

Case No.: INJEC-026T
Trademark Appln.
Cert. Of Mlg.:

12-30-2002
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	INJECTIMED, INC.)	Law Office:	105
Serial No.:	76/212,813)	TM Examiner:	
Filed:	February 20, 2001)	Verna B. Ririe	
Mark:	NO EXPOSURE TIME)		

APPELLANT'S BRIEF ON EX PARTE APPEAL

Box TTAB
No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir/Madam:

I. STATEMENT OF FACTS

Appellant seeks registration of the trademark "NO EXPOSURE TIME" for "shielded medical needles; safety device for hypodermic needles" on the Principal Register pursuant to 15 U.S.C. Section 1051. Appellant is appealing from the Final Office Action of the Examining Attorney mailed on April 26, 2002. An oral hearing is not requested.

In the Final Office Action, the Examining Attorney refused registration of the subject mark under Section 2(e)(1) of the Trademark Act on grounds that such mark merely describes the subject matter of Appellant's goods. More specifically, the Examining Attorney took the position that Appellant's mark identifies a desired feature of its goods, namely, limiting a needle's "exposure time".

In response to the Final Office Action refusing registration, Appellant filed a Notice of Appeal in the United States Patent and Trademark Office, which was mailed on October 28, 2002. Therefore, the subject Brief is timely filed.

II. ARGUMENTS

As previously specified, Appellant's trademark is the mark "NO EXPOSURE TIME." Due to the nature of Appellant's mark as a whole, which is at most suggestive, the Examining Attorney's refusal to register the subject mark under Section 2(e)(1) of the Trademark Act is misplaced and inappropriate in this application.

As set forth in the Initial Office Action, the Examining Attorney analyzed "that Appellant's mark 'NO EXPOSURE TIME' identifies a desired feature of the applicant's goods." See, Initial Office Action, page 2. In particular, she noted that "limiting the amount of 'exposure time' to needle is a safety concern for medical workers." Based upon this reasoning, the

Examining Attorney contemplated that "a needle or a safety device for a needle which eliminates the exposure time, or features 'no exposure time,' would be favored by those in the medical profession." Id. Only through undergoing such compounding analytical deducement was she able to attempt at making the assertion that Appellant's mark is merely descriptive of its goods.

In the Final Office Action, the Examining Attorney maintained her refusal based upon a continuing allegation of mere descriptiveness. However, Appellant respectfully disagrees with such grounds of rejection, and contends that a careful and complete analysis of the case-at-hand compels a determination that the subject mark does not merely describe its associated goods, but at least suggests them.

III. APPELLANT'S MARK DOES NOT MERELY DESCRIBE ITS GOODS, BUT AT LEAST SUGGESTS THEM.

A. The Patent and Trademark Office Has Failed To Meet Its Evidentiary Burden To Prove Mere Descriptiveness.

The United States Patent and Trademark Office bears the burden of establishing a *prima facie* showing of mere descriptiveness within the meaning of 15 U.S.C. Section 1052. In re Gyulay, 820 F.2d 1216, 3 U.S.P.Q.2d 1009 (Fed Cir. 1987). Doubt is resolved in favor of Appellant during *ex parte* prosecution, on the assumption that Appellant's competitors have the opportunity to oppose the

registration once published. In re Micro Instrument Corp., 222 U.S.P.Q. 252 (T.T.A.B. 1984).

To establish Appellant's mark as merely descriptive, the Patent and Trademark Office must provide evidence to demonstrate that the mark as a unitary phrase communicates a clear understanding of characteristics of Appellant's goods, without any need for analysis of the various words and without any need for extensive thought or imagination. See, Gilson, J., Trademark Protection And Practice, § 2.03 at 2-69 to 2-71 (1993); Hawes, James E., Trademark Registration Practice, § 704 at 7-12 (1996). It is not sufficient to simply establish that certain words or portions of the mark have some independent descriptive meaning in and of themselves. In re Siebert & Sons, Inc., 165 U.S.P.Q. 400 (T.T.A.B. 1970).

