

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: January 17, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HCA International Limited

Serial No. 85103030

Stephen A. Zemanick of Dorsey & Whitney LLP for HCA International Limited.

Evelyn Bradley, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Lykos and Gorowitz, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

HCA International Limited (“applicant”) filed an application to register the mark displayed below



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on the Principal Register for various goods and services in International Classes 16, 36, 42, and 44.¹

The Trademark Examining Attorney refused registration of applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of applicant's identified goods and services.

During *ex parte* prosecution, applicant conceded that the wording in its mark is merely descriptive and disclaimed the phrase "A MEMBER OF THE LEADERS IN ONCOLOGY CARE NETWORK" apart from the mark as shown. Thus, the sole issue on appeal is whether the stylization or design elements of applicant's mark render it inherently distinctive.

Applicant argues that the sizing of the wording, variations in capitalization and use of bold type text within its mark create a distinctive commercial impression apart from the disclaimed wording. The examining attorney, however, maintains that "the mark appears in ordinary and non-distinctive font," and that "the impact of the stylization of the lettering is lost in the descriptive significance of the wording." Appeal Brief, unnumbered p. 6.

It is well settled that when words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6 of the Trademark Act. *See In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977); *In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976) ("*Jackson Hole*"). Both applicant and the examining attorney have discussed in their briefs various cases

¹ Serial No. 85103030, filed August 9, 2010, pursuant to Sections 1(b) and 44(e).

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involving this issue.² See, e.g., *In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997); *In re Bonni Keller Collections, Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987); *In re American Academy of Facial Plastic Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002). While acknowledging that inquiries of this type are subjective and fact specific, here we find the *Jackson Hole* case to be analogous. In that case, applicant applied to register the mark shown below



with a disclaimer of the wording JACKSON HOLE. The examining attorney refused registration of the mark as primarily merely geographically descriptive. The Board reversed the refusal to register, agreeing with the applicant's position that "its mark consists not only of the mere geographical designation but also of the letters 'JH' displayed in a distinctive and prominent fashion so as to create a commercial impression in and of themselves..." *Jackson Hole*, 190 USPQ at 176. In particular, the Board noted

that the letters "JH" are twice the size of the other letters; that unlike any of the other letters, they are partly joined together, creating the visual impression of a monogram; and that they are set down from the

² For a thorough analysis of this issue and review of various marks consisting of descriptive wording shown in stylized lettering, see *In re Sadoru Group, Ltd.*, __ USPQ2d __ (TTAB 2012).

rest of the letters, which positioning has the effect of highlighting the “JH” couplet.

Id.

Similarly, in the mark before us, we find that the vertical arrangement in bold text of each of the initial letters of the main words in the phrase “LEADERS IN ONOCLOGY CARE” – the “L,” “O” and “C” – to be prominent and striking, to such a degree that they create a separate and inherently distinctive commercial impression consisting of the acronym “LOC.”

The determination regarding whether stylization is sufficient to carry a mark is “in the eyes of the beholder,” *Jackson Hole*, 190 USPQ at 176, and “a necessarily subjective one.” *In re Bonni Keller Collections, Ltd.*, 6 USPQ2d at 1227. We find that the impression conveyed by applicant’s mark includes the prominent display of “LOC” as an acronym, and that this impression is separate from the disclaimed wording in the mark. The examining attorney did not submit any evidence that “LOC” is a commonly recognized descriptive acronym, so based on the record before us we can conclude that it is a coined term. As such, we find the mark as a whole to be inherently distinctive.

Decision: The refusal to register under Section 2(e)(1) is reversed.