

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Date: 1/6/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Diabetes Association, Inc.

Serial No. 76149772

Manny D. Pokotilow of Caesar, Rivise, Bernstein, Cohen & Pokotilow for American Diabetes Association, Inc.

Robert L. Lorenzo, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Grendel and Rogers, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

American Diabetes Association, Inc. filed an application to register the designation DIABETES RISK TEST for "educational services, namely, providing the public with a questionnaire developed to assess an individual's risk factors for developing diabetes."¹ Applicant claims that its designation has acquired distinctiveness under Section 2(f) of the Trademark Act.

¹ Application Serial No. 76149772, filed October 19, 2000, alleging first use anywhere and first use in commerce on March 15, 1988.

The trademark examining attorney refused registration under Section 2(e)(1) of the Act on the ground that applicant's proposed mark, when used in connection with applicant's services, is generic and, thus, incapable of functioning as a source-identifying mark.

When the refusal to register was made final, applicant appealed.² Applicant and the examining attorney submitted briefs.³ Applicant requested an oral hearing, but the request subsequently was withdrawn.

In urging that the refusal to register be reversed, applicant claims that the examining attorney has not made a "substantial showing" of genericness to affirm the refusal.

² Applicant, in its brief, requests that, in the event the Board determines the showing of acquired distinctiveness to be insufficient, the Board remand the application to the examining attorney to allow applicant "an opportunity to respond to any objections that the examining attorney may have with applicant's supplemental showing." Applicant asserts that, because the examining attorney has taken the position that any evidence of acquired distinctiveness is irrelevant for a generic term, "the examining attorney has not addressed applicant's supplemental showing of acquired distinctiveness on its merits." (Brief, pp. 10-11). We see no reason to remand, and the request is denied. Although the examining attorney's final refusal is primarily based on genericness, the examining attorney further indicated that registration also was refused on mere descriptiveness and because applicant's Section 2(f) showing was insufficient. (Final Refusal, unnumbered p. 3). In stating this, the examining attorney specifically mentioned the facts set forth in Mr. Graham's second declaration.

³ The examining attorney, in his brief, asks the Board to take judicial notice of a dictionary definition retrieved from an on-line dictionary. Inasmuch as this Internet evidence was not made of record during the prosecution of the application, it will not be considered. In re Total Quality Group Inc., 51 USPQ 1474, 1476 (TTAB 1999).

According to applicant, the examining attorney has not shown by clear evidence that the general public views the designation DIABETES RISK TEST as being generic for applicant's educational services. Despite nearly two decades of use of the designation by applicant, there is, applicant contends, "substantially no usage of DIABETES RISK TEST by others." (Brief, p. 8). Applicant argues that the media uses of "diabetes risk test" introduced by the examining attorney are so indeterminate as to be insufficient proof of generic use. In support of registration, applicant submitted two declarations of John Graham, applicant's chief executive officer. The first one attested to applicant's substantially exclusive and continuous use since 1988 of the designation DIABETES RISK TEST as a mark for applicant's educational services. The second declaration furnished additional facts that indicate, according to applicant, relevant purchasers perceive the designation as a source indicator of applicant's services.

The examining attorney maintains that the record includes clear evidence of the genericness of the designation sought to be registered. The designation, according to the examining attorney, is generic for educational services rendered by way of a series of

questions to assess an individual's risk for developing diabetes. The examining attorney argues that other organizations and entities, such as hospitals, need to use the designation in providing services to educate the public, through the use of risk-assessment questionnaires, about the dangers and risks of diabetes. In support of the refusal, the examining attorney introduced dictionary definitions of "diabetes," "risk" and "test"; and excerpts of articles retrieved from the NEXIS database showing uses of "risk test(s)" in the context of health and disease assessments, and uses of "diabetes risk test(s)."

The issues on appeal are whether the term DIABETES RISK TEST is generic for applicant's educational services, namely, providing the public with a questionnaire developed to assess an individual's risk factors for developing diabetes, and, alternatively, if such term is not generic but rather just merely descriptive, whether it has acquired distinctiveness. Applicant has conceded the mere descriptiveness of the designation sought to be registered by seeking registration pursuant to Section 2(f). In essence, applicant's Section 2(f) claim of acquired distinctiveness is a concession that the mark is not inherently distinctive and that it therefore is not registrable on the Principal Register absent a sufficient

showing of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact."] (emphasis in original); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). Thus, the issue of mere descriptiveness is not an issue in this appeal.

