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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *The American Fertility Society*¹

Serial No. 74/568,765
On Remand From
The U.S. Court Of Appeals For The Federal Circuit

Mark Sommers and Doug Rettew of Finnegan, Henderson,
Farabow, Garrett & Dunner, L.L.P. for The American
Fertility Society.

Thomas Wellington, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

The U.S. Court of Appeals for the Federal Circuit, in
a decision dated August 18, 1999, vacated the Board's

¹ It appears that applicant is now known as the American Society of Reproductive Medicine. If applicant wishes to have the certificate of registration issued in its new name, applicant must make such a request in writing. The request must indicate that a change of name document has been recorded in the Office Assignment Division or that the document has been filed for recordation.

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May 18, 1998 decision affirming the refusal to register on the Supplemental Register the mark AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE for "association services, namely promoting the interests of the reproductive medicine industry" in the absence of a disclaimer of the phrase SOCIETY FOR REPRODUCTIVE MEDICINE. The Court stated that "the Board applied an incorrect legal test [for genericness] to the evidence before it, ruling the disputed phrase generic as a whole based solely on evidence that its constituent elements, 'society' and 'reproductive medicine,' were generic." The Court remanded the case to the Board for a re-determination of the genericness of the phrase SOCIETY FOR REPRODUCTIVE MEDICINE based on the proper legal test as set forth in *H. Marvin Ginn Corp. v. International Ass'n. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The Court noted that "the correct legal test for the genericness of phrases, as set forth in Marvin Ginn, requires evidence of 'the genus of the goods or services at issue' and the understanding by the public that the phrase primarily refers to that 'genus of goods and services.'" Further, the Court noted that *In re Gould Paper Corp.*, 843 F.2d 1017, 5 USPQ2d 1110 ["SCREENWIPE" is generic as applied to wipes for cleaning computer and television

screens] "is limited, on its facts, language, and holding, to compound terms formed by the union of words." (emphasis added).

Applying the Marvin Ginn test to the phrase SOCIETY FOR REPRODUCTIVE MEDICINE as a whole, I find that the phrase has not been proven to be generic for applicant's association services of promoting the interests of the reproductive medicine industry.

As noted by the Court, the evidence made of record by the Examining Attorney in support of a finding of genericness consisted of a dictionary definition of the word "society"; third-party applications and registrations for marks which include (and disclaim) the word "society"; and articles from the NEXIS data base which refer to the field of "reproductive medicine." Such evidence, is insufficient to establish that the entire phrase SOCIETY FOR REPRODUCTIVE MEDICINE is generic.

In this case, there is no evidence that the relevant public uses the phrase SOCIETY FOR REPRODUCTIVE MEDICINE as a generic or common descriptive name for association services in the nature of promoting the interests of the reproductive medicine industry. In the absence of such evidence, or other evidence that the phrase has no additional meaning to the relevant public other than the

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terms "society" and "reproductive medicine" have individually, I am constrained to conclude that SOCIETY FOR REPRODUCTIVE MEDICINE is not generic for applicant's services. See Marvin Ginn, *supra* and *In re Merrill, Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

Decision: The refusal to register is reversed.²

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board

Hanak, Administrative Trademark Judge, concurring:

I concur.

E. W. Hanak
Administrative Trademark Judge
Trademark Trial and Appeal Board

² Having applied the Marvin Ginn test to the phrase SOCIETY FOR REPRODUCTIVE MEDICINE as a whole as instructed by the Court, the inquiry is complete. I would not go further, as does Judge Simms in his concurring opinion, and require a disclaimer of the terms "society" and "reproductive medicine". Contrary to the concurring opinion, I am not convinced that the Court considered both terms to be generic, or simply considered the evidence submitted by the Examining Attorney to relate to the genericness of the terms. Also, it is noted that the Court refers to SOCIETY FOR REPRODUCTIVE MEDICINE as a "unitary phrase". TMEP Section 1213.06(a) states, in relevant part: "If the matter comprising the mark, or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise is required."

Simms, Administrative Trademark Judge, concurring:

Applying only the test for genericness set forth in *Marvin Ginn*, I am constrained to agree that, on this record, the words "SOCIETY FOR REPRODUCTIVE MEDICINE" are not generic for applicant's association services (although one might reasonably argue that this phrase, consisting of individual generic words is "so highly ... descriptive of the qualities of [applicant's services] that the slogan does not and could not function as a trademark to distinguish [applicant's services] and serve as an indication of origin." In re Boston Beer Co. L.P., ___ F.3d ___, 53 USPQ2d 1056 (Fed. Cir 1999)(holding BEST BEER IN AMERICA to be "incapable of registration as a trademark.")). However, because the words "society"³ and "reproductive medicine,"⁴ as acknowledged by the Court ("Therefore, the Board erred in finding that the *proven genericness* of the words, 'society,' and 'reproductive medicine,' without more, rendered generic the phrase SOCIETY FOR REPRODUCTIVE MEDICINE [emphasis added]."), are generic, and because I believe that it is desirable for registrants to clearly indicate what rights are not being and cannot be claimed as

³ "A voluntary association of individuals for common ends..."

⁴ Applicant has acknowledged that this is a recognized field of medicine.

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exclusive, apart from the mark as a whole, I would require applicant to submit a disclaimer of the exclusive right to use the words "SOCIETY" and "REPRODUCTIVE MEDICINE" apart from the mark as a whole. These words are clearly generic terms that applicant cannot claim as its own. See TMEP Sec. 1213.02(b). Also, when the Board reviews a disclaimer requirement on appeal, it is customary for us to affirm the requirement if the Board believes that even a part of the wording should be disclaimed. That is to say, if a portion of the wording which the Examining Attorney has required be disclaimed is determined to be either descriptive (without acquired distinctiveness, on the Principal Register) or generic (on both registers), then the Board affirms the disclaimer requirement to the extent that applicant is required to submit a disclaimer of that portion found to be

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descriptive or generic. The panel is remiss in not addressing this issue.⁵

R.L. Simms
Administrative Trademark
Judge, Trademark Trial
and Appeal Board

⁵ It would seem that if the words SOCIETY FOR REPRODUCTIVE MEDICINE were considered to form a unitary phrase (or be part of the alleged unitary phrase AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE) and, therefore, not the subject of a disclaimer, then either the Board or the Court would have rejected the Examining Attorney's disclaimer requirement out of hand, saying that no disclaimer is needed for this reason alone. I do not believe that either the Board or the Court viewed applicant's asserted mark as a unitary expression such that no disclaimer was necessary. See TMEP Sec. 1213.06(a). The Manual gives examples of what are considered unitary phrases ("Black Magic") and applicant's asserted mark is clearly not one.