

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of Anthem, Inc.	
Serial No.: 88/950,108	
Filed: June 5, 2020	Examining Attorney Andrea Butler Law Office 124
Mark: ANTHEM LINK	

**RESPONSE TO NON-FINAL OFFICE ACTION**

This responds to the non-final Office Action issued on September 16, 2020 (“Office Action”), in which the Examining Attorney (i) refused registration under Trademark Act Section 2(d) based on a likelihood of confusion with U.S. Registration Nos. 2751535, 2782982, 2930448, 2991078, 3611361, 3812659, 2893281, 3251801, 4719586, 4722826, 5175095, and 5713955, owned in the name of Anthem Insurance Companies; (ii) required that Applicant submit a disclaimer of the wording LINK apart from the mark as shown because it is merely descriptive of the identified services; and (iii) required that Applicant amend the identification of services.

**Section 2(d) – Likelihood of Confusion Refusal**

In response to the refusal under Trademark Act Section 2(d), Applicant notes that Applicant and Registrant Anthem Insurance Companies, Inc. are related companies and that Applicant and Registrant would be seen by consumers as a single source. As such, use of Applicant’s Mark is not likely to confuse the public with respect to the source of Applicant’s services.

In *In re Wella A.G.*, 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986), The Court stated that:

The question is whether, despite the similarity of the marks and the goods on which they are used, the public is likely to be confused about the source of the hair straightening products carrying the trademark "WELLASTRATE." In other words, is the public likely to believe that the source of the product is Wella U.S. rather than the German company or the Wella organization.

*In re Wella A.G.*, 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986); *cf. In re Wacker Neuson SE*, 97 USPQ2d 1408 (TTAB 2010) (finding that the record made clear that the parties were related and that the goods and services were provided by the applicant). The *Wella* Court remanded the case to the Board for consideration of the likelihood of confusion issue. In ruling on that issue, the Board concluded that there was no likelihood of confusion, stating as follows:

[A] determination must be made as to whether there exists a likelihood of confusion as to *source*, that is, whether purchasers would believe that particular goods or services emanate from a single source, when in fact those goods or services emanate from more than a single source. Clearly, the Court views the concept of "source" as encompassing more than "legal entity." Thus, in this case, we are required to determine whether Wella A.G. and Wella U.S. are the same source or different sources . . . .

The existence of a related company relationship between Wella U.S. and Wella A.G. is not, in itself, a basis for finding that any "WELLA" product emanating from either of the two companies emanates from the same source. Besides the existence of a legal relationship, there must also be a unity of control over the use of the trademarks. "Control" and "source" are inextricably linked. If, notwithstanding the legal relationship between entities, each entity exclusively controls the nature and quality of the goods to which it applies one or more of the various "WELLA" trademarks, the two entities are in fact separate sources. Wella A.G. has made of record a declaration of the executive vice president of Wella U.S., which declaration states that Wella A.G. owns substantially all the outstanding stock of Wella U.S. and "thus controls the activities and operations of Wella U.S., including the selection, adoption and use of the trademarks." While the declaration contains no details of how this control is exercised, the declaration is sufficient, absent contradictory evidence in the record, to establish that control over the use of all the "WELLA" trademarks in the United States resides in a single source.

*In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987) (emphasis in original), *rev'd on other grounds*, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988).

Therefore, as in *Wella*, the close relationship between Applicant and Registrant, which are related companies that both use the ANTHEM trademark, obviates any likelihood of confusion in the minds of consumers because the related companies constitute a single source.

Further, Registrant is a wholly owned subsidiary of Applicant. Thus, per TMEP § 1201.07(b)(i), if Applicant represents that either Applicant or Registrant owns all of the other entity, and there is no contradictory evidence in the record, the examining attorney should conclude that there is unity of control, a single source, and no likelihood of confusion.

Given the above, Applicant respectfully requests that the Examining Attorney withdraw the refusal under Trademark Act Section 2(d).

#### **Identification of Services**

Applicant hereby amends the identification of services to the following:

**Class 35:** Cost management for health care benefit plans of others; health care cost containment; health care cost review; health care utilization review services; business services, namely, the collection, reporting, and analysis of health care information and health care cost and quality data for business purposes; medical discount program, namely, administration of a program enabling participants to obtain discounts on products and services in the fields of health, vision, dental, behavioral health, and prescription drugs.

