

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: August 8, 2023

Mailed: August 18, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Molina Healthcare, Inc.

—
Serial Nos. 90887104 and 90887134¹

Robert E. Hough II of Sheppard, Mullin, Richter & Hampton LLP,
for Molina Healthcare, Inc.

Angela Micheli, Trademark Examining Attorney, Law Office 101,
Zachary Sparer, Managing Attorney.

—
Before Coggins, Dunn, and Elgin,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Molina Healthcare, Inc. (“Applicant”) seeks registration on the Principal Register of the two marks MOLINA MY HEALTH PERKS and MY HEALTH PERKS, each in standard characters, and each for services ultimately identified as:

¹ These appeals were consolidated in an earlier Board order. 9 TTABVUE. Because the records for the two applications are effectively identical, we refer in this decision to the appeal and prosecution records for application Serial No. 90887104. Citations to the appeal record refer to the TTABVUE docket system, and citations to the prosecution record refer to the .pdf version of the TSDR system. *See, e.g., In re Integra Biosciences Corp.*, 2022 USPQ2d 93, at *7 (TTAB 2022).

Business administration of a wellness incentive program;
Promoting public awareness of a wellness incentive
program, in International Class 35; and

Providing information in the fields of health and wellness,
in International Class 44.²

The Examining Attorney issued a requirement under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), for Applicant to disclaim HEALTH PERKS because, as she contended, it is merely descriptive of all of Applicant's services within the meaning of Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1), and thus an unregistrable component of the mark.³ When Applicant traversed the requirement,⁴ the Examining Attorney made the requirement final and refused registration of Applicant's mark in each class, maintaining that HEALTH PERKS is merely descriptive of all of Applicant's services, and therefore must be disclaimed apart from the mark as shown.⁵ Applicant appealed and requested reconsideration.

In its Request for Reconsideration, Applicant disclaimed HEALTH PERKS in Class 35 only. However, Applicant traversed the requirement to disclaim HEALTH PERKS for the Class 44 information services, and instead offered a disclaimer of only HEALTH in Class 44.⁶ The Examining Attorney noted that the disclaimer

² Application Serial Nos. 90887104 (for the MOLINA MY HEALTH PERKS mark) and 90887134 (for the MY HEALTH PERKS mark) were filed on August 17, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the marks in commerce.

³ March 30, 2022, Office Action at 2.

⁴ See July 19, 2022, Response to Office Action at 9-14.

⁵ August 19, 2022, Office Action at 1-2.

⁶ September 23, 2022, Request for Reconsideration at 1. "A disclaimer may be limited to pertain to only certain classes, or only to certain goods or services." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1213 (July 2023).

requirement had been satisfied for Class 35; but, denied the request for reconsideration as to Class 44, and maintained and continued the requirement for Applicant to disclaim HEALTH PERKS in that class.⁷

After the request for reconsideration was denied as to Class 44, the appeal was resumed. Applicant and the Examining Attorney filed briefs, and an oral hearing was held on August 8, 2023. We reverse the refusal to register in Class 44.⁸

I. Disclaimer of Descriptive Matter: Applicable Law

Under Section 6(a) of the Trademark Act, “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.”

15 U.S.C. § 1056(a). A disclaimer is a statement that the applicant does not claim the exclusive right to use a specified element of the mark. *See* TMEP § 1213.

[A] disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

In re La. Fish Fry Prods., 797 F.3d 1332, 116 USPQ2d 1262, 1267 (Fed. Cir. 2015) (Newman, Circuit Judge, concurring) (quoting *Sprague Elec. Co. v. Erie Resistor Corp.*, 101 USPQ 486, 486-87 (Comm’r Pats. 1954)).

⁷ November 9, 2022, Request for Reconsideration Denied at 1-2. *See also* September 26, 2022, Public Note (entering disclaimers from the Request for Reconsideration, and discussing the files with counsel for Applicant); November 9, 2022, Public Note (clarifying and correcting the disclaimers, and further discussing the files with counsel).

⁸ Inasmuch as the disclaimer requirement for the Class 35 services was satisfied upon reconsideration, the only issue remaining in these consolidated appeals is the disclaimer requirement of HEALTH PERKS for Class 44.

