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Paper No. 8
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allina Health System

Serial No. 75/866,849

Eric D. Paulsrud of Leonard, Street and Deinard for
Allina Health System.

Gina M. Fink, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Cissel, Hanak and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Allina Health System has filed a trademark
application to register the mark HEART INSTITUTES OF
AMERICA for "cardiovascular health care services."¹ The
application includes a disclaimer of "Heart Institute"
apart from the mark as a whole.²

¹ Serial No. 75/866,849, in International Class 42, filed December 8,
1999, based on an allegation of a bona fide intention to use the mark in
commerce.

² The Examining Attorney accepted the disclaimer as filed; however, we
note that the disclaimer uses the singular form of the word "Institute,"
whereas the mark uses the plural form of the word. Because the
difference is minimal, we construe the disclaimer of the actual phrase
in the mark, "Heart Institutes," to have been properly made. Should

The Trademark Examining Attorney has issued a final refusal to register under Section 2(e)(2) of the Trademark Act, 15 U.S.C. 1052(e)(2), on the ground that the mark is primarily geographically descriptive in connection with applicant's services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney contends that "Heart Institutes" is merely descriptive, if not generic, in connection with applicant's services. In support of this position, she notes applicant's disclaimer of this phrase and she points to the dictionary definitions of "heart" and "institute" in the record. The Examining Attorney also submitted excerpts of articles retrieved from the LEXIS/NEXIS database showing the use of the phrase "heart institute" in the context of discussions of services and facilities that are clearly encompassed by applicant's recitation of services.

The Examining Attorney contends, further, that "America" is a geographic term in the context of applicant's mark and services; and that "of America" in applicant's mark "describes the geographic scope of

applicant ultimately prevail in its appeal, we direct the Examining

applicant's services and nothing more." In this regard, we take judicial notice of the following definitions of "America" submitted with the Examining Attorney's brief:

Merriam-Webster's Collegiate Dictionary (10th ed. 1998), "1. either continent (N. America or S. America) of the western hemisphere. ... 3. UNITED STATES OF AMERICA."

Merriam Webster's Geographical Dictionary (3rd ed. 1997), "... In current use: either continent of the Western Hemisphere (North America or South America); often, specifically, the United States of America"

The American Heritage Dictionary of the English Language (3rd ed. 1992), "1. The United States."

Applicant states the following:

The subject mark does include the term American (*sic*).³ In one sense this is a geographical indicator. However, in the context of the subject mark, the term is much more than a geographic indicator. A geographic term may enjoy trademark protection without a showing of secondary meaning when [it] is used in an arbitrary or suggestive manner, taking into account the nature of the goods or services at issue. (*citations omitted.*)

The connotation of the word American (*sic*) in the field of health care services [is] that the services offered are the highest and best in the world. They are state of the art. The facilities are modern and well equipped. The medical practitioners are highly trained professionals who rank highly among their peers

Attorney to correct this discrepancy.

³ Applicant acknowledges in its recitation of facts in its brief that the mark in this application is HEART INSTITUTES OF AMERICA. However, in its argument in the brief, applicant repeatedly refers to the word "American" as part of its mark. We have considered this to be merely a typographical error in the brief.

in and among the worldwide medical community. (*emphasis in original*) As such, the term American (*sic*) in the context of the subject mark is not intended merely as, and indeed does not serve merely as, or primarily as, a geographic descriptor.

We agree with the Examining Attorney that the phrase "Heart Institutes" is merely descriptive in connection with applicant's identified services. Applicant has entered a disclaimer of this phrase and does not dispute this point. Based on the evidence of record it is clear that, when applied to applicant's services, the term "Heart Institute" immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely that applicant is an organization that offers cardiovascular, or heart-related, health care services. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term "Heart Institute" as it pertains to the identified services.

We consider, next, the Examining Attorney's contention that the "of America" portion of applicant's

mark is primarily geographically descriptive and that, in view of the highly descriptive nature of "Heart Institute," the mark as a whole is primarily geographically descriptive.

In order for a mark, or a portion thereof, to be considered primarily geographically descriptive under Section 2(e)(2), it is necessary to show that (i) the mark or relevant portion is the name of a place known generally to the public, and that (ii) the public would make a goods/place association, that is, believe that the goods or services for which the mark or relevant portion is sought to be registered originate in that place. See, e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's goods or services come from the geographical place named in the mark. See,

e.g., In re California Pizza Kitchen, Inc., supra; and *In re Handler Fenton Westerns, Inc.,* 214 USPQ 848, 850 (TTAB 1982).

Based on the dictionary definitions, and in the context of this mark for the services admittedly originating and offered in the United States, "of America" will clearly be perceived as indicating a specific geographic location known generally to the public, namely, the United States of America. While an alternative definition of "America" is the entire western hemisphere, it usually so indicates in its plural form, *i.e.*, "the Americas." Further, the phrase "of America" retains its primarily geographic character.

Considering the second part of the test, applicant admits that its services are offered in the United States of America. Thus, we presume a public association of the goods with the place from the fact that the applicant's services come from the geographical place named in the mark. Because both parts of the enunciated test have been met, we find "of America" is primarily geographically descriptive.

