

U.S. Trademark/Service Mark Application No.: 88485657

Mark: HIP

Applicant: Health Care Service Corporation

Client-Matter Reference No.: 094883.0266

Office Action Response Deadline: March 17, 2020

Office Action Response

I. Descriptiveness Refusal

In the Office Action dated September 17, 2019, the Examining Attorney refused registration on the ground that the mark is merely descriptive of Applicant's goods and services under Section 2(e)(1) of the Trademark Act. Applicant respectfully requests reconsideration in view of the following remarks, which demonstrate that the applied-for mark is not merely descriptive of the applied-for goods and services.

An acronym is only merely descriptive when it is generally understood (1) that the applied-for mark is an abbreviation, initialism, or acronym for specific wording; (2) the specific wording is merely descriptive of applicant's services; and (3) a relevant consumer viewing the abbreviation, initialism, or acronym in connection with applicant's services will recognize it as the equivalent of the merely descriptive wording it represents. *Trademark Manual of Examining Procedure* ("TMEP") §1209.03(h). In this case, Applicant's Mark is not merely descriptive because (1) the specific wording is not merely descriptive of applicant's services, and (2) the relevant consumer would not recognize the applied-for mark as the equivalent of the wording it represents.

A. "Health Innovation Platform" is, at most, suggestive of the goods and services identified in the application.

The statutory language for descriptiveness refusals imposes a stringent burden since the term "merely" is to be taken in its ordinary meaning of "only" or "solely." That is, when considered with the particular goods or services, the mark, because of its meaning, does nothing but describe them. It is well-recognized that to be regarded as "merely descriptive," a mark must have no significance other than as a descriptive term; "a mark is considered merely descriptive if it *immediately conveys* knowledge of a quality, feature, function, or characteristic of an applicant's goods or services." TMEP § 1209.01(b) (emphasis added). A suggestive mark, however, is one that "require[s] imagination, thought, or perception to reach a conclusion as to the nature of [the] goods." TMEP § 1209.01(a).

For example, in *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (T.T.A.B. 1972), the Board held that the mark "DRI-FOOT" was not merely descriptive of antiperspirant deodorant for feet. In reversing the Examining Attorney's descriptiveness refusal, the Board stated: "[A]lthough it is highly suggestive of applicant's goods, it possesses redeeming features which raise doubt as to the application of the 'merely descriptive' appellation." *Id.* at 318; *see also In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791, 792 (T.T.A.B. 1981) (finding the mark "COLOR

CARE” for bleach “intimates or suggests a characteristic of the product rather than being merely descriptive thereof.”).

With respect to the descriptiveness of “Health Innovation Platform,” the Examining Attorney fails to account for the many different meanings of “platform.” Similar to *In re Morton-Norwich Prods., Inc.*, in this case the mark *at most* “intimate[s] or suggest[s] a characteristic” of the services. It certainly does not *immediately* and *clearly* identify the nature or character of the services. In fact, it is unclear whether “health” modifies “innovation” or if “innovation” modifies “platform.” Regardless, neither interpretation clearly and immediately suggests the applied-for services.

With respect to the term “platform,” Applicant notes that the attached online dictionary definition (Exhibit A) lists the following entries:

- 1: Plan, design
- 2: a declaration of the principles on which a group of persons stands especially: a declaration of principles and policies adopted by a political party or a candidate
3. (a)(1): a usually raised horizontal flat surface especially: a raised flooring
(a)(2): a device or structure incorporating or providing a platform especially: such a structure on legs used for offshore drilling (as for oil)
(b): a place or opportunity for public discussion
4. (a): a usually thick layer (as of cork) between the inner sole and outer sole of a shoe
(b): a shoe having such a sole
5. (a): a vehicle (such as a satellite or aircraft) used for a particular purpose or to carry a usually specified kind of equipment
(b): OPERATING SYSTEM
also: the computer architecture and equipment using a particular operating system

There are so many diverse meanings for “platform” that prospective consumers cannot immediately understand the meaning of this term in relation to the applied-for services. The Examining Attorney has merely pointed to two examples of “platform” used in connection with “innovation” to reach the conclusion that consumers will immediately understand the mark to describe the applied-for services. It more likely, however, that prospective consumers will interpret “platform” to mean “a place or opportunity for public discussion”; “the principles on which a group of persons stands”; or “a plan or design.”