Throughout the subject prosecution, the Examining Attorney has merely used three excerpts from a computerized database for the proposition that Appellant's mark "NO EXPOSURE TIME" identifies a desired feature of the goods associated therewith. See, Initial Office Action, pages 3-5. However, in view of the standard as discussed above, Applicant respectfully submits that the cited excerpts fail to meet such standard in contending that the proposed mark is merely descriptive of the goods cited in the registration.

In particular, the usage of the terms "exposure time" in the Examining Attorney's three excerpts is inconsistent with the

reasons set forth for refusing registration of the proposed mark. More particularly, the terms "exposure time", as portrayed in the three excerpts, are solely used as a measurement of time.

Based on this usage of the terms, one cannot reasonably derive a clear understanding, or even a general one, that such terms signify a type of goods directed to shielded medical needles. Appellant's mark and the goods associated therewith clearly extend far beyond than mere measurement of time in that the mark is utilized in connection with medical devices, and more particularly medical needles, and even more particularly shielded medical needles. Thus, the cited excerpts that fail to capture the true essence of Applicant's goods cannot be used as evidentiary supports for the Examining Attorney's mere descriptiveness rejection.

The Examining Attorney appears to be in tacit agreement with such contention. As mentioned above, she continuously used her three excerpts to indicate that a prolonged amount of exposure time poses a problem, and it is favorable to limit such time in order to alleviate this problem. Only through presenting such complex analytical deducement was the Examining Attorney able to attempt to make the assertion that Appellant's mark is merely descriptive of its goods. Such rationale, however, is akin to a tacit admission that the cited excerpts fail to make the requisite connection between Appellant's mark and its associated goods. This should serve as an indication that the proposed mark does not immediately

communicate a clear understanding, without any need for analysis, of the nature or purpose of Appellant's goods and a compounding analytical deducement is at least needed to make the connection to the true nature of Appellant's goods. Thus, it is respectfully submitted that the Examining Attorney failed to demonstrate a *prima facie* showing of mere descriptiveness.

B. Appellant's Mark Is Not Merely Descriptive.

A term must directly provide some distinct information of characteristics of a product/service in order to be descriptive. Bliss Craft of Hollywood v. United Plastics Company, 294 F.2d 694 (2d Cir. 1961); Robert Bruce, Inc. v. Sears Roebuck & Company, 343 F. Supp. 1333 (E.D. Pa. 1972). With respect to composite marks, unless such mark is one-hundred percent (100%) descriptive, the mark as a whole is not "merely" descriptive. Rather, in order to be "merely" descriptive under the Trademark Act § 2(e)(1), such mark as a whole must immediately and clearly tell the average prospective purchaser only what the products/services are.¹ In re

¹ In holding that the term "Technology" used in connection with computer components is not merely descriptive, the Federal Circuit adopted the view that "Technology" is a very broad term which includes many categories of goods, and does not convey an immediate idea of the characteristics of Applicant's goods. In re Hutchinson Technology, 852 F.2d 552 (Fed Cir. 1988). Moreover, in holding that "The Driving Force" is not merely descriptive of a service of supplying leased drivers, the Court asked the question, "How does the term 'The Driving Force' immediately convey the notion of truck drivers, rather than, for example, personal chauffeurs, limousine drivers, bus drivers, taxicab drivers, etc." Manpower, Inc. v. Driving Force, Inc., 212 U.S.P.Q. 961 (T.T.A.B. 1981).

Disc Jockeys, Inc., 23 U.S.P.Q.2d 1715 (T.T.A.B. 1992); In re Richardson Inc. Co., 511 F.2d 559 (C.C.P.A. 1975).

