

Hearing: June 13, 2000

Paper No. 20
TEH

11/30/00

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merion Publications, Inc.

Serial No. 75/277,306

Rachel L. Brendzel of Blank Rome Comisky & McCauley, LLP for
Merion Publications, Inc.

Caroline Whitmire, Trademark Examining Attorney, Law Office 107
(**Thomas Lamone**, Managing Attorney).

Before **Simms**, Bucher and Holtzman, Administrative Trademark
Judges.¹

Opinion by **Holtzman**, Administrative Trademark Judge:

An application has been filed by Merion Publications, Inc.
to register ADVANCE FOR HEALTH INFORMATION EXECUTIVES for a
"magazine featuring information systems for executives and
administrators in the healthcare industry."² The application is

¹ Administrative Trademark Judge Rany Simms has been substituted on
this panel for Administrative Trademark Judge Linda Mcleod who is no
longer with the Office. The change in the composition of the panel
does not necessitate a rehearing of the oral argument. See, In re
Bose, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

based on an allegation of a bona fide intention to use the mark in commerce.

In the first Office action (issued September 22, 1997) the Trademark Examining Attorney required a disclaimer of the wording "FOR HEALTH INFORMATION EXECUTIVES" under Section 6 of the Trademark Act on the ground that the phrase is merely descriptive of both the subject matter and the intended audience for applicant's magazines. On October 15, 1997, applicant filed an amendment to allege use under Trademark Rule 2.76 alleging dates of first use and first use in commerce of June 1997. Then on February 26, 1998, applicant filed a response to the Office action wherein applicant amended the application to seek registration under Section 2(f) of the Act,

"...in part as to FOR HEALTH INFORMATION EXECUTIVES because the mark in its entirety has acquired distinctiveness as to 'ADVANCE FOR' combined with a professional designation. Consequently, Applicant's mark ADVANCE FOR HEALTH INFORMATION EXECUTIVES has become distinctive of the goods as evidenced by ownership of [a number of registrations]; all on the Principal Register for substantially the same mark for related goods."

Applicant based its 2(f) claim on ownership of eleven registrations on the Principal Register, including a registration for the mark ADVANCE FOR HEALTH INFORMATION PROFESSIONALS, each registration for a "magazine featuring the allied health

² Application Serial No. 75/277,306 filed April 18, 1997.

professions" and each including a claim of 2(f) as to the wording following ADVANCE in the respective marks.³

The Examining Attorney rejected applicant's evidence contending that none of the registrations is for the same mark as the mark herein, and continued the requirement for a disclaimer. Applicant then submitted additional argument and evidence which was also found to be insufficient by the Examining Attorney and when the requirement for a disclaimer was made final, applicant appealed. Both applicant and the Examining Attorney filed briefs on appeal, and applicant filed a reply brief. An oral hearing was held.⁴

As a preliminary matter, and to clarify the issue on appeal, we find that applicant has waived any claim of inherent distinctiveness of the phrase FOR HEALTH INFORMATION EXECUTIVES. Applicant, in response to the Examining Attorney's first Office

³ These registrations are for the following marks: ADVANCE FOR HEALTH INFORMATION PROFESSIONALS; ADVANCE FOR SPEECH-LANGUAGE PATHOLOGISTS & AUDIOLOGISTS; ADVANCE FOR RESPIRATORY CARE PRACTITIONERS; ADVANCE FOR RADIOLOGIC SCIENCE PROFESSIONALS; ADVANCE FOR ADMINISTRATORS IN RADIOLOGY & RADIATION ONCOLOGY; ADVANCE FOR ADMINISTRATORS OF THE LABORATORY; ADVANCE FOR DIRECTORS IN REHABILITATION; ADVANCE FOR MANAGERS OF RESPIRATORY CARE; ADVANCE FOR MEDICAL LABORATORY PROFESSIONALS; ADVANCE FOR OCCUPATIONAL THERAPISTS; and ADVANCE FOR PHYSICAL THERAPISTS.

⁴ This case was reassigned to a different Examining Attorney to write the appeal brief and to argue the case at the oral hearing.

action, amended the application to seek registration under Section 2(f) as to the wording FOR HEALTH INFORMATION EXECUTIVES without any argument or even a statement that the phrase is not descriptive. Applicant did not deviate from this position until it filed its reply brief on appeal. In its reply brief, applicant for the first time asserted that it "does not concede that the term 'Health Information Executives' is descriptive" and that the 2(f) amendment was requested by applicant "merely to aid in its speedy prosecution." (Applicant's reply, pp.2-3).

