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

Proceeding	77377330
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Dune Medical Devices Ltd.

Serial No. 77/377,330q

Trademark Examining Attorney:

J. Brendan Regan

Filed: January 22, 2008

Law Office 113

Mark: **MARGINPROBE**

APPLICANT'S APPEAL BRIEF

Applicant, by its attorneys, hereby submits this brief in support of its appeal filed September 17, 2010. For the reasons set forth below, Applicant respectfully requests that the Board reverse the refusal to register MARGINPROBE on the grounds that the mark is merely descriptive of the recited goods and pass Applicant's mark to publication.

I. BACKGROUND

Applicant seeks registration of the mark MARGINPROBE for "medical device, namely, a tissue characterization device for use in surgical procedures" in Class 10.¹ Registration has been refused on the grounds that MARGINPROBE is descriptive of the goods recited in Applicant's application.

In the first Office Action dated September 22, 2009, the Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act based on a determination that the mark is

¹ Application Serial No. 77/377,330 filed January 22, 2008.

merely descriptive. Specifically, the Examining Attorney concluded that MARGINPROBE would be immediately understood by prospective customers as “probes for use at (or ascertaining) the margins of tumors.”

On March 17, 2010, Applicant responded to the Office Action. Applicant argued that its mark for which there is no dictionary definition, is at best suggestive of Applicant's devices, and that the Examiner's evidence consisting of Internet search results referencing Applicant's medical devices are not supportive evidence of a descriptiveness refusal. Further, Applicant referenced a number of third party composite marks that include the term PROBE within the mark for medical devices in Class 10, as evidence that PROBE formative marks for said types of goods are considered suggestive rather than descriptive. In response to the Examiner's specific inquiries, Applicant also advised the Examining Attorney that its medical device is not used at margins, for determining margins, or obtaining margins. Rather, Applicant's device under the applied for mark is a hand-held probe pressed against the freshly excised resection surfaces of lumpectomy specimens to aid in the selection of tissue abnormalities for excision. Finally, Applicant informed the Examining Attorney that MARGINPROBE has been registered in Israel, Korea, Japan and in the European Union.

On April 6, 2010, the Examining Attorney issued a final refusal on descriptiveness grounds, maintaining that even though Applicant's device is not used for measuring margins, the fact that the probe determines whether the tissue being tested is normal or abnormal for a potential future lumpectomy during which the margins of a tumor may be measured, the device ultimately provides margin information.

On September 17, 2010, Applicant filed a Notice of Appeal.

II. ISSUE FOR DETERMINATION

Whether the term MARGINPROBE is merely descriptive, for purposes of Section 2(e)(1) of the Trademark Act, in connection with “medical device, namely, a tissue characterization device for use in surgical procedures,” in Class 10.

III. ARGUMENT

A. **Standard For Refusal On Descriptiveness Grounds**

It is well-established that a mark is “merely descriptive” only if it directly or immediately describes the nature or characteristic of products or services in connection with which the mark is used. See T.M.E.P. § 1209.01(b); *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 U.S.P.Q. 169, 177 (TTAB 1985); *In re The Stroh Brewery Co.*, 34 U.S.P.Q.2d 1796, 1797 (TTAB 1994) (“As has been stated repeatedly, a term is descriptive ‘if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods.’”) (quoting, *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215, 218 (CCPA 1978)). As such, the key consideration in assessing descriptiveness, is not whether the mark may, in some manner, be considered descriptive but rather whether the function, characteristic, use or ingredients of the goods or services described in the application are immediately and directly conveyed by the mark. By using such terms as “immediately” and “directly,” the Trademark Trial and Appeal Board (the “Board”) has imposed a high standard for categorizing a mark as “merely descriptive.” In addition, it is clear that it is the burden of the Examining Attorney, in the first instance, to make out a *prima facie* showing of mere descriptiveness as applied to the goods covered in the application.

B. Basis For Refusal

It is the Examining Attorney's position that the mark is merely descriptive of the goods because Applicant's device, though it does not measure or quantify margins, it indicates a margin. The Examiner believes that because Applicant's probe assesses tissue for the potential presence of a tumor whose margins would eventually be measured if one exists, as a result the probe is a device that offers margin information.

C. Argument

It is Applicant's position that the mark MARGINPROBE, as applied to the specific goods covered in Applicant's application, does not immediately or directly describe any feature, characteristic, or function of hand held probe used to aid in the selection of tissue abnormalities for excision.

As noted above, the Examining Attorney first refused registration based on the conclusion that the mark is descriptive of a probe for ascertaining the margins of a tumor. That conclusion is simply factually incorrect and Applicant pointed out to the Examining Attorney this factual inaccuracy when responding the initial refusal. As explained by Applicant, its probe does not actually determine margins or obtain margins. Rather, the probe assesses whether or not a tissue is normal or abnormal for future potential measurement and excision via lumpectomy. After being advised of the foregoing, the Examiner maintained the refusal but changed the rationale for such refusal, concluding that because a margin measurement may potentially be obtained *after* the probe determines whether or not there is a tumor whose margins need to be measured in the first place, the probe is providing margin information.