Genericness

We first turn to the issue of whether the designation DIABETES RISK TEST is generic when used in connection with educational services of providing the public with a questionnaire developed to assess an individual's risk factors for developing diabetes. A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. In *re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d

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1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra. The United States Patent and Trademark Office has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. In re Merrill Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Our first task under Marvin Ginn is to determine, based on the evidence of record, the genus of applicant's services. In its application, applicant identified the services as "educational services, namely, providing the public with a questionnaire developed to assess an individual's risk factors for developing diabetes." The record establishes that applicant educates individuals about diabetes by distributing its own risk test that allows these individuals, by answering seven questions, to learn of their risk of developing diabetes. Thus, the

genus of services is accurately reflected by the recitation of services in the involved application.

We next must determine whether the designation DIABETES RISK TEST is understood by the relevant public primarily to refer to that genus of services.

The examining attorney furnished dictionary definitions of the words comprising the designation sought to be registered. "Diabetes" is defined as "any of various abnormal conditions characterized by the secretion and excretion of excessive amounts of urine." The term "risk" means "possibility of loss or injury; something that creates or suggests a hazard." The term "test" is defined as "a critical evaluation; something (as a series of questions or exercises) for measuring the skill, knowledge, intelligence, capacities, or aptitudes of an individual or group." Merriam-Webster's Collegiate Dictionary.

The specimens comprise web pages from applicant's web site on the Internet. One of the links on the web site allows a visitor to "Take the Risk Test," and another link lets a visitor access "Frequently Asked Questions regarding the Risk Test." The specimen contains the seven-question questionnaire comprising applicant's "Diabetes Risk Test," together with the following introductory remarks:

Could you have diabetes and not know it?

Sixteen million Americans have diabetes--one in three does not know it! Take this test to see if you are at risk for having diabetes. Diabetes is more common in African Americans, Hispanics/Latinos, American Indians, Asian-Americans and Pacific Islanders. If you are a member of one of these ethnic groups, you need to pay special attention to this test. To find out if you are at risk answer the following questions and click on "CALCULATE" to see what information is returned.

Also of record are a number of excerpts of articles retrieved from the NEXIS database showing the term "risk test" used in connection with a variety of health and disease assessments. A representative sample shows the following uses: "the program also includes a risk test for the disease"; "'Healthy Living: Diabetes Living,' includes disease risk tests for customers"; "Shield's heart attack risk test"; "Heart group offers free risk tests"; "heart disease risk test"; "some health risk tests deliberately err on the side of caution"; "several stations giving consumers free health-risk tests and other feedback-oriented activities"; "cancer risk test results"; "cancer risk test is proving elusive"; "if you would like to take the American Heart Association's cardiovascular disease risk test"; "osteoporosis risk test"; "genetic-risk test

can complicate decisions"; and "hospital offering health risk tests."

Mr. Graham himself, in his second declaration, uses "risk test" in a generic manner (see infra), just like the uses in the NEXIS articles introduced by the examining attorney.

The examining attorney also introduced a number of NEXIS articles showing generic uses of "diabetes risk test(s)" (with no capitalization), with no reference to applicant. A representative sample follows:

....oral health demonstrations, a visit by the Glow Germ that teaches children proper hand washing techniques, a diabetes risk test, chair massage....
(*The Providence Journal*, February 25, 2005)

Diabetes Center Open House, diabetes risk tests, podiatry screenings and eye health information available, to recognize National Diabetes Awareness Month, sponsored by Montgomery General.
(*The Washington Post*, November 6, 2003)

Customers will be able to complete a self-assessment diabetes risk test and will be provided with an exclusive diabetes resource book and magazine to learn about early detection....
(*The Stevens Point Journal*, September 5, 2003)

For diabetes risk tests, stroke-risk assessments, body fat analysis and screenings for cholesterol, blood pressure, glucose, osteoporosis....
(*The News Journal*, September 20, 2002)

The Barnes-Jewish St. Peters Hospital Health Wise Center will offer diabetes risk tests during regular business hours on Monday and March 29.

