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14577-1 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION SERIAL NO. 76697006

MARK: STERNALVEST



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APPLICANT: PONGRATZ, JOSEPH S.

CORRESPONDENT'S REFERENCE/DOCKET NO:

14577-1

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EXAMINING ATTORNEY'S APPEAL BRIEF

The Applicant has appealed the Trademark Examining Attorney's Final Refusal to register the mark "STERNALVEST" on the basis that the applied-for mark merely describes a characteristic of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

STATEMENT OF FACTS

On April 22, 2009 applicant PONGRATZ, JOSEPH S. filed a use based trademark application seeking registration on the Principal Register of the mark STERNALVEST for "therapeutic thoracic/abdominal compression vest used for the purposes of stabilizing, immobilizing, and compressing any type of medical condition including an open wound or closed medical condition or for any preoperative and/or postoperative surgical procedure." in International Class 010.

In the Office Action mailed July 13, 2009 the examining attorney issued a Trademark Act Section 2(e)(1) refusal because the applied-for mark merely describes a characteristic of applicant's goods and required correction to applicant's use dates.

On January 15, 2010 the applicant responded, arguing against the refusal to register the mark on the basis of Trademark Act Section 2(e)(1) and submitted corrected use dates. On February 12, 2010 applicant submitted the required declaration which was not submitted with applicant's January 15, 2010 response. On February 18, 2010 the examining attorney issued a Final Office Action making final the Trademark Act Section 2(e)(1) refusal.

On August 18, 2010 the applicant appealed the examining attorney's Final Refusal to register applicant's mark under Trademark Act Section 2(e)(1).

On November 19, 2010 the appeal was forwarded to the examining attorney for brief.

On December 2, 2010 the case was reassigned to the current examining attorney.

ISSUE

The sole issue for consideration on appeal is whether the applicant's applied-for mark is merely descriptive of a characteristic of applicant's goods within the meaning of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

ARGUMENT

APPLICANT'S APPLIED-FOR MARK IS MERELY DESCRIPTIVE OF APPLICANT'S GOODS BECAUSE IT DESCRIBES A CHARACTERISTIC OF THE GOODS, DOES NOT CREATE A UNIQUE, NON-DESCRIPTIVE MEANING OR COMMERCIAL IMPRESSION, AND PROVIDES NO INCONGRUOUS MEANING AS USED IN CONNECTION WITH GOODS.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Generally, a mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a

descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968).

In this case, both the individual components and the composite result are descriptive of applicant's goods and/or services and do not create a unique, incongruous or nondescriptive meaning in relation to the goods and/or services.

Descriptiveness is considered in relation to the relevant goods. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

The fact that an applicant may be the first and only user of a merely descriptive designation is not dispositive on the issue of descriptiveness where, as here, the evidence shows that the word or term is merely descriptive. *See In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985); TMEP §1209.03(c).

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to

avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

APPLICANT'S MARK

Applicant's mark is **STERNALVEST**, in STANDARD CHARACTER MARK form.

Applicant seeks registration for the goods:

IC 010. US 026 039 044. G & S: THERAPEUTIC THORACIC/ABDOMINAL COMPRESSION VEST USED FOR THE PURPOSES OF STABILIZING, IMMOBILIZING, AND COMPRESSING ANY TYPE OF MEDICAL CONDITION INCLUDING AN OPEN WOUND OR CLOSED MEDICAL CONDITION OR FOR ANY PREOPERATIVE AND/OR POSTOPERATIVE SURGICAL PROCEDURE. FIRST USE: 20030801. FIRST USE IN COMMERCE: 20030801

I. ANALYSIS

Applicant's mark is not suggestive. No imagination or thought is required to determine the nature of Applicant's goods. Instead, "STERNALVEST" immediately identifies the intended use, characteristic and feature of Applicant's goods. Applicant offers therapeutic vests that are worn on or over the sternal region of one's body. Please see record evidence from application comprising Applicant's identification of goods and specimen of use. Furthermore, please see record attachments to the initial and final office actions comprising excerpted third party webpages, dictionary definitions and excerpted webpages from Applicant's website showing the goods in use.

First, applicant's specimen of record and excerpts from applicant's webpage provides evidence of the descriptive nature of the STERNALVEST mark as follows:

“Following sternectomy surgery, many patients ask why they were not fit with this SternalVest following their original heart surgery” [Emphasis added.]

(please see specimen of record submitted with incoming application, pp 2)

“Surgeons – “Excellent thoracic & sternal tissue stabilizer”” [Emphasis added.]

(<http://sternalvest.com> attached to Final Office Action, pp 3)

Here, as emphasized above, Applicant’s specimen of record provides evidence that applicant offers therapeutic vests that are worn on or over the sternal region of one’s body, namely, for use following sternectomy surgery and as a sternal tissue stabilizer.