Unless the question of inherent distinctiveness is clearly reserved, a claim of acquired distinctiveness under Section 2(f) is tantamount to a concession that the mark is not inherently distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984). Applicant has taken inconsistent positions on this matter and has not clearly stated an intention to maintain alternative claims. In fact, in response to the Board's specific question on this issue at the oral hearing, applicant's counsel expressly stated that applicant was not arguing the Section 2(f) claim in the alternative. Under the circumstances, we treat any claim of inherent distinctiveness of the phrase "FOR HEALTH INFORMATION EXECUTIVES" as waived, the phrase is accordingly regarded as merely descriptive within the meaning of Section

2(e)(1), and the sole issue on appeal is the sufficiency of applicant's evidence under Section 2(f).⁵

We turn then to the merits of the appeal. Applicant argues that the phrase FOR HEALTH INFORMATION EXECUTIVES has acquired distinctiveness essentially on the basis of the following evidence. First, applicant claims ownership of an "ADVANCE FOR" "family" of marks and argues that the mark ADVANCE FOR HEALTH INFORMATION EXECUTIVES is "an offspring of the ADVANCE FOR family of marks."

Applicant has also based its claim of acquired distinctiveness as permitted by Trademark Rule 2.41(b) on its ownership of an existing registration for the mark ADVANCE FOR HEALTH INFORMATION PROFESSIONALS. Applicant, relying on a likelihood of confusion analysis to support its position that the two marks convey the same commercial impression, concludes based thereon that the marks are "the same" for purposes of establishing acquired distinctiveness under that rule. In an

⁵ On a related matter, the portion of the mark for which applicant is seeking 2(f) registration is entirely unclear. For example, in response to the first Office action, applicant asserted that it is seeking registration under Section 2(f) "in part as to FOR HEALTH INFORMATION EXECUTIVES" (Applicant's February 26, 1998 response, unnumbered p.2). However, in its request for reconsideration applicant claimed that the "entire mark...is entitled to registration pursuant to Section 2(f)." (Applicant's request for reconsideration, p.2). Later still, in its appeal brief, applicant took the position that the 2(f) claim should apply only to the wording HEALTH INFORMATION EXECUTIVES (Applicant's brief, pp.2,5). We are deciding this case on the basis of whether applicant has sufficient evidence of acquired distinctiveness as to the phrase "FOR HEALTH INFORMATION EXECUTIVES."

attempt to demonstrate that the marks create "identical commercial impression[s]," applicant has submitted dictionary definitions of the words "executive" and "professional." Applicant points to the definition of "executive" as "having administrative or managerial responsibility," and the definition of "professional" as "having a particular profession as a permanent career." Applicant claims that these definitions show that "executive" and "professional" are "interchangeable" words.

Finally, applicant has submitted evidence that the mark ADVANCE FOR HEALTH INFORMATION EXECUTIVES has acquired distinctiveness through actual use. In support of this claim, applicant has submitted pages from its "AdvanceWeb" website which includes a form for subscribing to the publication, information for advertisers, articles of interest, and a vendor directory "all specifically focused around applicant's ADVANCE FOR HEALTH INFORMATION EXECUTIVES mark." Applicant has also relied on pages from two third-party websites, docsolutions.com and Voncomed.com, both of which contain references to applicant's ADVANCE FOR HEALTH INFORMATION EXECUTIVES magazine.

The burden of proving that a mark, or a portion of a mark, has acquired distinctiveness is on the applicant. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, supra. Applicant has not met this burden.

First, applicant's claim regarding the effect of its asserted family of marks on the specific issue in this case is untenable. Whether or not applicant owns a family of "ADVANCE FOR"⁶ marks or whether "ADVANCE FOR" is a distinctive component of applicant's composite mark has no bearing on the question of whether the wording which is not part of the so-called family name should be disclaimed or has acquired distinctiveness. It is clear that an unregistrable component of an otherwise registrable mark must, in the absence of a 2(f) showing, be disclaimed. See Section 6 of the Trademark Act.