(*St. Louis Post-Dispatch*, March 22, 2002)

Lions members will be in the lobby offering visitors a diabetes risk test.

(*Chicago Daily Herald*, March 12, 2002)

Free medical tests also will be provided at the fair, including a diabetes risk test, anonymous HIV testing, depression screening....

(*Belleville News-Democrat*, May 6, 2001)

The screenings will include body fat analyses, diabetes risk tests, breast cancer and depression tests.

(*The News Journal*, October 6, 2000)

Last month Wal-Mart launched a year-long Diabetes Living campaign that included diabetes risk tests for customers and literature and programs about preventing and controlling the disease.

(*The Washington Post*, October 3, 2000)

The board also learned the Tremont Lions Club will distribute sugar-free candy and diabetes risk tests March 31.

(*The Pantagraph*, March 21, 2000)

Cleveland Regional Medical Center in Shelby is offering free diabetes risk tests in its lobby....

(*Charlotte Observer*, March 22, 1999)

Each dinner guest received a pamphlet containing a diabetes risk test that detailed symptoms of the disease and risk factors.

(*Tulsa World*, May 5, 1998)

Several of the other NEXIS excerpts either are duplicates or were generated by wire services.⁴ In addition, applicant is correct in pointing out that many of the references to "diabetes risk test" in the other articles are, in fact, references to applicant's test. We would point out, however, that even some of these references show "diabetes risk test" used in a generic fashion, with all lower case letters and no capitalization. Use in this manner would be perceived as generic by individuals reading the articles. The following are examples of such use:

On Tuesday, the American Diabetes Association is urging people to take a diabetes risk test by calling (888)342-2383 or visiting the Web site at www.diabetes.org.

(Times-Picayune, March 26, 2000)

People also can obtain a free diabetes risk test today by calling the American Diabetes Association at (800)342-2383.

(Daily Oklahoman, March 24, 1998)

Determining if you are at risk for the disease is as easy as answering seven simple questions on the American Diabetes Association's diabetes risk test.

(St. Petersburg Times, March 26, 1996)

⁴ NEXIS excerpts from wire services are generally accorded limited probative value because it cannot be assumed that they have been seen in a newspaper or periodical. In re Patent and Trademark Services Inc., 49 USPQ2d 1537, 1538 n. 2 (TTAB 1998).

Based on this evidence, we find that "diabetes risk test" is used in a generic manner in the medical field to name a specific type of test, that is, a test to determine if one is at risk for developing diabetes.

The relevant public are ordinary consumers. Given the evidence of widespread use of the designation "diabetes risk test(s)" in a generic manner to name a type of test (or series of questions, i.e., a questionnaire), it is clear that ordinary consumers would understand the designation primarily to refer to a specific type of risk test. See *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972 (TTAB 2003) [CPA EXAMINATION is generic (and must be disclaimed apart from UNIFORM CPA EXAMINATION) for printed matter, namely, practice accounting examinations, accounting exams, accounting information booklets; and prior accounting examination questions and answers].

Inasmuch as applicant is seeking to register a service mark rather than a trademark, an additional consideration applicable to our genericness determination in this case is the legal principle that a term which is generic for a particular class of goods is also deemed to be generic for the services of selling those goods. Although applicant's test apparently is distributed free of charge, the same

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legal principle would apply. See, e.g., In re Candy Bouquet International, Inc., 73 USPQ2d 1883 (TTAB 2004) [CANDY BOUQUET generic for retail, mail and computer order services in the field of gift packages of candy]; In re CyberFinancial.Net, Inc., 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM generic for providing information regarding financial products and services on the Internet and providing electronic commerce services on the Internet]; In re A La Vielle Russie Inc., 60 USPQ2d 1895 (TTAB 2001) [RUSSIANART generic for a particular field or type of art and also for dealership services directed to that field]; In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999) [LOG CABIN HOMES generic for "architectural design of buildings, especially houses, for others," and "retail outlets featuring kits for constructing buildings, especially houses"]; In re Bonni Keller Collections Ltd., 6 USPQ2d 1224 (TTAB 1987) [LA LINGERIE generic for "retail store services in the field of clothing"]; and In re Half Price Books, Records, Magazines, Incorporated, 225 USPQ 219 (TTAB 1984) [HALF PRICE BOOKS RECORDS MAGAZINES generic for "retail book and record store services"]. See also In re Northland Aluminum Products, supra [BUNDT generic of a "ring cake mix" despite fact that evidence showed generic

use of term only for a type of cake, and not for a cake mix].

