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

Proceeding	86337786
Applicant	Hologic, Inc.
Applied for Mark	HOLOGIC 3D MAMMOGRAPHY
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Serial No. 86337786

Mark: HOLOGIC 3D
MAMMOGRAPHY

Filing Date: July 15, 2014

**APPLICANT'S EX PARTE
APPEAL BRIEF**

Applicant: Hologic, Inc.

Examining Attorney: Jeffrey J. Look

Law Office: 108

INDEX OF CITATIONS

Cases:

- Charrette Corp. v. Bowater Comm. Papers, Inc.*, 13 U.S.P.Q.2d 2040 (T.T.A.B. 1989)
- Educ. Dev. Corp. v. Economy Co.*, 562 F.2d 26, 195 U.S.P.Q. 482 (10th Cir. 1977)
- French Transit Ltd. v. Modern Coupon Sys., Inc.*, 818 F.Supp. 635, 29 U.S.P.Q.2d 1626 (S.D.N.Y. 1993)
- In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (T.T.A.B. 1972)
- In re Women's Publ'g Co.*, 23 U.S.P.Q.2d 1876 (T.T.A.B. 1992)
- Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 97 U.S.P.Q.2d 1878 (9th Cir. 2011)
- Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968)
- Swiss Watch Int'l, Inc. v. Fed'n Swiss Watch Indus.*, 101 U.S.P.Q.2d 1731, 1744 (T.T.A.B. 2012)
- Timex Grp. U.S., Inc. v. Focarino*, 993 F.Supp.2d 606 (E.D. Va. 2014)
- Union Carbide Corp. v. Ever-Ready Inc.*, 188 U.S.P.Q. 623 (7th Cir. 1976)
- Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 14 U.S.P.Q.2d 1577 (S.D. Ohio 1990)

Statutes:

Lanham Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1)

Secondary Sources:

- J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2015)
- Masami Ando et al., *Very High Contrast and Very High Spatial Resolution 2-D, 2.5-D and 3-D Breast Tissue Visualization under X-ray Dark Field Imaging*, in *Breast Imaging: 11th Annual Workshop* 104, 104-10 (Andrew D.A. Maidment et al. eds., 2012)
- ACR Radiology Coding Source™ for November-December 2014*, American College of Radiology, <http://www.acr.org/Advocacy/Economics-Health-Policy/Billing-Coding/Coding-Source-List/2014/Nov-Dec-2014/QA> (last visited Oct. 9, 2015)

Applicant, Hologic, Inc., respectfully appeals the Examining Attorney's requirement that Applicant disclaim the wording "3D MAMMOGRAPHY" from Applicant's mark HOLOGIC 3D MAMMOGRAPHY in standard characters ("Applicant's Mark") in U.S. Trademark Application Serial No. 86337786 (the "Application").

I. Procedural History.

In a non-final Office Action dated October 30, 2014, the Examining Attorney initially refused Applicant's Mark in connection with tomosynthesis technology. The Examining Attorney required a disclaimer of the wording "3D MAMMOGRAPHY" in Applicant's Mark, alleging that this wording was merely descriptive of the applied-for goods pursuant to Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1). Applicant filed a response to the Office Action on April 16, 2015. The Examining Attorney issued a final Office Action on May 20, 2015, which made final the refusal of the Application. On August 13, 2015, Applicant filed a Request for Reconsideration of the final refusal. In an Office Action dated September 12, 2015, the Examining Attorney denied Applicant's Request for Reconsideration.

Applicant appeals the Examining Attorney's final rejection and timely filed a Notice of Appeal with the Trademark Trial and Appeal Board on September 15, 2015. For the reasons set forth herein, Applicant respectfully submits that there is no valid impediment to registration and requests that the Examining Attorney's conclusion as to descriptiveness be reversed.

II. Factual Background.

Applicant is the world's largest provider of breast tomosynthesis systems used for screening and diagnosing breast cancer. Tomosynthesis is a method for performing high-resolution limited-angle tomography at mammographic dose levels. This advanced technology avoids two major pitfalls of traditional mammography—(i) normal breast structures obscuring

malignant tumors, and (ii) the appearance of summation shadows—which can hinder examination.

