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

Proceeding	77201064
Applicant	Prosthodontics Intermedica, P.C.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

IN RE: PROSTHODONTICS INTERMEDICA, P.C.

MARK: NO BONES SOLUTIONS

SERIAL NO.: 77201064

APPLICATION DATE: JUNE 8, 2007

APPLICANT'S MAIN BRIEF IN SUPPORT OF REGISTRATION

Prosthodontics Intermedica, P.C. (“Applicant”), by its undersigned attorneys, hereby submits its Main Brief in Support of Registration as follows:

By Office Action dated July 14, 2010, the Examining Attorney made a final refusal of registration of Applicant’s mark, No Bones Solutions (the “Mark”) under Trademark Act Section 2(e)1 as merely descriptive of the following services: “providing dental examinations, dental implants, and dental implant treatments”. Because the Mark requires imagination, thought, and perception to reach a conclusion as to the nature of the services, and the Mark conveys a unique commercial impression, the Examining Attorney committed an error of law in refusing registration under Section 2(e)1.

A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods. *Abercrombie & Fitch Co. v. Hunting World, Inc.* 537 F.2d 4 (2d Cir. 1976). In order to be more than descriptive, a mark must at require imagination, thought, and perception to reach a conclusion as to the nature of the goods or services. *Id.* Examples of marks that were found to be not descriptive include ICE BREAKERS for a mint-flavored gum, *Nabisco, Inc. v. Warner-Lambert Co.* 220 F.3d 43 (2d Cir. 2000); TIME RELEASE MOISTURIZER for a skin moisturizer, *Estee Lauder Inc. v. The Gap, Inc.*, 108 F3d

1503 (2d Cir. 1997); and CARMAX for the sale of used cars *Circuit City Stores, Inc. v. CarMax, Inc.* 165 F.3d 1047 (6th Cir. 1999). Though it may be a part of the service provided a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable. *See*, TMEP 1209.01(a), quoting, *In re Sutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). In all of these cases the mark may suggest certain aspects of the general industry that the user is involved in but leaves to the imagination the precise nature of the user's business.

More so, in this case the Mark does not even suggest the field of dentistry. Any type of industry could come to mind when a consumer views the Mark. In fact, the Mark, as further described in the specimens of record, is a name for a protocol that involves the use of zygoma implants transecting the sinus in combination with the immediate loading of the implants with a nonremovable prosthesis. The protocol may change, expand or stay as it is within the scope of the services for which Applicant has applied, the same as a registrant for retail store services may sell only books and then add compact discs. The conclusion, though, is inescapable: no consumer of dental services would link the mark to those services without using imagination, thought or perception.

Moreover, the words "NO BONES SOLUTIONS" convey a unique commercial impression when taken together. The lexicon of dental examinations and procedures is considerable and requires the consumer to make several mental leaps to the conclusion that ultimately implants are involved. The Mark is not "IMPLANTS FOR PEOPLE WITHOUT BONES". When perusing dentist advertisements the terms "NO BONES SOLUTIONS" could mean any number of different procedures.

The public cannot identify dentistry or dental implants from the Mark itself, and a the public cannot discern what services in particular as part of dentistry may be offered without further examination. As a result, though some portion of the dental implant services may be revealed by the terms "No Bones" it is not enough to render the Mark merely descriptive. So, from both the perspective of the general consuming public perusing different brands, and in connection with the particular services offered within dentistry the Mark is not merely descriptive, and Applicant respectfully requests reversal of the Examining Attorney's refusal under Section 2(e)1.

Respectfully Submitted,

REGER RIZZO & DARNALL LLP

BY:

A handwritten signature in black ink, appearing to read "Daniel L. Fiore", written over a horizontal line. The signature is cursive and includes a large, sweeping flourish at the end.

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INDEX OF AUTHORITIES

Abercrombie & Fitch Co. v. Hunting World, Inc. 537 F.2d 4 (2d Cir. 1976)

Circuit City Stores, Inc. v. CarMax, Inc. 165 F.3d 1047 (6th Cir. 1999)

Estee Lauder Inc. v. The Gap, Inc., 108 F3d 1503 (2d Cir. 1997)

In re Sutts, 217 USPQ 363 (TTAB 1983)

Nabisco, Inc. v. Warner-Lambert Co. 220 F.3d 43 (2d Cir. 2000)

TMEP 1209.01(a)