Prospective consumers will have to ponder and use their imagination when speculating as to the nature of the services offered in connection with this mark. Accordingly, any deduction about the nature of Applicant’s goods and services would require the consumer to undergo the type of mental leaps characteristic of suggestive marks. *See also In re Realistic Co.*, 169


U.S.P.Q. 610 (C.C.P.A. 1971) (reversing the T.T.A.B.’s refusal to register the mark “CURV” for permanent wave curling solutions, reasoning that although the mark “suggest[ed] a possible result of the intended use of the permanent wave curling solutions, it is not merely descriptive of the permanent wave curling solutions or the purpose for which such goods are to be used.”); *In re Nalco Chem. Co.*, 228 U.S.P.Q. 972, 973 (T.T.A.B. 1986) (finding the mark “VERI-CLEAN” for chemical antifouling additives “suggestive of the desired end result... but does not serve to describe the goods themselves”).

Contrary to the Examining Attorney’s refusal, “Health Innovation Platform” does not *immediately* convey an idea of the qualities or characteristics of Applicant’s services, but instead results in a mark that requires prospective consumers to use “imagination, thought and perception to reach the conclusion as to the nature of the [services].” As such, “Health Innovation Platform” is, at most, suggestive of the applied-for services, and therefore Applicant’s Mark (HIP) is not merely descriptive.

B. Applicant’s Mark Should be Allowed Given the Trademark Office’s Treatment of Similarly Constructed Marks.

The Trademark Office’s treatment of similarly-constructed marks on the Principal Register also lends support to Applicant’s position that “Health Innovation Platform” is at most suggestive of Applicant’s services. In this respect, Applicant includes below an illustrative chart of various marks featuring “INNOVATION” and/or “PLATFORM” that were approved for publication. Also attached are the corresponding application and registration records from the online trademark database of the Federal Register (Exhibit B). Applicant notes that none of the marks feature any disclaimers or other similar concessions of descriptiveness for “innovation” or “platform.”

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
A PLATFORM FOR INNOVATION RN: 5356604 SN: 87379298	Registered December 12, 2017 Int'l Class: 09 First Use: March 7, 2017 Filed: March 21, 2017	(Int'l Class: 09) computer software for license management; computer software used to track, monitor, and manage application software usage in the field of software licensing management; business analytics software for collecting and analyzing data to facilitate business decision making; computer software for computer aided design, engineering and manufacturing simulation; computer software that provides web-based access to applications and services through a web operating system or portal interface	Altair Engineering, Inc. (Delaware Corp.) 1820 E Big Beaver Rd Troy Michigan 48083-2031
A PLATFORM FOR INNOVATION RN: 3732158 SN: 77447256	Cancelled - Sec. 8 August 5, 2016 Int'l Class: 09 First Use: May 18, 2009	(Int'l Class: 09) computer software for computer aided design, engineering and manufacturing simulation; high grid computing software; business intelligence software	Altair Engineering, Inc. (Michigan Corp.) 1820 E. Big

TM/AN/RN/ Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
	Filed: April 14, 2008 Registered: December 29, 2009		Beaver Road Troy Michigan 480832031
<p>FLIP FOUNDATIONAL LEADERSHIP & INNOVATION PLATFORM and Design</p>  <p>RN: 4341256 SN: 85643908 Disclaimer: "LEADERSHIP"</p>	Registered May 28, 2013 Int'l Class: 35 First Use: March 1, 2010 Filed: June 5, 2012	(Int'l Class: 35) education leadership development	Flip Leadership, LLC (California Limited Liability Company) 753B Portola Street San Francisco California 94129
<p>HEALTHCARE ANALYTICS PLATFORM RN: 3088357 SN: 78322796 Disclaimer: "HEALTHCARE ANALYTICS"</p>	Renewed May 2, 2016 Int'l Class: 09 First Use: December 30, 2005 Filed: November 4, 2003 Registered: May 2, 2006	(Int'l Class: 09) computer software for the storage and analysis of health care data	Rgi Informatics, LLC (New York Limited Liability Company) 287 Sutton Road Cornwallville New York 12418
<p>RAPID PLATFORM INNOVATION RN: 3118339 SN: 78554878</p>	Cancelled - Sec. 8 February 22, 2013 Int'l Class: 42 First Use: January 1, 2005 Filed: January 27, 2005 Registered: July 18, 2006	(Int'l Class: 42) software architecture, for others, namely, designing the structure and relationships between the components of business software and software systems utilizing next generation technology platforms; design, development, programming and installation of business computer software for others, utilizing next generation technology platforms and consultation in regard to computer software and computer systems strategies utilizing next generation technology platforms	Digital Architects, Inc. (Texas Corp.) 1431 Greenway Drive, Suite 1000 Irving Texas 75038

