

**Trademark: SPECIALTY EXPEDITE**  
**App. No. 88089450**

In response to the Office Action dated November 16, 2018, regarding the below issues:

1. Identification Amendments
2. Refusal under Section 2(e)(1) – Merely Descriptive
3. Request for Further Information

Applicant responds as follows.

**Identification Amendments**

Applicant requests that the following identification amendments be entered into the record:

Class 9: Computer software for medical clinicians and pharmacists to electronically manage and process patient health records, prescriptions, and insurance claims.

Class 35: ~~Specialized retail pharmacy services for patients with particular medical conditions;~~ Retail pharmacy services; Online retail pharmacy services; Business administration of pharmacy reimbursement programs and services; Pharmaceutical services, namely, processing online and telephone prescription orders in retail pharmacies; Pharmaceutical cost management and drug utilization review services.

Class 36: Pharmacy benefit management services; Insurance claims administration; Insurance claims processing.

Class 44: Medical services; Medical advisory services; Nursing services.

**Refusal under Section 2(e)(1) – Merely Descriptive**

The Examining Attorney refuses Applicant's mark SPECIALTY EXPEDITE because it "...merely describes features of Applicant's service." Applicant respectfully asserts that: (1) SPECIALTY EXPEDITE is a unitary mark, which is suggestive and not descriptive of Applicant's services; (2) the combination of "SPECIALTY" and "EXPEDITE" is unusual and unique to Applicant; (3) the Office has not demonstrated that "specialty expedite" is a current phrase in common use by the consuming public or by members of Applicant's industry to identify the services listed in the application; and (4) Applicant has already been allowed to register similar "SPECIALTY" formative marks on the Principal Register. For these reasons, Applicant respectfully requests that the Examining Attorney withdraw her refusal.

**Applicant's Combination of "SPECIALTY" and "EXPEDITE" Forms a Unitary Mark, Which is Suggestive of Applicant's Services**

SPECIALTY EXPEDITE is a unitary mark. It creates a distinctive commercial impression, but does not objectively describe a characteristic or feature of Applicant's services. SPECIALTY EXPEDITE combines two terms to create a single suggestive concept. The words of the SPECIALTY EXPEDITE mark were designed to be understood together as applied to Applicant's services, to create an association in the minds of consumers. The mark, when taken as a whole, implies that Applicant's services provide a more efficient and effective means to navigate the prior authorization and benefit verification process. When combined, the terms "SPECIALTY" and "EXPEDITE" create a suggestive concept that is not merely or immediately descriptive of Applicant's services.

To be "merely" descriptive, the term must be "only" descriptive, i.e., the term serves no purpose other than to describe the goods or services. *In re Quick-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505 (C.C.P.A. 1980). "A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 U.S.P.Q. 1370, 1371 (Fed. Cir. 2004), quoting, *Estate of P.D. Beckworth, Inc. v. Comm'r*, 252 U.S. 538, 543 (1920). Further, for a combined

**Trademark: SPECIALTY EXPEDITE**  
**App. No. 88089450**

term to be descriptive, the mark must be considered in its entirety and not just its individual parts. See In re IP Carrier Consulting Grp., 84 U.S.P.Q.2d 1028, 1030 (T.T.A.B. 2007).

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods or services. There is a thin line of demarcation between a suggestive mark and a merely descriptive mark. See, e.g., In re Atavio, 25 U.S.P.Q. 57, 58 (T.T.A.B. 1978). Any doubt as to whether a mark is merely descriptive or suggestive is resolved, in accordance with the policy of the Trademark Trial and Appeal Board, in favor of the applicant by allowing publication of the mark for opposition. See In re Morton-Norwich Prods., Inc., 209 U.S.P.Q. 791 (T.T.A.B. 1981).

The combination, SPECIALTY EXPEDITE, creates a distinctive impression, separate and apart from each of its two components. Thus, a consumer must take a mental step or “leap” to determine that Applicant is offering a more streamlined prior authorization and benefits verification processes to allow for more efficient and effective administration of patient medication and communication. Applicant’s services allow clinicians and pharmacists to securely gather and obtain patient information through compatible electronic health record systems. As prescriptions are processed, patients can also obtain real-time prescription status updates. Applicant’s services allow for a better and more efficient patient onboarding experience and provides a better way to keep all parties informed of patient care and prescription administration.

At best, SPECIALTY EXPEDITE suggests that consumers will be provided with more efficient or specialized services, however, consumers are left to speculate whether “SPECIALTY” refers to the specific type or manner of personalized care, a particular field of medical practice, or a particular type of medication and whether “EXPEDITE” refers to Applicant’s prior authorization services, the benefits of taking certain medications, or the rendering of emergency care. Consumers are also left to speculate as to the manner that Applicant’s services are provided, whether online, in-person, or by phone and to what particular services SPECIALTY EXPEDITE refers. “SPECIALTY” could be interpreted as referring to “specialty care”, i.e., rehabilitation, specialized therapy, or personalized treatments, or a “clinical specialty” or medical field, i.e., oncology, dermatology or cardiology, or it could refer to “specialized clinicians” that only treat specific diseases or conditions. The term “EXPEDITE” suggests that an action will be “increased” or “sped up”, however, exactly what action this applies to is unclear. Applicant’s services are intended to improve the prior authorization process and the level of communication between clinicians and patients during this process – however, when a consumer encounters the mark, these features are not immediately and clearly conveyed.