We turn then to applicant's claim of acquired distinctiveness of the phrase FOR HEALTH INFORMATION EXECUTIVES based on its ownership of a registration for the mark ADVANCE FOR HEALTH INFORMATION PROFESSIONALS. Applicant has applied the wrong test in analyzing the similarity of these two marks. We begin by noting that Section 7(b) of the Trademark Act provides that a registration on the Principal Register "shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark and of registrant's exclusive right to use the mark in commerce in connection with the goods or services

⁶ It would appear that the "family" portion of the mark as shown in applicant's specimens and promoted on its web page, if anything, is the single word "ADVANCE," not the phrase "ADVANCE FOR."

specified in the certificate." See also *In re Electro Products Laboratories, Inc.*, 156 USPQ 54 (TTAB 1967). Thus, Section 7(b) creates the basis for permitting reliance on an existing registration, under certain circumstances, to support a claim that distinctiveness has been transferred to a mark which is essentially the same as the registered mark. Further, Trademark Rule 2.41 provides that, in appropriate cases, "ownership of one or more prior registrations on the Principal Register...of the same mark may be accepted as prima facie evidence of distinctiveness."

The ultimate question accordingly involves a determination of whether the current mark and the registered mark ADVANCE FOR HEALTH INFORMATION PROFESSIONALS, are "the same" for purposes of Rule 2.41(b). Applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. See, for example, *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of that rule, is similar to the analysis used in "tacking" cases to determine whether a party may rely, for purposes of establishing priority, on its prior use of a mark which is not identical to its present mark. See *In re Dial A Mattress Operating Corp.*, 52 USPQ2d 1910 (TTAB 1999) and TMEP

§ 1212.04. In this situation, the issue is whether the present mark and the previous mark are "legal equivalents." See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991) and *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. *Compania Insular Tabacalera, S. A. v. Camacho Cigars, Inc.*, 167 USPQ 299 (TTAB 1970). As applicant correctly notes, a minor difference in the marks such as mere pluralization or an inconsequential modification or modernization of the later mark will not preclude application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, *supra*. At the same time, however, it is clear that the "legal equivalents" standard is considerably higher than the standard for "likelihood of confusion." Thus, the fact that two marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*, and *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

In this case, the two marks are not legal equivalents. Applicant's present mark ADVANCE FOR HEALTH INFORMATION

EXECUTIVES, while perhaps similar to, is certainly not indistinguishable from, its registered mark ADVANCE FOR HEALTH INFORMATION PROFESSIONALS. Moreover, contrary to applicant's contention, the words "EXECUTIVE" and "PROFESSIONAL" do not convey the same meaning or commercial impression and their use results in more than a minor difference in the marks. The dictionary definitions supplied by applicant show that there may be a connection between the two words, but they do not in any way demonstrate that these terms are interchangeable or that one word is a synonym for the other. Applicant's own evidence reinforces the perception that the terms have separate and distinct meanings and commercial impressions. As can be seen from the printout from applicant's website, it is clear that the two titles are used to identify two different magazines and directed to two distinct audiences, "each serving a different discipline" in the health care field. (See Applicant's Exh. E attached to its request for reconsideration filed September 15, 1999). Thus, applicant itself promotes the different connotations of the two marks to its subscribers.

Finally, applicant's limited evidence of actual use of the present mark is not sufficient to establish that the phrase "FOR HEALTH INFORMATION EXECUTIVES" has acquired distinctiveness for applicant's magazines. Acquired distinctiveness is an association in the consumer's mind between the mark and the

source of the goods or services. In this case, the third-party references to applicant's mark are not significant because they do not indicate anything about consumer or industry perception of the mark. The website, voncomed.com, merely provides a link to applicant's magazine along with similar links to other industry sites. The second reference, appearing on the web page for docsolutions.com, merely provides information about an article which appears in applicant's magazine. Moreover, the mere display of the mark on applicant's web page, or the offer of a subscription or information about the magazine on its website does not establish this association. Absent specific evidence of, for example, the length of time the page for this magazine has been in existence, the number of "hits" received from visitors to the particular site, the advertising figures for the magazine, the number of subscribers to the magazine within the relevant market, or the revenue generated from subscriptions to the magazine, the evidence submitted by applicant is not particularly meaningful.⁷

Decision: The requirement for a disclaimer of the phrase FOR HEALTH INFORMATION EXECUTIVES is affirmed. However, if applicant submits the required disclaimer within thirty days of

⁷ The evidence submitted for the first time in the reply brief is unsupported and/or untimely and has not been considered herein.

Ser No. 75/277,306

the mailing date stamped on this decision, the refusal will be set aside. See Trademark rule 2.142(g).

R. L. Simms

D. E. Bucher

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board