

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77036122
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant submits the following in response to the Office Action dated October 12, 2007.</p> <p><b>Descriptiveness issue</b></p> <p>The Office has refused registration of the mark on grounds that the mark is descriptive of the services. Applicant submits that its mark is not descriptive. Alternatively, the mark is at least suggestive.</p> <p>The Office has refused registration arguing that the mark, DEC, is descriptive of "Direct Energy Conversion." The Applicant respectfully disagrees with the Office's assessment that DEC is merely descriptive of the Applicant's services and responds as follows.</p> <p>Applicant DOES NOT provide direct energy conversion to consumers. Applicant notes that the internet entries cited by the Office in the Office Action did not relate to, "power generating and/or storage devices, namely, <b>batteries</b> deriving power from nuclear decay processes" and "treatment of radioactive materials and/or porous substrates for use in the fabrication of power generating and/or storage devices, namely, <b>batteries</b> deriving power from nuclear decay processes; consulting and technical advisory services relating to the treatment of radioactive materials and/or porous substrates, and to the fabrication of power generating and/or storage devices, namely, <b>batteries</b> deriving power from nuclear decay processes, (emphasis added)" which are Applicant's listed goods and services.</p> <p>Whether a term is descriptive is determined not in the abstract but, rather, in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. <i>See In re: Bright-Crest, Ltd.</i>, 204 U.S.P.Q. 591 (TTAB 1979).</p> <p>In <i>In re: Gyulay</i>, 820 F.2d 1216 (1<sup>st</sup> Cir. 1987), cited by the Office, the mark the applicant sought to register was "APPLE PIE" in conjunction with potpourri. The product was designed to actually smell like apple pie. In the opinion, the court notes that the Board implicitly found that the purchasers, upon viewing the term "apple pie" used in conjunction with potpourri, would immediately associate the product with the scent of apple pie. In addition, in <i>In re: Bed and Breakfast Registry</i>, 791</p>	

F2d 157 (Fed. Cir. 1986), the descriptive nature of a mark was described as one that would immediately convey to one seeing or hearing it the thought of appellant's services. Further, whether a mark is merely descriptive is a question of fact, determined from the viewpoint of the relevant purchasing public.

The Office also cites several cases to support its argument that the Applicant's mark is descriptive. The Office relies on *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB 1979) in which COASTER-CARDS for coasters that could be mailed were found descriptive, and *In re MetPath Inc.*, 223 U.S.P.Q. 88 (TTAB 1984) in which the mark, MALE-P.A.P., was found descriptive of testing services for detecting for cancer in men.

The mark, DEC, is distinguishable from the words, "Apple Pie" and "Bed and Breakfast Registry," as it does not immediately convey a description of batteries that derive power from nuclear decay processes or consulting related thereto. The standard set out in the aforementioned cases regarding whether a term is descriptive is from the viewpoint of the relevant purchasing public. DEC does not immediately convey to anyone seeing or hearing it the thought of batteries that derive power from nuclear decay processes or consulting related thereto. In fact, in none of the evidence cited by the Office is there any reference to "batteries" or consulting.

Moreover, the mark, DEC, is clearly distinguishable from the marks in *In re Bright-Crest*, and *In re MetPath Inc.* DEC does not convey, immediately or otherwise, the type of goods and services offered by Applicant, as did COASTER-CARDS, which were literally coasters for use as greeting cards for mailing or MALE-P.A.P, which immediately conveyed that the test at issue was designed for men and related to cancer testing, as identified by the designation P.A.P.

While the Office utilizes a handful of print outs from various Web sites that simply mention Direct Energy Conversion in general, none of the print outs mention the acronym, DEC in connection with the goods and services offered by Applicant. Moreover, it is highly questionable that a consumer would even know that DEC is an acronym for Direct Energy Conversion.

Conversely, if the Office were to run a search on the words "Apple Pie" and "Bed and Breakfast" dozens of uses, or perhaps hundreds would appear. This supports the aforementioned cases holding that the common consumer knows the meanings of these words. In fact, apple pie and the smell of apple pie is something that is commonly referred to as "American," and Bed and Breakfast establishments are encountered in most areas. Moreover, unlike "Apple Pie" or "Bed and Breakfast" the acronym DEC or even "Direct Energy Conversion" is not well known. It is highly unlikely that the average consumer would immediately associate the mark DEC with the services offered by Applicant.

Moreover, Applicant respectfully submits that DEC is not merely descriptive, because it is not possible to associate the mark with Applicant's services without a multi-stage reasoning process and additional information. If a multi-stage reasoning process is required to determine attributes of the applicant's services, a mark is not descriptive. See, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, vol. 2, §11:67; *In Re Tennis in the Rand, Inc.*, 199 U.S.P.Q. 808 (9th Cir. 1979). "Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services." TMEP §1209.01(a).

