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Subject: U.S. TRADEMARK APPLICATION NO. 85646871 - GEL TECH - 6220-007 - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85646871

MARK: GEL TECH



**CORRESPONDENT ADDRESS:**

MARY M LEE

MARY M LEE PC

1300 E 9TH ST NO 4

EDMOND, OK 73034-5760

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Sound Sleep Products, Inc.

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

6220-007

**CORRESPONDENT E-MAIL ADDRESS:**

mml@marymlee.com

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, Sound Sleep Products, Inc., has appealed the examining attorney's final refusal to register the mark "GEL TECH" for mattresses. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a) on the ground that the mark is merely descriptive of the goods.

### **FACTS**

On June 8, 2012, applicant applied to register the mark “GEL TECH” for “mattresses,” in International Class 20. The application was initially refused registration on September 25, 2012, based on a prior pending application with Serial Number 85278556, on a likelihood of confusion with Registration Number 3636884, and on the ground that the mark is merely descriptive of the goods. On March 22, 2013, applicant responded to the office action refuting the Section 2(d) refusal, the potential refusal with the prior pending application, and the Section 2(e)(1) refusal. Applicant also offered a disclaimer of the term GEL in this response. Applicant then filed an Amendment to Allege Use on March 29, 2013. On March 25, 2013, the application was suspended pending the outcome of the prior pending application, and maintaining the Section 2(d) and 2(e)(1) refusals. On May 25, 2015, the refusal with Registration Number 3636884 and potential refusal with Serial Number 85278556 were withdrawn, but the Section 2(e)(1) refusal was made final. On September 11, 2015, applicant requested reconsideration of the final refusal and resubmitted the disclaimer of the term GEL. On October 5, 2015, the request for reconsideration was denied. On October 29, 2015, applicant filed a further request for reconsideration, and applicant filed a brief on January 24, 2016.

### **ISSUE**

The issue on appeal is whether the mark “GEL TECH” is merely descriptive of a feature of applicant’s mattresses.

### **ARGUMENT**

**THE MARK “GEL TECH” IS MERELY DESCRIPTIVE OF A FEATURE OF APPLICANT’S GOODS, AND, THEREFORE, THE MARK IS PROPERLY REFUSED REGISTRATION UNDER TRADEMARK ACTION SECTION 2(e)(1).**

Trademark Act Section 2(e)(1) bars registration of an applied-for mark that merely describes the goods or services named in the application. 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); see, e.g., *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

"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 a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

#### The Mark is Merely Descriptive

Applicant has applied to register the proposed mark "GEL TECH" for mattresses. Applicant's mark is merely descriptive because it immediately and logically describes a feature or characteristic of applicant's mattresses.

The term "GEL" means "a jelly-like substance," and "a semi-solid colloidal suspension of a solid dispersed in a liquid." See attachments to the March 25, 2012, Office Action pgs. 12-13. "TECH" is an

acronym for the term “technology,” and the term technology is defined as “the application of practical sciences to industry or commerce.” See attachments to the March 25, 2012, Office Action pgs. 14-19.

Often, gel is used in connection with the filling of a mattress.

Further, the evidence of record shows that the term “GEL” is commonly used as a substance in the composition of mattresses, and TECH is used to describe the advanced technology used in the creation of the mattress that incorporate this type of substance in its core or filling. Examples obtained from internet web pages and made of record showing the terms “GEL” and “TECH” include the following:

- [www.nicholascase.net/soundsleep/geltech.html](http://www.nicholascase.net/soundsleep/geltech.html): This blog states the mattresses contain “Gel-infused memory foam.” See attachments to the May 25, 2015, Final Office Action page 2.
- [www.coronamattressstore.com/gel-tech.html](http://www.coronamattressstore.com/gel-tech.html): This web page includes information about the composition of mattresses: “The MBC **Gel-Tech** the best value in the MBC with a Comfort Scale rating of 5 and a firmness Scale of 3 this mattress provides full perimeter reinforcement with high density foam making this mattress more durable.” See attachments to the May 25, 2015, Final Office Action pgs. 3-4.
- [www.amazon.com/Memory-Foam-Cool-Gel-Mattress](http://www.amazon.com/Memory-Foam-Cool-Gel-Mattress): This business provides mattresses for purchase that contain “Memory Foam with Cool **Gel**.” See attachments to the May 25, 2012, Final Office Action pgs. 5-8.
- [www.mattressranchlcom/our-mattresses](http://www.mattressranchlcom/our-mattresses): This business provides mattresses and states “**Gel Tech**,” and contains “Pressure relieving memory foam blended with cooling gel. See attachments to the May 25, 2015, Final Office Action pgs. 9-13.

