

**This Opinion is Not a
Precedent of the TTAB**

Mailed: July 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re B & D Dental Corp.
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Serial No. 85591438
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Garron M. Hobson and Eric E. Westerberg of Thorpe North and Western, LLP.,
for B & D Dental Corp.

Zachary B. Cromer, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

—
Before Kuhlke, Wolfson and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

B & D Dental Corp. (“Applicant”) seeks registration on the Principal Register of
the mark DIGITALPREP (in standard characters) for, as amended,

dental software for automatically generating an electronic
model of a cutting guide positionable on a patient’s teeth
and marking margins on the electronic model of a
patient’s teeth in International Class 9.^{1 2}

¹ Application Serial No. 85591438 was filed on April 6, 2012, based upon applicant’s
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the
Trademark Act.

² Applicant erroneously classified its goods in International Class 10. The
classification has been amended to International Class 9. We note the Examining

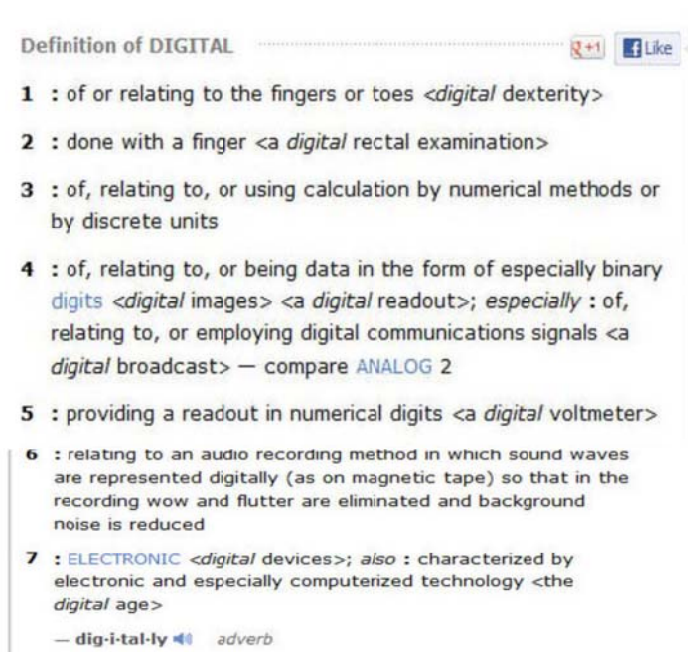
The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that Applicant's mark is merely descriptive. When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term

Attorney, in his brief, indicated the classification requirement is still outstanding, but Applicant did not appeal this issue. In view thereof, the requirement is moot and the reclassification has now been entered into the record. The better practice would have been for the Examining Attorney to have telephoned the Applicant to resolve the reclassification issue following Applicant's amendment of the identification to include goods in class 9 only, and then to have issued a Priority Action/Examiner's Amendment reclassifying the goods and making Final the refusal under Section 2(e)(1). *See* TMEP 708.03 ("A priority action may be used for a final or nonfinal refusal or requirement.")

may have other meanings in different contexts is not controlling. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

To support the refusal, the Examining Attorney has submitted the following definition of “digital” from the Merriam-Webster On-Line Dictionary (m-w.com):



Office Action dated July 20, 2012; and the following definitions of “prep” from several medical dictionaries³:

- to prepare for a medical examination or surgical procedure - The American Heritage Medical Dictionary © 2007, 2004 Houghton Mifflin Company;
- 1. -abbreviation for prepare. 2. - abbreviation for preparation, particularly when referring to

³ Available at “medical-dictionary.thefreedictionary.com.”

preparation for surgery - Mosby's Medical Dictionary, 8th edition © 2009 Elsevier; and

- “colloquially, to prepare skin or other body surface for an operative procedure, usually by applying antiseptic solutions.” – Medical Dictionary for the Dental Profession – © Fairlex 2012.

Office Action date March 29, 2013.

The Examining Attorney also submitted evidence from several websites establishing the growing use of digital technology in the dental field, including the use of computer aided design (CAD) and computer aided manufacture (CAM).

Examples include the following:

- Excerpt from an article: “In the case of digital impressioning, the creators of the impression-taking devices have introduced scientific developments in the fields of optics, digitation, and CAD/CAM into the art of capturing impressions of prepared teeth and surrounding structures to develop 3D digital and even physical representations from which dental restorations can be made.”... Nathan S. Birnbaum and Heidi B. Aaronson, *Digital Dental Impression Systems*, Inside Dentistry (February 2011); accessed online at www.dentalaegis.com”;
- Excerpt from an article: “Digital dental impressioning is a disruptive technological advancement that so surpasses the accuracy and efficiency of former techniques for obtaining replicas of prepared teeth for the purpose of fabricating restorations that its adoption by dentists is rapidly eclipsing the use of elastomeric impression materials.” *Id.*;
- Promotional material for Cliosoft dental imaging software: “Seamlessly sync your digital imaging exams with your practice management patient chart or appointment book” Sota Imaging – www.sotaimaging.com;
- Blog for Digital Dentist: The latest developments in digital imaging technology are now the foundation of a digital practice that will incorporate implantology, orthodontics and prosthodontics.” www.thedigitaldentist.blogspot.com; and

