

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

January 17, 2020

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RE: Serial No: 88377046
Mark: PRACTICESUITE
Applicant: VINOD NAIR
Office Action Of: July 17, 2019

RESPONSE TO OFFICE ACTION

Dear Mr. Toplak:

In response to the Trademark Office Action, emailed on July 17, 2019, the Applicant respectfully responds as follows:

No Conflicting Marks

The Applicant acknowledges that the examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), TMEP §704.02.

Trademark Act Section 2(e)(1) Refusal

The examining attorney has refused registration for **PRACTICESUITE** under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209.01(b), 1209.03 et seq. claiming that the trademark is merely descriptive.

The legal standard for descriptiveness is that it must immediately call to mind a significant aspect of the Applicant's goods (in re Intelligent Instrumentation Inc., 40 U.S.P.Q.

2d 1792 (TTAB 1996). If there had been anything in them, which was “incongruous, indefinite or susceptible to multiple connotations,” or if any “imagination, cogitation, or gathering of further information” were required to perceive precisely the merely descriptive significance of the term as it relates to what the product is designed to do, then the term would not be considered descriptive. (In re Eden Foods, Inc., 24 U.S.P. 2d 1757, 1759 (TTAB 1992) (to be descriptive, a term must immediately convey characteristics of goods or services).

The trademark examiner cited a plurality of cases and combined their rulings in a fashion to support his claim that: “PRACTICESUITE” is merely descriptive.

We disagree with the examiner’s findings because, although the examiner provided definitions for both “practice” and “suite”, there are a myriad of differing definitions for each term, that when combined would create a plurality of different meanings that would lead to confusion. This ensuing confusion would speak to the fact that the terms are not merely descriptive. This, as supported, would deem “PRACTICESUITE” suspect to “incongruous, indefinite or susceptible to multiple connotations,” re Intelligent Instrumentations Inc.

The American Heritage® Dictionary of the English Language: Fourth Edition 2000 defines “Practice “as follows:

Transitive Verb: 1. To do or perform habitually or customarily; make a habit of: *practices courtesy in social situations.*

2. To do or perform (something) repeatedly in order to acquire or polish a skill: *practice a dance step.*

3. To give lessons or repeated instructions to; drill: *practiced the students in handwriting.*

4. To work at, especially as a profession: *practice law.* **5.** To carry out in action; observe: *practices a religion piously.* **6. Obsolete** To plot (something evil).

Intransitive Verb:

1. To do or perform something habitually or repeatedly.

2. To do something repeatedly in order to acquire or polish a skill.

3. To work at a profession.

4. Archaic To intrigue or plot.

Noun: 1. A habitual or customary action or way of doing something: *makes a practice of being punctual.*

2a. Repeated performance of an activity in order to learn or perfect a skill: *Practice will make you a good musician.* **b.** A session of preparation or performance undertaken to acquire or polish a skill: *goes to piano practice weekly; scheduled a soccer practice for Saturday.* **c.** *Archaic* The skill so learned or perfected. **d.** The condition of being skilled through repeated exercise: *out of practice.*

3. The act or process of doing something; performance or action: *a theory that is difficult to put into practice.*

4. Exercise of an occupation or profession: *the practice of law.*

5. The business of a professional person: *an obstetrician with her own practice.*

6. A habitual or customary action or act. Often used in the plural: *That company engages in questionable business practices. Facial tattooing is a standard practice among certain peoples.*

7. Law The methods of procedure used in a court of law.

8. Archaic a. The act of tricking or scheming, especially with malicious intent. **b.** A trick, scheme, or intrigue.

Additionally, the American Heritage® Dictionary of the English Language: Fourth Edition 2000 defines “**Suite**” as follows:

Noun: 1. A staff of attendants or followers; a retinue. **2a.** A group of related things intended to be used together; a set. **b.** (*also*) A set of matching furniture: *a dining room suite.* **3.** A series of connected rooms used as a living unit. **4. Music a.** An instrumental composition, especially of the 17th or 18th century, consisting of a succession of dances in the same or related keys. **b.** An instrumental composition consisting of a series of varying movements or pieces. **5. Computer Science a.** A group of software products packaged and sold together,

usually having a consistent look and feel, a common installation, and shared macros. **b.** A group of procedures that work cooperatively: *The TCP/IP suite of protocols includes FTP and Telnet.*

The examiner claims that the identified mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods. And that the determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract.

With these two point in mind we can disregard such definition combinations of “practice” and “suite” that in the abstract could occur, such as repeatedly playing music or a doctor’s or lawyer’s furniture. For example, or a myriad of other non-sensical combinations. But, if we combine definitions that would be related to computerized program for the aid of a practice, even a medical practice ambiguity still exists. Enough ambiguity to cause confusion and prevent immediate identification of the mark, so that the mark is not merely descriptive.

For example, “PRACTICESUITE” could be construed as a software program that makes a Doctor or other practitioner better, such as in internet training, tutoring and testing, something that our product does not do. Alternatively, it could be interpreted as an interactive Doctor’s or Lawyer’s office that would circumvent the patient’s need to see a physical practitioner, such as an online help desk. On the other hand, it could be a software program that assists Doctors in performing or running their practice.

The fact that this unique combination of two words brings up so many possibilities within the narrow construction of case law strengthens our argument that the term “PRACTICESUITE” is not merely descriptive and so should be allowed registration.

Specimen Refusal: PARTIAL REFUSAL APPLIES TO CLASS 35 ONLY

Registration is refused because the specimen does not show the applied-for mark in use in commerce in International Class 35. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). Specifically, applicant has identified in Class 35 applicant's services as "Healthcare management service organization (MSO) services, namely, providing practice organization, management and administrative support services to individual physicians or small group practices".

Applicant's specimen appears to show non-downloadable software provided by applicant for medical billing applications.

Applicant stated refusal by doing one of the following:

- (1) **Deleting the class to which the refusal pertains;**

IDENTIFICATION OF SERVICES

The examining attorney has refused registration for PRACTICESUITE under 37 C.F.R. §2.32(a)(6); TMEP §1402.01 claiming that the trademark the wording "electronic health management" is unclear as to the type of the devices.

Class 35: Remains Unchanged

Class 42: Providing on-line, non-downloadable, Internet-based software application for medical billing for physicians and health care institutions;

Providing temporary use of non-downloadable cloud-based software for connecting, operating, and managing networked in the internet of things (IoT) as *"Smart Healthcare" as the technology for creating a healthcare system, connecting available medical resources and healthcare services.(added)*

The Applicant has responded to all issues raised in the Office Action. If any further information or response is required, please contact the applicant. The applicant may be reached by telephone at (510) 284-2425.

Respectfully submitted,

Vinod Nair

Date: January 17, 2020