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Subject: U.S. Trademark Application Serial No. 88138743 - PHYSICIAN TALENT OFFICER - 6125.01 - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 88138743

**Mark:** PHYSICIAN TALENT OFFICER

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**Reference/Docket No.** 6125.01

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**STATEMENT OF THE CASE**

Applicant seeks to register the mark "PHYSICIAN TALENT OFFICER" in standard character format for "human resources consultancy and consulting services in the fields of business management, human resources, and business organizational design". Applicant has appealed the Trademark

Examining Attorney's final refusal under Trademark Act Section 2(e)(1). Registration was refused because the mark is descriptive as it relates to the aforementioned services.

### **FACTS**

Applicant filed the application on October 1, 2018, seeking registration on the Principal register of the mark PHYSICIAN TALENT OFFICER for "human resources consultancy and consulting services in the fields of business management, human resources, and business organizational design" in Class 35. The application was based upon applicant's intent to use the mark under Trademark Act Section 1(b).

In the first Office Action, dated January 15, 2019, the examining attorney issued a refusal under Trademark Act Section 2(e)(1) for descriptiveness.

On July 15, 2019, applicant filed a response contravening the refusal under Trademark Act Section 2(e)(1).

On July 22, 2019, the examining attorney issued a final refusal under Trademark Act Section 2(e)(1).

On January 21, 2020 applicant filed a notice of appeal.

On March 18, 2020 applicant filed its appeal brief.

On March 20, 2020, the case was forwarded to the examining attorney for a brief.

### **PRELIMINARY EVIDENTARY ISSUE**

Applicant has submitted new evidence with its appeal brief. Specifically, applicant has cited Black's Law Dictionary and [www.irs.gov](http://www.irs.gov) in its brief. No such evidence was attached to applicant's sole response prior to its brief.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

## ISSUE

The sole issue on appeal is whether the wording PHYSICIAN TALENT OFFICER, and thus, the mark PHYSICIAN TALENT OFFICER, describes applicant's human resources consultancy and consulting services in the fields of business management, human resources, and business organizational design.

## ARGUMENT

**BECAUSE THE MARK PHYSICIAN TALENT OFFICER, DESCRIBES A CHARACTERISTIC OF THE SERVICES, THE MARK IS NOT ELIGIBLE FOR REGISTRATION ON THE PRINCIPAL REGISTER.**

A mark is merely descriptive if "it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant's] goods or services." *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b).

The following internet dictionary excerpts of record define the terms OFFICER, TALENT and PHYSICIAN:

Officer: "One who holds an office of authority or trust in an organization, such as a corporation or government." [www.ahdictionary.com](http://www.ahdictionary.com)

Officer: "someone with a position of authority in an organization."  
[www.macmillandictionary.com](http://www.macmillandictionary.com)

Talent: "Natural endowment or ability of a superior quality; A person or group of people having such ability: The company makes good use of its talent."  
[www.ahdictionary.com](http://www.ahdictionary.com)

Talent: "A person who possesses unusual innate ability in some field or activity."  
[www.vocabulary.com](http://www.vocabulary.com)

Physician: "One who has a Doctor of Medicine." [www.ahdictionary.com](http://www.ahdictionary.com)

Physician: “A physician is a doctor; licensed medical practitioner.” [www.vocabulary.com](http://www.vocabulary.com)

See evidence attached to the January 15, 2019 Office action at Pages 2-16. See also attached article from [www.dhrinternational.com](http://www.dhrinternational.com), discussing the important role of Chief TALENT OFFICERS at Pages 17-22: “Sometimes called managing director, operating partner, talent partner, human capital partner, recruiting partner, to name a few, many organizations title this role chief TALENT OFFICER (CTO)....The CTO role is a complex and evolving position. It essentially combines recruiting with succession planning.”

The examining attorney attached 21 third party registrations in support of the finding that the term OFFICER is descriptive. See final Office Action issued on July 22, 2019, at Pages 2-58. Third-party registrations featuring goods and/or services the same as or similar to applicant’s goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *E.g., In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (quoting *Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992)). The registrations establish consistent treatment of OFFICER as descriptive with regard to consulting services.