The instant case is more analogous to *Tanel Corp. v. Reebok Int'l, Ltd.*, 774 F.Supp. 49, 16 U.S.P.Q.2d 20354 (D. Mass. 1990) in which the mark, 360°, was found to be suggestive of sports shoes because one must use considerable imagination to remember that 360 is the number of degrees in a

circle, connect that circle to movement and image that the mark connotes the ability to pivot in the shoe for a full circle.

In this case, a consumer will not readily know what DEC stands for, and even if a consumer did know, the consumer would still have to conduct some multi-stage reasoning to determine the operation of Applicant's products. The term, DEC, does not describe in any clear or precise way (or an indirect way), the goods or services offered under this trademark. If the information a mark conveys is indirect or vague, as in this case, and if imagination, thought and additional information are needed to reach a conclusion as to the exact nature of the services then a mark is suggestive and not merely descriptive. *MCCARTHY, Id.*, §11:67.

DEC is also analogous to the mark "Slick Craft" described in *AMF, Inc. v. SleekCraft Boats*, 599 F.2d 341, 349 (9<sup>th</sup> Cir. 1979). The test for suggestiveness is whether a mark sheds some light upon the characteristics of the goods but involves an element of incongruity, and in order to be understood as descriptive, the mark must be taken beyond such a suggestive or figurative sense through an effort of imagination on the part of the observer. *See, General Shoe Corp. v. Rosen*, 111 F2d 95 (4<sup>th</sup> Cir. 1940).

The mark, DEC, is similar to the mark, "slick craft" in *AMF, Inc. v. SleekCraft Boats*, 599 F.2d 341, 349 (9<sup>th</sup> Cir. 1979). In *AMF* the word "slick" was used to depict certain qualities of a boat. The boat was promoted as fast recreational ski boat with a cutting edge hull. *AMF*, 599 F.2d at 350. And the Court found that the word "craft" was a commonly used term for boat. *Id.* at 351. The mark was considered suggestive because it did not readily describe the boat, but required some thought on the part of the consumer. In addition, the image conjured up by the consumer was not the product, the boat, but other images as well. *Id.* at 350.

In this case, as in *AMF*, the consumer must give some thought to all elements of the mark: in this case the meaning of the acronym, DEC, is not likely to be readily known (or known at all) by the purchasing public before making a connection between the mark and Applicant's services. As already mentioned above, descriptive words define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood, and a suggestive mark is one for which a consumer must use imagination or any type of multistage reasoning to understand the mark's significance. Even if DEC is known in meaning to the consuming public it is not descriptive of "power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes" and "treatment of radioactive materials and/or porous substrates for use in the fabrication of power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes; consulting and technical advisory services relating to the treatment of radioactive materials and/or porous substrates, and to the fabrication of power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes." Therefore, the mark must be taken in a suggestive or figurative sense through an effort of imagination on the part of the observer rendering the mark suggestive and not descriptive.

#### SIGNATURE SECTION

RESPONSE SIGNATURE	/rayferrera/
SIGNATORY'S NAME	Raymond Ferrera
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	04/09/2008

AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Wed Apr 09 12:18:43 EDT 2008
TEAS STAMP	USPTO/RFR-66.237.153.98-2 0080409121843706930-77036 122-420fd9e63b95e312cab67 e3f33a057d9ad-N/A-N/A-200 80409121401967626

PTO Form 1960 (Rev 9/2007)

OMB No. xxxx-xxxx (Exp. x/xxxx)

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. 77036122 has been amended as follows:

#### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant submits the following in response to the Office Action dated October 12, 2007.

#### Descriptiveness issue

The Office has refused registration of the mark on grounds that the mark is descriptive of the services. Applicant submits that its mark is not descriptive. Alternatively, the mark is at least suggestive.

The Office has refused registration arguing that the mark, DEC, is descriptive of "Direct Energy Conversion." The Applicant respectfully disagrees with the Office's assessment that DEC is merely descriptive of the Applicant's services and responds as follows.

Applicant DOES NOT provide direct energy conversion to consumers. Applicant notes that the internet entries cited by the Office in the Office Action did not relate to, "power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes" and "treatment of radioactive materials and/or porous substrates for use in the fabrication of power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes; consulting and technical advisory services relating to the treatment of radioactive materials and/or porous substrates, and to the fabrication of power generating and/or storage devices, namely, **batteries** deriving power from nuclear decay processes, (emphasis added)" which are Applicant's listed goods and services.

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#### SIGNATURE(S)

##### Request for Reconsideration Signature

Signature: /rayferrera/ Date: 04/09/2008

Signatory's Name: Raymond Ferrera

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77036122

Internet Transmission Date: Wed Apr 09 12:18:43 EDT 2008

TEAS Stamp: USPTO/RFR-66.237.153.98-2008040912184370

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