

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Oral Hearing: June 10, 2008 Mailed: September 23, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Medical Rehabilitation Providers Association
v.
UB Foundation Activities, Inc.

Opposition No. 91158512
(Consolidating Cancellation No. 92043381)

Deborah M. Lodge and Mary F. Love, of Patton Boggs, LLP for
American Medical Rehabilitation Providers, Association.

Paul I. Perlman, of Hodgson Russ LLP for UB Foundation
Activities, Inc.

Before Grendel, Zervas, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

The opposer and petitioner in this case is American
Medical Rehabilitation Providers Association (AMRPA). The
applicant and respondent is UB Foundation Activities, Inc.
(UBFA). UBFA is the successor-in-interest to the marks at
issue in these consolidated proceedings. The mark at issue
for opposition is "FIM" for "printed publications in the
field of rehabilitation, namely printed coding forms,

guides, measurement instruments, and reports"¹ in International Class 16. The mark at issue for cancellation is "THE FIM SYSTEM" for "developing measuring instruments and educational manuals for use by others in the field of rehabilitation; teaching others to measure and report rehabilitation outcomes; analyzing rehabilitation outcomes for others,"² in International Class 41.

AMRPA initiated the opposition on November 7, 2003 and the cancellation on May 28, 2004. AMRPA filed a motion to consolidate the cases on October 29, 2004, which the Board granted on November 1, 2004. In the notice of opposition and the petition to cancel, AMRPA alleged that the marks "FIM" and "THE FIM SYSTEM," respectively, are "generic and incapable of acquiring distinctiveness." AMRPA further alleged in both of its complaints that to the extent the marks are not deemed generic, they are "merely descriptive" and they "lack acquired distinctiveness." UBFA denied the salient allegations of the notice of opposition and the petition to cancel. Both parties filed briefs, and AMRPA filed a reply brief. At the request of both parties, an

¹ Application No. 75497361, filed June 4, 1998, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use and first use in commerce on January 1, 1994. The application claims acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

² Registration No. 2647644, registered on November 12, 2002, based on a filing date of June 4, 1998, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use and first use in commerce on January 1, 1996. The registration claims acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

oral hearing was scheduled and took place on June 10, 2008. The hearing was presided over by this panel.

After careful consideration of the evidence and the arguments presented by the parties, for the reasons discussed herein, AMRPA's opposition to the registration of "FIM" is dismissed, and its petition to cancel "THE FIM SYSTEM" is denied.

The Record

The record in these consolidated proceedings consists of the pleadings and the files of the "FIM" application and "THE FIM SYSTEM" registration. Additionally, both parties submitted multiple testimony depositions and notices of reliance.

AMRPA took the testimony deposition, with accompanying exhibits, of the following 3 individuals:

1. Ms. Carolyn Zollar, Vice-President for Government Relations and Policy for AMRPA.
2. Gerben DeJong, Ph.D., Senior Fellow at the National Rehabilitation Hospital.
3. Dr. Kenneth Adams, Chief Medical Officer for Rehab Care Group.

UBFA additionally took the testimony deposition, with accompanying exhibits, of the following 6 individuals:

1. Ms. Kathleen Dann, Chief Operating Officer for Uniform Data Systems.

Opposition No. 91158512
(Consolidating Cancellation No. 92043381)

2. Ms. Francis Hagerty, Director of Marketing for Uniform Data Systems.
3. Ms. Elizabeth Eisenhauser, Information Resource Specialist for Uniform Data Systems.
4. Ms. Janet Bailey, Director of Clinical Trials for Uniform Data Systems.
5. Dr. Samuel J. Markello, Associate Director of Uniform Data Systems.
6. Dr. Carl Granger, Executive Director of Uniform Data Systems.

Standing

Generally, opposer/petitioner must show a "personal interest in the outcome of the proceeding" as well as "a reasonable basis for belief of damage." *See Books on Tape Inc. v. The Booktape Corp.*, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (petitioner, as a competitor of respondent, "clearly has an interest in the outcome beyond that of the public in general and has standing.") It is not necessary that opposer/petitioner allege or establish its own prior rights in the marks at issue. *Id.* AMRPA alleged the following in its petition to cancel "THE FIM SYSTEM", with substantially similar allegations in its opposition to "FIM":

2. Petitioner AMRPA is an association of medical rehabilitation providers, providing education, research and advocacy in the areas of medical rehabilitation, services, and costs, and patient assessment tools and

outcome reporting. AMRPA has a membership of over 400 rehabilitation providers and other members. It conducts regular meetings, publishes several publications and operates a sophisticated inpatient rehabilitation outcomes system used by inpatient rehabilitation providers to assist inpatient rehabilitation facilities to comply with government regulations.