**Class 36:** Health insurance administration; health and medical insurance underwriting, consulting, and claims administration services; underwriting, issuance and administration of health insurance plans; providing online information in the field of health insurance plan benefits

**Class 44:** Providing information on health and health care via the Internet; providing personal health information via the Internet; providing health care information via telephone; medical counseling; personal medical history management services, namely, maintaining computerized medical data, claim data and databases containing the medical condition of individuals for medical management purposes; providing an online medical health records database; wellness and health-related consulting services; consulting services in the fields of medical care; providing an interactive website featuring information and links to the websites of others relating to health, wellness, nutrition, weight loss, stress management and stress reduction; health care services; preventative health care services; health care services, namely, providing medical wellness information and wellness programs; health care in the nature of health maintenance organizations; managed health care services; telemedicine services; medical services, namely, medical consultations by physicians provided via phone, online chat or videoconferencing.

### **Disclaimer**

As noted above, the Examining Attorney has required that the wording LINK be disclaimed apart from the mark as shown because it is merely descriptive of a feature of Applicant's services. As evidence for why such a disclaimer should be required, Applicant cites evidence from the American Heritage Dictionary, which shows that the term LINK can be defined as "[a] graphical item or segment of text in a webpage or other electronic document that, when clicked, causes another webpage or section of the same webpage to be displayed" and is "[a]lso called hotlink, hyperlink." The Examining Attorney argues that since Applicant provides its services electronically, the consumer or user will link to Applicant's website or database to access the medical information and databases provided by Applicant. As such, the Examining Attorney believes the wording LINK is descriptive of the services and must be disclaimed apart from the mark as shown.

Under TMEP §1213.03(a), "[t]ypically, an unregistrable component of a registrable mark is the name of the goods or services, other matter that does not indicate source, matter that is merely descriptive or deceptively misdescriptive of the goods or services, or matter that is primarily geographically descriptive of the goods or services." Further, under TMEP §1209.01(b), a term is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. Suggestive terms, on the other hand, are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a

desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread).

In the case at hand, the term LINK requires thought and perception to reach a conclusion as to the nature of Applicant's services. The attached evidence from Merriam-Webster Dictionary shows that the definition of LINK is "a connecting element or factor." Here, Applicant is using the wording LINK to suggest that Applicant connects its users with health care services and health care information. As such, the wording LINK in the applied-for mark is not merely descriptive but rather suggestive of the services identified in the application. While Applicant will be providing information via the Internet and such information could potentially contain links to other webpages or databases as is common on the Internet generally, the term LINK in the mark is not being used to describe that or any other specific characteristic or feature of Applicant's services. In any event, the fact that Applicant's website may contain some links to other webpages or databases would be ancillary to the overall services provided by Applicant to consumers under the applied-for mark.

Moreover, the Examining Attorney has not provided any evidence in support of the allegation that the term LINK is descriptive for all of the services in the application. The Examining Attorney has not provided evidence to support that the term LINK is descriptive for many of the services identified in the application, such as cost management for health benefit plans, health care cost containment, and health insurance administration. Many of the services identified in the identification are not provided via the internet and do not or cannot involve the provision of internet hyperlinks or hotlinks. Thus, given that the Examining Attorney has not limited the disclaimer requirement to specific classes or services and has required that the wording LINK be disclaimed apart from the mark as shown for all of the services identified in

the application, the Examining Attorney has failed to establish that the wording LINK is merely descriptive for all of the identified services and has failed to provide evidence to support the requirement that the term LINK be disclaimed apart from the mark for all of the services in the application.

Applicant also notes that numerous marks have been registered by the Office that contain the wording LINK but do not contain a disclaimer of the term LINK or are registered on the Principal Register with the term LINK combined with descriptive wording. These marks are all registered for use in connection with health care services and other services related to health care and medical services and to some extent are offered online. These registrations show that the Office has not treated LINK as descriptive in connection with the types of services identified in the application. Applicant requests that the Examining Attorney act consistently with prior treatment of the term LINK as suggestive by the Office in connection with health care and health care related services. Examples of these registered marks are noted below and the registration certificates are attached:

- Registration for MEDICARE LINK (Reg. No. 3729597), owned by Resource Link of Michigan, Inc., for “Consulting services, namely, to employers, community organizations, brokers and beneficiaries, related to consumer information regarding health care plan options, products and programs in the field of managed care and state and federal medical care programs.”
- Registration for HEALTHLINK (Reg. No. 5964829), owned by Healthlink Systems, Inc., for “Managed care services, namely, electronic processing of health care information” and “Internet-based health care information services; Medical information; Providing information in the field of diabetes; Providing information in the field of nursing; Providing health care information by telephone and the internet; Providing healthcare information; Providing medical information.”
- Registration for PROVIDERLINK (Reg. No. 4197159), owned by Covisint Corporation, for “providing secure electronic transmission of data and documents to allow hospitals, doctors and other health care professionals to access and transmit medical information and patient records.”