On February 11, 2011, Applicant received approval from the U.S. Food and Drug Administration to market its tomosynthesis systems in the United States for medical use. At that time, Applicant was concerned that many potential customers could not easily pronounce or spell the word “tomosynthesis.” Moreover, while “tomosynthesis” is an accurate description of the technology used in Applicant’s imaging system, it does not uniquely identify Applicant. As a result, Applicant created the trademark HOLOGIC 3D MAMMOGRAPHY so that hospitals, clinics and doctors would associate Applicant’s Mark with Applicant and immediately recognize Applicant’s brand of tomosynthesis systems. No other company has used or is using Applicant’s trademark HOLOGIC 3D MAMMOGRAPHY as the brand name of a competing breast tomosynthesis system.

III. Argument.

I. ***Legal Standard.***

A mark is suggestive, rather than descriptive, if it requires consumers to use thought, imagination or perception to understand the mark’s significance. *See Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 97 U.S.P.Q.2d 1878, 1881 (9th Cir. 2011) (affirming that the mark VERICHECK is suggestive, not descriptive, of check verification services); *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 14 U.S.P.Q.2d 1577, 1589 (S.D. Ohio 1990) (holding HEARTWISE suggestive for foods low in fat and cholesterol because it requires imagination to conclude that such food is “wise for the heart”). If a mark does not unequivocally and immediately describe to consumers the nature of an applicant’s specific goods, then the mark should be considered suggestive and deserving of registration. *See French Transit Ltd. v. Modern Coupon Sys., Inc.*,

818 F.Supp. 635, 29 U.S.P.Q.2d 1626, 1627 (S.D.N.Y. 1993) (holding that a suggestive mark “only ‘indirectly’ describes the goods or services at issue”).

2. *Applicant’s Mark Is Not Merely Descriptive of Applicant’s Goods Because Applicant’s Goods Do Not Produce Three-Dimensional Images.*

In the instant case, Applicant’s Mark is not merely descriptive because it does not “convey[] an immediate idea of the ingredients, qualities or characteristics” of Applicant’s products. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479, 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968). Before it can determine whether a term is descriptive, the Board must define and examine the term in the context in which it is used. Here, Applicant has applied to use the term “3D” in connection with mammography imaging systems, which are also known as tomosynthesis systems. As it is understood by the sophisticated professionals and healthcare providers who operate in this field and comprise Applicant’s target customer base, and as discussed in greater detail below, “3D” is a highly technical term for an image that provides a complete volumetric view of an object’s height, width and depth.

The Examining Attorney chose to ignore the technical definition and instead applied a definition of “3D” that includes images that give merely the *effect* or *appearance* of height, width and depth. The distinction between the technical definition and the Examining Attorney’s definition of choice is significant and meaningful to the medical professionals who are the target purchasers and users of Applicant’s branded tomosynthesis systems. The Examining Attorney’s failure to consider the fact that Applicant’s customers are hospitals, clinics, doctors and radiologists is clear from the Examining Attorney’s response to Applicant’s Request for Reconsideration, in which he ignored the nature of the market for expensive radiological equipment and instead argued that “the abbreviation 3D” is generally understood by consumers as meaning “three-dimensional.” Presumably the Examining Attorney considers “consumers” to

be the general public, but it is clearly evident that the general public does not purchase tomosynthesis devices.

In the medical imaging field, traditional 3D-imaging technology, such as computerized tomography (“CT”) scanners and medical resonance imaging (“MRI”) machines, enables doctors to generate complete detailed images of the body parts they examine. In other words, if one was able to cut a body part into tiny pieces, one could predict the characteristic of every piece and at every location from a three-dimensional image. Both CT and MRI technology are acknowledged by professionals and professional organizations in the field to be “3D” because only those technologies produce the complete image necessary to view every piece at every location in the images they produce. These images do not merely give the effect of “3D”—they are in fact three-dimensional as understood in the medical community. Thus, the term “3D” may be considered an accurate descriptor of CT and MRI technology.

