

RESPONSE TO OFFICE ACTION

I. Introduction

This is a response to the Office Action issued on February 27, 2019. The Examining Attorney refused registration of Applicant's CORTLAND BIOMEDICAL mark based on her belief that Applicant's mark is primarily geographically descriptive. The Examining Attorney also requested additional information about the application and required amendments to the identification of the goods and services.

II. Applicant's Mark is Not Primarily Geographically Descriptive

To support her argument that CORTLAND BIOMEDICAL is primarily geographically descriptive, the Examining Attorney argues "Cortland is the name of a city in New York," "the Applicant is located in Cortland, NY," "Cortland is the name of a type of apple from Cortland County" and that "BIOMEDICAL is descriptive of Applicant's goods and services." For the reasons discussed below, Applicant respectfully disagrees that its mark CORTLAND BIOMEDICAL is primarily geographically descriptive for medical devices and related services.

A mark is primarily geographically descriptive when all of the following factors are demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods and/or services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place or services-place association; that is, purchasers would be likely to believe that the goods and/or services originate in the geographic place identified in the mark.

Trademark Manual of Examining Procedure ("TMEP") §1210.01(a); see *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). Not all terms which are geographically suggestive are unregistrable. *In re Nantucket, Inc.*, 213 U.S.P.Q. 889 (C.C.P.A. 1982). If there is no connection between the geographical meaning of the mark with the goods or services in the public mind, registration should not be refused. *Id.*

An analysis of the foregoing factors weighs in favor of registration of Applicant's mark CORTLAND BIOMEDICAL, and that the mark is not primarily geographically descriptive.

Applicant does not dispute that Cortland is located in New York or that Cortland is the name of the city in which it is currently located. However, Applicant's mark is CORTLAND BIOMEDICAL,

not CORTLAND APPLES. Moreover, "CORTLAND" in Applicant's mark is not generally known to the public as a particular geographic place, nor would consumers who do recognize "Cortland" as a geographic place likely associate "Cortland" with the medical devices and instruments and related services claimed in the instant application.

A. "Cortland" is an Obscure Geographic Place or Location That Also Has Significance as a Surname

To support a refusal to register geographic matter, the Trademark Act requires that the mark be *primarily* geographic, that is, that its primary significance to the relevant consumers in the United States be that of a geographic location... When it is not clear on its face that the primary significance of the mark is that of a geographic location, the record must include substantial evidence to support a conclusion that the mark identifies a place "known generally to the relevant American public." See *In re Newbridge Cutlery*, 776 F.3d at 862, 113 USPQ2d at 1450 (emphasis added). TMEP 1210.02(b).

The evidence offered by the Examining Attorney is insufficient to establish "Cortland Biomedical" as a generally known geographic place or location. The Examiner's only evidence is a dictionary definition of "Cortland" as either a city in Central NY, a variety of apple, or a tree bearing such fruit. This evidence is not substantial and does not confirm whether the *primary significance* of this term is as a city, an apple, a tree, or none of these things.

Moreover, there are at least six other geographic locations named "Cortland" making it an obscure geographic location at best. In particular, Applicant notes, among others, Cortland County, NY (mentioned above); Cortland, OH; Cortland, IL; Cortlandville, NY; Cortlandt, NY; or Courtland, AL. See Exhibit A. Based on the many geographic locations across the United States named "Cortland" (or the phonetic equivalent thereof), a consumer encountering Applicant's mark CORTLAND BIOMEDICAL for the first time likely would not immediately identify "Cortland" in Applicant's mark as referencing a specific geographic location, such that "Cortland" cannot be considered a generally known location.

Furthermore, "Cortland" has significance as a surname. The online 2000 U.S. Census shows that over 100 individuals have the surname "Cortland" in the United States. Because of its size, only a portion of census is pasted below:

157330	CONTURSI	157234	103	0.03	89893.7	94.17	0	0	0	0	5.83
157331	CONOWAY	157234	103	0.03	89893.7	67.96	31.07	0	0 (S)	(S)	
157332	CORLIN	157234	103	0.03	89893.8	97.09	(S)	0	0 (S)	(S)	
157333	CORYN	157234	103	0.03	89893.8	98.06	(S)	0	0	0 (S)	
157334	CORTLAND	157234	103	0.03	89893.8	63.11	25.24	4.85 (S)	(S)	4.85	
157335	CORDSEN	157234	103	0.03	89893.9	88.35	0 (S)	0	0	6.8 (S)	
157336	COAKE	157234	103	0.03	89893.9	97.09	(S)	0	0 (S)	0	
157337	COLLMANN	157234	103	0.03	89893.9	98.06	0 (S)	0	0	0 (S)	
157338	CIRKA	157234	103	0.03	89894	99.03	0	0	0 (S)	(S)	

See Exhibit B https://www.census.gov/topics/population/genealogy/data/2010_surnames.html.

