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Subject: U.S. TRADEMARK APPLICATION NO. 77377330 - MARGINPROBE - T-10831 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77377330

**MARK:** MARGINPROBE



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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:** Dune Medical Devices Ltd.

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

T-10831

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's final refusal to register the proposed mark MARGINPROBE on the grounds that the mark is merely descriptive of the applicant's goods:

medical device, namely, a tissue characterization device for use in surgical procedures (Class 10)

The undersigned respectfully requested that this refusal be affirmed.

**FACTS**

On January 22, 2008, the applicant applied for registration on the Principal Register of the proposed mark MARGINPROBE for "medical device, namely a tissue characterization device for use in surgical procedures." The application was based on Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), and Trademark Act Section

44(d), 15 U.S.C. Section 1126(d). In an Office Action dated September 29, 2009, the examining attorney refused registration under Section 2(e)(1) because the applicant's mark merely describes its goods. The examining attorney also required that the applicant furnish certain information for the record. In a response entered March 17, 2010, the applicant supplied the required information, and argued that its mark is not merely descriptive of its goods. On April 6, 2010, the examining attorney issued a final refusal on the grounds of Section 2(e)(1). The applicant filed a notice of appeal and its brief on September 17, 2010.

#### ARGUMENT

Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), as amended, provides as follows:

No trademark by which the [services] of the applicant may be distinguished from the [services] of others shall be refused registration on the principal register on account of its nature unless it—

(e) Consists of a mark which,

(1) when used on or in connection with the [services] of the applicant[,] is merely descriptive ... of them ... .

A mark is considered merely descriptive under this section if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant goods or services.

*In re Gyulay*, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP Section 1209.01(b).

In the instant appeal, the applicant's mark **MARGINPROBE** merely describes the applicant's "tissue characterization device," which is simply a **probe** that indicates the presence or absence of a **margin**. Specifically, as made of record by evidence attached to the initial Office Action (and still not disputed by the applicant\*), the applicant's particular device is a "hand-held surgical **probe** [used to] enable obtaining a clear **margin** during a single lumpectomy procedure."

In information provided to this Office in its response of March 17, 2010, the applicant indicated "that the word 'margin' has th[is] meaning: the distance between the tumor and the resection surface, as defined by permanent pathology. A margin has a numeric value in mm's. ... It is important to note that the indication the MARGINPROBE provides is binary, red for cancer down to 1mm below the resection surface, or blue for normal tissue when measuring on the resection surface, with no quantification of the distance of the tumor from the surface."

Further, "probe" appears to be the generic term for the applicant's goods, according to several sources made of record (and not factually disputed by the applicant):

- The Dune Medical (Caesarea, Israel) **probe** uses Radio Frequency Spectroscopy to characterize breast tissue in real-time during surgery to determine **margin** malignancy status and holds promise to reduce re-excision procedures
- The company's product **Margin Probe** is a breast cancer assessment **probe** and used in intraoperative detection of tumors at the resection **margins** (positive **margins**) in specimens of patients undergoing breast conserving surgery.

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\* Actually, the applicant objected that "The stories included in the Examining Attorney's refusal simply refer to Applicant and are by no means supportive evidence of a descriptiveness refusal"—but the applicant does not explain *why* the stories are not supportive. Significantly, the applicant does not allege that the stories contain factual inaccuracies. If the relevant wording ("margin" and "probe") were used in those stories *only* in a proprietary/source-indicating fashion, then the applicant would have a point; but the stories are replete with examples of the relevant wording being used to describe the goods—the applicant's product in particular, which presumably constitutes better evidence than stories about competitors' goods.

- A cancer patient with positive **margins** typically requires a second surgery, with accompanying trauma and expense, to re-shave tumor sites for adequate tissue removal. The Dune Medical (Caesarea, Israel) **probe** uses Radio Frequency Spectroscopy to characterize breast tissue in real-time during surgery to determine **margin** malignancy status and holds promise to reduce re-excision procedures.
- A novel hand-held surgical **probe** shows promise in clinical studies that it could consistently enable obtaining a clear **margin** during a single lumpectomy procedure. In real time, the **probe** detects differences in electrical waveforms reflected from fresh tissue specimens. This and other observations from an ongoing, international multi-center study of the surgical **probe**, developed by Dune Medical Devices, Ltd., Israel, were reported by researchers at the annual scientific meeting of the American Society of Breast Surgeons (ASBS).