Applicant’s tomosynthesis technology does not generate three-dimensional images as the term is understood in the relevant market. According to the American College of Radiology, the premier medical imaging professional society representing more than 37,000 radiologists, oncologists and physicians, “Breast tomosynthesis is not truly 3-D in any sense, and is not the 3D imaging as is done for CT and MR.” *ACR Radiology Coding Source for November-December 2014*, American College of Radiology, <http://www.acr.org/Advocacy/Economics-Health-Policy/Billing-Coding/Coding-Source-List/2014/Nov-Dec-2014/QA> (last visited Oct. 9, 2015). Unlike the three-dimensional images produced by CT scanners and MRI machines, tomosynthesis technology creates a “limited angle tomography” scan. Instead of imaging a body part from all angles to create a complete image, tomosynthesis systems “photograph” and compile multiple images into an image set of the subject body part. This image set necessarily

includes gaps, even if miniscule, which the radiologist reading the image set must factor into her assessment. Imagine, for example, a deck of cards. While the full deck presents a complete rectangular box or prism, there remain very small spaces between each card, which result in a difference in image completeness and clarity. Therefore, while Applicant's tomosynthesis system will generate images of human breast tissue in greater detail than traditional 2D mammography technology, Applicant's tomosynthesis is not a "3D" technology as the term is understood by Applicant's sophisticated target purchasers. Indeed, in the medical imaging field, tomosynthesis imaging is often referred to as "2.5D" imaging. *See Masami Ando et al., Very High Contrast and Very High Spatial Resolution 2-D, 2.5-D and 3-D Breast Tissue Visualization under X-ray Dark Field Imaging*, in *Breast Imaging: 11th Annual Workshop* 104, 104-10 (Andrew D.A. Maidment et al. eds., 2012). While the term "3D" is suggestive of Applicant's technology, it is not descriptive when viewed by Applicant's potential consumers. *See ACR Radiology Coding Source, supra* ("[Tomosynthesis] is not 3-D in the way most of us think about 3D.").

For purposes of determining whether Applicant's Mark is descriptive, it is critical that the Board consider Applicant's Mark in connection with Applicant's applied-for goods: a tomosynthesis system for breast imaging. The record is clear that Applicant's tomosynthesis technology does not literally create a three-dimensional medical image. *See Masami Ando et al., supra*, at 104-10 (describing tomosynthesis as "2.5-D" technology). The Examining Attorney incorrectly asserted that Applicant's Mark is descriptive of a product that "makes 3D mammographic images." Yet, as the record conclusively demonstrates, Applicant's tomosynthesis technology is not a 3D technology and does not have the capability to create

three-dimensional images as the term is understood in the relevant market. Therefore, the term “3D” cannot be said to be merely descriptive of Applicant’s products.

3. Applicant’s Mark Is Suggestive Because Applicant’s Sophisticated Customers Will Find Applicant’s Mark Incongruous.

To evaluate the distinctiveness of a mark, courts consider the perception of a majority of the relevant consumer group, rather than the general public. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:70 (4th ed. 2015). If the goods are sold only to sophisticated purchasers with an intimate knowledge of the goods, courts will evaluate whether this group would find the mark descriptive or suggestive. *See Educ. Dev. Corp. v. Economy Co.*, 562 F.2d 26, 195 U.S.P.Q. 482, 485 (10th Cir. 1977) (holding that where purchasers are sophisticated and discriminating persons in the educational field, the meaning to them, not the general public, is the issue). If to a majority of prospective purchasers the applied-for mark is not merely descriptive of the underlying product or service, the mark should be held to be suggestive.

Here, the prospective purchasers of Applicant’s goods are sophisticated and discriminating professionals in the field of medical imaging. The hospitals and medical services clinics that purchase Applicant’s tomosynthesis systems, and the radiologists who use them, understand that Applicant’s Mark suggests a tomosynthesis system that produces more robust images than traditional x-ray technology, rather than describes a literal three-dimensional imaging system. As a result, the potential purchasers of Applicant’s tomosynthesis systems understand Applicant’s Mark as unique, incongruous, and not merely descriptive of Applicant’s technology.