The remaining evidence attached to the Final Office action issued on July 22, 2019 is from [www.ere.net](http://www.ere.net), [www.forbes.com](http://www.forbes.com), [www.workable.com](http://www.workable.com), [www.linkedin.com](http://www.linkedin.com) and [www.paycor.com](http://www.paycor.com). The evidence establishes the fact that TALENT OFFICER is a well-known term of art within the field of human resources:

“The people assuming the Chief **Talent Officer** role are often people who have demonstrated their business credentials, perhaps by running a business unit or by their involvements in product development or customer service. Many of them have also spent time building work

teams, grappling with the internal people issues in teams and who have an understanding of the external trends and issues that are changing the nature of work and the ways people want to engage in work.” (Emphasis added) [www.ere.net](http://www.ere.net) at Page 59 of the July 22, 2019 Office action.

“Many companies are strengthening their internal talent management capabilities with the chief **talent officer** role. This new leader in the C-suite is responsible for every aspect of human resources from the talent life cycle, managing internal recruitment teams, career development, employee engagement, succession planning and more... Chief TALENT OFFICERS need to implement initiatives catering to developing future generations of leadership... Chief TALENT OFFICERS must consider key values when communicating with internal TALENT pools to promote a more transparent company culture. New approaches to TALENT development may require organizational leaders to change their mindset set.” (Emphasis added.) [www.forbes.com](http://www.forbes.com) at Pages 61 - 63 of the July 22, 2019 Office action.

“New Trends In HR: The Chief TALENT OFFICER... People Management... The world of human resources is in the midst of a fundamental shift. Gone are the days when hiring consisted of simply receiving resumes and conducting interviews: now, TALENT management is the name of the game. To reflect that, some organizations are hiring a Chief TALENT OFFICER, or a senior executive who is tasked with managing TALENT relationships. [www.paycor.com](http://www.paycor.com) at Page 66 of the July 22, 2019 Office action.

“What is a Chief TALENT OFFICER? A Chief **Talent Officer** is in charge of the organizations internal and external talent acquisition strategy, especially for C-suite candidates (i.e. executives, managers and team leaders. This is a senior-level role aiming to create high-performance teams that help companies grow.” (Emphasis added.) [www.workable.com](http://www.workable.com) See Page 64 of the July 22, 2019 Office action.

The evidence establishes the wording TALENT OFFICERS is a term of art in the field of human resources, business management and business organizational design. Applicant finds or provides consultation regarding potential TALENT OFFICERS for its clients. The term TALENT on its own also refers to the individuals who are managed by TALENT OFFICERS. In this case, TALENT refers to a group of PHYSICIANS identified by the TALENT OFFICER as potential employees that possess the skill necessary for a particular

assignment or job. See also attached article regarding PHYSICIAN TALENT from [www.healthleadersmedia.com](http://www.healthleadersmedia.com) at Page 67 of the July 22, 2019 Office action, establishing the fact that medical professionals are referred to as TALENT.

Applicant insists that the mark is not descriptive because “no hospital, healthcare organization, or insurance company (e.g. relevant consumers/clients of appellant’s services) would ever appoint/elect/hire a purely legal entity such as a limited partnership (as is the Appellant) as C-level officer with authority over the company.” See applicant’s brief at Pages 10 and 11. To clarify, the point of the refusal is not that applicant itself provides the services of a PHYSICIAN TALENT OFFICER. The point is that applicant provides input in the selection of PHYSICIAN TALENT OFFICERS to its clients in the course of its human resources, business management and business organizational design consulting activities. Determining the descriptiveness of a mark is done in relation to an applicant’s goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831. The evidence of record in this case is directly on point and proves the descriptive nature of the mark in relation to the services. By way of contrast, applicant did not submit any evidence to distinguish the meanings of the words in the mark. Indeed applicant did not submit any evidence at all with the exception of its attempts to introduce evidence with its brief.

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or

services are, but “whether someone who knows what the goods and[/or] services are will understand the mark to convey information about them.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012). In this case no leap of imagination is required to recognize the fact that PHYSICIAN TALENT OFFICER refers to the employees that applicant helps recruit for its customers. Applicant’s clients, as enumerated in its brief, are hospitals, healthcare organizations and insurance companies. These entities are aware of the meaning of the mark because it describes the individuals whom they seek to hire to manage their PHYSICIAN TALENT.

### **CONCLUSION**

The wording PHYSICIAN TALENT OFFICER is descriptive of applicant’s consulting services in the fields of business management, human resources, and business organizational design and is, therefore, ineligible for registration on the Principal Register. For the foregoing reasons, registration has been refused and it is respectfully submitted that the final refusal for descriptiveness under Trademark Act Section 2(e)(1) be affirmed.

Respectfully submitted,

/Tracy Whittaker-Brown, Esq./

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