

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Subimo, LLC

Serial No. 78545277

Michael N. Haynes of Michael Haynes PLC for Subimo, LLC

Michael P. Keating, Trademark Examining Attorney, Law
Office 101 (Ronald R. Sussman, Managing Attorney)

Before Seeherman, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Subimo, LLC has appealed from the final refusal of the Trademark Examining Attorney to register "CoverageAdvisor" for "providing on-line pamphlets and brochures in the field of health care performance data and healthcare reporting data." The application was filed on January 11, 2005, and initially was based on Section 1(a) of the Trademark Act, claiming dates of first use on June 1, 2002, with goods

identified as "publications, namely pamphlets and brochures, including internet publications, in the field of health care performance data and healthcare data reporting." When the Examining Attorney found that the specimen, an advertisement showing a form, was not acceptable to show use of the mark on pamphlets and brochures, applicant amended the basis of its application to Section 1(b) (intent-to-use), and also amended its identification to the services listed above.

The Examining Attorney has refused registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified services.

Applicant and the Examining Attorney have filed appeal briefs. With his appeal brief, the Examining Attorney submitted a number of dictionary definitions and has requested that the Board take judicial notice of them. To the extent that the definitions are taken from dictionaries that are available in printed format, we grant this request. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). However, we note that two of the definitions are taken from

WordNet and from Investor Words, which appear to be solely on-line sources. These definitions have not been considered. See TBMP §1208.04 (the Board will not take judicial notice of definitions found only in on-line dictionaries and not available in printed format).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, 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). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). Whether a term 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 the goods or services, and the possible significance that the term would have to the average

purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

It is the Examining Attorney's position that "CoverageAdvisor" describes a significant characteristic of the pamphlets and brochures that applicant will provide on-line. In support of this refusal, he has submitted, inter alia, the following dictionary definitions taken from The American Heritage Dictionary of the English Language, 4th ed., © 2000:

Coverage: inclusion in an insurance policy or protective plan;
The extent of protection afforded by an insurance policy

Adviser/advisor: one that advises, such as a person or firm that offers official or professional advice to clients

Healthcare: the prevention, treatment and management of illness and the preservation of mental and physical well-being through the services offered

by the medical and allied health professions.

He also made of record the following definitions of

"coverage" taken from insurance company websites:

The benefits that are provided according to the terms of a participant's specific health benefits plan.

CIGNA glossary of health care terms

The scope of the protection provided under a contract of insurance.

INSWEB

In addition, the Examining Attorney has submitted pages from applicant's website, www.subimo.com, which discuss applicant's Coverage Advisor service, and which includes the following statements:

About the Coverage Advisor
You look at many factors when you select insurance coverage. This tool helps you consider the financial and tax impact of your plan choices so you can select the one that best meets your needs.

To learn about health plans which can help you save for the future, click here to explore HSAs.

As noted, a mark is merely descriptive if it describes a characteristic of the applicant's goods or services. In this case, we find that "CoverageAdvisor" describes a characteristic of the subject matter of the on-line pamphlets and brochures that applicant will provide as part

of its identified services. Although applicant has identified the subject matter of its pamphlets and brochures very generally, i.e., being in "the field of health care performance data and healthcare reporting data," it is clear from applicant's advertising materials that health insurance and alternative protective plan coverage data is part of the health care performance data and healthcare reporting data. Applicant cannot avoid a finding of descriptiveness merely by using more general terms to identify the subject matter of its on-line materials.¹ Cf. *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007). In that decision, the Court affirmed the Board's finding that LAWYERS.COM was a generic term for information exchange concerning the law, legal news, and legal services, despite the fact that applicant had deleted "information exchange concerning lawyers" from the identification, and had argued that it was not seeking to register the mark for selling

¹ In its brief applicant asserts that the final Office action "inexplicably" equates "health care" with "health insurance benefits," and argues that these phrases and the concepts that they represent are not equivalent. We make clear that we do not consider these terms to be the same, or to represent the same concepts. However, applicant's identification is not for "health care" per se, but for materials "in the field of health care performance data and healthcare reporting data." As noted above, data about health insurance coverage and alternative protection plans is encompassed within the phrases used by applicant in its identification.

lawyers or offering services of lawyers, but for more limited services. The Court determined that LAWYERS.COM was still generic for the amended identification because lawyers "are necessarily an integral part of the information exchange about legal services." Id., 82 USPQ2d at 1380. The Court also stated, citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005), that it is appropriate for the Board to consider the applicant's website to understand the meaning of the services for which registration is sought. Thus, in determining the question of mere descriptiveness, we must view applicant's identification regarding "the field of health care performance data and healthcare reporting data" as including data relating to health insurance and alternative protection plans.²