Courts routinely recognize that incongruous marks are suggestive and not merely descriptive. *See, e.g., Union Carbide Corp. v. Ever-Ready Inc.*, 188 U.S.P.Q. 623, 635 (7th Cir.

1976) (“[I]ncongruity is a strong indication of non-descriptiveness.”). For example, in *Timex Group U.S., Inc. v. Focarino*, the U.S. District Court for the Eastern District of Virginia held that the mark INTELLIGENT QUARTZ for quartz timepieces was incongruous, and therefore not descriptive, because of the specialized definition of the word “intelligent” in the field of computer science and technology and with respect to the watch industry. 993 F.Supp.2d 606, 609 (E.D. Va. 2014). The record demonstrated that “intelligent” technology is that which is equipped with a microprocessor or computer and, as a result, is capable of performing certain independent functions and storing information. *Id.* at 608. The applicant’s products, however, functioned the same as any quartz time piece: “the quartz crystal in a Timex INTELLIGENT QUARTZ watch oscillates at a precise frequency, creating a time base for the watch.” *Id.* at 609. Microprocessors do not control the quartz, and “a quartz crystal is not capable of engaging in data storage or processing.” *Id.* As a result, in the context of the watch industry the mark “INTELLIGENT QUARTZ is nonsensical as a compound mark and thus cannot accurately describe how a timekeeping device works.” *Id.* Therefore, the court held, the mark was not descriptive of the immediate idea of the ingredients, qualities or characteristics of the goods. *Id.*; *see Stix Products*, 160 U.S.P.Q. at 785.

In the instant case, in the context of the medical imaging field, Applicant’s Mark HOLOGIC 3D MAMMOGRAPHY is incongruous and is not descriptive of Applicant’s goods. In the sophisticated field of medical imaging, the word “3D” denotes technology that produces a literally three-dimensional image. CT scanners and MRI machines, which employ this sort of 3D technology, have very specific functions which are known and understood in the field. These types of true three-dimensional imaging systems are separate and apart and are not interchangeable with Applicant’s tomosynthesis imaging system, which merely generates a

volumetric effect. In the context of medical imaging, the mark HOLOGIC 3D MAMMOGRAPHY is nonsensical as a compound mark and does not describe the technical characteristics of Applicant's products. Instead, it is used to suggest a more robust image than traditional 2D mammography technology in terminology that is readily understood by the professional customer. Hospitals, clinics, and radiologists—Applicant's potential customers—will easily understand the suggestion that Applicant's product produces an image with greater volume and detail than traditional 2D mammography, but will not otherwise be otherwise misled since they are familiar with tomosynthesis technology. As a result of this incongruity, Applicant's Mark is not merely descriptive.

4. *The Examining Attorney's Evidence of Media Misuse of Applicant's Mark Does Not Establish that Applicant's Mark Is Descriptive or Generic.*

The Examining Attorney continues to rely upon various articles and webpages attached to the original Office Action, dated October 30, 2014, and the Reconsideration Letter, dated September 12, 2015, to support his contention that Applicant's Mark is generic or merely descriptive. Applicant, in its response dated April 16, 2015, submitted the Declaration of James D. Culley, Ph.D. (the "Culley Declaration"), which analyzed each of the Examining Attorney's cited articles and explained that *nearly all* of their uses of Applicant's Mark were in fact references to Applicant's proprietary breast tomosynthesis system. *See* April 16, 2015 Response to Office Action, TSDR p. 12–32. The examples of third-party use cited by the Examining Attorney are clearly insufficient to prove that Applicant's Mark is a merely descriptive or generic term for Applicant's product. Moreover, the rare and sporadic examples of actual descriptive misuse of Applicant's Mark identified by the Examining Attorney are far from the pervasive third-party use necessary to render Applicant's otherwise distinctive mark generic. *See Swiss Watch Int'l, Inc. v. Fed'n Swiss Watch Indus.*, 101 U.S.P.Q.2d 1731, 1744 (T.T.A.B. 2012)

(finding media misuse of SWISS mark for watches insufficient to prove that mark had become generic). This infrequent misuse of Applicant's Mark by the media or other third-parties is clearly insufficient to deny Applicant trademark rights in Applicant's Mark.