Pursuant to TMEP §1210.02(b)(i)(A), a term's geographic significance may not be its primary significance if the term also has surname significance. That is surely the case with "Cortland." Moreover, the statute makes no distinction between rare and commonplace surnames. *E.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985).

In light of the foregoing, there is no basis upon which to identify "Cortland" as a generally known geographic place or location. Instead, the evidence shows that "Cortland" refers to several obscure geographic locations, one of which shares its name with a variety of apples. In addition, "Cortland" has significance as a surname. As such, the first factor weighs in favor of Applicant and the registration of CORTLAND BIOMEDICAL.

B. Consumers are Unlikely to Associate "Cortland" with Medical Devices and Services

Only when the geographic location named in the mark is generally known to the public as a place where the goods and services come from, and the applicant's goods and services actually come from that location, then a services-places association might be presumed. *In re California Pizza Kitchen Inc.*, 10 U.S.P.Q.2d 1704, 1706 (T.T.A.B. 1988). Where there exists a genuine issue that the place named in the mark is so obscure or remote that purchasers would fail to recognize the geographic place as the source of the services, the Examining Attorney must submit evidence to establish a goods/services-place association. *See, In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 at 1451. If a geographic term is not likely to impress upon consumers that the services emanate from the geographic place named, the use of the term is evidence of arbitrary usage. *See, e.g., 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 14:03 (4th ed. 2013); *In re John Harvey & Sons Ltd.*, 32 U.S.P.Q.2d at 1453 (finding HARVEY'S BRISTOL CREAM for cakes flavored with sherry wine not primarily geographically descriptive since evidence of record does not show that Bristol, England, is associated with cakes flavored with sherry wine in manner that would cause American public to assume that Bristol is cakes' place of origin). It is more difficult to establish a services/place association than a goods/place association. TMEP §1210.04(b).

In the instant action, a goods/services-place association cannot be presumed because, as discussed above, "Cortland" is an obscure geographic location arguably known for apples (if known at all) and is also a surname. Moreover, the Examining Attorney has not presented any evidence to establish that consumers would in fact make an association between "Cortland" and the relevant goods and services. There is also no evidence to establish that "Cortland" is known as a particular destination for medical devices, instruments, and related services. Accordingly, even though Applicant is located in Cortland, NY, there is nothing in the record that establishes consumers associate Cortland, NY or Cortland County generally as a destination for medical devices, instruments, or related services.

As shown in the Examining Attorney's evidence, Cortland County is associated with "a variety of apple having red skin and crisp flesh." Furthermore, given that "Cortland" is a surname in the United States, it is possible consumers will perceive "Cortland" in Applicant's mark as a surname rather than a specific geographic location.

In light of the foregoing, there is no basis upon which to presume or establish a goods/services–place association between “Cortland” and Applicant’s goods and services. As such, the third factor weighs in favor of Applicant and registration of CORTLAND BIOMEDICAL.

C. Any Doubt Must be Resolved in Applicant’s Favor

The TTAB has a policy of resolving doubt in the applicant’s favor in *ex parte* cases. See, *In re Benthin Management*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995) (merely a surname refusal); *In re Hines*, 32 U.S.P.Q.2d 1376, 1377 (T.T.A.B. 1994) (disparaging marks refusal); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1654-55 (T.T.A.B. 1990) (scandalous and disparaging marks refusal); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (descriptiveness refusal); *In re Int’l Taste Inc.*, 53 USPQ2d 1604 (T.T.A.B. 2000) (geographic descriptiveness refusal).

The Federal Circuit has recognized and approved this policy. See, *In re Maverty Media Group Ltd.*, 31 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1998). To uphold the instant refusal on the grounds of geographic descriptiveness would effectively resolve any doubt with respect to the registrability of CORTLAND BIOMEDICAL against Applicant, contrary to the policy of the TTAB and contrary to the explicit guidelines set forth in *In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (“It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark and to resolve reasonable doubt in favor of the applicant in accordance with practice and precedent.”). Accordingly, the refusal to register Applicant’s mark CORTLAND BIOMEDICAL on the basis of geographic descriptiveness should be withdrawn in accordance with practice and precedent.


D. Conclusion

In sum, Applicant’s mark CORTLAND BIOMEDICAL is not geographically descriptive. The mark is geographically suggestive at best as there is no immediate connection between the place named in the mark and the goods and services claimed in the instant application. “Cortland” is not generally known to the public nor would consumers be likely to associate “Cortland” as a particular destination for medical devices, instruments, and related goods and services claimed in the instant application. Rather, “Cortland” is an obscure geographic location arguably known for apples and is a surname. Finally, practice and precedent require that any remaining doubt must be resolved in favor of Applicant. Therefore, in light of the foregoing, the mark CORTLAND BIOMEDICAL is not geographically descriptive.