- Information regarding CAD/CAM: “To say the future of dentistry is in CAD/CAM is an understatement. It’s here now and it’s here to stay. Computer-aided design/computer-aided manufacturing technology for dentistry is allowing us to provide even better care for patients.” The Dentistry IQ Network, www.dentaleconomics.com; and
- Information regarding marginal integrity: “As with all restorations, marginal integrity is critical to the long-term success of the restoration. The replication of the tooth margin in traditional lab restorations is directly affected by various impression materials, techniques, shrinkage, or expansion of both the impression material and or the dental stone, the amount of time elapsed between the impression and the model work, the accuracy of the die trim, and the expansion and/or contraction associated with the final casting of the restoration ...
... What could take hours or sometimes days in a lab, takes minutes on the computer [when] [t]he CAD portion of the process begins ...” *Id.*

Final Office Action dated March 29, 2013.

Without addressing the evidence, Applicant argues that

[t]he term “DIGITAL” within the mark DIGITALPREP is not merely descriptive because the term is vague and lacks specificity. The term “digital” is associated with a wide variety of entirely different products and services. The term is used in association with computers, software, photography, music, storage media, cell phones, radios, timekeeping, imaging equipment – almost any modern electronic device,⁴ and

the term “prep” within applicant’s mark communicates only a vague and indirect meaning to consumers and is therefore not descriptive under the imagination test. The examining attorney submits that “prep” merely described preparation for a procedure. While applicant does not concede this point, even if the Examining Attorney is correct, the term would still be too vague and indefinite to be merely descriptive. Even the Evidence submitted by the Examining Attorney demonstrates this ambiguity, as

⁴ Appeal Brief, unnumbered pp. 3-4, 6 TTABVue at 4-5.

the term “prep” or “preparation” is used in connection with preparing dentists for their board exams.⁵

Applicant’s argument is not well-taken. As stated *supra*, “[w]hether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term may have other meanings in different contexts is not controlling.” *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Applicant’s goods are dental software for automatically generating an electronic model of a cutting guide positionable on a patient’s teeth and marking margins on the electronic model of a patient’s teeth. The mark immediately conveys to purchasers, i.e., dentists, that applicant’s software is used in preparing for dental procedures by digitally creating models of patients’ teeth.

[The following information on Applicant’s website⁶ supports our finding that the term DIGITALPREP describes both a feature and a function of Applicant’s goods:

⁵ Appeal Brief, unnumbered pp. 6-7, 6 TTABVUE at 7-8.

⁶ www.origincadcam.com

ORIGIN Precision Digital Solutions - Driven By Innovation

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>> KOD® DigitalPrep™
>> 3Shape

Provide your dentist with the most innovative breakthrough in modern dentistry

KOD® DigitalPrep™

1st Appointment - No Prep → Finished DigitalPrep™ → Next Appointment Prep Guide, Model & Postback → Prepping the Tooth

Restoration Seated on the Same Day as Prepped! No Provisionals Needed *U.S. and International Patent Pending

3minKODDigitalPrepNTSC.mp4 Share More info

Digital Precision For One Visit Restorations

Precise Fit and Digital Predictability

The prep guide is printed and the final restorations milled simultaneously with digital accuracy.

Optimal Restorative Outcome

- Eliminates Possible Errors Due To Temporaries.
- Eliminates Possible Errors Due To Prep Design.
- Reduces Possible Errors Due To Impressions, No Cord, No Margin Line Capture
- Eliminates Possible Errors Due To Stone Models

Less Hands on Labor / Enhanced Patient Satisfaction

Laboratory

- 3D Printed Model
- 3D Printed Prep Guide
- Milled Semi Finished Restoration
- Just Need Simple Stain and Glaze

Operatory

- Minimal Invasive Prepping
- Accurate Margin Placements
- Perfect Path of Insertion
- No Fabrication of Provisional's
- One Visit, Under an Hour

Office Action dated July 20, 2012.

Finally, Applicant argues that its mark should be considered suggestive because “[t]he Record includes several U.S. trademark registrations for marks that include the term ‘digital’ or ‘prep’ and that are used in connection with analogous goods.” Appeal Brief, unnumbered p. 6, 6 TTABVue at 7. Applicant listed four registrations, two that include the term PREP and two that include the term “DIGITAL.” While three of the registrations cover software products, none of the

covered software is related to Applicant's software. Similarly, the goods in the final registration (fecal sample specimen collection, transport and preparation device) are not related to Applicant's goods. Moreover, this issue was addressed by our primary reviewing court when determining the nature of the term "ULTIMATE" in registered trademarks. The Court stated:

The record in this case contains many prior registrations of marks including the term ULTIMATE. These prior registrations do not conclusively rebut the Board's finding that ULTIMATE is descriptive in the context of this mark. As discussed above, the term ULTIMATE may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception. The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985). Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.

In re Nett Designs Inc., 57 USPQ2d at 1566. As with the *Nett Designs* case, the third-party registrations introduced do not rebut our findings that DIGITALPREP is descriptive of Applicant's goods.

Decision: The refusal to register Applicant's mark DIGITALPREP is affirmed.