3. Registrant's mark consists of the generic words "THE" FIM" and "SYSTEM." "THE" and "SYSTEM" do not add any distinctiveness to the mark. "FIM" is commonly understood in the rehabilitation field as the acronym for "functional independence measure." Both "FIM" and "functional independence measure" are common, descriptive terms used in the medical rehabilitation field to denote a particular type of assessment tool and process called the "Functional Independence Measure" and related documentation and scores. Both terms are used by the Petitioner AMRPA, by AMRPA members and by others in the field, in connection with measuring a patient's physical ability to function independently.
4. Government regulations from the Center for Medicare and Medicaid Services ("CMS") require rehabilitation providers to submit a specific form, the Inpatient Rehabilitation Facilities-Patient Assessment Instrument ("IRF-PAI"), in order to obtain Medicare reimbursement under the Inpatient Rehabilitation-Prospective Payment System ("IRF-PPS"). The mandatory IRF-PAI forms include functional independence measures or FIM components.

(Pet. to Cancel, paras. 2-4)

UBFA has not contested AMRPA's standing in either proceeding. We find that AMRPA has established sufficient grounds to plead and prosecute these actions.

Genericness

Generic terms are words or phrases that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.

The Federal Circuit has established a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. In an opposition/cancellation, the opposer/petitioner has the burden of proving genericness by a "preponderance of the evidence." *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006) (in counterclaim for cancellation, "[i]t is applicant's burden to demonstrate by a preponderance of the evidence that DARJEELING is generic, or that the mark has become generic as a result of opposer's failure to exercise control over

use of the mark," citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991)).

As AMRPA has acknowledged repeatedly in the record, the "FIM" and "THE FIM SYSTEM" terms at issue in these consolidated proceedings refer to rehabilitation tools utilized by rehabilitation health care professionals. (Zollar dep. at 62:19 and 90:12-17; Adams dep. at 39:5-6; DeJong dep. at 55:14-56:2 and 83-88). Accordingly, we find that the genus of goods covered by both the "FIM" and "THE FIM SYSTEM" marks is "rehabilitation assessment tools." We find too that the relevant public is health care professionals who are involved in the field of rehabilitation.

1. Alleged generic use of "FIM" by the relevant public.

Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). AMRPA's exhibits and deposition testimony include various uses of the term "FIM." In its brief, AMRPA pointed to several of these uses to support its assertion that the relevant public uses "FIM" in a generic manner. Since AMRPA highlighted these particular uses, we consider them AMRPA's

best evidence of genericness. A sampling of AMRPA's highlighted uses includes:

1. "I am writing to you regarding the Functional Independence Measure (FIM) and the Uniform Data System (UDSmr). Schoolcraft College has a very well known and established Occupational Therapy Assistant Program. Fifty-percent of our clinical field work centers are FIM subscribers. Our students are required by these centers to use the FIM." Letter from Schoolcraft College to Janet Bailey, Director of Subscriber Services to Uniform Data System for Medical Rehabilitation, dated February 4, 1998.
2. "Figure 1: (a) Evolution of the scores obtained for each individual FIM item. A score of 1 corresponds to total dependency, and 7 to full independence for daily-life activities. (b) Evolution of the Neurobehavioural Rating Scale-Revised (NRS-R) scores. Only the most significant items are represented. A score of 1 corresponds to no disorder, 2 to mild trouble, 3 to moderate trouble and 4 to severe trouble." BRAIN INJURY, 1996 VOL. 10, No. 2, 149-153.
3. "Differences in functional outcome were determined by analyzing admission, discharge and changes in FIM scores. An additional measure of functional outcomes included successful prosthetic ambulation and prosthetic complications during admission." Am J. PHYS. MED. REHAB. at 353-357.
4. "We are looking at a modified version of the FIM, at least for our own documentation, and then using the standard FIM scores only for our UDS reporting." Letter from Cypress Rehabilitation Center dated January 30, 1997.
5. "CEC Continuing Education Consortium . . . FIM Certification Training Class" March 23 - 9:00 am to 12:30 pm. Fee \$45. 3 contact hours." March 1998 brochure.

