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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/873139

**MARK:** OSTEO PLATFORM



**CORRESPONDENT ADDRESS:**

DAVID M. CARTER  
CARTER, DELUCA, FARRELL & SCHMIDT, LLP

STE 225  
445 BROADHOLLOW RD  
MELVILLE NY 11747-3615

**APPLICANT:** Juvent, Inc.

**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

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

1429-53

**CORRESPONDENT E-MAIL ADDRESS:**

docket@cdfslaw.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**FACTS**

On May 1, 2006, applicant Juvent, Inc. filed an application under Section 1(b) requesting registration of the mark, OSTEO PLATFORM, Serial No. 78873139. The application identified the goods for which the mark is intended to be used as, "medical apparatus, namely, vibration plates for therapeutic purposes," in International Class 9.

On August 25, 2006, the first examining attorney refused registration on the grounds that the mark is merely descriptive of a characteristic, feature or function of applicant's goods, and including a page from applicant's Internet site showing a man standing on a small platform said to treat and prevent osteoporosis using vibrations. (See Examiner's first Office Action dated August 25, 2006, page 2).

Applicant responded on February 22, 2007, acknowledging that its goods "are intended for use by those suffering from bone loss and muscle mass," and that its goods, "involve the use of a platform area on which the users stand." Nevertheless, applicant asserted that the term is "descriptive as applied to merchandise related to computer software goods" but is "not descriptive of [applicant's] vibration plates for therapeutic purposes."

On April 23, 2007, the second examining attorney issued a final refusal on the grounds that the mark is descriptive of applicant's goods. The Office Action included as evidence several pages from applicant's Internet site showing users of applicant's goods standing on vibrating platforms and several articles indicating that the words "osteo" and "platform" are commonly used to describe similar and related goods.

On October 19, 2007, applicant filed a request for reconsideration, arguing that the wording "osteo platform" is, "an impressive sounding composite non-sequitur, which, by definition cannot 'describe' the goods it is accused of describing," because the word "platform" in the mark "connotes a "system on which programs or operating systems operate."

On October 29, 2007, the examining attorney denied reconsideration of the final Office Action.

Applicant filed an appeal brief with the Trademark Trial and Appeal Board on January 8, 2008.

## ISSUE

The sole issue on appeal is whether the applicant's mark OSTEO PLATFORM is descriptive of applicant's goods, "medical apparatus, namely, vibration plates for therapeutic purposes."

## RELEVANT LAW

The relevant law and standard is Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). 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.

## ARGUMENT

THE MARK IS MERELY DESCRIPTIVE OF THE CHARACTERISTICS,  
FUNCTION, FEATURES, PURPOSE AND/OR USE OF APPLICANT'S  
GOODS

A. The Individual Meanings of the Words Are Descriptive

The dictionary evidence shows that the word "osteo" is a well-known word of Greek origin which means "bone." Several articles attached to the final Office Action show that ordinary use of this word is consistent with this dictionary definition, including articles from the *St. Petersburg Times* of Florida, the *St. Louis Post-Dispatch* of Missouri, and *The Chicago Times Tribune*. (See Final Office Action dated April 23, 2007, pgs. 8-14).

As the evidence also shows, the word "osteo" is also used as an abbreviated form of other words that describe medical conditions related to bones, such as osteoporosis. For example, a page from the International Osteoporosis Foundation Internet site provided with the final Office Action shows use of the word "Osteo" as an shortened reference to osteoporosis. Abbreviations of descriptive terms are descriptive if they convey to consumers the descriptive connotation of the original term. *See e.g., Martell & Co. v. Societe Anonyme de La Benedictine*, 116 F.2d 516, 48 U.S.P.Q. 116 (C.C.P.A. 1941). Thus, even if applicant intended the word "osteo" to refer not only to bones but to medical conditions related to bones, such as osteoporosis, this word is nevertheless descriptive because it conveys to consumers the descriptive connotation of the original term: bone.

