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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Caregivers Advisory Panel, Inc.

Serial No. 76/136,363

Gary L. Jones of Kohrman Jackson & Krantz, P.L.L. for The Caregivers Advisory Panel, Inc.

Michael J. Souders, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Hairston, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The Caregivers Advisory Panel, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register THE CAREGIVERS ADVISORY PANEL as a trademark for "marketing research services in the medical products and services business."[1] Registration has been finally refused

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[1] Application Serial No. 76/136,363, filed September 27, 2000, and asserting first use anywhere and first use in commerce on June 2, 2000.

pursuant to Section 2(e)(1) of the Trademark Act, §1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified services.

Applicant and the Examining Attorney have filed appeal briefs. No oral hearing was requested.

Before turning to the merits of this case, we must consider a preliminary matter. Applicant, for the first time with its brief on appeal, submitted printouts of certain pages from its web site and contends that such evidence establishes that its mark has acquired secondary meaning. Applicant, however, did not amend its application to seek registration under the provisions of Section 2(f) during the prosecution of the application. Moreover, as noted by the Examining Attorney, this evidence is untimely because Trademark Rule 2.142(d) requires that the record in an application be complete prior to appeal. Under the circumstances, we have given no consideration to the printouts and applicant's argument with respect to secondary meaning. Thus, the only issue before us on appeal is mere descriptiveness.

In support of his position that THE CAREGIVERS ADVISORY PANEL is merely descriptive of "marketing research services in the medical products and services business",

the Examining Attorney has pointed to applicant's specimens which contain the following statement:

> The Caregivers Advisory Panel is a national panel of family caregivers who provide information about their needs, wants and opinions.

Also, the Examining Attorney points to the mission statement at applicant's web site:

- The purpose of the TCAP is to assemble a large body of knowledge from caregivers to advise health care manufacturers and service providers as well as policy makers…

- Unlike one individual survey, a dedicated panel of family caregivers provides an ongoing resource of knowledge, insight and wisdom.

The Examining Attorney also made of record dictionary definitions of the words "caregiver," "advisory," and "panel;" and copies of third-party registrations for marks that include a disclaimer of the word "panel" or "advisory". Based on the foregoing evidence, the Examining Attorney concludes that THE CAREGIVERS ADVISORY PANEL is merely descriptive of the identified services because "[it] indicates that the applicant is a[n] advisory panel of caregivers." (Final office action, p. 3).

Applicant, in urging reversal of the refusal to register, concedes that the individual words "caregivers," "advisory," and "panel" have descriptive significance as used in connection with applicant's services. Nonetheless,

applicant contends that the combined phrase THE CAREGIVERS ADVISORY PANEL is incongruous because applicant's services are not directed to caregivers themselves, but rather to companies which serve caregivers. Thus, according to applicant, its mark is at most suggestive of its services.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods or services. In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a mark describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather it is sufficient if the mark describes a significant attribute or idea about them. Moreover, whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is

being used on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

On the other hand, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. In re Abcor Development Corp., supra at 218. As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of into which category a mark falls frequently being a difficult matter involving a good measure of subjective judgment. In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978).

In the present case, we find that the Examining Attorney has not established that, when applied to applicant’s services, the phrase THE CAREGIVERS ADVISORY PANEL directly conveys information about the nature of the services. We believe that some mental processing would be required for prospective customers of applicant’s services

to readily perceive the merely descriptive significance of THE CAREGIVERS ADVISORY PANEL as it pertains to marketing research services in the medical products and services business. Applicant concedes that the individual words that comprise applicant's mark have descriptive significance when used in connection with the services. However, considering the mark as a whole, we find that the combination of the words in the mark herein results in certain ambiguities such that no single meaning for the phrase is immediately apparent. See In re Recovery, Inc., 196 USPQ 830 (TTAB 1977)[Board reversed refusal to register RECOVERY for group therapy and self-help aftercare services because term "appears, at first blush, to possess a descriptive significance" but requires mental processing to explain significance].

As we see from the specimens of record, applicant has two classes of customers. One class of customers are caregivers who will join applicant's organization and, in return for participating in surveys and research, receive benefits in the nature of home health equipment for testing, cash and awards. The other class of customers are companies/organizations which manufacture medical products and provide other services to caregivers. These companies/organizations do not join applicant as such, but

rather, work with applicant to arrange for the distribution of products or services, presumably for purposes of getting assessments from applicant's members.

Applicant's mark THE CAREGIVERS ADVISORY PANEL has potentially different connotations to these classes of customers, and is therefore ambiguous when used in connection with "marketing research services in the medical products and services business." To caregivers, the mark may connote that applicant's marketing research services are designed to assist them in the selection of home health products and services. To companies and organizations which manufacture products and provide other services to caregivers, the mark may connote that applicant's marketing research services are designed to aid them in the development of their products and services. In view of the ambiguous nature of applicant's mark, we find that it is not merely descriptive of the identified services.

Finally, we recognize that we must resolve whatever doubt we may have regarding the merely descriptive character of the mark in favor of applicant and the mark should be published for opposition. In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

Decision: The refusal to register under Section 2(e)(1) of the Act is reversed.

Bottorff, Administrative Trademark Judge, dissenting:

I do not agree with the majority's conclusion that applicant's mark is not merely descriptive of the services recited in the application. Applicant's market research services are rendered by means of, or utilize, an advisory panel made up of caregivers, i.e., a caregivers advisory panel. Applicant's mark directly and immediately describes this significant feature or characteristic of applicant's services. I see no ambiguity. Accordingly, I would affirm the refusal to register.