6. "Although the IRF-PAI contains portions of the FIM - an evaluation tool that an estimated 85% of the inpatient rehab world uses now - it has additional questions about medical conditions and comorbidities." PPS Alert for Inpatient Rehab, August 2001.
7. "The first product to come from Granger's initiative was the Functional Independence Measure or FIM, a paper system used by adult rehabilitation units." Buffalobizjournal.com June 18-24, 2004.

The evidence submitted by AMRPA does not bear its burden of showing genericness of the "FIM" term. While the first excerpt spells out "Functional Independence Measure," it also indicates source from the Uniform Data System, which is "a division of UB Foundation Activities that offers tools to the medical rehabilitation field." (Dann dep. at 8:29-9:1). UDS was created in 1985 to handle "FIM" operations and licensing. (Granger dep. 151:3-15). The second excerpt compares the "FIM" to another, similar test. The third excerpt simply describes the test, and the fourth excerpt again acknowledges UDS as the source of the "FIM." The fifth excerpt indicates "FIM" as a proprietary system that requires certification; the sixth refers to a rehabilitation tool that seeks to surpass the success of the "FIM"; and the seventh acknowledges Dr. Granger, Executive Director of UDS, as the creator of the "FIM." These excerpts go against AMRPA's position, by pointing to an understanding among the relevant public that "FIM" does *not* refer to generic "printed publications in the field of rehabilitation, namely

printed coding forms, guides, measurement instruments, and reports" as identified in UBFA's Application No. 75497362.

To further counter the notion that "FIM" refers to a genus in and of itself, UBFA submitted ample evidence of other rehabilitation assessment tools that either mimic the FIM, complement it, or simply provide some other type of rehabilitation assessment. See UBFA's brief and testimony citations, pp. 29-30, which point to 18 different rehabilitation assessment tools, some of which are used as proprietary marks. UBFA's evidence is supported by AMRPA's employee and witness, Carolyn Zollar. (Zollar dep. at 77:1-12 "There are various instruments that measure different parts of functional independence and ability, yes.").

UBFA has further shown by probative evidence that health care professionals in the field of rehabilitation recognize it as the source of the "FIM." See UBFA's Exhibits #12-16. There is substantial evidence in the record of potential subscribers requesting permission from UBFA's UDS division to use the "FIM" instrument and mark. *Id.* To the extent a "FIM" user or media outlet may occasionally fail to acknowledge "FIM" as a proprietary mark, UBFA polices and corrects such misuse. *Id.* To that effect, the record shows numerous letters from UBFA notifying institutions and media outlets when the "FIM" mark has been misattributed. *Id.*

Moreover, UBFA has produced evidence of its use of "FIM" as a mark in printed publications. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999) (applicant capitalized its proposed mark and placed it in quotations, indicating belief that the term is used as mark and not in generic sense). Indeed, UBFA has used the term "FIM" with a "TM" to indicate its trademark rights on the FIM instrument forms, the form required by Medicare, and licensed from UDS by thousands of facilities, for at least the past 10 years. See UBFA's Exhibits 12-16.

Accordingly, AMRPA has not met its burden of establishing generic use by the relevant public of "FIM". Instead, as shown in the record, the relevant public perceives that there are other rehabilitation codes available to them, and they refer to the FIM as a particular option that emanates from a particular source, the UDS division of UBFA.

2. *Alleged generic use of "THE FIM SYSTEM" by the relevant public.*

The mark at issue in the cancellation proceeding, "THE FIM SYSTEM," is a phrase. The test for evaluating the genericness of a phrase is, as with a one-word mark, set forth in *H. Marvin Ginn, supra*, 228 USPQ at 530. However, the Federal Circuit has dictated that in evaluating a phrase under the two-pronged test of *H. Marvin Ginn*, we must determine whether there is sufficient evidence of

genericness of "the meaning of the disputed phrase as a whole." See *In re American Fertility Soc.*, *supra*, 51 USPQ2d at 1837.

