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

Proceeding	85646871
Applicant	Sound Sleep Products, Inc.
Applied for Mark	GEL TECH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Sound Sleep Products, Inc.

Appl. No.: 85/646,871

Mark: GEL TECH

Filed: June 8, 2012

Law Office 117

Examiner: Anne C. Gustason

Att'y Dkt. No.: 6220-007

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S MAIN BRIEF ON APPEAL

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I. APPLICANT'S MARK

Applicant seeks registration of the mark "GEL TECH" for mattresses.

II. DESCRIPTION OF THE RECORD

The application was filed on June 8, 2012, under 15 U.S.C. § 1052(b) based on Applicant's intention to use the mark GEL TECH, hereafter the "Mark," for mattresses in International Class 20.

A first Office action issued September 25, 2012. In this action, the Examiner refused registration based on a likelihood of confusion with the mark TECHNOGEL for mattress components in U.S. Registration No. 3,636,884, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d). The Examiner also noted a prior-filed application, namely, Application No. 85/278,556 for the mark TECHNOGEL for mattress toppers. The Examiner also refused registration pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), based on a finding that the Mark was merely descriptive.

On March 22, 2013, Applicant filed a response presenting arguments against both the Section 2(d) refusal based on the TECHNOGEL registration and the Section 2(e)(1) refusal of the Mark as merely descriptive. Applicant declined to address the prior-filed application.

On March 25, 2013, the Examiner maintained the refusals under Section 2(d) and 2(e)(1) and suspended action on the application pending disposition of the prior filed '556 application.

On March 29, 2013, Application filed an amendment to allege use, and on April 2, 2013, the AAU was accepted.

On May 25, 2015, another Office action issued lifting the suspension. The Section 2(d) refusal based on Registration No. 3,636,884 and the potential refusal based on Application No. 85/278,556 were withdrawn. The Section 2(e)(1) refusal was made final.

On September 11, 2015, Applicant filed a timely request for reconsideration acknowledging the descriptive nature of the term “gel” and entering a disclaimer of the term.

On October 5, 2015, the Examiner maintained the Section 2(e)(1) refusal. The Examiner included additional evidence comprising several web pages.

On October 29, 2015, in preparation for appeal, Applicant filed a second request for reconsideration arguing the newly cited web pages failed to support the descriptiveness refusal and also offering declaration evidence.

On November 24, 2015, Applicant timely filed its Notice of Appeal.

III. STATEMENT OF THE ISSUES ON APPEAL

The sole issue presented by this appeal is whether Applicant’s mark GEL TECH is merely descriptive of mattress.

IV. ARGUMENT AND AUTHORITIES

A. The standard and burden of proof.

The burden of demonstrating that a mark is merely descriptive is on the Office. *See In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987). The Examiner must make a prima facie case that more than an inconsequential number of prospective customers would view the designation as merely descriptive. *Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55, 62 (2d Cir.

1961) (held that POLY PITCHER was not merely descriptive because the number of people who understood "poly" to be synonymous with "polyethylene" was inconsequential). The standard is what the designation would mean to the average customer in view of how the designation is used by the application. *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591, 593 (T.T.A.B. 1979).

The Examining Attorney has not met the burden of establishing that a substantial number of average prospective purchasers in the United States would perceive the term GEL TECH as merely descriptive of mattresses.

B. The Examiner's evidence.

1. Dictionary definitions.

The Examiner showed that the terms "gel" and "tech" were defined in dictionaries. According to the definitions submitted, "gel" is a jelly-like substance used in cosmetics and medical products. In chemistry, it refers a semi-solid colloidal suspension. In biochemistry, it means a slab or cylinder of an organic polymer. It may also be used as a verb. "Tech" can refer to a technical college, or to the word "technical" or "technology." "Technology" may mean the application of science to industry or commerce or to the total body of knowledge. Thus, the Examiner's proffered dictionary definitions establish that each of these terms is broadly used across many industries.

Notably, neither of these terms has been shown to have any special significance in relation to mattresses. Perhaps more significantly, the Examiner offered no dictionary definition of the phrase "gel tech" or "gel technology."

2. Use by competitors.

The Examiner failed to show any use of the Mark as whole descriptively by competitors or by any third party. The only instances of third party usage of the term “gel tech” provided by the Examiner are easily removed as probative evidence.

