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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86849500
Applicant	Nordstrom, Inc.
Applied for Mark	EMERSON ROSE
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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Nordstrom, Inc.

Applicant / Appellant,

Appeal No.: 86/849,500

APPEAL BRIEF

Application filed: December 15, 2015

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APPEAL BRIEF

I. INTRODUCTION

Applicant appeals from a refusal to register the mark EMERSON ROSE (the “Mark”) for “belts, blazers, blouses, camisoles, cardigans, coats, footwear, dresses, gloves, hosiery, jeans, jumpsuits, lingerie, mock turtlenecks, neckwear, pajamas, pants, robes, scarves, shawls, shirts, shorts, shrugs, skirts, slacks, socks, suits, sweaters, sweatshirts, tank tops, ties, topcoats jackets, turtlenecks, underwear, vests, clothing wraps” in Class 25 based on the Examining Attorney’s assertion that Applicant’s Mark is likely to cause confusion with Trademark Reg. No. 4,624,173 for EMERSON ROSE HEART FOUNDATION (the “Cited Registration”) owned by Emerson Rose Heart Foundation (the “Cited Registrant”) for “charitable fundraising services by means of organizing and conducting projects to promote awareness of congenital heart defects in children” in Class 36.

The refusal to register is in error. Given the substantial differences between Applicant’s Mark and the mark of the Cited Registration and the goods and services in question, confusion is unlikely. For these reasons, Applicant respectfully requests that the Board reverse the Examining Attorney’s findings and approve Applicant’s Mark for publication.

II. ARGUMENT

A. There Is No Likelihood of Confusion Between the Cited Registration and Applicant’s Mark

Applicant appeals the Examining Attorney’s finding that a likelihood of confusion exists between Applicant’s EMERSON ROSE mark for a list of clothing, footwear and fashion accessories (*e.g.*, belts, gloves, scarves) and Registration No. 4,624,173 for EMERSON ROSE HEART FOUNDATION for use in connection with charitable fundraising services by means of organizing and conducting projects to promote awareness of congenital heart defects in children. Applicant respectfully submits that there is no likelihood of confusion for at least the following reasons:

(1) Applicant’s Mark and the mark of the Cited Registration differ in all material aspects, namely, appearance, sound, meaning and commercial impression; and

(2) the goods and services in question are not related or marketed in such a way that they would be encountered in situations that would create the incorrect assumption that they originate from the same source.

1. Applicant’s Mark and the Mark of the Cited Registration Differ in All Material Aspects, Namely, Appearance, Sound, Meaning and Commercial Impression

Likelihood of confusion is synonymous with “probable” confusion—it is not sufficient if confusion is merely “possible.” *American Steel Foundries v. Robertson*, 269 U.S. 372, 384 (1926). In a likelihood of confusion determination, marks are compared in their entireties for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Compound marks must be analyzed in the way they are used and perceived. *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992 (finding that compound mark VARGAS GIRL, in its entirety, created a different commercial impression from VARGA alone). As marks tend to be perceived in their entireties, they should accordingly be analyzed in their entireties to determine if confusion is likely and, thus, any descriptive portion should be given appropriate consideration, particularly where the mark at issue tends to derive significant contribution therefrom. As the Federal Circuit ruled in *Hearst*, diminishing the term “girl” as descriptive was erroneous, given that the mark VARGAS GIRL derived significant contribution from the component “girl” and doing so changed the applicant’s mark (*see id.*). In this case, the differences in the marks are even more pronounced than those at issue in *Hearst*, and the mark of the Cited Registration derives significant contribution from the HEART FOUNDATION portion, a portion which changes the overall commercial impression of the mark and thus precludes the HEART FOUNDATION portion from being ignored or diminished when evaluating likelihood of confusion.

When Applicant's Mark and the mark of the Cited Registration are viewed in their entireties with proper weight given to each term as mandated by the Federal Circuit, differences in each and every material aspect, namely, appearance, sound, meaning and commercial impression, confirm that confusion is unlikely.