The dictionary evidence also shows that the relevant meaning of the word "platform" in this context is that of a slightly raised level surface. (See Final Office Action dated April 23, 2007, pgs. 2 and 3).

Thus, the words OSTEOPLATFORM describe the function, purpose and use of applicant's goods, a set of "vibration plates" which form an elevated surface used to provide vibrations intended to treat bone conditions. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

B. The Combined Wording in the Mark is Descriptive

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, non-descriptive 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 non-descriptive 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 such 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.

Notably, attached to the final Office Action are a series of pages from applicant's Internet site indicating, among other things, that applicant's goods, (some or all of which are marketed under the name Juvent 1000), are used by "standing on the Juvent Platform in an upright and relaxed stance." These pages also depict several people standing on a small platform several inches higher than the floor and roughly two feet square. (See Final Office Action of April 23, 2007, Pages 5 and 7). Other evidence attached to the action included a review of applicant's products which indicates that the applicant's "[p]latform offers a safe and effective therapy for osteoporosis clients." [Id. pg. 8).

Applicant has acknowledged in its response of February 22, 2007, that the goods "***will be used for the treatment of osteoporosis...for the aging population...***" Applicant further acknowledged that its goods "***are intended for use by those suffering from bone loss and muscle mass.***" This character and purpose of applicant's goods is thus clearly described by the word "osteo" in applicant's mark.

Applicant has also acknowledged in its response of February 22, 2007 that the goods "***involve the use of a platform area on which the users stand.***" This nature or character of applicant's goods is described by the word "platform" in applicant's mark.

### C. Applicant Acknowledged the Attributes of the Goods Described By The Mark

Applicant discounts the significance of its acknowledgements and the pages from its Internet site, arguing that the attributes of applicant's products are not apparent without reliance on such evidence, and that a "mental leap" is required to determine the attributes of applicant's goods. (See Appellant's Brief pg 10). Examining attorneys are required to support refusals and requirements with relevant evidence. Such ample evidence was properly placed in the record along with the refusal to register applicant's mark in this instance and the evidence supports the refusal to register. TMEP §710.01.

Notwithstanding applicant's acknowledgements of the features and purposes of the goods described by the mark, applicant argues that the word "platform" refers to "computer software and programs and operating system platforms" and "in no way describes a medical apparatus used for therapeutic purposes." (See Appellant's Brief pg. 11). For this reason, the applicant argues, the mark creates an "impressive sounding non-sequitur, which, by definition, cannot 'describe' the goods it is accused of describing." (See Appellant's Brief pg. 12).

As noted in the final Office Action, descriptiveness is considered in relation to the relevant goods and/or services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974); TMEP §1209.03(e). Thus, the fact that the word "platform" has some other meaning unrelated to applicant's goods does not alter or diminish the descriptiveness of applicant's mark relevant to vibration platforms for the treatment of bone conditions.

### D. First or Sole Use of Descriptive Terms Does Not Diminish Their Descriptiveness of the Goods

Next, applicant argues that, because applicant's competitors are not using the words in applicant's mark, competitors do not need to be able to use the words in applicant's mark in order to compete effectively and applicant's mark therefore should not be considered descriptive. The fact that an applicant may be the first and sole user of a merely

descriptive or generic 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).

Moreover, the evidence provided with the final Office Action indicates that other entities are using the word “platform” in relation to vibration machines with features similar to those of the applicant. (See Final Office Action of October 29, 2007, pgs. 2, 9, 10, 12, 13). This evidence includes illustrations and explanations of vibrating or oscillating platforms used for exercise or medical treatment and claiming similar health benefits. [Id. pgs. 13, 15-17, 68-74]. It also includes a patent application describing a competitor’s “orthopedic treatment apparatus” as comprising a “movable *platform*.” This evidence also provides additional examples of the use of the word “osteo” to refer to afflictions related to the bones similar to those the applicant claims are treated by its goods.