Two of the so-called third party uses relied on by the Examiner are Applicant’s own product. The Lady Americana Gel Tech mattress sold by the Maui Bed Store and the Gel Tech mattress sold by the Mattress Ranch are both manufactured by Applicant, and the Gel Tech designation is clearly used by Applicant as a trademark for these mattresses. See the Declaration of Mr. Anderson, Applicant's Marketing Director, submitted with the reconsideration request on October 29, 2015.

The Gel Tech branded mattress sold on the Furniture Helpers site and on The Mattress Store site are the same mattress product sold by the two different retailers. The mattress is made by MBC Mattress Company, an unrelated third party. MBC Mattress Company is clearly using the term as a trademark and not descriptively, as the Examiner contends. See the product pages submitted with the reconsideration request filed by Applicant on October 29, 2015. The trademark GEL TECH is displayed prominently as a trademark and is listed along with other distinctive, non-descriptive trademarks, such as Catalina, Atlantis, and Venus. While the use of the term GEL-TECH as a trademark by MBC Mattress Company is without the consent of Applicant, it nevertheless demonstrates that this competitor views the term a source identifier and not a descriptor of the product.

The only other evidence submitted by the Examiner was an Amazon listing for “Memory Foam with Cool Gel Full Size Mattress and Box Springs Set.” “Gel

Tech” appears as part of the model number only, not used anywhere descriptively. This is plainly not a descriptive use of the term.

Thus, the Examiner has presented no evidence whatsoever of the descriptive use of the term “gel tech” by third parties.

3. Use by Applicant.

The Examiner also points to the specimen submitted with Applicant’s allegation of use, which is a display that prominently presents the term GEL TECH and its accompanying logo along with descriptive information about the product. This descriptive information refers to “gel infused memory foam.” This makes clear that the common descriptive phrase for this feature is not “gel tech” and supports the fact that customers were not expected to readily understand the meaning of the designation “gel tech.”

Moreover, Applicant’s marketing director has attested to the fact that in his thirty years in the mattress and bedding industry, he is unaware of any use of the term “gel tech” descriptively.

The Examiner contends that “both the individual components and the composite result are descriptive of applicant’s goods and/or services and do not create a unique, incongruous or nondescriptive meaning in relation to the goods and/or services. Specifically, the mattresses will contain gel and incorporate scientific properties or advanced

C. Applicant’s mark is too vague and non-specific to be violative of Section 2(e)(1).

A mark is merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, only if it immediately describes an ingredient, quality,

characteristic or feature of the goods, or if it directly conveys information regarding the nature, function, purpose or use of the goods. *In re Abcor Development Corp.*, 200 U.S.P.Q. 215, 217-218 (C.C.P.A. 1978). If information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a “suggestive,” not descriptive, manner. In order to be deemed merely descriptive, a designation must convey the descriptive information with a reasonable degree of particularity. *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 598 (T.T.A.B. 1978).

Each of the words “gel” and “tech” is used in relation to all sorts of goods and services. On the other hand, it should be noted that there are several other federally registered marks for GEL TECH or similar terms in several other widely diverse industries. The mark GEL TEK is federally registered for fish food (Reg. No. 3,657,809) with a disclaimer of “gel.” The mark GEL-TECH is federally registered for footwear. (Reg. No. 2,741,510). The mark GEL-TECH is federally registered for batteries. (Reg. No. 2,041,305). The mark GELTECH is federally registered for bicycle saddles. (Reg. No. 1,559,743). See Exhibits A-D submitted herewith.¹ All of these registrations were granted based on a finding of inherent distinctiveness; none of them is registered under Section 2(f). Applicant’s mark is no more descriptive of mattresses than any of these of these registered marks is descriptive of their respective goods.

Several cases demonstrate that in order to be deemed merely descriptive, a designation must convey some relatively specific and well understood information about

¹ These registrations were relied on by Applicant in the first response filed March 22, 2013. In none of the following Office actions did the Examiner advise Applicant that this listing was insufficient to make the registrations of record. Thus, the Examiner has waived any objection to the Board’s consideration of the prior registrations here on appeal.

the products involved. In *TMS*, the applicant sought registration of the mark THE MONEY SERVICE for financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution. The Board stated:

After considering carefully applicant's mark "THE MONEY SERVICE" in relation to the services set forth in its application papers, namely, financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution, it is our opinion that because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language, it suggests a number of things, *but yet falls short of describing applicant's services in any one degree of particularity*. To effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. In short, what we are saying is that applicant's mark "THE MONEY SERVICE" does not directly or indirectly convey any vital purposes, characteristics or qualities of applicant's services. Thus, the mark is suggestive and not a merely descriptive designation. [emphasis supplied]

In re TMS Corp. of the Americas, 200 U.S.P.Q. at 59. The term "gel tech" in Applicant's mark is no more definite or descriptive of Applicant's mattresses than "money" was in the mark in *TMS*.

