

Response to Office Action

Serial No. 88/024,794 — Mark: **CARE TRANSITIONS**

The Trademark Office has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that Applicant's mark, CARE TRANSITIONS, is merely descriptive of the recited services, which include healthcare services, hospice services, palliative care services and the provision of healthcare information. Applicant traverses this refusal and contends that its mark, as a whole, is not merely descriptive of the services recited in the application. Consequently, Applicant maintains that the refusal under Section 2(e)(1) is inappropriate.

It is well-established that a mark is considered merely descriptive only if it “immediately conveys information” about an ingredient, characteristic, function or feature of a product or service. *See, e.g., In re Time Solutions Inc.*, 33 U.S.P.Q.2d 1156, 1157 (T.T.A.B. 1994); *see also In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694, 1696 n.4 (T.T.A.B. 2002) (noting that it is “well settled” that a mark is considered to be merely descriptive only “if it *immediately* describes an ingredient, quality, characteristic or feature thereof or if it *directly* conveys information regarding the nature, function, purpose or use of the goods or services” (emphasis added)). Moreover, it is not sufficient that the mark convey any indefinite scrap of information about the services, it must provide the consumer with an unambiguous idea as to the nature of those services. *See Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55, 60 (2d Cir. 1961) (“Unless a word gives some reasonably accurate — some tolerably distinct knowledge — as to [the services], it is not descriptive within the meaning of trademark terminology.”). If information about the services given by the term used as a mark is indirect or vague — requiring imagination, thought or perception to reach a conclusion about the nature of those services —

then the term is being used in a suggestive, not descriptive, manner. *Stix Products, Inc. v. United States Merchants & Mfns., Inc.*, 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968).

As the cases and commentary make clear, a key component of the “merely descriptive” test is not whether the mark can, in some manner, arguably be considered descriptive, but rather whether the function, characteristic or use of the mark in relation to Applicant’s services is *immediately* and *directly* conveyed. The Board, by using such terms as “immediately” and “directly,” has imposed a high threshold for categorizing a term as merely descriptive — a threshold that Applicant’s mark does not cross.

The fact that Applicant’s mark is not properly characterized as merely descriptive stems in part from the vague and imprecise nature of the terms that comprise Applicant’s mark. The term TRANSITIONS is susceptible to various meanings within the context of healthcare and end-of-life services (such as are often involved with hospice and palliative care services).

In re Hutchinson Technology informs us that some terms are too vague or too broadly applicable to be considered merely descriptive. *See* 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988). In that case, the Court of Appeals for the Federal Circuit found that the word TECHNOLOGY could not be considered merely descriptive, explaining

“technology” is a very broad term which includes many categories of goods. The term “technology” does not convey an immediate idea of the “ingredients, qualities or characteristics of the goods” listed in Hutchinson’s application. Therefore, the term “technology” is not “merely descriptive”

Id. at 1493. The term TRANSITIONS falls within this category of terms that are not merely descriptive. It is unclear from a simple reading of the term what type of performance is being referred to.

For the reasons set forth above, Applicant submits that its mark CARE TRANSITIONS cannot be considered to be merely descriptive of the services recited in the application. Accordingly,

Applicant respectfully requests that the refusal to register its mark on the ground that it is merely descriptive be withdrawn.

With this response, the application is in condition for publication.