TM/AN/RN/ Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
THE PLATFORM OF PLATFORMS FOR VIRTUAL HEALTH SN: 88130796	Allowed - Intent to Use Statement of Use - Non-Final Refusal Mailed November 14, 2019 Int'l Class: 09,10,38,44 First Use: December 20, 2017 Filed: September 25, 2018	(Int'l Class: 09) Computer peripherals; Computer programs for controlling, operating and interfacing video cameras with computers; Computer software and hardware for use in telemedicine allowing for digital image capture, image processing, digital storage and delivery of images, information and data, digital communications, and video conferencing; Videocameras; Webcams; Wireless computer peripherals (Int'l Class: 10) Integrated medical examination systems comprising medical devices and computer software for information management for use in web-based physical examination and assessment of patients in a remote, clinical setting; medical imaging apparatus for use in telemedicine examinations, namely, cameras, video cameras, digital cameras and digital video cameras (Int'l Class: 38) Wireless electronic transmission of data from portable electrocardiogram (ECG) acquisition device and software system (Int'l Class: 44) Telemedicine services	Globalmedia Group, LLC, Dba Globalmed (Arizona Limited Liability Company) 15023 North 73rd Street Scottsdale Arizona 85260

Applicant acknowledges that third-party applications and registrations are generally not conclusive on the question of descriptiveness and that the Examining Attorney must consider each case on its own merits. However, the charts and attached registration/application records clearly evidence a recognized policy on behalf of the Trademark Office of registering, without a disclaimer or other finding of descriptiveness, other marks that include “INNOVATION” and/or “PLATFORM.”

C. The Relevant Consumer Would Not Readily Understand HIP to be "substantially synonymous" with “Health Innovation Platform.”

In most cases, additional evidence is required to “establish that the acronym is readily understood to be substantially synonymous with the descriptive wording it represents.” *Id.*; *see also Modern Optics Inc. v. The Univis Lens Co.*, 234 F.2d 504, 506 (C.C.P.A. 1956) (finding the record insufficient to show that CV is a generally recognized term for multifocal lenses and lens blanks); *In re Harco Corp.*, 220 U.S.P.Q. 1075 (T.T.A.B. 1984) (finding the record insufficient to show that the relevant consumers would understand CPL as no more than an abbreviation of “computerized potential log”).

Here, the Examining Attorney states that HIP is merely descriptive because it is an abbreviation for the wording “health innovation platform,” which “identifies a common

innovation system in the field of health.” As support for this contention, the Examining Attorney provided printouts from a mere two websites—neither of which show use of HIP as an abbreviation for “health innovation platform.” Such evidence is clearly insufficient to demonstrate that the relevant consumers would readily recognize HIP as “the equivalent of” or “substantially synonymous” with “health innovation platform.” See e.g., *Modern Optics Inc. v. The Univis Lens Co.*, 234 F.2d 504, 506 (C.C.P.A. 1956) (“While the record shows there are individuals to whom the letters ‘CV’ constitute a generic designation of trifocal lenses, we are of the opinion it has not been established that such is the rule rather than the exception.”). Moreover, Applicant notes that Acronym Finder provided 64 possible meanings for the abbreviation HIP (Exhibit C), none of which is “health innovation platform.” This evidence further supports Applicant’s assertion that the relevant consumers would not understand HIP to be “substantially synonymous” with “health innovation platform.”

The record fails to demonstrate that the relevant consumer viewing the HIP acronym in connection with applicant’s services will recognize it as the equivalent of “health innovation platform.” Accordingly, Applicant’s Mark is not merely descriptive.

D. Doubt must be resolved in favor of the Applicant.

Any doubt as to whether Applicant’s mark is merely descriptive should be resolved in favor of Applicant. In *In re Intelligent Med. Sys., Inc.*, 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987), the Board remarked on the number of occasions that “there is a thin line between a suggestive and a merely descriptive designation, and where reasonable men may differ, it is the Board’s practice to resolve the doubt in applicant’s favor. . . .” See also *In re the Rank Org. Ltd.*, 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984). Applicant’s arguments and attached evidence have raised significant doubts as to the alleged descriptiveness of the applied-for mark. Accordingly, Applicant respectfully submits that the withdrawal of the refusal to register is not only warranted, but is within the Examining Attorney’s permissible exercise of discretion.

E. Conclusion

For all of the above-stated reasons, Applicant’s mark is suggestive, and not merely descriptive, of Applicant’s services. As such, Applicant respectfully requests withdrawal of the refusal to register.

II. Identification of Services

Applicant hereby amends its identification of services as follows:

Business management consulting services; business strategic planning services; business consulting services in the fields of management consulting specializing in strategic innovation and growth in the medical and healthcare industries; business consulting services, namely, providing assistance in development of business strategies, industry expertise and creative ideation in the medical and healthcare industries; business management consulting, strategic planning and business advisory services provided to the medical and healthcare industries; providing **business** information in the fields of

business innovation process, business management, consulting and advisory services,
strategic planning and business opportunities in the medical and healthcare industries