The mark INTELLIGENT MEDICAL SYSTEMS was held not merely descriptive of electronic thermometers in *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674 (T.T.A.B. 1987). The mark was used for "electronic thermometers for measuring human body temperature." The Board found that the word "intelligent" has no special significance or meaning in the medical products field, and reasoned:

The fact that the word "intelligent" is, for the sake of argument, descriptive of a component within applicant's electronic thermometers (i.e. the electronic processor) does not automatically mean that this word is "merely descriptive" of the electronic thermometers themselves. ... While the word "intelligent" when applied to computers may immediately impart information about computers to average prospective purchasers of

computers, the word “intelligent” when applied to electronic thermometers does not, insofar as the record herein shows, immediately impart *with any “degree of particularity” information about electronic thermometers* to average prospective purchasers of electronic thermometers. [emphasis supplied]

In re Intelligent Medical Systems Inc., 5 U.S.P.Q.2d at 1675-76. The term “gel tech” has no special meaning in the mattress or bedding industry. Rather it is a broad and non-specific term that does not qualify as merely descriptive.

In the case of *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), the Board held that the marks ZN-PLUS, CA-PLUS, and MN-PLUS for mineral supplements containing zinc (Zn), calcium (Ca) or manganese (Mn), respectively, were not merely descriptive.

Significantly though, none of these marks possess a merely descriptive significance. At most, each of these marks suggest the presence in the particular product of the chemical material identified by the symbol and something more as other ingredients. To the extent that *there is nothing in the marks or, in particular, the term “PLUS” to indicate with any degree of particularity just what this something more is*, the marks fall within the suggestive range of the trademark spectrum enumerated by various tribunals although possibly somewhere in the far end of this range of marks. In sum, the marks “Zn-PLUS”, “Ca-PLUS”, and “Mn-PLUS” as used by applicant do not per se fall within the category of marks proscribed by Section 2(e)(1). [emphasis supplied]

Plus Products v. Medical Modalities Associates, Inc., 211 USPQ at 1204-1205. Similarly, in Applicant’s mark GEL TECH the information conveyed by the term GEL TECH is so broad and non-specific, it is not properly considered merely descriptive within the meaning of by Section 2(e)(1).

The term SPEEDI BAKE was held not to be mere descriptive of frozen dough because it only vaguely suggested a desirable characteristic of the product, namely, that it quickly and easily may be baked into bread. Thus, the mark was deemed

suggestive rather than descriptive. *In re George Weston Limited*, 228 USPQ 57, 58 (T.T.A.B. 1985).

In the case of *In re The House Store, Ltd.*, 221 U.S.P.Q. 92 (T.T.A.B. 1983), the applicant sought to register the mark THE HOUSE STORE for retail store services in the field of furniture and housewares with the word “store” disclaimed. The Board reversed the Examiner for having “cast his net too broadly.” Relying on *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57 (T.T.A.B. 1978), the Board found that the mark was too broad to describe the services with *the requisite “immediacy and particularity,”* and, consequently, ruled that the mark was suggestive rather than impermissibly descriptive. *In re The House Store, Ltd.*, 221 U.S.P.Q. at 93.

The mark PEST PRUF was held not to be merely descriptive of animal shampoo with a *sufficient “degree of particularity”* but rather was merely suggestive of a possible end result of the use of the product *In re Aid Laboratories, Incorporated*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983).

As these cases make clear, a designation can be technically descriptive of a product without being “merely descriptive,” as proscribed by Section 2(e)(1). If the designation is so broad or vague that it does not convey specific information to the average consumer, then it suggestive and not merely descriptive.

A mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought, or perception is required in order to determine what attributes of the goods or services the mark indicates. *In re Abcor Development Corp.*, 200 U.S.P.Q. at 218; *In re Mayer-Beaton Corp.*, 223 U.S.P.Q. 1347, 1349 (T.T.A.B. 1984). There is a thin line of

demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment

V. CONCLUSION

Based on the evidence of record, Applicant submits that the term GEL TECH as used by Applicant for mattresses is too vague and non-specific to be deemed merely descriptive. Rather, this phrase is suggestive and entitled to federal registration.

At the very least, Applicant has shown that there is doubt as to the descriptiveness of Applicant's mark. And, this doubt must be resolved in Applicant's favor. As the Board stated in *In re WSI Corporation*, 1 U.S.P.Q.2d 1570 (T.T.A.B. 1986):

As the Board has indicated on numerous occasions, the suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment. Indeed, this case may well present such a challenge in making the necessary classification. At the very least, however, we have doubts about the "merely descriptive" character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark act, it is clear that such doubts are to be resolved in favor of applicants. *In re Pennwalt Corp .*, 173 USPQ 317 (TTAB 1972) ("DRI-FOOT" for anti-perspirant foot deodorant); *In re Ray J. McDermott and Co, Inc .*, 170 USPQ 524 (TTAB 1971) ("SWIVEL-TOP" for fuel transfer mooring buoys).

In re WSI Corporation, 1 USPQ2d at 1573.

Based on the foregoing, Applicant's mark GEL TECH is not merely descriptive of mattresses. Accordingly, reversal of the descriptiveness rejection is respectfully requested.

Respectfully submitted,

/Mary M. Lee/

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Attorney for Applicant

Int. Cl.: 31

Prior U.S. Cls.: 1 and 46

United States Patent and Trademark Office

Reg. No. 3,657,809

Registered July 21, 2009

**TRADEMARK
PRINCIPAL REGISTER**

GEL TEK

SERGEANT'S PET CARE PRODUCTS, INC. (NE-
VADA CORPORATION)

2625 S 158TH PLAZA

OMAHA, NE 681301770

FOR: FISH FOOD, IN CLASS 31 (U.S. CLS. 1 AND
46).

FIRST USE 9-0-2004; IN COMMERCE 9-0-2004.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "GEL", APART FROM THE MARK
AS SHOWN.

SER. NO. 77-651,992, FILED 1-19-2009.

HEATHER SAPP, EXAMINING ATTORNEY

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,041,305

United States Patent and Trademark Office

Registered Feb. 25, 1997

**TRADEMARK
PRINCIPAL REGISTER**

GEL-TECH

EAST PENN MANUFACTURING COMPANY,
INC. (PENNSYLVANIA CORPORATION)
DEKA ROAD
LYON STATION, PA 195360147

FIRST USE 8-0-1995; IN COMMERCE
8-0-1995.

SN 74-690,503, FILED 6-19-1995.

FOR: ELECTRIC STORAGE BATTERIES, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

KEVIN PESKA, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,741,510

Registered July 29, 2003

**TRADEMARK
PRINCIPAL REGISTER**

GEL-TECH

ASICS CORPORATION (JAPAN CORPORATION)
1-1 MINATOJIMA-NAKAMACHI 7 CHOME
CHUO-KU KOBE 650-8555, JAPAN

OWNER OF U.S. REG. NOS. 1,776,598, 2,590,361
AND OTHERS.

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND
39).

SER. NO. 76-447,058, FILED 9-3-2002.

FIRST USE 12-0-2001; IN COMMERCE 12-0-2001.

ANDREA SAUNDERS, EXAMINING ATTORNEY

EXHIBIT C

Int. Cl.: 12

Prior U.S. Cl.: 19

United States Patent and Trademark Office **Reg. No. 1,559,743**
Registered Oct. 10, 1989

**TRADEMARK
PRINCIPAL REGISTER**

GELTECH

VELO ENTERPRISE CO., LTD. (TAIWAN COR-
PORATION)
NO. 1012, SEC. 1
CHUNG SHAN ROAD
TACHIA, TAICHUNG HSIEN, TAIWAN

FIRST USE 9-0-1988; IN COMMERCE
11-0-1988.

SER. NO. 782,479, FILED 2-23-1989.

FOR: BICYCLE SADDLES, IN CLASS 12 (U.S.
CL. 19).

CHRIS A. F. PEDERSEN, EXAMINING ATTOR-
NEY

EXHIBIT D