In addition, in connection with the Office Action dated September 12, 2015, the Examining Attorney provided the results of a LEXIS search for Applicant's Mark as proof that Applicant's Mark is merely descriptive. The Board should give no weight these search results. As the Board has previously held, the mere appearance of a trademark in media articles, as evidenced by search results from LEXIS or an online search engine, is insufficient to prove what impact such use may have had on consumers in the marketplace. *See Charrette Corp. v. Bowater Comm. Papers, Inc.*, 13 U.S.P.Q.2d 2040 (T.T.A.B. 1989); 2 McCarthy § 11:88. The Examining Attorney provided no additional evidence that such uses refer generally to breast tomosynthesis rather than specifically to Applicant and its products. Therefore, these additional search results are dispositive of nothing and do not support a finding that Applicant's Mark is merely descriptive or generic.

Moreover, by conducting general LEXIS media searches rather than examining medical trade journals and digests, the Examining Attorney continues to ignore the way in which Applicant's target customers understand and use Applicant's Mark. In connection with the Culley Declaration, Applicant submitted the results of a search of the PubMed database on March 25, 2015 for Applicant's Mark and for the generic term "tomosynthesis." *See* April 16, 2015 Response to Office Action, TSDR p. 14–15. The PubMed database consists of more than 24 million citations for biomedical literature compiled from MEDLINE, life science journals and online medical books—literature with which Applicant's target customers are intimately familiar. *Id.* The PubMed search identified only 13 articles that contained the term "3D

mammography” and 63 articles that contained the term “3-D mammography,” for a total of 76 articles. *Id.*

In contrast, the PubMed search revealed that medical industry publications use the generic term “tomosynthesis” over 16 times more frequently than Applicant’s Mark to refer to the type of technology Applicant provides. *Id.* The PubMed search identified nearly 1250 articles that used the generic term “tomosynthesis” in reference to breast imaging technology: 233 articles mentioned “digital breast tomosynthesis,” 308 articles used “breast tomosynthesis,” and 708 articles contained “tomosynthesis.” *Id.* In view of the medical community’s actual use of these terms, it is clear that Applicant’s Mark is not a generic term for Applicant’s tomosynthesis systems.

5. Any Doubt Regarding Descriptiveness Should Be Resolved in Favor of Applicant.

Any doubt as to whether a mark is descriptive should be resolved in favor of the Applicant. As Professor McCarthy states:

Because the line between merely descriptive and only suggestive terms is “so nebulous,” the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination.

2 McCarthy, supra, § 11:51. The Board has consistently applied this reasoning. *See, e.g., In re Women’s Publ’g Co.*, 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992) (holding that DECORATING DIGEST for a magazine on decorating was not descriptive and noting that “in accordance with precedent,” the Board “must resolve any reasonable doubt in favor of [the] applicant”); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (holding that DRI-FOOT for foot deodorant was not descriptive and noting that any “doubt should be resolved in favor of the applicant”).

IV. Conclusion.

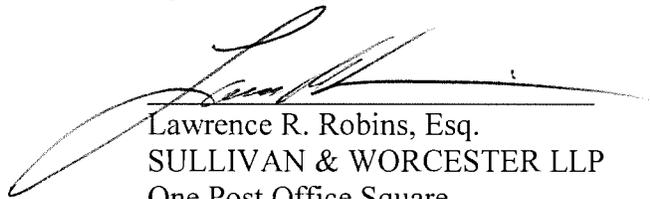
In view of the foregoing, the Applicant respectfully requests that the Board withdraw the Examining Attorney's disclaimer requirement, reverse the refusal to register Applicant's Mark and permit the Application to advance to publication.

Respectfully submitted,

HOLOGIC, INC.

By its attorney,

Dated: November 5, 2015

A handwritten signature in black ink, appearing to read "Lawrence R. Robins", is written over a horizontal line. The signature is fluid and cursive, with a long, sweeping underline that extends to the right.

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