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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76716800
LAW OFFICE ASSIGNED	LAW OFFICE 109
<b>MARK SECTION</b>	
MARK	<a href="http://tmng-al.uspto.gov/resting2/api/img/76716800/large">http://tmng-al.uspto.gov/resting2/api/img/76716800/large</a>
LITERAL ELEMENT	NORTH TEXAS COMMUNITY HEALTHCARE COALITION
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<b><u>RESPONSE TO FINAL OFFICE ACTION</u></b>	
<p>Applicant has carefully reviewed the issue raised by the Examiner in the Final Office Action issued on June 25, 2015 and believes the objection by the Examiner is resolved by the arguments and analysis set forth below, making the application in condition for acceptance. Below are Applicant's arguments in response to the Geographically Descriptive refusal asserted by the Examiner.</p> <p><u>Geographically Descriptive Refusal</u></p> <p>The Examining attorney has refused registration of Applicant's mark NORTH TEXAS COMMUNITY HEALTHCARE COALITION under § 2(e)(2) of the Lanham Act, on the ground that "the mark is primarily geographically descriptive of the applicant's services." Reconsideration of this refusal is earnestly requested.</p> <p>The Lanham Act provides in relevant part that no trademark shall be refused</p>	

registration on the Principal Register on the account of its nature *unless* it is *primarily* geographically descriptive. 15 U.S.C. § 1052(e)(2). Pursuant to the plain language of the statute, the burden is on the Patent and Trademark Office to prove that the mark is primarily geographically descriptive.

### The Standard Test

The three-prong test used by the TTAB to determine whether a mark is geographically descriptive, may be summarized as:

1. the primary significance of the mark is that of the name of a place generally known to the public;
2. that the public would make a goods/place or services/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place;
3. the goods or services come from the place named by or in the mark.

*See In re JT Tobacconists* 59 USPQ2d 1080 (2001). However, the Examiner has failed to demonstrate how Applicant's mark and the services with which it is associated, meet this test. Below is a discussion of how this mark fails the test.

According to the first prong of the test, the mark must contain the name of a place and this place is known generally to the public. The Examiner has submitted evidence of news reports referring to North Texas. One can make an assumption about where the geographical location of "NORTH TEXAS" is, but the fact is that most people describe much of the northern portion of the state of Texas as "North Texas". However, residents of Dallas and Fort Worth generally refer to "North Texas" as the area east of Abilene, south of Oklahoma and north of Waco. Therefore, the general public may have a general idea of where "North Texas" is, but the definition varies based on who is making the reference. Accordingly, the general public, expanding to everyone who may encounter the mark, will not have knowledge of exactly what is meant by "North Texas." This means that the first prong of the test fails, as North Texas may be considered a geographical location, but the exact area referred to by a consumer, will vary. Secondly, the Examiner has failed to show that North Texas is well known for healthcare services. This is where that mark fails to meet the second prong of the test.

According to the second prong of the test, in order for a mark to be considered geographically descriptive, the public would have to make a goods/place association. In other words, the consumer would have to believe that Applicant's services relating to a coalition of health services providers, or advocacy services to promote healthcare awareness, or healthcare services originates in North Texas and that consumers associate Texas with healthcare services. Here, the Examiner has defined the terms HEALTHCARE, COALITION, and COMMUNITY, but there is no evidence that consumers would believe that Texas is generally known for a coalition of health services providers, or advocacy services to promote healthcare awareness, or providing healthcare services. Texas is certainly known for its Dallas Cowboys professional football team and the Dallas Mavericks professional basketball team, but it is not widely known for a coalition of health services providers, or advocacy services to promote healthcare awareness, or providing healthcare, especially healthcare originating from North Texas. Clearly, there is no goods/place association. Hence, the mark fails to meet the second portion of the test.

The third prong of the test is that the services are actually provided in the place named in the mark. This prong of the test is met.

In order for Applicant's mark to be found to be geographically descriptive, it is not sufficient for the Examiner to establish simply that the mark is the name of a place generally known by the public.... the Examiner must also establish that the public associates the goods or services with the place which the mark names. See *In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725, 1726 (Fed. Cir. 1990). Accordingly, simply satisfying the third prong of the test does not make a mark primarily geographically descriptive.

Based on the foregoing and the fact that the first and second prongs of the test are not met, Applicant asserts that the mark is not primarily geographically descriptive and requests that this ground for refusal be withdrawn.

Further support can be found in *In re Trans Continental Records, Inc.*, 62 USPQ 2d 1541, (TTAB 2002) ("O-TOWN" is not geographically descriptive of entertainment services originating in Orlando, Florida: it is a "relatively obscure geographic reference

to Orlando.” These cases are analogous to the instant case in that North Texas is not geographically descriptive of “healthcare services” because it is not associated with “healthcare services.” If buyers don’t really care whether the goods come from the place named then this is evidence that the mark is being used in an arbitrary sense. McCarthy on trademarks and unfair competition, © 2004 West, A Thomson Company, § 14:7. Here, an ill person would not care whether the treatment he is receiving comes from North Texas. Therefore, the mark is being used in an arbitrary sense.

The Restatement (Third) of Unfair Competition §14, comment d (1995) states that the issue in determining whether a particular designation is likely to be perceived by consumers as geographically descriptive, is whether a significant number of prospective purchasers are likely to understand the term as descriptive of geographic origin or location. In response to this question with regard to the present case, one would answer no because North Texas is not known for healthcare services. Thus, the designation NORTH TEXAS COMMUNITY HEALTHCARE COALITION cannot be deemed primarily geographically descriptive.

