


# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p><b>Applicant:</b> HCR Healthcare, LLC</p> <p><b>Serial Number:</b> 88/491,533</p> <p><b>Filed:</b> June 27, 2019</p> <p><b>Mark:</b> GIVE WHERE YOU LIVE HEARTLAND (&amp; Design)</p> 	<p>Simon Teng Examining Attorney</p> <p>Law Office 105</p>
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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

## RESPONSE TO OFFICE ACTION

### I. Identification of Goods and Services

The Examining Attorney has advised that portions of the identifications of services in Class 36 are indefinite and must be clarified and/or reclassified. In response, Applicant has amended the identifications of services as follows:

**Class 36:** Charitable fundraising services; charitable fundraising services by means of selling goods to raise funds; charitable fundraising services by means of organizing, arranging, and conducting special events; charitable fundraising services for relating to seniors with food insecurities

### II. Request for Disclaimer

The Examining Attorney has requested that Applicant disclaim the wording 'GIVE WHERE YOU LIVE' and Applicant agrees:

**No claim is made to the exclusive right to use GIVE WHERE YOU LIVE separate and apart from the mark as shown.**


### III. Mark Description

The Examining Attorney has requested that Applicant submit an amended description of the mark because the current description is incomplete and does not describe all significant aspects of the mark. In response, Applicant has amended the mark description to read as follows:

The mark consists of five stylized buildings of varying heights outlined in black. The buildings overlap a stylized blue colored cloud. The left most building features an orange gable roof, a round window outlined in black and colored blue, and a blue door outlined in black. To the right of this building is a green colored stylized building featuring green colored windows outlined in black, a stylized awning alternating between the colors orange and yellow, and a green colored door outlined in black. The center building is colored white and features a gable roof outlined in black and colored white and a stylized heart shape outlined in black and colored white appears in the top portion. Below the heart is the stylized words “GIVE WHERE YOU LIVE” in a stacked formation outlined in black. “GIVE” is colored blue. “WHERE YOU” is colored black. “LIVE” is colored yellow. To the right of the center building is a stylized narrow vertical building colored blue featuring a spire-like roof colored orange and outlined in black, a stylized clock outlined in black and colored blue, and windows and a door outlined in black and colored blue. The right most building features a gable roof outlined in black and colored yellow and a window outlined in black and colored blue. Behind the right most building is a stylized tree outlined in black featuring black colored branches and green leaves. The right portion of the tree features shading that is colored white. At the very bottom is the stylized word “HEARTLAND” in black.

### IV. Trademark Act Section 2(d), Likelihood of Confusion

The Examining Attorney has refused registration of the applied-for mark on grounds that applied-for mark is likely to be confused with U.S. Trademark Registration No. 4,087,329 for the




stylized mark:  (the “Cited Registration”). Applicant believes no reasonable likelihood of confusion exists and respectfully requests that the Examining Attorney reconsider the refusal in light of the following remarks.

#### **DISSIMILARITY OF THE MARKS & WEAKNESS OF THE CITED REGISTRATION**




The Examining Attorney contends that the applied-for mark is likely to be confused with the Cited Registration because both marks contain the literal element GIVE WHERE YOU LIVE. *See* Office Action, pg. 4. However, where, as here, the overlapping element is suggestive or otherwise weak, the other distinguishing elements may carry more significance with respect to

the commercial impressions created by the marks. TMEP § 1207.01(b)(vii); *See e.g., In re Bed & Breakfast Registry*, 229 U.S.P.Q. 818 (Fed Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *see also Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 U.S.P.Q. 414 (TTAB 1962) (finding no likelihood of confusion between THERM-A-JUG and THERMEX on the basis that “THERM” is suggestive of a heat-insulating product).

As the Examining Attorney aptly noted, GIVE WHERE YOU LIVE—as a standalone phrase—is a very weak indicator of source. TMEP § 1207.01(d)(iii) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005) (“If the evidence establishes that the consuming public is exposed to third-party use of a similar mark on similar [services], it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’”)). The weakness of phrase is evidenced by the fact that there are at least 35 different entities that are currently using GIVE WHERE YOU LIVE in connection with charitable fundraising services. Set forth below and attached as **Exhibit A** is a representative sample of such uses.<sup>1</sup>

Mark:	URL:
	<p><a href="https://givewhereyoulive.wixsite.com/miamicounty">https://givewhereyoulive.wixsite.com/miamicounty</a></p>
	<p><a href="https://www.unitedwaynorman.org/givenorman">https://www.unitedwaynorman.org/givenorman</a></p>
	<p><a href="https://bit.ly/2WCcPWf">https://bit.ly/2WCcPWf</a></p>

<sup>1</sup> The marks listed herein are in addition to the sixteen uses of GIVE WHERE YOU LIVE that the Examining Attorney identified in the Office Action.

