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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/775491

MARK: VASCULAR RECONDITION

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TTAB INFORMATION:
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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark VASCULAR RECONDITIONING for use on: pharmaceuticals, namely, energy-activated compounds used for treatment of cardiovascular systems, in class 5; as well as for catheters, in class 10. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) because the mark merely describes how the applicant's goods function, and their intended use.

FACTS

On December 22, 2005, the applicant applied to register the mark VASCULAR RECONDITIONING for use on: pharmaceuticals, namely, energy-activated compounds used for treatment of cardiovascular systems, in class 5; as well as for catheters, in class 10. On June 21, 2006, the mark was refused as descriptive under Trademark Act Section 2(e)(1). Applicant responded on September 21, 2006, entering arguments against the

refusal. A final refusal of the mark as descriptive under Trademark Act Section 2(e)(1) was made on October 23, 2006.

The applicant filed a request for reconsideration. The request for reconsideration was denied on February 28, 2007. This appeal ensued.

ISSUE

The sole issue on appeal is whether the applicant's mark, VASCULAR RECONDITIONING, is merely descriptive of the identified goods, and should be refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. section 1052(e)(1).

ARGUMENT

THE MARK AS APPLIED TO THE GOODS WOULD BE UNDERSTOOD BY CONSUMERS ONLY TO IMMEDIATELY DESCRIBE HOW THE GOODS FUNCTION AND THEIR INTENEDED PURPOSE.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 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 §1209.01(b).

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods or services. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *Goodyear Tire & Rubber Co. v. Cont'l Gen. Tire, Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2003); *In re TMS Corp. of Ams.*, 200 USPQ 57, 58 (TTAB 1978).

Terms that identify the function or purpose of a product or service may be merely descriptive or generic under 15 U.S.C. §1052(e)(1). *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); In re Reckitt & Colman, North America Inc., 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984) (WALLYBALL held descriptive of sports clothing and game equipment); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (BURGER held merely descriptive of cooking utensils); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jams and jellies).

A. THE PROPOSED MARK IS ONLY A COMBINATION OF DESCRIPTIVE TERMS CONVEYING THEIR COMMON MEANING WITHOUT A SEPARATE NON-DESCRIPTIVE MEANING.

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *E.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark so created imparts an

incongruous meaning as used in connection with the goods and/or services. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive. *E.g.*, *In re Copytele Inc*., 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.

The Applicant is seeking registration of the proposed mark VASCULAR RECONDITIONING for use on pharmaceuticals, namely, energy-activated compounds used for treatment of cardiovascular systems, in International Class 5; as well as for catheters, in International Class 10. In the Outgoing Office Action dated October 23, 2006, the Examining Attorney noted that the word "recondition" means "to restore to good condition, especially by repairing, renovating, or rebuilding." See attached dictionary definitions. The Examining Attorney also noted that the word "vascular" commonly describes things related to the cardiovascular system, which includes the heart and blood vessels. See Outgoing Office Action dated June 21, 2006, attached web site articles and dictionary definition. Therefore, under the plain meaning of the proposed mark as a whole, "VASCULAR RECONDITIONING" would be commonly understood to describe repairing of the cardiovascular system, including the heart or blood vessels.

Applicant does not argue against the common meanings of VASCULAR and RECONDITIONING. See applicant's response of September 21, 2006, Part D. Applicant proposes to apply the mark to the goods of pharmaceuticals, namely, energy-activated compounds used for treatment of cardiovascular systems, in International Class 5; and catheters, in International Class 10. Applicant has also stated that the goods are

used to treat arteriosclerosis, that "VASCULAR RECONDITIONING is suggestive of a desired effect of stabilizing or even regressing the formation of atherosclerotic plaque in the cardiovascular system through the use of an energy-activated compound," and that "The goods function by using the catheter to activate the compounds with light generated by a diode array. The purpose of using the goods is to prevent restenosis following intervention in the superficial femoral artery in patients with peripheral artery disease and to stabilize vulnerable plaque in patients with coronary artery disease at risk from acute coronary syndromes." See Applicant's Response of January 30, 2007, Part 1, Paragraphs 2 and 5. The Examining Attorney also provided evidence showing that applicant's catheters in class 10 necessarily include vascular catheters. *See* June 21, 2006 Outgoing Office Action including website evidence describing vascular catheters. Thus, applicant is incorrect, and VASCULAR RECONDITIONING is not suggestive of a desired end result of using the goods. Rather, the proposed mark tells the user something about, that is, describes, the goods.