Appellant respectfully submits that a consumer encountering the mark "NO EXPOSURE TIME" in the marketplace would not immediately know that Appellant was providing shielded medical needles. As thoroughly mentioned above, the terms utilized in the proposed mark likely incline the consumer to form a thought in regards to a measurement of time. Any inclination towards the true nature of Appellant's goods appears to be unsubstantial, and requires at least a compounding analytical thought to arrive at some kind of knowledge regarding Appellant's goods. Even assuming any secondary implications, the consumer in the marketplace will not logically formulate an immediate and clear reference only to the true nature of Appellant's goods, especially when the proposed mark could just as easily be taken by consumers to apply to various number of different products such as, for example, those that are associated with film exposure (such as X-ray film) or skin exposure to radiation (such as UV light).

C. Appellant's Mark Is At Least Suggestive.

A term is suggestive if it requires imagination, thought or perception to reach a conclusion as to the nature of the goods/services. Kendall-Jackson Winery, Ltd. v. E. & J. Gallo

Winery, 150 F.3d 1042 (9th Cir. 1998); Stix Products, Inc. v. United Merchants Manufacturers, Inc., 295 F. Supp. 479 (S.D.N.Y. 1968). If the mental leap between the mark and the product's/service's attributes is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. McCarthy On Trademarks (3d Ed. 1992) at § 11.21[1], pg. 108-109, citing Investacorp., Inc. v. Arabian Investment Banking Corp., 931 F.2d 1519 (11th Cir. 1991).

For example, various courts held that the following marks are suggestive through utilizing such approach, that is, they all required imagination, thought or perception as to the respective goods associated therewith:

- 1) "CITIBANK" for an urban bank. Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540 (11th Cir. 1984);
- 2) "COPPERTONE" for sub tan oil. Douglas Labs, Corp. v. Copper Tan, Inc., 210 F.2d 453 (2d Cir.), cert denied, 347 U.S. 968 (1954);
- 3) "LOC-TOP" for bottle closure caps. In re Polytop Corp., 167 U.S.P.Q. 383 (T.T.A.B. 1970); and
- 4) "MATERNALLY YOURS" for maternity clothing shop. Maternally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538 (2d Cir. 1956).

The proposed mark "NO EXPOSURE TIME" is similar to the above exemplary marks in that it does not directly convey any particular

information about Appellant's goods, namely, shielded medical needles. At least, a creative indirect approach, or an explanation, is needed to make any connections thereto. Therefore, Appellant submits that such occurrence can only be the derivation of a formulated thought process which strongly indicates that its mark is at least suggestive of its goods, and not merely descriptive.

IV. CONCLUSION

The analysis of the case-at-hand strongly favors finding of non-descriptiveness. As such, it is respectfully submitted that the Examining Attorney's refusal to register is inappropriate and cannot be sustained. Accordingly, a reversal of the refusal to register Appellant's mark is respectfully requested.

Respectfully submitted,

Date: 12/27/02

By: 

Matthew A. Newboles
Registration No. 36,224
STETINA BRUNDA GARRED & BRUCKER
75 Enterprise
Suite 250
Aliso Viejo, CA 92656
(949) 855-1246

Attorney for Appellant
InjectiMed, Inc.

TTAB

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Applicant:	INJECTIMED, INC.)	Law Office:	105
Serial No.:	76/212,813)	Examiner:	
Filed:	FEBRUARY 20, 2001)		VERNA BETH RIRIE
For:	NO EXPOSURE TIME)		

TRANSMITTAL

BOX TTAB - NO FEE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir/Madam:

Enclosed for filing in the above-referenced matter please find the following:

1. APPELLANT'S BRIEF ON EX PARTE APPEAL (in triplicate);
2. Certificate of Mailing; and
3. Return postcard.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: 12/27/02

Customer No.: 007663

By: *[Signature]*
 Matthew A. Newboles
 Registration No. 36,224
 STETINA BRUNDA GARRED & BRUCKER
 75 Enterprise, Suite 250
 Aliso Viejo, CA 92656
 (949) 855-1246

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