In the present case, the Examining Attorney assigned significant weight to the fact that Applicant's Mark and the mark of the Cited Registration begin with EMERSON ROSE and that the Cited Registrant disclaimed exclusive rights to the words HEART FOUNDATION in the Cited Registration. The Examining Attorney therefore concludes that although the marks must be compared in their entireties, the additional descriptive wording "Heart Foundation" is insufficient to create a different commercial impression between the marks. Applicant respectfully disagrees.

Applicant respectfully submits that the Examining Attorney failed to give proper weight to the differences in appearance, sound, meaning and commercial impression created by the words HEART FOUNDATION. Several circuits have recognized that even where marks share a dominant term, additional distinguishing terms, even if descriptive, can effectively negate any confusing similarity between the two. *See Freedom Sav. and Loan Ass'n v. Way*, 757 F.2d 1176 (11th Cir. 1985) (finding a lack of confusing similarity between FREEDOM REALTY and FREEDOM SAVINGS AND LOAN ASSOCIATION because of the effect of non-dominant terms in the respective marks); *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass'n*, 651 F.2d 311 (5th Cir. 1981) (holding that district court's determination of confusingly similarity between SUN FEDERAL SAVINGS AND LOAN ASSOCIATION and SUN BANKS was clearly erroneous in light of non-dominant terms and differences in design elements). This rule has clear application in the present case. While the marks at issue share a common leading portion, the differences in appearance, sound, meaning and overall commercial impression stemming from the inclusion of HEART FOUNDATION in the mark of the Cited Registration have a significant effect, sufficient to avoid a likelihood of confusion.

For instance, the descriptive nature of the words HEART FOUNDATION actually serves to distinguish the marks, as consumers, seeing the word FOUNDATION, will immediately call to mind and understand that the mark is related to a group dedicated to research and/or charitable services, and a mark containing HEART FOUNDATION creates the more specific commercial impression of research and charitable services related to heart issues. Still further, the inclusion of HEART FOUNDATION changes the overall impression of the mark as it likely causes consumers to perceive EMERSON ROSE as the name of individual that serves as the inspiration for the foundation (see “About Emerson Rose Heart Foundation” from the July 7, 2016 Office Action evidence, which discusses the founding of Emerson Rose Heart Foundation (ERHF) after the passing of the founders’ daughter, Emerson Rose, who died from complications related to a complex congenital heart defect). Consumers therefore perceive a very different commercial impression between EMERSON ROSE HEART FOUNDATION as applied to the registered services of organizing and conducting projects to promote awareness of congenital heart defects in children which were inspired by a child named Emerson Rose and Applicant’s use of EMERSON ROSE as a fanciful trademark for a line of clothing, footwear and fashion accessories (e.g., belts, gloves, scarves) unrelated to charitable fundraising altogether, let alone to projects to promote the awareness of congenital heart defects in children. In light of the significant differences in appearance, sound and meaning stemming from the inclusion of HEART FOUNDATION as referenced above, the marks, when considered in their entirety as required, create very different overall commercial impressions that preclude a finding of likely confusion. See *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (“The basic principle in determining confusion between marks is that the marks must be compared in their entirety . . . It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” (Citations omitted)). See also *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134-35 (Fed. Cir. 2015).

To emphasize, it is improper for the Examining Attorney to discount and effectively overlook the significant impact of the disclaimed wording HEART FOUNDATION in the Cited Registration. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (holding that the disclaimed elements of a mark are relevant to the assessment of similarity “because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.”); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983) (“[I]t is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion.”). As such, the disclaimed subject matter in the Cited Registration must be considered and given its proper weight when comparing the marks in their entireties.

Indeed, the differences in appearance, sound, meaning and commercial impression between the marks alone are sufficiently substantial for the Board to find that this factor is dispositive of the issue of likelihood of confusion. See *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *du Pont* factors were considered in [opposer’s] favor, as the Board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 146-61 (Fed. Cir. 1998) (“[O]ne *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”) *Keebler Co. v. Murray Bakers Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (agreeing with the Board that the “more important fact for resolving the issue of likelihood of confusion . . . is the dissimilarity in commercial impression between the marks”). In analyzing the marks at issue it is imperative to consider the mark of the Cited Registration, namely, EMERSON ROSE HEART FOUNDATION, as a whole and, in doing so, find that the differences between the mark of the Cited Registration and

Applicant's Mark are substantial, and more than sufficient to distinguish the marks and preclude confusion.