Applying this principle to the facts of this case, we find that DIABETES RISK TEST is generic as used in connection with applicant's educational services. The designation sought to be registered should not be subject to exclusive appropriation even if applicant is the leading organization in educating the American public about diabetes; other organizations and entities should have an equal right to use "diabetes risk test" in connection with educational services provided via their own questionnaires for risk assessment. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999).

Acquired Distinctiveness

If applicant's proposed mark is generic, as we have concluded it is, then no amount of evidence of acquired distinctiveness can establish that the mark is registrable. In re Northland Aluminum Products, Inc., supra at 964. Even long and successful use of a term does not automatically convert a generic term into a non-generic term. In re Helena Rubinstein, Inc., 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969). However, for the sake of completeness, we now address applicant's claim that its mark has acquired distinctiveness. On this issue,

applicant has the burden of proof. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant").

"[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha International Corp., supra at 1008. In this case that standard is extremely difficult to meet since, if DIABETES RISK TEST is not generic for applicant's services, it must be considered highly descriptive of them.

John Graham, applicant's chief executive officer, asserts in his second declaration that the mark DIABETES RISK TEST has acquired distinctiveness for applicant's educational services. Mr. Graham goes on to state, in pertinent part, as follows regarding, in his own words, applicant's "risk test":

Applicant has been using the mark DIABETES RISK TEST since 1988.

The mark DIABETES RISK TEST has become distinctive through applicant's exclusive and continuous use.

The mark DIABETES RISK TEST has become well known to the public by virtue of the fact that millions of the tests have been distributed. In 1998, 4.3 million risk tests were distributed; in the year 1999 and 2000 8 million risk tests were distributed in each year;

and in the year 2001 6.5 million risk tests were distributed.

In addition to hard copies of the risk test distributed, the DIABETES RISK TEST website was visited 57,079 times from June to December 2001.

The American Diabetes Association receives 30 to 50 requests each year from other organizations to reprint the risk test.

The use of the designation since 1988, and the almost 27 million tests distributed during the period of 1998-2001, indicate that the risk test has been popular among health-conscious Americans. Likewise, the number of visitors to applicant's web site and the number of requests to reprint applicant's risk test bear on the popularity of the test. It is difficult, however, to accurately gauge the level of this popularity in the vast medical educational services field in the absence of context, that is, additional information such as how widespread is the distribution of risk tests in the medical field and whether the extent of distribution of applicant's test is above or below the norm, or additional information as to how the numbers of visitors to applicant's web site compare to other medical field web sites offering risk tests. Standing alone, the test distribution number and the visitors number appear to be less than impressive in the

enormous medical field. In any event, this evidence does not show that the relevant consumers of applicant's educational services (namely, ordinary consumers) have come to view the designation DIABETES RISK TEST as applicant's source-identifying mark. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and In re Recorded Books Inc., 42 USPQ2d 1275 (TTAB 1997). The issue here is the achievement of distinctiveness, and the evidence falls short of establishing this.

In the event DIABETES RISK TEST is found not generic, we conclude that the evidence is insufficient to support registration of applicant's highly descriptive mark on the Principal Register pursuant to the provisions of Section 2(f). Given the highly descriptive nature of DIABETES RISK TEST for applicant's educational services rendered by way of a test to assess risk for developing diabetes, much more evidence (especially in the form of direct evidence from the relevant public) than what applicant has submitted would be necessary to show that the mark has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the applicant to establish acquired distinctiveness. *Yamaha International Corp. v. Hoshino*

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Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra.

Decision: The refusal to register on the ground of genericness is affirmed. If the designation DIABETES RISK TEST is ultimately found not generic, applicant nonetheless has not met its burden of proving that the designation has acquired distinctiveness.