover, when Applicant does display the wording “Institute on Aging” with the logo, the wording is a prominently used, separable element from the logo, and thus fully capable of acquiring distinctiveness. *See, e.g.*, TSDR p. 72. There is no legal or factual basis for concluding that the “Institute on Aging” wording is used in a way that has prevented it from acquiring distinctiveness.

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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