III. Applicant’s Mark has Acquired Distinctiveness In Part Based on Prior Registrations for CORTLAND

Without admitting or conceding in any way to the initial determination of the Examining Attorney that Applicant’s mark is primarily geographically descriptive, Applicant submits that it has acquired distinctiveness in part based on its registrations of the same mark, CORTLAND on

the Principal Register for sufficiently similar goods. TMEP §1212.04. In particular, Applicant’s ownership of the following existing CORTLAND registrations establishes acquired distinctiveness. TSDR printouts of these registrations are attached as Exhibit C.

Mark	Reg.	Goods/Services
	4,632,606	<p>Class 9: Non-metal umbilicals, namely, diver umbilical cables that supplies breathing air and other life support services from the surface to a diver; non-metal umbilicals, namely, umbilical cables that can supply air, gas, electricity, power, communication services, video and optical services, and other life support services, for marine, land, and aerospace applications</p> <p>Class 10: Synthetic ropes and non-metal cables for medical applications, namely, ligament replacements, specialized sutures, and device linear actuators used in heart catheterization procedures</p> <p>Class 22: Ropes; non-metal cables; synthetic ropes and synthetic cables; synthetic ropes and non-metal cables for aerospace, marine, military, and security applications; synthetic ropes and non-metal cables for lifting operations; umbilicals in the nature of non-metal cables for marine, land, and aerospace applications</p>
CORTLAND	2,348,325	Class 22: Non-metal ropes and non-metal cables for marine and aerospace applications

IV. Information Requirement

Applicant submits the following answers in response to the Examining Attorney’s Information Requirement:

(1) Are the applicant’s goods developed using or do the goods apply principles of biomedicine?

Applicant responds as follows: *“Yes. Our services include designing, developing and manufacturing products that apply the principles of biology, anatomy and physiology, tissue engineering and textile engineering. To that end, our team is comprised of staff that are trained in the various disciplines that support biomedical science including Biomedical Engineering, Tissue Engineering, Biotechnology and Medical Textile Technology. Each of these background and disciplines is critical in our interaction with our client base.”*

Applicant does not currently have fact sheets, instruction manuals, brochures, and/or advertisements bearing Applicant’s mark as requested by the Examiner. Third party examples are attached as Exhibit D.

(2) Does the applicant apply biomedical principles in the provision of the applicant’s services?

Applicant responds as follows: *Yes. Our service portfolio requires us to comment on the physical, mechanical, and biological behaviors of our designed products as they interact with the human body. This includes predicting how the product will become enhanced/degraded over time as a*

patient's anatomy acts upon the structure. Predicting the biologic, biochemical, biomechanical and physiological response of the various polymeric fabric structures that we create is a key function of our role in manufacturing a product for our clients.

(3) If the answer to questions (1) and (2) above is "no," then what is the significance of the term "BIOMEDICAL" in the proposed mark?

Applicant responds as follows: *See above.*

V. Amended Goods and Services Identification

Consistent with the Examining Attorney's suggestion, Applicant amends its Class 10 and 40 identification of goods and services as follows. Changes are denoted below in bold font. This amendment has also been entered into the appropriate section of the TEAS Response to Office Action form.

Class 10: Medical apparatus, devices and instruments, namely, **diagnostic apparatus for medical purposes, electrocardiographs, gastroscopes, cannulae, catheters, medical guidewires, surgical apparatus and instruments, suture needles, suture materials, suture thread, heart pacemakers, stents, surgical implants comprising of artificial materials** for use in the fields of interventional cardiology, cardiothoracic surgery, interventional radiology, interventional neurology, general surgery, hernia repair, wound repair and management, orthopedic surgery, soft tissue repair, otolaryngology, endocrinology, gastroenterology, urology, and women's health; medical textiles composed of artificial materials, namely, implantable polymeric and metallic textiles for use in cardiovascular, orthopedic, neurovascular and general surgeries; medical textiles composed of artificial materials for use in medical implants, namely, woven, non-woven, knitted and braided polymeric, resorbable and metallic textile structures

Class 40: manufacturing services, namely, custom manufacturing of parts and components for use in medical devices to the order and/or specification of others; **custom manufacturing and fabrication services of medical components and materials for others**; custom manufacturing of medical devices, medical instruments, implantable medical devices and components; processing of medical components; **treatment of medical materials by the manufacture and assembly of high performance fibers and textiles, cloth cutting, textile treating, laser scribing, metal treating and tempering, and the warping of yarns for use in weaving and knitting machinery**; braiding, knitting, and weaving of high performance fiber textiles for medical devices

VI. Conclusion

For the foregoing reasons, Applicant respectfully submits that all barriers to registration have been removed. Therefore, passage to publication is respectfully requested.