² Applicant has made the argument that because it amended its application from a use-based application to one seeking registration based on an asserted intent to use its mark, (because its original specimen was found to be unacceptable), the specimen it originally submitted when it based its application on use in commerce should be ignored. Similarly, applicant asserts that the web pages showing applicant's current use of "CoverageAdvisor" should be ignored because all that the Board may consider are the services for which applicant intends to use its mark, and those services may be determined only on the basis of the amended identification. Applicant's assertion is incorrect. As noted above, we may look to all the materials that are properly of record to understand the meaning of the identified services. We also point out that, if applicant were to succeed in its argument that we should not consider information regarding health insurance protection or alternative protective coverage to be encompassed within its identification, a Statement of Use filed by applicant with a specimen showing use

Having determined that data concerning health insurance and alternative protection plans is part of the subject matter of the on-line pamphlets and brochures of applicant's identified services, we discuss why "CoverageAdvisor" directly conveys information about such subject matter. First, while applicant's mark is depicted without a space between "Coverage" and "Advisor," because the initial letters of both words are capitalized, the two individual words are readily discernible in the mark. In fact, with the exception of the depiction of the mark in the application and drawing pages, applicant has repeatedly referred to its mark as two separate words, COVERAGE ADVISOR, in all its filings. When these two words are combined into the term "CoverageAdvisor," and used in connection with on-line pamphlets and brochures in the field of health care performance data and healthcare reporting data, the mark has a clear meaning that tells consumers the health care performance data and healthcare reporting data in these pamphlets and brochures include information or advice about health care insurance and protection.

of the mark in connection with health insurance protection or insurance considerations in the selection of such protection would be unacceptable.

Applicant has asserted that the word "coverage" has several meanings, including, in addition to "2.a. Inclusion in an insurance policy or protective plan" and "b. The extent of protection afforded by an insurance policy": "1. the extent or degree to which something is observed, analyzed, and reported: complete news coverage of the election; 3. The amount of funds reserved to meet liabilities; 4. The percentage of persons reached by a medium of communication, such as television or a newspaper."³ Combining these definitions with the definition of ADVISOR taken from the Cambridge Advance Learner's Dictionary, "someone whose job is to give advice about a subject," applicant contends that the mark "CoverageAdvisor" could have several meanings, to wit:

1. someone whose job is to give advice about the extent or degree to which health care performance is observed, analyzed, and reported;
2. someone whose job is to give advice about inclusion in a health care insurance policy or protective plan;
3. someone whose job is to give advice about the extent of protection afforded by a health care insurance policy;
4. someone whose job is to give advice about the amount of funds reserved to meet health care liabilities; and

³ The American Heritage Dictionary, as quoted by applicant in its response filed February 10, 2006.

5. someone whose job is to give advice about the percentage of persons reached by healthcare reporting data.

As noted above, the determination of whether a term is merely descriptive must be made in the context of the identified services. First, we point out that the definition of "advisor" is "one that advises, such as a person or firm," and thus is not specifically limited to a person as applicant's proposed meanings ("someone whose job...") indicate. In the context of the identified services, "advisor" would be viewed by consumers as the entity (i.e., applicant) that provides the advice. With respect to the word "coverage," again, the meaning of the word must be considered in the context of the identified services. Applicant appears to be playing some semantic games in attempting to apply, for example, the definition of "coverage" as it relates to news coverage to the identified services. The appropriate inquiry, however, is not whether one can come up with some creative writing exercise to see how different definitions could possibly apply and therefore result in a meaning for a mark; rather, we must consider how the consumer for the products or services will view the mark in the context of the identified goods and services. See *In re Polo Int'l Inc.*,

51 USPQ2d 1061 (TTAB 199) (DOC in DOC-CONTROL would be understood to refer to the documents managed by applicant's software, as opposed to the word "doctor"). Because of the commonly known meaning of "coverage" in the context of healthcare as relating to a health insurance policy or protective plan, consumers will readily understand "CoverageAdvisor," as used in connection with "providing on-line pamphlets and brochures in the field of health care performance data and healthcare reporting data" as describing a significant aspect of the data provided by these pamphlets and brochures, i.e., that this data may be used as information or advice in making decisions about healthcare coverage. In this connection, two of the meanings proposed by applicant are indeed applicable to the applicant's identified services, i.e., the mark directly conveys that the entity offering the services is providing advice about inclusion of protection (coverage) in a health care insurance policy or protective plan, or advice about the extent of protection afforded by a health care insurance policy.

Finally, applicant argues that there is no evidence that prospective competitors of applicant would need to use the term "CoverageAdvisor" to describe their services. The evidence submitted by the Examining Attorney regarding the

merely descriptive nature of the term shows that this is a term that should remain available for use by competitors; in fact, this is the very basis for the Section 2(e)(1) prohibition against one party obtaining exclusive rights to a merely descriptive term. To the extent that applicant may be asserting, albeit without any evidence to that effect, that no competitors currently use the term "CoverageAdvisor," it is well-established that a word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods or services does not imbue the term with source-identifying significance. In re Hunter Fan Co., 78 USPQ2d 1474 (TTAB 2006). See also, In re National Shooting Sports Foundation, Inc., 210 USPQ 1018 (TTAB 1983) (the fact that the applicant may be the first to use a merely descriptive designation does not justify registration if the term projects only merely descriptive significance).

Decision: The refusal of registration is affirmed.