In sum, when the marks are viewed in their entireties with proper weight given to each term as mandated by the Federal Circuit, differences in all material aspects, namely, appearance, sound, meaning and commercial impression confirm that confusion is unlikely.

2. The Goods and Services in Question Are Not Related or Marketed in Such a Way That They Would Be Encountered in Situations That Would Create the Incorrect Assumption That They Originate From the Same Source

Applicant respectfully submits that its goods and the Cited Registrant's services are clearly distinguishable and unlikely to be confused by consumers in the marketplace. As noted above, Applicant's goods are various clothing items, footwear and fashion accessories (*e.g.*, belts, gloves, scarves) in Class 25 while the Cited Registration is for charitable fundraising services by means of organizing and conducting projects to promote awareness of congenital heart defects in children in Class 36.

The Examining Attorney explained in the March 28, 2016 Examiner's Amendment/Priority Action that when marks are "virtually identical" there is a lower burden necessary to show that goods and services are related, namely, that the relevant goods and/or services need not be as close to support a finding of a likelihood of confusion. Applicant submits that the subject marks are not, in fact, virtually identical. Additionally, Applicant respectfully submits that the Examining Attorney's application of the lower "need not be as close" standard is inappropriate in this case. The TMEP states that "when comparing services...with less apparently related goods such as... 'cooking classes' with 'kitchen towels,' 'something more'—beyond the fact that the goods are used in the provision of the services—must be shown to indicate that consumers would understand such services and goods to emanate from the same source." TMEP 1207.01(a)(ii). In this case, Applicant's goods and the Cited Registrant's services are even less related than the aforementioned example from the TMEP. While some charitable organizations may also provide hats and t-shirts as ancillary promotional items (along

with other oft used promotional items such as pens, flash drives, mugs, etc.), this is insufficient to support a finding that consumers are likely to believe clothing, footwear and fashion accessories (e.g., belts, gloves, scarves) and charitable services emanate from a single source. To be clear, the Cited Registration is not for clothing, but instead, is registered only for “charitable fundraising services by means of organizing and conducting projects to promote awareness of congenital heart defects in children.” Applicant submits that the higher “something more” standard should be applied because the relatedness of clothing, footwear and fashion accessories (e.g., belts, gloves, scarves) and the Cited Registrant’s charitable fundraising services is not evident, well known, or generally recognized. The Examining Attorney has not satisfied the “something more” burden necessary to demonstrate that the goods and services at issue are related.

The TMEP states that “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” TMEP 1207.01(a) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371 (Fed. Cir. 2012)). In this case, just because the Cited Registrant (and other foundations or fundraising organizations) may offer or provide t-shirts, hats or other oft used promotional merchandise bearing their foundation name to raise awareness about congenital heart defects in children or other causes, it does not mean that clothing, footwear and fashion accessories (e.g., belts, gloves, scarves) on one hand and fundraising services to promote awareness about diseases or other causes on the other hand are somehow marketed in a way that would lead consumers to believe such goods and services originate from the same source. Put another way, consumers simply do not expect fundraising organizations, such as the Cited Registrant, to sell a line of clothing, footwear and fashion accessories (e.g., belts, gloves, scarves). As such, there is no likelihood of confusion on the basis of relatedness of the goods and services.

The Examining Attorney has attempted to show the relatedness of the goods and services by identifying five, third-party registrations showing charitable services and clothing as emanating from a single source, claiming that this evidence supports the position that the charitable services provided by the Cited Registrant are related to the clothing, footwear and fashion accessories identified by Applicant. However, “courts have on numerous occasions stated the position that [listed third-party] registrations are of little probative value in determining likelihood of confusion in the absence of evidence to establish their use in the marketplace.” *In re Melville Corporation*, 18 USPQ.2d 1386 (TTAB 1991). Applicant respectfully submits that the evidence the Examining Attorney offered in connection with these registrations does not sufficiently demonstrate such evidence of use in the marketplace and, therefore, the third party registrations are of little probative value and are insufficient to satisfy the Examining Attorney’s burden.

