

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/663345

MARK: THE PREVENTIVE PLAN

77663345

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: U.S. Preventive Medicine, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

044103.0043

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

Applicant is requesting reconsideration of a final refusal mailed October 18, 2009.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Applicant again based its argument that the term "PREVENTIVE PLAN" is not descriptive on the fact that the Office has, in the past, registered the term "PLAN" on the Principal Register without a disclaimer. However, the case law is clear that third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. An applied-for mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

On the other hand, the Office has also issued numerous third party registrations for similar services in which the term "plan" was disclaimed. *See attached third party registrations.* In this regard, third-party registrations, where the relevant word or term has been disclaimed for similar or related services, are probative evidence on the issue of descriptiveness. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

As was pointed out in earlier Office actions, applicant provides “plans” that incorporate both personal coaching services and generalized medical services that address lifestyle behavior modifications, medication therapy and consumer specific objectives in order to create a “preventive plan” that is shared by both the patient and primary care provider. *See dictionary definitions.* Since the term is used by others in the healthcare industry it should remain in the public domain for others to use when describing like services based on a similar concept. *See Internet evidence previously made of record showing generic/descriptive use of the term by others.*

Accordingly, applicant’s request for reconsideration is *denied*. The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/Russ Herman/
Attorney
Law Office 101
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STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: May 14, 2010

76027705

DESIGN MARK

Serial Number

76027705

Status

SECTION 8-ACCEPTED

Word Mark

PROMEDICAL PLAN, INC.

Standard Character Mark

No

Registration Number

2727569

Date Registered

2003/06/17

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

PROMEDICAL PLAN PHC, INC CORPORATION 2300 N. COMMERCE PKWY, #302
WESTON FLORIDA 33326

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Healthcare.
First Use: 2000/08/01. First Use In Commerce: 2000/08/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PLAN, INC." APART FROM
THE MARK AS SHOWN.

Name/Portrait Statement

Applicant disclaims any right to use the cross design portion of its
mark in whole or in part in shades of red or orange, or in whole or in
part in white on a background solely of shades of red or orange, or in
any combination thereof.

Filing Date

2000/04/17

Examining Attorney

Print: May 14, 2010

76027705

CAPSHAW, DANIEL

ProMedical⁺ Plan, Inc.

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