- Registration for MEDI LINK HEALTH SERVICES, LLC and Design (Reg. No. 4545944), owned by Medi Link Health Services, LLC, for “Home health care services, namely, geriatric health care which includes speech therapy, home health aid, physical therapy, nutritional consultations, occupational therapists, and nursing services.”
- Registration for REHABLINK (Reg. No. 3626518), owned by Marianjoy, Inc., for “physical rehabilitation and health care services.”
- Registration for NURSE LINK (Reg. No. 1942717), owned by North Mississippi Health Services, Inc., for “telephone information services featuring health care information provided by nurses.”
- Registration for DOCLINK (Reg. No. 4931656), owned by AOK Mobile Ltd, for “Computer application software for mobile phones, namely, software for connecting health care professionals in the field of healthcare communications.”
- Registration for LINK MY HOSPITAL (Reg. No. 5991632), owned by Link My Doctor, Inc., for “Health care services offered through a network of health care providers on a contract basis.”
- Registration for LINK PROGRAM (Reg. No. 4055291), owned by Sharsheret, Inc., for “Providing information concerning the causes, detection, diagnosis, and treatment of breast cancer and related medical and psychological issues to breast cancer patients and their families, to the public, and to health-care professionals; providing information in the field of breast cancer and related medical and psychological issues via the internet; Telephone hot line services to provide medical information in the field of breast cancer including related psychological issues to breast cancer patients” and “Telephone hot line services to provide supportive emotional counseling to breast cancer patients; Providing personal and emotional support to breast cancer patients through a network of breast cancer survivors and other volunteers.”
- Registration for THE INTERNET LINK TO HEALTH (Reg. No. 2678544), owned by HealthWebAmerica.com, Inc., for “providing information in the field of health education and delivery of health care via a global computerized network to the general public.”
- Registration for VETERANSLINK (Reg. No. 5187031), owned by Cardinal Innovations Healthcare Solutions, for “Charitable services, namely, to provide health care services to enhance the connectedness, well-being and health of service members, veterans and their families.”

It has long been acknowledged that there is a very thin line of demarcation between terms that are merely descriptive and those that are suggestive. *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004); *Anheuser-Busch,*

*Inc. v. Holt*, 92 USPQ2d 1101, 1105 (TTAB 2009). “The categories are in actuality ‘central tones in a spectrum ... and are frequently difficult to apply.’” *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) (quoting *Soweco, Inc. v. Shell Oil, Co.*, 617 F.2d 1178, 207 USPQ 278, 282 (5th Cir.1980), cert. denied, 450 U.S. 981 (1981)).

Here, the wording LINK does not immediately describe any specific characteristic or feature of Applicant’s services. Consumers will need to make a mental step to determine how the term LINK relates to the identified goods. This is the essence of suggestiveness, requiring imagination, thought, and perception to arrive at the qualities or characteristics of the services. Further, the Examining Attorney has failed to provide sufficient evidence to show that LINK is descriptive of all of the services identified in the application. Moreover, Applicant has shown that the wording LINK is not has not been treated as descriptive in the past by the Office in connection with health care related services and that Applicant’s mark is unitary in nature due to the message being conveyed to consumers by the mark as a whole, which renders the disclaimer requirement inappropriate. Finally, any doubts with respect to descriptiveness of a term must be resolved in favor of Applicant. *See In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972). Therefore, a term does not have to be devoid of all meaning in relation to the goods or services to be registrable. Therefore, Applicant respectfully requests that the disclaimer requirement with respect to the wording LINK be withdrawn.

### **Conclusion**

Applicant has fully addressed all of the issues raised by the Examining Attorney in the Office Action. Applicant has shown that Applicant is a wholly owned subsidiary of Registrant and, as such, Applicant and Registrant will be seen by consumers as a single source. Thus, there is no likelihood of confusion amongst consumers as to the source of the services. Applicant has



also amended the identification of services and provided arguments and evidence to support the withdrawal of the inappropriate disclaimer requirement with respect to the wording LINK for all of the services identified in the application. As such, based on the above response, Applicant respectfully requests that the Examining Attorney withdraw the refusal under Trademark Section 2(d) and the disclaimer requirement and approve the applied-for mark for publication with the amended identification of services provided herein.

Respectfully submitted,

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