Moreover, to the extent that the Examining Attorney’s evidence shows that certain third parties have registrations covering both types of goods does not alone establish that the goods are sufficiently related to support a finding of likely confusion. See, e.g., *In re Trend Electronics International, Inc.*, 77/003,068 (TTAB May 9, 2008) (not citable as precedent) (finding no likelihood of confusion between VISTA ACOUSTICS with “acoustics” disclaimed for “audio and video electronic equipment for homes and vehicles, namely speakers, amplifiers, receivers, and audio and video controllers and control systems” and VISTA for “computer conferencing components, namely, computer hardware and software for distributing teleconferencing signals, video cameras, video monitors, speakers, video and audio recorders, computer keyboards, power supplies and microphones” despite evidence such as third-party registrations listing the respective goods and web pages from manufacturers and retailers who offer goods such as video cameras, speakers, audio recorders and players, and video monitors as well as amplifiers, audio/video receivers and audio/video controllers). See also *In re Tera Media Corporation*, Serial No. 75/617,075 (TTAB September 16, 2004) (not citable as precedent) (finding no likelihood of confusion between TERA MEDIA CORPORATION and Design for “blank

recordable, removable optical and magnetic storage media” and TERAMEDIA for “computer hardware and software for multimedia communications and networks, namely, computers, monitors, projectors, keyboards, fingerprint scanners, cameras, microphones, switches, transmitters, servers, terminals, utility concentrators, power supplies, encoders and software therefor; and instruction manuals sold therewith” despite evidence of an online retailer selling such goods).

The evidence of record is insufficient to establish that Applicant’s goods and the Cited Registrant’s services are marketed in such a way that they would be encountered in situations that would create the incorrect assumption they originate from the same source.

For example, Attachment A contains two pages from the evidence relied upon for the Examining Attorney’s assertion that the goods and services are sufficiently related to support a finding of likely confusion. However, a careful review shows a Facebook posting notifying readers that a group called “Sole Savers Shoes” is supporting the charitable services, and for every pair of red shoes you buy from Sole Savers Shoes, a portion of the proceeds will be given to the Emerson Rose Heart Foundation. This is therefore a promotion of Sole Savers Shoes branded shoes, and it does not constitute use of “Emerson Rose Heart Foundation” as a trademark for clothing.

As noted in Attachment B, it appears that the Emerson Rose Heart Foundation also runs a charitable golf tournament, and the attendance fee covers the greens fees, a golf cart, meals and a tournament t-shirt which presumably may bear the name of the Emerson Rose Heart Foundation. Again, this would not constitute use of “Emerson Rose Heart Foundation” as a trademark on clothing, but instead, will be perceived by consumers as an ornamental, non-trademark use on t-shirts, distributed to promote the Cited Registrant’s charitable services.

The remaining evidence relied upon by the Examining Attorney to refuse registration shows similar ornamental, non-trademark use of charities’ names on t-shirts and other promotional clothing items such as sweatshirts. Such ornamental use to promote charitable services does not constitute trademark use on clothing, and is insufficient to show that consumers

expect clothing, footwear and fashion accessories (*e.g.*, belts, gloves, scarves) on one hand and charitable services on the other hand to emanate from the same source.

Simply put, a consumer who encounters the use of EMERSON ROSE on clothing, footwear and fashion accessories (*e.g.*, belts, gloves, scarves) sold through retail trade channels (*e.g.*, Applicant's Nordstrom[®] stores and online retail store) will not be confused by the concurrent use of EMERSON ROSE HEART FOUNDATION in connection with charitable services inspired by Emerson Rose Smith or the ornamental use of the "Emerson Rose Heart Foundation" name on promotional items such as t-shirts. The Cited Registrant does not manufacture or sell clothing, nor is it expected that one offering charitable services would also be in the business of marketing clothing, footwear and fashion accessories. Accordingly, the Cited Registrant's charitable services and related promotional merchandise are unlikely to be encountered under any circumstances that would lead to consumer confusion with Applicant's clothing, footwear and fashion accessories to be sold under the EMERSON ROSE brand.