#### E. The Commercial Impression of The Words In The Mark Is Not Altered When The Words Are Combined

The applicant further argues that the mark is a “composite phrase” that forms a different commercial impression than that of the individual words in the mark and that “mental gymnastics” are therefore necessary for consumers to understand the attributes of applicant’s goods from applicant’s mark. (See Appellant’s Brief, pgs. 11-12).

This is not a case of first impression. It is well-established that descriptive terms do not form an alternative, non-descriptive meaning merely by being combined. As noted above, for a mark that combines descriptive terms to be registrable on the Principal Register absent a showing of distinctiveness, it must form a non-descriptive meaning. *See, e.g., In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of “computer software for use in development and deployment of application programs on a global computer network”); *In re Putman*

*Publ'g Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ON-LINE merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts). Here, no such non-descriptive meaning is formed by the combining of the words in the applicant's mark. Conversely, the wording in applicant's mark is rendered *more* descriptive when combined because it is less likely that consumers will associate the goods with computer platforms given that the word "platform" is preceded by the word "bone" in the mark.

Applicant also asserts that the examiner has improperly dissected the mark to arrive at a conclusion that the mark is descriptive. Although the applicant is correct in stating that a composite mark is tested for its validity and distinctiveness by looking at it as a whole rather than dissecting it into component parts, the examiner notes the following observation made by the Trademark Trial and Appeal Board:

It is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof with respect to the question of descriptiveness provided that the ultimate determination is made on the basis of the mark in its entirety. An Examining Attorney's discussion of each word separately in order to show that the term in its entirety is descriptive is not the same thing as dissecting a mark.

*In re Hester Industries, Inc.*, 230 USPQ 797, n.5 (TTAB 1986).

#### F. The Third Party Registrations Provided By Applicant Are Not Relevant to the Descriptiveness of Applicant's Mark

The applicant seems to suggest that consumers of the applicant's goods will believe that the mark is "descriptive of computer software platforms" in part because a number of marks containing the word "platform" for computer related goods have been registered without a disclaimer of this word. Applicant also cites a number of marks containing the word "osteo" for which no disclaimer was required. For instance, applicant compares the unitary mark OSTEOGRAF and OSTEO-PIN to its mark, OSTEO PLATFORM, noting that the word "OSTEO" has not been disclaimed.

Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

Nevertheless, many if not all of the marks cited by the applicant appear to be unitary and therefore the wording in these marks is not subject to a disclaimer. TMEP §1213.05. Applicant's evidence of these registrations thus has no impact on the descriptiveness of applicant's mark. Conversely, the terms "osteo" and "platform" generally appear to be disclaimed when included in third party registrations for marks that are not unitary and are related to bones or goods that constitute platforms. (See Final Office Action of October 29, 2007, pgs. 51-61).

### G. The Word "Osteo" Is Commonly Understood to Mean "Bone"

Finally, applicant argues that consumers are unlikely to understand that the word "osteo" means "bone" because the word is "derived from the Greek language" and "it is not likely that all consumers are well versed in the Greek language." This argument misinterprets the significance of the word's origin.

The word "osteo" is not written in Greek nor is it undecipherable without a thorough knowledge of Greek, but instead is merely of Greek origin. In fact, the word "osteo" is not Greek at all, but is merely the English derivation of the Greek word "osteon," as explained in the Office Action dated April 23, 2007. This word (osteo) has since been widely adopted by English speakers and is now a quite common word in the English language, as the ample dictionary and other evidence confirms. Consumers therefore do not need to speak Greek to know that the word "osteo" means "bone."

## CONCLUSION

Applicant's mark OSTEOPLATFORM is descriptive of applicant's, "medical apparatus, namely, vibration plates for therapeutic purposes." The applicant has acknowledged and

the evidence confirms that the plates comprise a vibrating platform designed and intended to treat bone conditions. Thus, for the foregoing reasons, the examining attorney respectfully requests that the refusal to register on the basis of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

/Edward Fennessy/  
Trademark Examining Attorney  
Law Office 114  
1.571.272.8804

K. Margaret Le  
Managing Attorney  
Law Office - 114