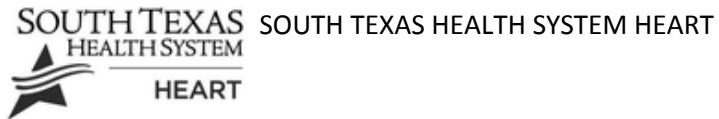


Note To The File

Serial Number: 88094386
Date: 12/07/2018 8:32 pm
Created by: Timothy Schimpf



Searched

- Google
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Checked

- Geo. Sig.
- Surname
- Translation

Changed

- Issued Examiner's Amendment and Entered Changes

Contacted Applicant/Atty

- via Phone
- via E-Mail

From: Schimpf, Timothy

Sent: Friday, December 07, 2018 2:19 PM

To: 'charlacher@williamsmullen.com' <charlacher@williamsmullen.com>

Subject: Trademark Applications for SOUTH TEXAS HEALTH SYSTEM, Revised Suggestions

Hello, my name is Tim Schimpf and I am an examining attorney with the U.S. Patent and Trademark Office. I am following up on phone conversations regarding a few changes to my suggestions regarding how the star design is described in the mark description, and changes to the Section 2(f) claim in two of the applications. Each of applicant's changes are acceptable. My suggestions from my earlier email have been updated below.

As a reminder, the ten trademark applications owned by UHS of Delaware, Inc:

88081596 SOUTH TEXAS HEALTH SYSTEM CLINICS WEIGHT LOSS

88081603 SOUTH TEXAS HEALTH SYSTEM CLINICS GASTROENTEROLOGY

88081609 SOUTH TEXAS HEALTH SYSTEM CLINICS CARDIOLOGY

88081615 SOUTH TEXAS HEALTH SYSTEM CLINICS OB/GYN

88081646 SOUTH TEXAS HEALTH SYSTEM CLINICS PRIMARY CARE

88094242 SOUTH TEXAS HEALTH SYSTEM MCALLEN

88094347 SOUTH TEXAS HEALTH SYSTEM EDINBURG

88094356 SOUTH TEXAS HEALTH SYSTEM BEHAVIORAL

88094386 SOUTH TEXAS HEALTH SYSTEM HEART

88094396 SOUTH TEXAS HEALTH SYSTEM CHILDREN'S

There are several issues that can be resolved with applicant's approval.

Mark Descriptions: The wording of the mark descriptions needs to be amended to address the positioning of the wording relative to one another. As we discussed, the description of the star design can remain consistent with applicant's prior registrations. I suggest amending the mark descriptions to:

Serial Nos. 88081596

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "CLINICS" above a second horizontal straight line above the stylized wording "WEIGHT LOSS". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CLINICS" appears a design of a star with two curved lines in the center.

Serial Nos. 88081603

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "CLINICS" above a second horizontal straight line above the stylized wording "GASTROENTEROLOGY". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CLINICS" appears a design of a star with two curved lines in the center.

Serial Nos. 88081609

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "CLINICS" above a second horizontal straight line above the stylized wording "CARDIOLOGY". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CLINICS" appears a design of a star with two curved lines in the center.

Serial Nos. 88081615

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "CLINICS" above a second horizontal straight line above the stylized wording "OB/GYN". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CLINICS" appears a design of a star with two curved lines in the center.

Serial Nos. 88081646

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "CLINICS" above a second horizontal straight line above the stylized wording "PRIMARY CARE". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CLINICS" appears a design of a star with two curved lines in the center.

Serial No. 88094242

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "MCALLEN". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "MCALLEN" appears a design of a star with two curved lines in the center.

Serial No. 88094347

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "EDINBURG". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "EDINBURG" appears a design of a star with two curved lines in the center.

Serial No. 88094356

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "BEHAVIORAL". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "BEHAVIORAL" appears a design of a star with two curved lines in the center.

Serial No. 88094386

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal straight line above the stylized word "HEART". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "HEART" appears a design of a star with two curved lines in the center.

Serial No. 88094396

The mark consists of the stylized wording "SOUTH TEXAS" above the stylized wording "HEALTH SYSTEM" above a horizontal curved line above the stylized word "CHILDREN'S". Below the word "SOUTH" and to the left of the wording "HEALTH SYSTEM" and "CHILDREN'S" appears a design of a star with two curved lines in the center.