Merely descriptive terms are unregistrable under Section 2(e)(1) of the Trademark Act, and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Failure to comply with a disclaimer requirement is a basis for refusing registration of the entire mark. *See In re La. Fish Fry Prods.*, 116 USPQ2d at 1265; *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1403 (TTAB 2018).

A term is “merely descriptive” within the meaning of Section 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). A term “need not immediately convey an idea of each and every specific feature of the [services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the [services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

Whether a term is merely descriptive is “evaluated ‘in relation to the particular [services] for which registration is sought, the context in which the mark is used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use,’” *In re Chamber of Com. of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *Bayer*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys Water Sports*, 118 USPQ2d

at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). “In other words, we evaluate whether someone who knows what the [services] are will understand the mark to convey information about them.” *Fat Boys Water Sports*, 118 USPQ2d at 1513 (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)).⁹

II. Analysis

The Examining Attorney required Applicant to disclaim the term HEALTH PERKS, apart from the mark as a whole, on the basis that it is merely descriptive of Applicant’s Class 44 services (i.e., “providing information in the fields of health and wellness”). In support of her argument that the term immediately conveys information about a characteristic or feature of the information services, the Examining Attorney points to only two pieces of evidence: a dictionary definition of “perk” and an excerpt from Applicant’s website.¹⁰ According to the Examining Attorney, “perk” is defined as “a benefit to which one is entitled because of one’s job or arising from a particular situation . . . [and] an advantage or benefit arising from a particular situation;” and Applicant’s website states that:

My Health Perks is Molina Healthcare’s Health & Wellness member engagement program that provides access to wellness programs, healthy information and a \$50 wellness incentive program.

Earn a \$50 Gift Card

⁹ A term is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the services are to reach a conclusion about their nature from the term. *See, e.g., Fat Boys Water Sports*, 118 USPQ2d at 1515.

¹⁰ *See* 10 TTABVUE 3, citing March 30, 2022, Office Action at 3 (oxfordreference.com), and August 19, 2022, Office Action at 5 (www.molinahealthcare.com).

- Complete the two steps below to help us better understand your health needs and earn a \$50 gift card.

1. Tell us about your health – Log into your My Molina Portal and visit the My Wellness page to complete the My Health Perks Molina Wellness Assessment
2. Complete your annual physical – Visit your Primary Care Provider (PCP) for your annual Wellness Examination.

- Claim your reward: We will notify you via email once you've completed your online wellness assessment and your Annual Wellness Exam claims have been received.

Other My Health Perks Program Features

- My Health Perks provides access to a suite of wellness programs and information:
 - Interactive programs to help manage Asthma, Heart Disease, Depression, Diabetes, High Blood Pressure & High Cholesterol [and]
 - Health education programs and information, to support a healthy lifestyle.¹¹

The Examining Attorney contends that “[A]pplicant’s provision of information in the fields of health and wellness is a perk for those enrolled in [A]pplicant’s health plan as well as those who find themselves on [A]pplicant’s website. [That is, t]he information is itself a perk as the subject matter of the information, health and wellness, provides a benefit, advantage, or perk to anyone who accesses the information” and that “[A]pplicant’s website clearly shows that the wording ‘health

¹¹ 10 TTABVUE 3, quoting OXFORD DICTIONARY OF ENGLISH (oxfordreference.com) (March 30, 2022, Office Action at 3) and ‘My Health Perks’ (www.molinahealthcare.com) (August 19, 2022, Office Action at 5).

perks’ in relation to its health and wellness information services is descriptive in identifying a feature of those services.”¹²

There is no question that “health” is descriptive of Applicant’s information services, and it has been disclaimed. *See In re NextGen Mgmt., LLC*, 2023 USPQ2d 14, at *9 (TTAB 2023) (“Use of a term in an application’s recitation of services strongly suggests that the term is merely descriptive.”); *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *18 (TTAB 2022) (a disclaimer is a concession that a term is not inherently distinctive). However, Applicant argues that the evidence of record is insufficient to support the disclaimer requirement in Class 44 of HEALTH PERKS, as a combined term, as opposed to the disclaimer of HEALTH alone which Applicant already provided.¹³ Applicant contends that the Examining Attorney has not met the evidentiary burden to establish that either PERKS or HEALTH PERKS is merely descriptive of the information services, because she failed to offer any evidence showing use of the term HEALTH PERKS in connection with information services like those of Applicant, and because there is no evidence demonstrating that PERKS, alone, is descriptive of providing information in the fields of health and wellness.¹⁴