Additionally, the following excerpts show the terms “GEL” and “TECH” used in connection with mattresses:

- [www.mauibedstore.com/products/lady-americans-mattresses/specialty-mattress-12-essence-gel-tech-memory-foam](http://www.mauibedstore.com/products/lady-americans-mattresses/specialty-mattress-12-essence-gel-tech-memory-foam): This business will provide “Lady Americana **Gel-Tech** Mattress,” which contains “Liquid Gel infused memory foam that will keep you cool during the hot and humid Hawaiian nights!” See attachments to the October 5, 2015, Request for Reconsideration Denied pgs. 2-4.
- [www.furniturehelpers.com/gel-tech-mattress-set.html](http://www.furniturehelpers.com/gel-tech-mattress-set.html): This business indicates, “This might just be the best mattress you can buy in this price range. Featuring a 4” pillow top that is filled with nano pocket coils, **gel** visco memory foam and visco memory foam you feel like you are sleeping on a cloud.” See attachments to the October 5, 2015, Request for Reconsideration Denied pgs. 10-11.

- [www.barrsfurniture.com/product/gel-tech-mattress](http://www.barrsfurniture.com/product/gel-tech-mattress): This business offers a “**GEL TECH MATTRESS.**” See attachments to the October 5, 2015, Request for Reconsideration Denied pgs. 14-16.
- [www.hhfurniture.com/ren/bedrooms/gel-memory-foam-bed](http://www.hhfurniture.com/ren/bedrooms/gel-memory-foam-bed): This business will provide “**QUEEN Gel Tech Memory Foam Mattress**” See attachments to the October 5, 2015, Request for Reconsideration Denied pgs. 17-18.

Accordingly, the evidence of record establishes that the term “GEL” is widely used in the mattress field to provide the user with exceptional sleep quality in that the gel substance provides greater cooling and tend to make the mattresses last longer. These are important and desirable features for the consumer. Please see the attached web page evidence referenced above from [Coronamattressstore.com](http://Coronamattressstore.com) which states, “...full perimeter reinforcement with high density foam making this mattress more durable.” See attachments to the May 25, 2015, Final Office Action pgs. 3-4. Further, the gel or gel-like substance will conduct heat from the user and will move it away to keep the user cool throughout the night. Please see the attached web page evidence referenced above from [Amazon.com](http://Amazon.com) which states the mattresses will contain, “3” gel memory foam sleep cool technology.” See attachments to the May 25, 2012, Final Office Action pgs. 5-8.

The terms GEL and TECH immediately describe the composition of a component of the mattresses (the gel) incorporated through the use of advanced knowledge (the tech, or technology). A consumer will likely be searching for, and shopping for, a mattress that contains this advanced technology because it provides a perceived improvement over previous products and/or practices in the mattress industry. The above-referenced evidence demonstrates that it is common practice in the mattress community to infuse the mattresses with gel for a better or more restful sleep. As stated in their Request for Reconsideration “Applicant acknowledges the descriptive nature of the term ‘gel’ when use[d] apart from the mark as whole.[sic] Accordingly, Applicant herein disclaims the term ‘gel.’” See argument from September 11, 2015.

Applicant argues however that, "... '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." See Applicant's Appeal Brief dated January 24, 2016, pg. 3. Applicant also unsuccessfully argues that, "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.'" See Applicant's Appeal Brief dated January 24, 2016, pg. 3.

Descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

It is not necessary to demonstrate that the definitions solely or directly address applicant's goods. It is, rather, that the consuming public would believe the goods comprise advanced technology through the use of a gel, or jelly-like substance, in the mattresses. The existence of clear definitions strongly indicate what meaning consumers would apply to these words in the context of these goods.

Further, applicant argues that "...it should be noted that there are several other federally registered marks for GEL TECH or similar terms in several other widely diverse industries." See Applicant's Appeal Brief dated January 24, 2016, pg. 6. The fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. See *In re*

*Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Applicant's argument that the mark considered as a whole is not merely descriptive is without merit. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a).

Applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the terms "GEL TECH" is descriptive of a feature or characteristic of the goods. Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace

and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209.

Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

### **CONCLUSION**

The evidence of record shows that the term "GEL TECH" used in connection with applicant's mattresses is descriptive of a feature of the goods. Applicant's mattresses contain gel technology, or tech for short. Therefore, applicant's proposed mark "GEL TECH" merely describes a feature or characteristic of its mattresses. Accordingly, the examining attorney respectfully requests the refusal to register the mark under Trademark Act Section 2(e)(1) is proper and should be affirmed.

Respectfully submitted,

/Anne C. Gustason/

Trademark Examining Attorney

Law Office 117

(571) 272-9722

[anne.gustason@uspto.gov](mailto:anne.gustason@uspto.gov)

/Hellen Bryan-Johnson/

Managing Attorney

Law Office 117