
To: C/HCA, Inc. (jgregory@middreut.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77419209 - FIRST ONSITE -
N/A
Sent: 3/12/2010 7:23:09 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/419209

MARK: FIRST ONSITE

77419209

CORRESPONDENT ADDRESS:

JULIE ANN GREGORY
MIDDLETON REUTLINGER
2500 BROWN WILLIAMSON TOWER
LOUISVILLE, KY 40202-3410

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: C/HCA, Inc.

CORRESPONDENT'S

REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

jgregory@middreut.com

OFFICE ACTION – FILE RETURNED TO TTAB

ISSUE/MAILING DATE: 3/12/2010

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on January 30, 2010.

PLEASE NOTE – It is noted that the applicant's notice of appeal was filed on July 9, 2009.

Accordingly, upon entry of this action, the instant application will be returned to the Trademark Trial and Appeal Board in accordance with TMBP §1204.

For the reasons set forth below, the refusal is now made FINAL under Trademark Act Section 23 because the proposed mark is generic and therefore unregistrable on the Supplemental Register. See 15 U.S.C. §1091; 37 C.F.R. §2.64(a).

Registration has been refused on the Supplemental Register because the applied-for mark is generic for applicant's goods. Trademark Act Section 23(c), 15 U.S.C. §1091(c); see *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (holding SCREENWIPE generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (holding BUNDT, a term that designates a type of cake, generic for ring cake mix); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (holding ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel, Inc.*, 16 USPQ2d 1469 (TTAB 1990) (holding ICE PAK generic for reusable ice substitute for use in food and beverage coolers); TMEP §§1209.01(c) *et seq.*

A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of services at issue?; and
- (2) Does the relevant public understand the designation primarily to refer to that class or genus of services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1209.01(c)(i).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the services. TMEP §1209.01(c); see *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the services, and cannot be registered as service marks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c).

A word or term does not need to be a noun to be generic. See *In re Reckitt & Coleman, N. Am. Inc.*, 18 USPQ2d 1389, 1390-91 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers for use on permanent press products); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (holding LITE generic for beer); TMEP §1209.01(c)(ii). In addition, a word or term that is the name of a key ingredient, characteristic or feature of the services can be generic for those services and thus, incapable of distinguishing source. A term does not need to be the name of the services to be found incapable of serving as an indicator of origin. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (holding SUDSY generic for ammonia); *In re Eddie Z's Blinds & Drapery, Inc.*, 74

USPQ2d 1037 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of candy"); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); see TMEP §§1209.01(c) *et seq.*

In the case at hand the applicant is seeking registration of FIRST ONSITE, in standard character form, for health care services and medical services. In this case, the class or genus of services at issue is medical and health care services.

"First" is defined as "occurring or acting before all others in time; earliest." *The American Heritage Dictionary of the English Language*, (4th ed. 2000). "On site" is defined as accomplished or located at the site of a particular activity or concern: *on-site medical treatment for accident victims.*" *Dictionary.com Unabridged*, (v 1.1), (emphasis in original), citing *Random House Unabridged Dictionary*, (2006). The website evidence of record demonstrates that the combined wording, "first onsite," is used to designate the first care providers at a location where individuals need medical attention. (Copies of definitions accompanied first Office action, dated June 25, 2008; website evidence accompanied Office action dated January 12, 2009).

The applicant argues that the applicant "is not simply a 'first responder unit'" instead, it offers all types of health care and medical services under the applied-for mark." However, if the applicant is providing "all types of health care and medical services" under the proposed mark, then the applicant's services would, in fact, encompass first onsite medical care services.

The applicant also maintains that the wording FIRST ONSITE is used in relation to services other than medical services and, therefore, "the relevant public does not primarily refer use of 'First Onsite' to refer to 'health care services' or 'medical services.'" However, descriptiveness is considered in relation to the relevant services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

In response to the applicant's reference to third party registrations encompassing the word ONSITE, it is noted that at least two of the referenced registrations feature disclaimers of the exclusive right to use the word ONSITE. See U.S. Reg. Nos. 3313933 and 2649449. Moreover, none of the registrations are comprised of the exact wording in the case at hand, FIRST ONSITE. Finally, 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).

Accordingly, for the foregoing reasons, the refusal to register under Section 23 of the Trademark Act is hereby made final and the instant application will be returned to the Trademark Trial and Appeal Board for further action on the *ex parte* appeal.

/Martha L. Fromm/
Martha L. Fromm
Trademark Attorney
Law Office 106
Phone: (571) 272-9320
Fax: (571) 273-9106 (formal responses)

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

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.

To: C/HCA, Inc. (jgregory@middreut.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77419209 - FIRST ONSITE - N/A
Sent: 3/12/2010 7:23:13 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION

Your trademark application (Serial No. 77419209) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on 3/12/2010 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. Read the Office letter by clicking on this [link](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77419209&doc_type=OOA&)
http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77419209&doc_type=OOA&

OR go to <http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact TDR@uspto.gov.

PLEASE NOTE: The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. Contact the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. Respond within 6 months, calculated from 3/12/2010 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) **Response to Office Action form**. If you have difficulty using TEAS, contact TEAS@uspto.gov.

ALERT:

Failure to file any required response by the applicable deadline will result in the ABANDONMENT (loss) of your application.

Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.