Even though, as the applicant indicates, the *precise measurement* of the margin (i.e., the “numeric value in mm's”) is determined later in the specimen’s chain of custody, the applicant’s probe does provide margin *information*: if the tissue being probed produces a blue rather than a red reading, that tissue will not be considered for further examination—because there is *no margin* to be measured. By contrast, a red reading means that *there is a margin* to be measured, even though the exact value of the tumor’s distance from the surface may not be immediately known. So the applicant’s device, insofar as it is a *tumor* detector, is by that very fact a *margin* detector—in the form of a probe; thus, a margin-detecting probe. As indicated in the original Office Action (emphasis in original):

“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).

To analogize roughly, if the mark were FROZENPROBE and the so-named device's function were to indicate whether the specimen being tested is above (red) or below (blue) the point of frozenness, the mark would still be merely descriptive of the device even though its output is limited to the binary ">0°C or <0°C" reading; in other words, this hypothetical probe still tells *whether* a specimen is frozen, even if it does not address *what degree of frozenness* for those specimens determined to be <0°C.

So it is with the applicant's device, named MARGINPROBE: from the information of record, it would seem that when the probe displays blue, it indicates tumor-free tissue; but when the probe displays red, it indicates malignant tissue having some margin. The mark MARGINPROBE merely describes the applicant's goods because, as to certain specimens, the applicant's **probe indicates a margin** (even without "quantif[ying]" it).

The applicant argues as follows:

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.

As an initial matter, it is not seen how a preliminary characterization of the applicant's highly-sophisticated goods that was based on limited information and that was refined *one time* by the lights of the information supplied by the applicant qualifies as "ever changing." Regardless, it does not follow that the case for mere descriptiveness is "strained" just because "Applicant's probe is not a margin **measuring** probe"

(emphasis altered); this reality means only that the mark **MEASURINGPROBE** would not be merely descriptive—but the mark under consideration is **MARGINPROBE**, so the proper relationship to consider is that of the term *margin* to the applicant’s probes. Likewise, the fact that it is the margins *of tumors* that the applicant’s probes may indicate the presence of is beside the point; just because the hypothetical mark TUMORPROBE would be *even more* descriptive (nay generic) does not save the actual mark MARGINPROBE from being merely descriptive.

The applicant further argues as follows (emphasis supplied):

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 with out being [merely] descriptive of them. *[Citations omitted.]* 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.

Once again, the applicant is focusing on some aspect of the goods that is not described by the mark (at all) and is using that to urge the conclusion that the mark is not merely descriptive. The applicant may as well be arguing that its goods are shipped in blister packaging—and since one would not realize this upon encountering MARGINPROBE, the mark is “therefore” not merely descriptive. By starting at the wrong point, the applicant progresses down the wrong path to arrive at the wrong conclusion about the mark at hand. Rather, the proper starting point is the terminology comprising the mark (“margin” and “probe”), and the proper path involves analyzing what significance *these* terms may have vis-à-vis the goods; as seen above, the conclusion of mere

descriptiveness is inescapable when “margin” and “probe” are the subject of inquiry. Analyzing the non-descriptiveness of wording *not* appearing in the mark simply does not inform the inquiry of whether the mark is merely descriptive; that such outcome-driven wording selections do not merely describe the goods does not undermine the mere descriptiveness of wording (“margin” and “probe”) lifted straight from the mark. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Finally, the applicant argues that “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.” Not only do “prior decisions of examining attorneys do not establish PTO policy” (*see, e.g., In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361 (Fed. Cir. 1999)), but the applicant is overlooking the case-by-case nature of proper examination. Those other marks are distinguishable from the instant applicant’s mark in that the additional terminology besides PROBE is *not* merely descriptive, as MARGIN *is* for the goods at issue in the instant case.

The strongest case that can be made *against* the mere descriptiveness of the applicant’s mark is that, as to those tissue specimens that turn out to be non-cancerous, the applicant’s device is *not* probing margins because there are no margins to be probed. However, this means only that the applicant’s mark does not describe the function of the applicant’s goods in *every* situation—and it is enough to meet the Section 2(e)(1) bar if the mark is merely descriptive in *any* situation; presumably this is true all the more

forcefully where, as here, there are only two situations possible (there being cancer having certain margins or there being no cancer).

#### CONCLUSION

The applicant is correct that “any doubt on the issue [of descriptiveness] should be resolved in favor of the Applicant,” but the facts in the instant case leave no such doubt. Because the applicant’s mark MARGINPROBE merely describes the applicant’s probe that can indicate the presence of a margin, the examining attorney requests that the refusal to register the applicant’s mark on the basis that it merely describes the applicant’s services should be affirmed.

Respectfully submitted,

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