Conclusion

Applicant contends that its mark is not primarily geographically descriptive and respectfully submits that the Application is in condition for allowance and publication for registration on the Principal Register. It is believed that all issues outlined by the Examiner regarding registrability have been addressed.

<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Lisa R. Hemphill/
<b>SIGNATORY'S NAME</b>	Lisa R. Hemphill
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Texas Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	214.999.4682
<b>DATE SIGNED</b>	12/28/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	

<b>SUBMIT DATE</b>	Mon Dec 28 17:09:40 EST 2015
<b>TEAS STAMP</b>	USPTO/RFR-XX.XX.XX.XX-201 51228170940978525-7671680 0-550e1be785c8b966b5dbe10 6c8f3935adc1951695c556163 58a9419f5b3e158bcca-N/A-N /A-20151228165138235332

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OMB No. 0651-0050 (Exp 07/31/2017)

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **76716800** NORTH TEXAS COMMUNITY HEALTHCARE COALITION(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/76716800/large>) has been amended as follows:

### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

### **RESPONSE TO FINAL OFFICE ACTION**

Applicant has carefully reviewed the issue raised by the Examiner in the Final Office Action issued on June 25, 2015 and believes the objection by the Examiner is resolved by the arguments and analysis set forth below, making the application in condition for acceptance. Below are Applicant's arguments in response to the Geographically Descriptive refusal asserted by the Examiner.

#### **Geographically Descriptive Refusal**

The Examining attorney has refused registration of Applicant's mark NORTH TEXAS COMMUNITY HEALTHCARE COALITION under § 2(e)(2) of the Lanham Act, on the ground that "the mark is primarily geographically descriptive of the applicant's services." Reconsideration of this refusal is earnestly requested.

The Lanham Act provides in relevant part that no trademark shall be refused registration on the Principal Register on the account of its nature *unless* it is *primarily*

geographically descriptive. 15 U.S.C. § 1052(e)(2). Pursuant to the plain language of the statute, the burden is on the Patent and Trademark Office to prove that the mark is primarily geographically descriptive.

### The Standard Test

The three-prong test used by the TTAB to determine whether a mark is geographically descriptive, may be summarized as:

1. the primary significance of the mark is that of the name of a place generally known to the public;
2. that the public would make a goods/place or services/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place;
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See *In re JT Tobacconists* 59 USPQ2d 1080 (2001). However, the Examiner has failed to demonstrate how Applicant's mark and the services with which it is associated, meet this test. Below is a discussion of how this mark fails the test.

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According to the second prong of the test, in order for a mark to be considered

geographically descriptive, the public would have to make a goods/place association. In other words, the consumer would have to believe that Applicant's services relating to a coalition of health services providers, or advocacy services to promote healthcare awareness, or healthcare services originates in North Texas and that consumers associate Texas with healthcare services. Here, the Examiner has defined the terms HEALTHCARE, COALITION, and COMMUNITY, but there is no evidence that consumers would believe that Texas is generally known for a coalition of health services providers, or advocacy services to promote healthcare awareness, or providing healthcare services. Texas is certainly known for its Dallas Cowboys professional football team and the Dallas Mavericks professional basketball team, but it is not widely known for a coalition of health services providers, or advocacy services to promote healthcare awareness, or providing healthcare, especially healthcare originating from North Texas. Clearly, there is no goods/place association. Hence, the mark fails to meet the second portion of the test.

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In order for Applicant's mark to be found to be geographically descriptive, it is not sufficient for the Examiner to establish simply that the mark is the name of a place generally known by the public.... the Examiner must also establish that the public associates the goods or services with the place which the mark names. See *In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725, 1726 (Fed. Cir. 1990). Accordingly, simply satisfying the third prong of the test does not make a mark primarily geographically descriptive.

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Further support can be found in *In re Trans Continental Records, Inc.*, 62 USPQ 2d 1541, (TTAB 2002) ("O-TOWN' is not geographically descriptive of entertainment services originating in Orlando, Florida: it is a "relatively obscure geographic reference to Orlando." These cases are analogous to the instant case in that North Texas is not

geographically descriptive of “healthcare services” because it is not associated with “healthcare services.” If buyers don’t really care whether the goods come from the place named then this is evidence that the mark is being used in an arbitrary sense. McCarthy on trademarks and unfair competition, © 2004 West, A Thomson Company, § 14:7. Here, an ill person would not care whether the treatment he is receiving comes from North Texas. Therefore, the mark is being used in an arbitrary sense.

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#### Conclusion

Applicant contends that its mark is not primarily geographically descriptive and respectfully submits that the Application is in condition for allowance and publication for registration on the Principal Register. It is believed that all issues outlined by the Examiner regarding registrability have been addressed.

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Lisa R. Hemphill/ Date: 12/28/2015

Signatory's Name: Lisa R. Hemphill

Signatory's Position: Attorney of Record, Texas Bar Member

Signatory's Phone Number: 214.999.4682

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute

power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76716800

Internet Transmission Date: Mon Dec 28 17:09:40 EST 2015

TEAS Stamp: USPTO/RFR-XX.XX.XX.XX-201512281709409785

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