We are not persuaded otherwise by applicant's arguments to the contrary. Applicant alleges that "America" in its mark has a connotation pertaining to

quality. However, applicant presents no evidence in support of this statement, which is simply conjecture. Even if applicant were to establish that "America" has this connotation of quality in certain circumstances, this is secondary because of the primary significance of the term in question, "of America," as a geographic indicator. See *In re Monograms America, Inc.*, 51 U.S.P.Q.2d 1317 (TTAB 1999) and cases cited therein.

Although the mark includes the phrase "Heart Institute," there is no indication in the record that this phrase serves any purpose other than, as stated above, to describe that applicant is an organization that offers cardiovascular, or heart-related, health care services. Thus, we find that this phrase is so highly descriptive of a significant feature of applicant's services that it does not detract from the primary significance of applicant's composite mark as being geographically descriptive.⁴

⁴ We note that each case must be decided on its particular facts. In *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251 (1916), the Supreme Court found AMERICAN GIRL not primarily geographically descriptive in connection with shoes. However, "America," preceded by the preposition "of" in this case renders "America" clearly and only geographic in significance and the record contains no evidence in support of another connotation.

For the foregoing reasons, we conclude that HEART INSTITUTES OF AMERICA is unregistrable under Section 2(e)(2) of the Trademark Act.

Decision: The refusal to register is affirmed.

Hanak, Administrative Trademark Judge, dissenting:

For two reasons, I respectfully disagree with my colleagues that the mark HEART INSTITUTES OF AMERICA is primarily geographically descriptive for "cardiovascular health care services," and accordingly I dissent.

First, the majority's decision is at odds with the holdings of most courts that the addition of any matter to AMERICA or AMERICAN, even descriptive matter, will cause the mark in its entirety to be removed from the geographically descriptive category. This legal principle is best articulated by Professor McCarthy in the following fashion: "One of the most-used marks appears to be AMERICAN. On the whole, courts have held that the addition or variation of any element of AMERICAN, no matter how slight, will remove it from the geographically descriptive category for American-based sellers. For example, AMERICAN GIRL shoes, ALL AMERICAN on radios, AMERICAN PLAN CORPORATION for insurance services and AMERICANA for hotel services, were held

arbitrary uses." 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 14:11 at pages 14-30 to 14-31 (4th ed. 2001)(emphasis added, citations omitted).

For example, the mark AMERICAN RADIO STORES was held to be entitled to protection without proof of secondary meaning despite the fact that "the words 'radio' and 'stores' ... are purely descriptive." *American Plan Corp. v. State Loan & Finance Corp.*, 365 F.2d 635, 150 USPQ 767, 769 (3rd Cir. 1966), *cert. denied*, 385 U.S. 1011 (1967).

Second, I find that based on this record applicant has established that the word AMERICA, when used in connection with health care services, does indeed connote high quality. It is true, as the majority notes, that applicant did not present evidence showing that AMERICA, as applied to health care services, connotes high quality. However, this is not the entire story. In response to the first Office Action, applicant stated that "the connotations of the word [AMERICA] in the field of health care services are that the services offered are the highest and best in the world." In the second and final Office Action, the Examining Attorney in no way disputed applicant's contention. Indeed, at page 2 of

this second Office Action, the Examining Attorney even stated that "the term AMERICA may suggest prestige."

Obviously, by their very nature ex parte Board cases are somewhat informal. When an applicant makes a factual statement not supported by evidence, it is incumbent upon the Examining Attorney to either accept the factual statement as true, or to not accept this factual statement and point out to the applicant that it has failed to provide evidentiary support for the statement. To require applicants to submit affidavits or declarations in support of every factual statement contained in their responses to Office Actions would place a needless burden upon applicants, and indeed the PTO. In other words, many factual statements made by applicants will not be challenged by Examining Attorneys, and hence there is no purpose served in vastly enlarging the application files with numerous affidavits or declarations.

Because I believe that applicant has established through the silence and statements of the Examining Attorney that the word AMERICA, as applied to health care services in general and cardiovascular health care services in particular, denotes high quality, I find that the

primary significance of AMERICA as applied to such services is not geographical. The majority cites *In re Monograms America Inc.*, 51 USPQ2d 1317 (TTAB 1999) wherein the mark MONOGRAMS AMERICA was held primarily geographically descriptive for "consulting services for owners of monogram shops." Two comments are in order. First, the United States of America is well known for high quality health care services. The same cannot be said for consulting services for owners of monogramming shops. Second, in *Monograms America* the Board pointed out that applicant failed to present evidence showing that AMERICA indicated high quality or excellence for consulting services for owners of monogramming shops. 51 USPQ2d at 1320. However, there is nothing in the *Monograms America* case to indicate that applicant, during the examination process, contended that AMERICA stood for high quality as applied to its services and that the Examining Attorney failed to dispute this contention. In sharp contrast, in the present case not only did the Examining Attorney fail to dispute applicant's contention that when applied to health care services AMERICA indicated high quality, but instead, the Examining Attorney, as previously noted, actually stated that "the term AMERICA may suggest prestige."