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Subject: U.S. TRADEMARK APPLICATION NO. 77201064 - NO BONE SOLUTIONS - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77201064

MARK: NO BONE SOLUTIONS



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Prosthodontics Intermedica, P.C.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's refusal to register the trademark on the ground that it is merely descriptive of applicant's services within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

### **FACTS**

Applicant applied for registration on the Principal Register for the mark "NO BONE SOLUTIONS" for "[d]entistry services, namely, providing dental examinations; dentistry services, namely, dental implant services; dentistry services, namely, providing dental treatment pertaining to dental implants." Registration was refused under Trademark Act Section 2(e)(1) because the applied-for mark merely describes characteristics of the of applicant's services. The examining attorney's evidence in support of the refusal includes dictionary definitions, internet evidence, as well as applicant's promotional materials and statements. This appeal follows examining attorney's final refusal under Section 2(e)(1).

### **ARGUMENT**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. 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).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods and/or services. *See In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

### **THE APPLIED-FOR MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES CHARACTERISTICS OF THE SERVICES**

The applied-for mark “NO BONE SOLUTIONS” merely describes characteristics of applicant’s services that are identified as “[d]entistry services, namely, providing dental examinations; dentistry services, namely, dental implant services; dentistry services, namely, providing dental treatment pertaining to dental implants.”

In determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”).

Here, the descriptive significance of the composite “NO BONE SOLUTIONS” is supported by a review of the definitions of the three individual elements that comprise the applied-for mark. The relevant definitions of the terms “NO”, “BONE”, and “SOLUTION” are:

No: Not any

Bone: The dense, semirigid, porous, calcified connective tissue forming the major portion of the skeleton of most vertebrates.

Solution: The method or process of solving a problem.

[The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company; originally attached to the Office Action of 9/28/07.]

It is well settled that the determination of whether a mark is merely descriptive is considered in relation to the identified goods and services, 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). In this case, in relation to the applicant’s identified dental examination, treatment, and implant services, it is clear that the wording “NO BONE” will be understood by the relevant consumers in the dentistry field as referring to dental services designed for people who have been diagnosed as not having any calcified connective tissue, i.e., “no bone”, available for traditional dental procedures. Furthermore in relation to the applicant’s dentistry services, the term “SOLUTIONS” will be understood by relevant consumers to refer to services that solve dental problems.

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 dentistry services, and do not create any unique, incongruous or nondescriptive meaning in relation to the services. Specifically, the wording "NO BONE" merely identifies the particular dental condition to which the applicant's services pertain, and the word "SOLUTIONS" merely identifies that the dental services are for the purpose of solving dental problems. The words as used in the applied-for mark entirely fail to create any unique, incongruous or nondescriptive meaning in relation to the applicant's dentistry services.

In the final refusal dated July 14, 2010, the examining attorney attached Internet excerpts from websites which show the wording "NO BONE" used in a descriptive manner in the field of dentistry.<sup>1</sup> In particular, the evidence included the following references:

- [www.dental-implants.com](http://www.dental-implants.com): "More Advanced 'No Bone' Grafting procedures" and "No Bone for Implants?" (p.4)
- [www.chicagometrocosmeticimplantdentist.com/no\\_bone.html](http://www.chicagometrocosmeticimplantdentist.com/no_bone.html): "No Bone" (p. 15.)
- [www.michiganreconstructiveimplantdentistry.com/ridge\\_splitting.html](http://www.michiganreconstructiveimplantdentistry.com/ridge_splitting.html): "Solutions for No Bone" and "No Bone for Implants?" (p. 20)
- [www.worksinusa.com/dental-implants/man-with-no-bone-gets-dental-implants-teeth-in-an-hour-pt-2.html](http://www.worksinusa.com/dental-implants/man-with-no-bone-gets-dental-implants-teeth-in-an-hour-pt-2.html): "Man with NO BONE gets Dental Implants/TEETH IN AN HOUR!!" (p.26)
- [www.floridareconstructivedentistry.com](http://www.floridareconstructivedentistry.com): "Lower Jaw No Bone No Teeth" (p. 29)
- [www.icyou.com](http://www.icyou.com): "Woman patient with NO BONE gets Dental Implants at Pi Dental Center!" (p. 31)
- [www.toothnerve.com](http://www.toothnerve.com): "Man with nearly impossible dental condition with little to no bone, receives TEETH IN AN HOUR DENTAL IMPLANTS." (p. 34)
- [www.dentistrytoday.com](http://www.dentistrytoday.com): "No Bone Solutions for the Severely Atrophic Maxilla" (p. 36)

Upon encountering the wording "NO BONE SOLUTIONS" in connection with applicant's dental services, consumers will immediately understand such wording to convey the idea that the dental services feature procedures for those who have no bone available for dental implants. Applicant's competitors have a business need to use the wording "NO BONE SOLUTIONS" to accurately describe and market dental services offered to patients who have little or no bone available for implants.<sup>2</sup>

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<sup>1</sup> Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. See *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

<sup>2</sup> 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

The materials submitted by the applicant, identified as a “professional article” and a “[d]igest circulated to professionals and customers promoting services provided under the mark,” clearly demonstrate that the applicant’s identified services relate to a dental protocol designed for patients who have “no bone”, and/or who have received “no bone” diagnoses. In this context, it is clear that the wording “no bone” merely describes the particular dental condition to which applicant’s dentistry services pertain. In particular, please note the following excerpts from these materials (emphasis supplied):