Whether a term is merely descriptive is a finding of fact and must be based upon substantial evidence, *Fat Boys Water Sports*, 118 USPQ2d at 1513 (citing *Bayer*, 82 USPQ2d at 1831), which is “more than a mere scintilla” and “such relevant

¹² 10 TTABVUE 3, 4.

¹³ 6 TTABVUE 7.

¹⁴ 6 TTABVUE 5, 7.

evidence as a reasonable mind would accept as adequate to support a conclusion.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal quotation marks, citation, and subsequent history omitted)).

The record on these consolidated appeals is quite thin. As noted above, the Examining Attorney’s brief relies on only two pieces of evidence (i.e., a dictionary definition of “perk,” and an excerpt from Applicant’s website). The Examining Attorney did not make an information request,¹⁵ or make of record any news database or Internet evidence demonstrating the meaning or showing third-party use of the combined term HEALTH PERKS.

The Examining Attorney’s contentions that the information Applicant provides is itself a perk, and that HEALTH PERKS identifies a feature of the information services, apparently are based on Applicant’s provision of the administration and promotion services for the wellness incentive program.¹⁶ However, because each class

¹⁵ Under Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b), an examining attorney “may require the applicant to furnish such information . . . as may be reasonably necessary to the proper examination of the application.” Generally, information and materials provided in response to a Rule 2.61(b) requirement can be useful in the Board’s review on appeal of the Examining Attorney’s substantive refusal, and likewise useful in the Examining Attorney’s determination of whether to maintain the refusal in the first place. *See* TMEP § 814 (“If an information request is properly focused on obtaining the information most relevant to evaluate a particular . . . requirement, examination is more efficient and refusals (or allowances) of registration based on insufficient facts and information can be avoided.”).

¹⁶ *See* 10 TTABVUE 3 (“Applicant’s website shows the applicant provides various benefits, advantages, or perks for enrolling in its health plan . . . includ[ing] a \$50 gift card if the enrollee fills out a health questionnaire and receives a wellness exam. Additional . . . perks for the enrollee include access to wellness programs and information, and health information related to managing medical conditions and supporting a healthy lifestyle.”), 4 (“In this case,

in Applicant's multi-class application is, in effect, a separate application, we consider each class separately, and determine whether the Examining Attorney has shown that the term HEALTH PERKS is merely descriptive and must be disclaimed with respect to each class. *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 (TTAB 1987); *cf. Monster Energy Co. v. Tom & Martha LLC*, 2021 USPQ2d 1197, at *11 n.15 (TTAB 2021) ("With multiple class applications, the Board treats each class as a single class application, and the claims and evidence are considered as they bear on each class, separately."). In other words, each class of services is independent from the other class of services.

When requiring a disclaimer directed to all classes in a multi-class application, such as these in the consolidated appeal, examining attorneys should adduce evidence substantiating the requirement on a class-by-class basis. The record before us contains only a scintilla of evidence related to the Class 44 services, but no more. Because that is not adequate to support a reasonable conclusion that HEALTH PERKS is merely descriptive of the information services, *see Real Foods Pty. v. Frito-Lay N. Am.*, 128 USPQ2d at 1372, we find that the Examining Attorney has not carried the burden for a disclaimer requirement with respect to the Class 44 services.

the applicant's website clearly shows that the wording "health perks" in relation to its health and wellness information services is descriptive in identifying a feature of those services.").

III. Decision

The refusal to register Applicant's marks MOLINA MY HEALTH PERKS and MY HEALTH PERKS based on the requirement, made under Trademark Act § 6(a), for a disclaimer of the wording HEALTH PERKS in Class 44 is reversed.¹⁷

¹⁷ The applications will proceed with the current disclaimers of HEALTH PERKS as to Class 35 and HEALTH as to Class 44.