In addition, the term SPECIALTY EXPEDITE could just as easily be applied to rush package delivery, a fast food restaurant, or car repair services. The terms “SPECIALTY” and “EXPEDITE” could be combined and used in connection with a variety of unrelated services in a number of unrelated industries. See In re The Realistic Co., 169 U.S.P.Q. 610, 611 (C.C.P.A. 1971) (CURV held not descriptive of permanent wave curling solutions based in part on the fact that “curve” could be used with many different products). When a customer considers SPECIALTY EXPEDITE, he or she does not immediately think of prior authorization and benefit verification services. All of the above variables require consumers to engage in a multi-stage reasoning process, which only confirms that the mark is suggestive of Applicant’s services. See In re Tennis in the Round, Inc., 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978) (finding that TENNIS IN THE ROUND for a round tennis stadium was suggestive rather than descriptive, even though its name gave some clue as to its characteristics).

**The Mark Consists of an Unusual Combination of Two Common Terms**

The unusual combination of the term “SPECIALTY” followed by the term “EXPEDITE” removes the mark from the realm of a descriptive phrase that immediately conveys a feature or characteristic that a consumer would associate with the services identified by the mark. The Board has found compound word marks to be suggestive, even where the separate components alone may describe significant features or characteristics of the applicant’s services. See in In re Intermedia Advertising Group, Serial No. 76/092,228 (TTAB March 19, 2004) (holding REWARDTV to be

**Trademark: SPECIALTY EXPEDITE**  
**App. No. 88089450**

suggestive for a trivia game that awarded prizes based on knowledge of television programs, even though the board viewed “REWARD” and “TV” to be descriptive). See also In re Clear Channel Outdoor, Serial No. 78/962,079 (TTAB Dec. 18, 2008) (holding TAXI ENTERTAINMENT NETWORK suggestive for advertisements placed on in-cab television programming because “although the record demonstrates that “TAXI” and “ENTERTAINMENT NETWORK,” as individual components of applicant’s mark, describe features or characteristics of applicant’s services, the examining attorney did not establish that consumers, upon seeing applicant’s mark TAXI ENTERTAINMENT NETWORK, would perceive it as merely describing a feature or characteristic of applicant’s advertising services”); In re Scott McKeever, Serial No. 78/919,885 (TTAB Sept. 10, 2008) (holding MY HORSE PLAYER suggestive for computer software to assist horseplayers, i.e., those who bet on horse races).

In this case, SPECIALTY EXPEDITE is a unitary mark that does not immediately convey that Applicant provides services to improve the prior authorization and benefits verification processes. SPECIALTY EXPEDITE creates a unique commercial impression beyond the sum of its parts and it is, therefore, suggestive.

**The Office has not Presented any Evidence that “Specialty Expedite” is a Descriptive Phrase Used by the Consuming Public or Used within Applicant’s Industry**

The Office has not presented any evidence that “specialty expedite” is a descriptive phrase commonly used by the consuming public or used within Applicant’s industry. Applicant is aware that non-use of a phrase does not foreclose that the mark may still be descriptive. See In re Nat’l Shooting Sports Found, Inc., 219 U.S.P.Q. 1018 (T.T.A.B. 1983). However, a mark must be deemed descriptive in its entirety, and merely showing that each part of the mark may be or has the potential to be descriptive does not meet the Office’s burden. See In re IP Carrier Consulting Grp., 84 U.S.P.Q.2d at 1030. The Office has produced definitions of “specialty” and “expedite” and third party use of each term individually. The Office has not provided supportive evidence or third party descriptive use of the unitary mark SPECIALTY EXPEDITE, as a whole. As shown above, when combined, “specialty” and “expedite” create a unique and distinctive commercial impression. In fact, the majority of the first page of internet search results or “hits” for “specialty expedite” specifically refer to Applicant or unrelated third party delivery or courier services. Applicant attaches these search results at Exhibit A. The Office has not met its burden of showing that this unitary mark is descriptive and in common use.

**Applicant has been allowed to Register other “SPECIALTY” Formative Marks on the Principal Register**

To further demonstrate the suggestive nature of Applicant’s mark, Applicant directs the Examining Attorney’s attention to Applicant’s other unitary “SPECIALTY” formative marks, which have been allowed to register on the Principal Register, such as SPECIALTY CONNECT and CVS SPECIALTY. In addition, Applicant notes that its application for SPECIALTY SELECT was allowed by the Office, but subsequently abandoned by Applicant. Applicant’s SPECIALTY EXPEDITE trademark is highly analogous to these marks, particularly SPECIALTY CONNECT and SPECIALTY SELECT, which were deemed by the Office to be suggestive. Office records detailing these registrations are attached hereto as Exhibit B. To remain consistent with the Office’s prior examination practices, Applicant’s mark for SPECIALTY EXPEDITE should also be allowed to register on the Principal Register.

**Request for Further Information**

For further information about Applicant’s services rendered in connection with the SPECIALTY EXPEDITE mark, Applicant directs the Examining Attorney to the materials attached at Exhibit C. As these materials demonstrate, while Applicant’s SPECIALTY EXPEDITE solution may fall under the umbrella of CVS Specialty, the services provided strive to reduce paperwork and wait time, increase efficiency within the prior authorization process, and improve communication between clinicians and patients by implementing more connected electronic health record systems.

**Conclusion**

**Trademark: SPECIALTY EXPEDITE**

**App. No. 88089450**

Applicant respectfully requests that the Examining Attorney reconsider and withdraw her objection and approve Applicant's mark for publication.