III. CONCLUSION

Considering the substantial differences between Applicant's Mark and the mark of the Cited Registration in appearance, sound, meaning and commercial impression, as well as the dissimilarities between and the goods and services in question, confusion is unlikely. For these reasons, Applicant respectfully requests that the Board reverse the Examining Attorney's findings and approve Applicant's Mark for publication.

Submitted via ESTTA on June 5, 2017.

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ERHF Newsletter

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Spring 2016 Emerson Rose Heart Foundation e-Newsletter

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Together we are changing the future for those affected by CHDI Check out our late...
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Emerson Rose Heart Foundation
May 23

Below is an opportunity for the CHD community to share their experiences, give input and raise awareness about CHDs and the need for continued research and funding:
*The American Heart Association (AHA), in partnership with Patient-

APR 16 **CHD Community Connect**
Sat 10:00 AM in EDT - 1700 Wade Hampton Blvd., Greenville, SC...
14 people interested - 23 people going

Emerson Rose Heart Foundation updated their cover photo.
March 2 · 🌐

Emerson Rose Heart Foundation
March 1 · 🌐

Sole Savers Shoes is joining the fight for CHD and giving back to little hearts during the months of February and March with their red shoes! Buy a pair and a portion of the proceeds will be given to the Emerson Rose Heart Foundation. <http://www.solesavers.co/coll.../just-launched/products/tevana>



Tevana

ATTACHMENT B

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Health

Emerson Rose Heart Foundation Annual Golf Tournament Raises Funds for Families with Congenital Heart Defects



EmersonRoseHeartFoundation.org

PR-Inside.com: 2015-09-16 23:08:19

Clemson, SC -- September 16, 2015 -- The Emerson Rose Heart Foundation® (ERHF), a non-profit organization dedicated to helping babies born with congenital heart defects (CHDs), announces their fifth annual golf tournament to be held October 23rd at Smithfields Country Club in Easley, South Carolina. Presented by Bi-Lo, the golf tournament raises funds and awareness to serve families in financial need and to advance medical treatment for children with heart defects.

Registration opens at 11:00 a.m. followed by lunch and a silent auction at 12 o.m. The captain's choice golf

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Registration opens at 11:00 a.m., followed by lunch and a silent auction at 12 p.m. The captain's choice golf tournament begins at 1 p.m. with a shotgun start and concludes with a post-event dinner at 5:30 p.m. Four-person teams are being formed now at a fee of \$300 per team or individual play is available at \$75 per player. Registration includes golf cart, greens fee, tournament tee shirt, lunch and dinner.

Sponsorships for the tournament are available at various levels to include company logos on the event tee shirt and hole signs, social media recognition, website listings, promotional merchandise and more. Exclusive sponsorships are also available for longest drive, closest to the pin, and the beverage cart.

In parallel to the golf tournament, ERHF will host two receptions at Smithfields Country Club for those living with CHDs. A reception for adults living with CHDs will be held from 4-5 p.m., while a reception for families of children living with CHDs will take place from 4:30-5:30 p.m. The goal for these receptions is to create opportunities where the CHD community can develop and to form supportive relationships. Both receptions are sponsored by Masimo Corporation, provider of innovative noninvasive monitoring technologies.

"Since its inception, this golf tournament has proven to be a wonderful celebration of all the ERHF has been able to accomplish and a time to dream about what the future will hold as we continue to labor on mission for the lives of children here and abroad," stated Jason Smith, co-founder of Emerson Rose Heart Foundation. "It is once again a privilege to have Bi-Lo as our title sponsor and we are extremely excited about this year's event."

Specific information about the annual golf tournament can be found by visiting emersonroseheartfoundation.org/golftournament/

About Emerson Rose Heart Foundation

Emerson Rose Heart Foundation (ERHF) was founded in 2011 by Jason and Susan Smith after the passing of their daughter, Emerson Rose, who died from complications related to a complex congenital heart defect (CHD).

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