- “Evaluation of the bone volume confirmed the original ‘**no bone** maxilla’ diagnosis.” [Excerpt from article titled “i-CAT Case of the Month Against All Odds” (One-page specimen submitted on 3/28/2008)]
- “What happens to the patients who have worn dentures for decades with little or **no underlying bone support?**” [Excerpt from article titled “Against All Odds A ‘No Bone Solution™’” in PROSTHODONTIC Insights, A Digest of Recent Trends, techniques and Clinical Concepts of Dental and facial Esthetics, Vol. 20, No. 2, December 2007 (p.2 of the Response to Office Action, 3/28/2008) ]
- “A 67-year-old retired surgeon was referred to the Pi Dental Implant Center by his periodontist and restorative dentist in April 2007 with a prior diagnosis of ‘**no bone** in the maxilla (Figs 1A-C).’” [Excerpt from article titled “Against All Odds A ‘No Bone Solution™’” in PROSTHODONTIC Insights, A Digest of Recent Trends, techniques and Clinical Concepts of Dental and facial Esthetics, Vol. 20, No. 2, December 2007 (p.3 of the Response to Office Action, 3/28/2008)]
- “For patients with **no remaining alveolar bone**, the ‘No Bone Solution™’ protocol demonstrated in this article is an ideal treatment that avoids major bone grafting and the long associated healing and treatment time. The ‘No Bone Solution™’ potentially shortens treatment time to only 3 visits over a 3 month period. It also provides patients with little or **no bone** with a non-removable solid set of teeth in just one day.” [Excerpt from article titled “Against All Odds A ‘No Bone Solution™’” in PROSTHODONTIC Insights, A Digest of Recent Trends, techniques and Clinical Concepts of Dental and facial Esthetics, Vol. 20, No. 2, December 2007 (p.6 of the Response to Office Action, 3/28/2008)]

Based on the above-referenced evidence provided by the applicant, the dentistry services with which applicant uses its applied-for mark pertain to a protocol designed for patients with “**no bone.**” Moreover, the following excerpts demonstrate that the terms “solution” and “solutions” are merely descriptive of dental implant services that solve the dental problems of patients who have experienced bone loss (emphasis supplied):

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215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

- “If adequate bone volume allows, placing tilted implants, or implants in the pterygomaxillary region have been predictable **solutions** for the edentulous maxilla.” [Excerpt from article “No Bone Solutions For The Severely Atrophic Maxilla” in DENTISTRY TODAY, March 2008 (p. 9 of TEAS Petition to Revive Office Action, 6/04/2010)]
- “The Zygomatic Implant technique will allow me to help the patients with advanced bone loss that have been wearing ill fitting dentures for years and have been told by their dentist that they have no **solutions** or that the only **solution** for them is to wear lousy upper denture.” [Excerpt from article dated June 29, 2009 “Indiana Implant Dentist Receives training In Cutting Edge Protocol to Rescue the Denture Sufferers” (p. 56-57 of Final Office Action, 7/14/2010)]

Consumers of applicant’s dentistry services who are patients with little or no bone, will immediately expect that the applied-for mark NO BONE SOLUTIONS is used in connection with dentistry services designed to solve the dental problems of patients with no bone.

**APPLICANT HAS FAILED TO ARTICULATE A NON-DESCRIPTIVE MEANING OF THE APPLIED-FOR MARK**

Applicant has argued against the refusal primarily by asserting that the applied-for mark “requires imagination, thought, and perception to reach a conclusion as to the nature of the services,” (2) that the applied-for mark “conveys a unique commercial impression,” and (3) that the applied-for mark “does not even suggest the field of dentistry.” The examining attorney respectfully disagrees.

Applicant has failed to articulate any reasonable rationale for concluding that dental patients who have little or no bone for dental implants would need to use imagination, thought, or perception to understand that dental services provided in connection with the applied-for mark “NO BONE SOLUTIONS” would be suitable for the dental condition of such patients. A mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983). In this case, the applied-for mark “NO BONE SOLUTIONS” immediately conveys information about the identified dentistry services to dental consumers who have no bone available for dental implants, namely, that the dentistry services are suitable for dental patients who have been diagnosed as having no bone available for traditional dental implantation services.

Applicant's assertion that the applied-for mark "conveys a unique commercial impression" is unsupported and therefore is of little weight. Whereas the examining attorney has established that the individual components as well as the composite "NO BONE SOLUTIONS" are descriptive of applicant's dentistry services that pertain to those who have been diagnosed as having no bone available for dental implants, the Applicant has failed to articulate any reasonable unique, incongruous or nondescriptive meaning of the wording in relation to the identified dentistry services. Although applicant has speculated that "the terms 'NO BONES SOLUTIONS'[sic] could mean any number of different procedures", applicant has not backed up this allegation with any concrete examples of a reasonable non-descriptive meaning of the wording in relation to the identified services. Applicant has not articulated any rationale under which it would be reasonable to believe that dental consumers who have had diagnoses of having no bone available for implantation would perceive the wording "NO BONE SOLUTIONS" as having a non-descriptive meaning in relation to dentistry services.

Further, applicant's argument that the public "cannot identify dentistry or dental implants" from the applied-for mark is without merit and ignores the principle that the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, 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). Within the context of applicant's particular dental services, consumers will immediately recognize that applicant provides dental procedures that resolve the problems of dental patients who have no remaining bone.

### **CONCLUSION**

For the foregoing reasons, the refusal to register on the basis of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), for the reason that the applied-for mark is merely descriptive of the identified services, should be affirmed.

Respectfully submitted,

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