Mark:	URL:
	<a href="https://www.columbusparkfoundation.org/">https://www.columbusparkfoundation.org/</a>
<b>GIVE WHERE YOU LIVE</b>	<a href="https://bit.ly/2UdxUEJ">https://bit.ly/2UdxUEJ</a>
	<a href="https://www.givewhereyoulivecollier.org/">https://www.givewhereyoulivecollier.org/</a>
	<a href="https://www.capagency.org/gala/">https://www.capagency.org/gala/</a>
GIVE WHERE YOU LIVE	<a href="https://www.bgcozarks.org/gwyl/">https://www.bgcozarks.org/gwyl/</a>
GIVE WHERE YOU LIVE	<a href="https://www.givewhereyouliveday.com">https://www.givewhereyouliveday.com</a>
GIVE WHERE YOU LIVE	<a href="https://bit.ly/3bjGYh3">https://bit.ly/3bjGYh3</a>
GIVE WHERE YOU LIVE	<a href="https://hpcfil.org/give-where-you-live-fundraiser/">https://hpcfil.org/give-where-you-live-fundraiser/</a>
GIVE WHERE YOU LIVE	<a href="https://bit.ly/3dtJ9Rl">https://bit.ly/3dtJ9Rl</a>
GIVE WHERE YOU LIVE	<a href="https://www.unk.edu/kso/support/give_where_you_live.php">https://www.unk.edu/kso/support/give_where_you_live.php</a>
GIVE WHERE YOU LIVE	<a href="https://bit.ly/2Wyuv58">https://bit.ly/2Wyuv58</a>
GIVE WHERE YOU LIVE	<a href="https://www.themattandmollyteam.com/give-where-you-live/">https://www.themattandmollyteam.com/give-where-you-live/</a>
GIVE WHERE YOU LIVE	<a href="https://2415realty.com/give">https://2415realty.com/give</a>
GIVE WHERE YOU LIVE	<a href="https://cbgiving.com">https://cbgiving.com</a>
GIVE WHERE YOU LIVE	<a href="https://givehcgrowhc.org/">https://givehcgrowhc.org/</a>

There is also a state registration for GIVE WHERE YOU LIVE (for administration of charitable grants and philanthropic funds) that has been peacefully coexisting with the Cited Registration since at least as early as January 1, 2010. *See Exhibit B.* Based on the foregoing, it is reasonable to infer that subsisting ‘GIVE WHERE YOU LIVE’ marks—many of which are identical—have managed to coexist without confusion because of the marketplace dilution, the differences among the respective services, and/or the distinguishing matter in each mark. *American Hosp. Supply Corp. v. Air Products Chemicals, Inc.*, 194 U.S.P.Q. 340 (TTAB 1997) (noting that widespread usage of a term or common feature indicates that a term has a normally understood meaning or suggestiveness in the trade, and that marks containing the term or feature have been registered for the same or closely related goods or services because the remaining

portions of the marks are sufficient to distinguish the marks as a whole from one another). The peaceful coexistence of several ‘GIVE WHERE YOU LIVE’ marks also strongly suggests that no one entity can claim broad rights in this phrase, and that registration of Applicant’s design mark is unlikely to cause confusion with the Cited Registration.

Applicant further submits that the Examining Attorney has discounted the importance of the other elements in Applicant’s mark. *In re National Data Corp*, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (“It is improper to dissect the marks and focus on one portion instead of the total commercial impression.”). To begin with, the marks have a different number of words (4 vs. 5) and syllables (5 vs. 7), both of which create differences in how the marks sound and are pronounced. The prominent stylization, distinctive font, and graphical elements in Applicant’s mark—none of which overlap with the Cited Registration—also create a meaningful visual distinction, especially compared to the commercial manner in which the registrant displays its mark. *See Exhibit C*; *see also Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (C.C.P.A. 1974) noting that it is improper to ignore any portion of a composite mark); *In re Electrolyte Labs., Inc.*, 920 F.2d 645, 647 (Fed. Cir. 1990) (“[T]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.”). The inclusion of the HEARTLAND term, which is suggestive of Applicant’s Midwest roots, and which Applicant has continuously used throughout the U.S. for nearly 45 years, also mitigates the risk of consumer confusion. *See Exhibit D*. Indeed, because of Applicant’s longstanding ownership and extensive use of its family of HEARTLAND marks—which is now comprised of nine federal registrations—the public has come to recognize marks containing the HEARTLAND term as being uniquely associated with Applicant. *See Exhibit E*.

Given the significant differences in sight, sound and meaning, the crowded field of similar ‘GIVE WHERE YOU LIVE’ marks, and the fact that numerous prior decisions have held no likelihood of confusion to exist in circumstances similar to those here, Applicant respectfully submits that the differences in the marks themselves are sufficient to preclude any reasonable likelihood of confusion. *See e.g., M2 Software, Inc. v. M2 Communications, Inc.*, 78 U.S.P.Q.2d (Fed. Cir. 2006) (finding no likelihood of confusion between M2 and M2 Communications, even with the disclaimer of “communications,” for interactive CD-ROMS); *see also In re Electrolyte*

*Laboratories*, 920 F.2d 645 (holding “K+ and Design” for a dietary potassium supplement not confusingly similar to “K+EFF” for a dietary potassium supplement).<sup>2</sup>

**V. Conclusion**

In view of the foregoing, and having responded to all issues raised in the Office Action, this application is believed to be in condition for publication, and reconsideration and favorable action are respectfully requested. If it is determined that the application is not in condition for allowance, the Examining Attorney is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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<sup>2</sup> The USPTO has also found, on multiple occasions, that virtually identical marks for identical, overlapping or related charitable services such as: (a) GIVE LIFE [Serial No. 87/411,410] and GIVE LIFE A CHANCE [Reg. No. 5,156,476]; (b) PROJECT GOOD [Reg. No. 5,130,267] and PROJECT GOOD GIFT [Reg. No. 3,682,463]; and (c) BE GOOD [Reg. No. 5,942,224] and BE GOOD - DO GOOD [Reg. No. 4,556,626], are not likely to cause consumer confusion. As a result, and because the aforementioned marks are far closer in appearance than the applied-for mark and the Cited Registration, Applicant respectfully submits that a similar finding is warranted here. *See Exhibit F.*