It is submitted that Applicant's mark is nothing more than a suggestive term and the suggestiveness of the mark is clearly evident by simply considering the Examining Attorney's ever changing and strained analysis employed by him in order to somehow try to find Applicant's mark unregistrable under Section 2(e)(1) of the Act. Applicant's probe is *not* a margin measuring probe. Rather, it is a probe used to determine tissue abnormality. The mark requires substantial mature thought or imagination on the part of the prospective purchaser to arrive at an understanding of the nature of the goods. "A mark cannot be descriptive if it requires a step by step reasoning process to establish a connection between the mark and the goods based upon the 'standpoint of the average prospective purchaser.'" *In re Abcor Dev. Corp.* at 218)(citations omitted). Therefore, if some operation of imagination, thought or perception is necessary to reach a conclusion as to the nature or quality of the goods or services, the mark is suggestive, not merely descriptive. *In re George Weston Ltd.*, 228 U.S.P.Q. 57, 58 (TTAB 1985).

While it may be true that MARGINPROBE conjures up the idea that Applicant's goods are somehow related to tumor assessment, this does not render the term merely descriptive. The Board has noted that a mark may convey some meaning concerning the goods or services without being descriptive of them. *RJR Foods, Inc. v. Queen Spray Cranberries, Inc.*, 174 U.S.P.Q. 244, 245 (TTAB 1972) (GRAPE BERRY for beverage consisting of concord grape juice, cranberry juice, water, and less ingredients held not merely descriptive because the mark failed to indicate with particularity which type of berry juice was in the beverage). MARGINPROBE is such a mark. At most, it may conjure up the idea that the goods offered have something to do with tumor assessment but it does not immediately describe any feature or characteristic of the goods. Moreover, it is axiomatic that "one may be informed by suggestion

as well as description.” *In re Reynolds Metals Corp.*, 178 U.S.P.Q. 296, 297 (CCPA 1973). The fact that persons encountering Applicant’s mark might recognize a suggestion regarding Applicant’s goods, does not render the mark merely descriptive. *See e.g. In re George Weston Ltd.* at 58. (SPEEDI BAKE is suggestive, not merely descriptive of desirable characteristic of dough that quickly bakes into bread); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (TTAB 1972) (DRI-FOOT is not merely descriptive of anti-perspirant deodorant for feet). MARGINPROBE is a suggestive term that sheds some light upon the characteristics of Applicant’s goods but only through an effort of imagination by the prospective purchaser.

Applicant’s conclusion is further supported by the following decisions of the Board finding that the marks shown were suggestive and therefore registrable: *Time Mirror Magazines, Inc. v. Ski West Magazine, Inc.*, Can. No 92,018,736 (TTAB Sept. 10, 1992) (SKI WEST held not descriptive because imagination was required to translate the mark into “skiing in the west,” “ski the west” or “go ski the mountains in the western United States”); *In re Dun & Bradstreet Corp.*, Ser. No. 74/062,448 (TTAB July 13, 1992) (LEGAL SEARCH held not descriptive of database services for searching public records, but suggestive since the mark covered computer services for searching a variety of public records and business information generated by the requirements of commercial law).

Moreover, as previously submitted, there are a number of registered third party composite marks that include the term PROBE within the mark for medical devices in Class 10. The Trademark Office has in the past considered PROBE formative marks for said types of goods as suggestive rather than descriptive.

Furthermore, Applicant has also submitted evidence to demonstrate that Applicant's mark herein has been accepted for registration in the European Union, Israel, Korea, and Japan. Applicant recognizes that the successful registrations of the mark in EU and said countries is not binding on the United States and the Trademark Office. However, for the same reasons the mark was found registrable in those countries, that same rationale should allow registration in this country where, as here, the mark does not merely describe any feature or characteristic of the goods.

Finally, the Board is reminded that while Applicant believes the mark clearly falls on the suggestive side of the descriptiveness/suggestive line, any doubt on the issue should be resolved in favor of the Applicant with the mark being published for opposition so that any third party believed to be damaged by the registration of Applicant's mark, can file an opposition. *See In re The Rank Org., Ltd.*, 222 U.S.P.Q. 324 (TTAB 1984); *In re Shutts*, 217 U.S.P.Q. 363, 365 (TTAB 1983); *In re Pennwalt Corp.* at 319; *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (TTAB 1972).

IV. CONCLUSION

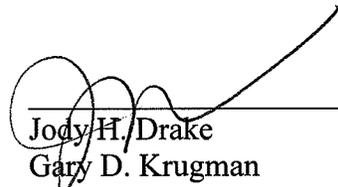
For the foregoing reasons, it is respectfully requested that Section 2(e)(1) descriptiveness refusal for registration be reversed and Applicant's mark passed to publication.

APPLICANT'S APPEAL BRIEF
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Applicant requests that , in the unlikely event the Board elects to affirm the Section 2(e), refusal, the application should in such case be amended to the Supplemental Register with the mark then proceeding to registration on the Supplemental Register.

Respectfully submitted,

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