Second, internet evidence of record provides analogous descriptive use of therapeutic vests in the nature of applicant’s as follows:

“Therapeutic Vest Will Help Children With Autism, ADHD, Anxiety”

[Emphasis added.] (<http://www.sciencedaily.com> attached to Initial Office Action, pp 15)

"The halo-vest protects patients with cervical instability from neurological injury." [Emphasis added.] (<http://thejns.org> attached to Initial Office Action, pp 18)

"Therapeutic Bracing Garments" "Shoulder Stability Vest" [Emphasis

added.] (<http://www.straps.net> attached to Initial Office Action, pp 20)

"A newly designed thorax support vest prevents sternum instability after median sternotomy” [Emphasis added.] (<http://www.sciencedirect.com> attached to Initial Office Action, pp 22)

"Female Post Breast Surgery Compression Vest W/Zipper” [Emphasis added.]

(www.makemeheal.com attached to Initial Office Action, pp 47)

Here, as emphasized above, internet evidence of record provides analogous wording describing therapeutic vests in the nature of applicant's in this case, namely, "Shoulder Stability Vest", "thorax support vest", and "Female Post Breast Surgery Compression Vest". Consequently, in relation to the applied-for goods, consumers are accustomed to encountering the descriptive word VEST paired with additional descriptive words to describe a characteristic of therapeutic vests.

Presentation of the mark as a single combined term does not alter the merely descriptive nature of the wording. A "compound mark," which consists of two or more words combined to create a single word, is merely descriptive if (1) the individual words are descriptive and retain their descriptive meaning within the compound mark, and (2) the compound mark has no unique or incongruous meaning as applied to the goods. See *In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL the equivalent of THE ATL, a common nickname for the city of Atlanta, merely descriptive of publications featuring news and information about Atlanta); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of highly automated cooling towers); *In re Entenmann's, Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990) (holding OATNUT merely descriptive of bread containing oats and hazelnuts), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991); TMEP §1209.03(d).

Finally, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *E.g.*, *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark, or portion thereof, created by combining only descriptive words depends on whether a new and different

commercial impression is created, and/or the mark so created imparts an incongruous meaning as used in connection with the goods. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods, the mark is merely descriptive. *E.g., In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.

Here, Applicant's mere combination of the descriptive words STERNAL and VEST does not automatically create a new nondescriptive word or phrase. A new and different commercial impression is not created nor is there an incongruous meaning as used in connection with applicant's goods. No imagination is required to understand the intended use, characteristic and feature of Applicant's goods, namely, therapeutic vests that are worn on or over the sternal region of one's body, simply put, a sternal vest.

APPLICANT'S ARGUMENTS IN SUPPORT OF REGISTRATION ARE UNPERSUASIVE.

The first and sole user of a merely descriptive designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods.

Applicant argues that the mark must be suggestive because a search on a computerized database fails to show anyone using the wording. The examining attorney respectfully disagrees.

That an applicant may be the first and only user of a merely descriptive designation is not dispositive on the issue of descriptiveness where, as here, the evidence shows that the wording is merely descriptive. See *In re Sun Microsystems, Inc.*, 59

USPQ2d 1084, 1087 (TTAB 2001); In re Acuson, 225 USPQ 790, 792 (TTAB 1985); TMEP §1209.03(c).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract. In re Abcor Dev. Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); see, e.g., In re Polo Int'l Inc., 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); In re Digital Research Inc., 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system); see TMEP §1209.01(b).

Here, there is no question that upon viewing the mark with full knowledge of what Applicant’s goods are, that the average consumer would perceive the mark as merely descriptive for the goods. Applicant offers therapeutic vests for wearing on one’s sternal region. As such, the combined terms, when viewed in relation to the identified goods, directly identifies a significant feature, characteristic, purpose and use of those goods.

The first and sole user of a merely descriptive designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods.

Applicant argues that:

“There is nothing in the mark that is descriptive of the key feature of Applicant’s goods – that it is a *medical* product used to *stabilize, immobilize* and *compress* post-surgical wounds.” (Appellant's brief at p.1)

As such, applicant further argues that the applicant's mark is not merely descriptive under Section 2(e)(1). The examining attorney respectfully disagrees.

For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“[A] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.”) (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). Furthermore, a term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *Goodyear Tire & Rubber Co. v. Cont'l Gen. Tire, Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2003); *In re TMS Corp. of Ams.*, 200 USPQ 57, 58 (TTAB 1978).

Here, as noted above, no imagination is required to understand the intended use, characteristic and feature of Applicant's goods, namely, therapeutic vests that are worn on or over the sternal region of one's body.

CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the refusal of registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), be affirmed.

Respectfully submitted,

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