As in *American Fertility*, the party with the burden of proof in proving genericness (here AMRPA) has failed to meet that burden. AMRPA has not provided evidence of the sort that might show "THE FIM SYSTEM" to be generic in the eyes of the relevant public, such as by use in dictionaries, newspapers, magazines, trade journals, and other publications. *In re Northland Aluminum Prods., Inc.*, 227 USPQ at 963. AMRPA did not even allege in its brief that it had proven "THE FIM SYSTEM" mark to be generic, and indeed it did not.

Merely Descriptive

AMRPA has alleged in its pleadings and its brief that "FIM" and "THE FIM SYSTEM" are merely descriptive marks. UBFA does not dispute that allegation. Rather, both are on file with Section 2(f) claims of acquired distinctiveness. 15 U.S.C. §1052(f). Accordingly, that both marks are "merely descriptive" is an established fact in these proceedings. See *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (when a mark is registered under the provisions of Section 2(f), "the statute accepts a lack of inherent distinctiveness as an established fact"); *Omnicom Inc. v. Open Systems Inc.*, 19 USPQ2d 1876, 1878 (TTAB 1989) (registrant's claim of

secondary meaning pursuant to Section 2(f) is evidence that the mark in question is not inherently distinctive).

Acquired Distinctiveness

Unlike with the genericness determination, the burden is on the 2(f) applicant/registrant to show that its marks have acquired sufficient distinctiveness to overcome their status as "merely descriptive." *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, *supra*, 6 USPQ2d at 1007.³ The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Id.*; *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983). It is sufficient that the relevant public associate the marks with a single, albeit anonymous, source. *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

The more descriptive the marks, the greater the burden will be on the applicant/respondent to prove its distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki*

³ The Federal Circuit in *Yamaha* explained that an opposer must merely establish a *prima facie* case for the burden to shift to applicant. We find here that AMRPA has done so, and that the burden has shifted to UBFA to prove acquired distinctiveness by a preponderance of the evidence.

Co. Ltd., *supra*, 6 USPQ2d at 1008. In *Yamaha*, the Federal Circuit Court of Appeals affirmed the Board's ruling that with a product design configuration, there was a greater burden on the applicant to show acquired distinctiveness. Nevertheless, the Board found, and the Federal Circuit affirmed, that even with that greater burden, eight years of substantially exclusive and continuous use plus substantial sales and promotion by the defendant, along with an identification of source on the products yielded a sufficient showing.

Here, the marks, while "merely descriptive," are not so "highly descriptive" of the identified goods and services as to require an undue amount of evidence to show acquired distinctiveness. *Id.* UBFA has produced probative evidence showing significant revenue generated by the "FIM" and "THE FIM SYSTEM" marks over the past 12 years, longer than that considered to be sufficient for the "greater" burden in *Yamaha*. In particular, UBFA licenses its "FIM" and "THE FIM SYSTEM" marks along with other proprietary software and information to a large number of subscribers for substantial revenue. (Hagerty dep. at 120:5-6.). In 1994, UBFA had 622 subscribers to the "FIM," generating \$1,533,767 in sales revenue (*Id.*, and Exhibit 6). By 2006, that number had hugely increased to 1,130 subscribers, generating \$6,334,837 in sales revenue. *Id.* About 76% of the relevant market of inpatient rehabilitation facilities subscribe to UBFA's

Opposition No. 91158512
(Consolidating Cancellation No. 92043381)

products and services encompassing the "FIM" and "THE FIM SYSTEM" marks. (Dann dep. at 12:4-9).

To the extent a "FIM" user or media outlet may occasionally fail to acknowledge "FIM" as a proprietary mark, UBFA polices and corrects such misuse. See UBFA's Exhibits 12-16. To that effect, the record shows numerous letters from UBFA notifying institutions and media outlets when the "FIM" mark has been misattributed. *Id.* Accordingly, on this record, we find that UBFA has met its burden of proving acquired distinctiveness of both the "FIM" and "THE FIM SYSTEM" marks.

Conclusion

AMRPA's opposition to the registration of "FIM" is dismissed and its petition to cancel "THE FIM SYSTEM" is denied.

DECISION: The opposition is dismissed and the petition to cancel is denied.