Identification of Services for Serial Nos. 88081609 and 88094386: The wording "heart care services" in these two identifications needs to be amended because it needs to be clear about the overall nature of the services, such as that they are medical services. I suggest amending the identification to:

"Medical services; healthcare services; **medical services, namely, heart care** ; providing a web site featuring medical information" in International Class 44.

Descriptiveness and Section 2(f): All of the wording of each of the marks is descriptive or generic. Specifically, the wording SOUTH TEXAS and MCALLEN and EDINBURG are geographically descriptive, the wording HEALTH SYSTEM and CLINICS is generic for the health care services, and the various medical specialties are descriptive of what is treated. Applicant has claimed ownership of a variety of prior registrations that begin with SOUTH TEXAS and frequently include HEALTH SYSTEM or something similar. Applicant has relied on Section 2(f) in part for several of these prior registrations, such as recent registration U.S. Registration No. 4717569. I would suggest a similar Section 2(f) claim of acquired distinctiveness for the current applications to avoid having to disclaim all the wording. This claim may be made based on its prior registration, U.S. Registration No. 3507432. It would be a claim of Section 2(f) in part for the wording of that registration: "SOUTH TEXAS HEALTH SYSTEM". Additionally, as we discussed Serial Nos. 88094242 and 88094347 would include additional Section 2(f) in part claims based on other prior registrations for the wording MCALLEN and EDINBURG.

Section 2(f) Statement for all applications except Serial Nos. 88094242 and 88094347

"SOUTH TEXAS HEALTH SYSTEM" has become distinctive of the services as evidenced by ownership of active U.S. Registration No. 3507432 on the Principal Register for the same mark for sufficiently similar services.

Section 2(f) Statement for Serial No. 88094242

"SOUTH TEXAS HEALTH SYSTEM" has become distinctive of the services as evidenced by ownership of active U.S. Registration No. 3507432 on the Principal Register for the same mark for sufficiently similar services. "MCALLEN" has become distinctive of the services as evidenced by ownership of active U.S. Registration No. 3658060 on the Principal Register for the same mark for sufficiently similar services.

Section 2(f) Statement for Serial No. 88094347

"SOUTH TEXAS HEALTH SYSTEM" has become distinctive of the services as evidenced by ownership of active U.S. Registration No. 3507432 on the Principal Register for the same mark for sufficiently similar services. "EDINBURG" has become distinctive of the services as evidenced by ownership of active U.S. Registration No. 4432657 on the Principal Register for the same mark for sufficiently similar services.

Disclaimer: In addition to the Section 2(f) claim, applicant would need to disclaim the generic wording and descriptive wording not covered by the Section 2(f) claim in each of the marks, including HEALTH SYSTEM and CLINICS and various medical specialties and geographic locations. With applicant's permission, I will add the following statement to the record:

Serial Nos. 88081596

No claim is made to the exclusive right to use "HEALTH SYSTEM CLINICS WEIGHT LOSS" apart from the mark as shown.

Serial Nos. 88081603

No claim is made to the exclusive right to use "HEALTH SYSTEM CLINICS GASTROENTEROLOGY" apart from the mark as shown.

Serial Nos. 88081609

No claim is made to the exclusive right to use "HEALTH SYSTEM CLINICS CARDIOLOGY" apart from the mark as shown.

Serial Nos. 88081615

No claim is made to the exclusive right to use "HEALTH SYSTEM CLINICS OB/GYN" apart from the mark as shown.

Serial Nos. 88081646

No claim is made to the exclusive right to use "HEALTH SYSTEM CLINICS PRIMARY CARE" apart from the mark as shown.

Serial No. 88094242

No claim is made to the exclusive right to use "HEALTH SYSTEM" apart from the mark as shown.

Serial No. 88094347

No claim is made to the exclusive right to use "HEALTH SYSTEM" apart from the mark as shown.

Serial No. 88094356

No claim is made to the exclusive right to use "HEALTH SYSTEM BEHAVIORAL" apart from the mark as shown.

Serial No. 88094386

No claim is made to the exclusive right to use "HEALTH SYSTEM HEART" apart from the mark as shown.

Serial No. 88094396

No claim is made to the exclusive right to use "HEALTH SYSTEM CHILDREN'S" apart from the mark as shown.

Please respond by **Monday, December 10** as whether applicant agrees to these amendments. If applicant agrees, I can make the amendments through an examiner's amendment and approve the applications for publication.

If you would prefer, I would be happy to discuss this over the telephone at the number listed below. If you have any questions, please let me know.

Timothy Schimpf

Examining Attorney, Law Office 113

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