Consequently, when the proposed mark is applied to the applicant's goods, the user is immediately informed that the purpose of both the pharmaceuticals and the catheters is for VASCULAR RECONDITIONING, or restoring parts of the cardiovascular system to good condition. Thus, the proposed mark is immediately descriptive of the purpose of applicant's goods. Further, by applicant's own description of the proposed mark's meaning in relation to the goods, there is no separate, non-descriptive meaning. When viewing the proposed mark as applied to the goods, there is no imagination, thought, or perception required to reach a conclusion about their use or purpose.

B. WORDS DESCRIBING GOODS ARE NOT INHERENTLY DISTINCTIVE SIMPLY BECAUSE THE WORDS IMMEDIATELY CONVEY INFORMATION ABOUT THE PURPOSE OF THE GOODS, RATHER THAN WHAT THE GOODS ARE.

Applicant argues that the "RECONDITIONING" component of the proposed mark "has a very general meaning" and is therefore merely suggestive of goods associated therewith. Applicant also relies on the argument that "consumers seeing "VASCULAR RECONDITIONING" do not immediately know the nature of the goods." See Applicant's response of September 21, 2006, paragraph 3.

As the dictionary definition of record establishes, the word RECONDITIONING is descriptive of any act of bringing something into good condition. See office action of October 23, 2006, attached dictionary definition. Moreover, the Examining Attorney provided several websites demonstrating the descriptive use of the word RECONDITIONING in medical and health applications to describe various acts of bringing body parts or components into a good condition, whether by physical exercise or applying a pharmaceutical or treatment. See Office Action of October 23, 2006. Of particular note, the evidence includes discussion of reconditioning subcortal center connections in the brain for treating tinnitus, reconditioning blood flow to treat gastrointestinal problems, reconditioning cells by applying copper histadine, using nutritional supplements to recondition the immune system, reconditioning environmentally damaged skin by applying topical treatments, and reconditioning nerves by electrical stimulation to restore bladder control. See Office Action of October 23, 2006, www.utmb.edu/otoref/Grnds/Tinnitus-9901/tinnitus-901 html,

www.intmed.vcu.edu/home/welcome/current_research.html, www.jbc.org/cgi/content/full/274/29/20265, www.drsmoothie.com/naturesnutrients.html, www.jbaxters.com/treatments.html, and www.painful-bladder.org/diagnosis-treatment.html, respectively. This evidence shows that the common understanding of the word RECONDITIONING in medical and health applications is descriptive of bringing a body part or component into good condition regardless of the method used to do so. This wording does not lose its descriptive meaning when applied to the applicant's goods, or put into the context of the VASCULAR system. Rather, this wording simply retains its commonly understood meaning. RECONDITIONING, modified by the word VASCULAR as used on these goods clearly indicates that the goods are used for the purpose of reconditioning in the vascular system. The words can mean nothing else.

Additionally, the fact that an applicant may be the first and sole user of a merely descriptive designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

The Applicant also argues that evidence showing descriptive use of the mark by applicant's own subsidiary does not support a descriptive argument. To the contrary, this evidence is highly persuasive on the issue of descriptiveness. In the office action of October 23, 2006, the Examining Attorney supplied evidence that included a web page

from www.lightsciences.com. On this web site, a company called Vascular Reconditioning, a company, is described as having developed an "interventional *vascular reconditioning* procedure to treat vulnerable plaque in patients having coronary artery disease." (Emphasis added.) In applicant's own materials, the wording VASCULAR RECONDITIONING is used as an adjective. This usage of the wording VASCULAR RECONDITIONING by the applicant immediately conveys meaning, and tells the consumer that VASCULAR RECONDITITIONING is a purpose or use. From applicant's own usage, the public would immediately understand that the company VASCULAR RECONDITITIONING sells pharmaceuticals, namely, energy-activated compounds and catheters used specifically for VASCULAR RECONDITIONING.

In summary, the mark VASCULAR RECONDITIONING is descriptive under Trademark Act Section 2(e)(1) as applied to the goods of pharmaceuticals, namely, energy-activated compounds used for treatment of cardiovascular systems and catheters. The common meaning of the wording immediately conveys the use or purpose of the goods to the consumer. Further, applicant's own usage of the same wording reinforces the descriptive meaning. Thus, the consumer is highly likely to understand the mark as descriptive of how the goods function and their intended purpose, without thought, perception, or imagination, when applied to the goods.

CONCLUSION

For the foregoing reasons, and based on the cited authority, it is respectfully requested that the refusal to register applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Sections 1052(e)(1), be affirmed.

Respectfully submitted,

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