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**TTAB**

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

9 In re Application of:

10 JOSEPH S. PONGRATZ

11 Serial No.: 76/697006

12 Mark: STERNALVEST

13 Filing Date: April 22, 2009  
14

**APPLICANT'S MAIN BRIEF ON  
APPEAL**

15  
16 Pursuant to Rule 1203.02(a), Trademark Trial and Appeal Board Manual of Procedures,  
17 Applicant respectfully submits its Main Brief on Appeal.

18 **I.**

19 **Procedural History**

20 On April 22, 2009, Applicant filed a new application to register its STERNAL VEST  
21 mark in Class 10 for:

22 "Therapeutic thoracic/abdominal compression vest used for the purposes of  
23 stabilizing, immobilizing, and compressing any type of medical condition  
24 including an open wound or closed medical condition or for any  
preoperative and/or postoperative surgical procedure".

25 Applicant has been using the STERNAL VEST mark in commerce since August 1,  
26 2008. On February 24, 2010, the Examining Attorney issued an Office Action in which he



1 issued his final refusal to register Applicant's mark under Trademark Act Section 2(e)(1), 15  
2 U.S.C. § 1052(e)(1). The sole basis of the Examiner's Final Refusal was his contention that  
3 Applicant's mark is "merely descriptive of the applicant's goods." Applicant is appealing that  
4 final refusal.

## 5 II.

### 6 Introduction

7 The Examiner's refusal to register Applicant's STERNALVEST.COM mark on the  
8 grounds that it is merely descriptive was erroneous. As set forth below, the mark is clearly *not*  
9 "merely" descriptive, but rather is at most suggestive of Applicant's goods and thus entitled to  
10 trademark protection without proof of secondary meaning. The TTAB should reverse the  
11 Examiner and permit the mark to proceed to publication.

## 12 III.

### 13 Argument

#### 14 Applicant's STERNALVEST.COM Mark Is Not Descriptive

15 The words "STERNAL VEST" clearly do more than to convey "an immediate idea of  
16 the ingredients, qualities or characteristics of the goods." Stix Products, Inc. v. United  
17 Merchants & Manufacturers Inc., 295 F.Supp. 479, 488, 160 U.S.P.Q. 777, 785 (S.D.N.Y.  
18 1968). There is **nothing** in the mark that is descriptive of the key feature of Applicant's goods  
19 -- that it is a *medical* product used to *stabilize, immobilize and compress* post-surgical wounds.

20 Rather, Applicant's mark is at most suggestive, since the phrase "requires imagination,  
21 thought and perception to reach a conclusion as to the nature of goods. "[S]uggestive marks  
22 are entitled to trademark infringement protection, without the necessity of considering  
23 elements of 'secondary meaning.'" Maidenform, Inc. v. Munsingwear, Inc., 1977 U.S. Dist.  
24 LEXIS 14726, 8-9 (S.D.N.Y. 1977) (finding that UNDERNEATH IT ALL was not  
25 descriptive for underwear and thus was entitled to trademark protection). See also Colgate-  
26 Palmolive Co. v. House of Men, Inc., 143 U.S. P.Q. 159 (TTAB 1964) (RAPID-SHAVE for

1 shaving cream suggestive); Synergistic Int'l, LLC v. Korman, 402 F. Supp. 2d 651, 660 (E.D.  
2 Va. 2005) (GLASS DOCTOR is not descriptive but suggestive of a glass repair service) aff'd  
3 in part, vacated in part, on other grounds, remanded, 470 F. 3d 162 (4<sup>th</sup> Cir. 2006).

4 The alleged descriptive nature of Applicant' STERNAL VEST mark is further belied  
5 by the fact that if one runs a MEGA news search of the complete LEXIS/NEXIS news  
6 database for the five (5) most recent years from the present date, *one discovers there is not a*  
7 *single article in any of these hundreds of thousands of articles contained in thousands of*  
8 *publications where the word STERNAL is used within two words of VEST.* [See Exhibit 1.] If  
9 the mark were truly descriptive, there would be some instances where the words have been  
10 used together in a descriptive fashion. The words have not been used together in that fashion,  
11 not once.

12 IV.

13 Conclusion

14 STERNALVEST.COM is not a descriptive mark. It is at most suggestive and thus  
15 registerable. The Examiner should be instructed to permit Applicant's mark to proceed to  
16 publication.

17 RESPECTFULLY SUBMITTED this 16<sup>th</sup> day of November, 2010.

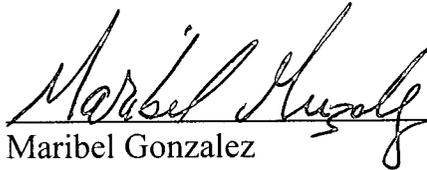
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