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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NOS. 86337786, 86354289 and 86337786

MARKS: HOLOGIC 3D MAMMOGRAPHY

GENIUS 3D MAMMOGRAPHY

HOLOGIC 3D MAMMOGRAPHY

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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Hologic, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

89000.0098

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EXAMINING ATTORNEY'S APPEAL BRIEF

INDEX OF CITATIONS

Cases:

In re Abcor Dev. Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)

In re ActiveVideo Networks, Inc., 111 USPQ2d 1581 (TTAB 2014)

In re Analog Devices Inc., 6 USPQ2d 1808, 1810 (TTAB 1988)

In re Bayer Aktiengesellschaft, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)

Charette Corp. v. Bowater Comm. Papers, Inc., 13 USPQ 2d 2040 (TTAB 1989)

In re The Chamber of Commerce of the U.S., 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012)

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DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)

In re Hotels.com, L.P., 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009)

In re Leatherman Tool Grp., Inc., 32 USPQ2d 1443, 1449 (TTAB 1994)

In re Medical Disposables, 25 USPQ2d 1801 (TTAB 1801)

In re Meridian Rack & Pinion, 114 USPQ2d 1462, 1464 (TTAB 2015)

In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)

In re Nett Designs, Inc., 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)

In re Northland Aluminum Prods., Inc., 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985).

In re Phoseon Tech., Inc., 103 USPQ2d 1822, 1826 (TTAB 2012)

In re Scholastic Testing Serv., Inc., 196 USPQ 517, 519 (TTAB 1977);

In re Stereotaxis Inc., 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005);

In re Sun Microsystems, Inc., 59 USPQ2d 1084, 1087 (TTAB 2001);

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Statutes:

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I. INTRODUCTION

Applicant has appealed from Final Office Actions issued on May 20, 2015 in connection with application Serial Nos. 86337802, 86354289 and 86337786 for the marks 3D MAMMOGRAPHY

GENIUS 3D MAMMOGRAPHY and HOLOGIC 3D MAMMOGRAPHY, respectively. As for application Serial No. 86337802, the mark was refused registration under Section 2(e)(1) of the Trademark Act, 15 USC Section 1052(e)(1) as being merely descriptive of a feature, function, purpose or characteristic of applicant's identified goods for mammography imaging systems. With regard to Application Serial Nos. 86354289 and 86337786 for the marks GENIUS 3D MAMMOGRAPHY and HOLOGIC 3D MAMMOGRAPHY, the only issue concerned a disclaimer of the wording "3D MAMMOGRAPHY" apart from the mark because this portion of each mark is merely descriptive of a feature, characteristic, function or purpose of the goods. On December 16, 2015, this Board granted the examining attorney's motion to consolidate the three appeals for ease of briefing and handling. Each of these cases have common issues of law and fact which pertain to the registrability of the wording "3D MAMMOGRAPHY" on the Principal Register as a whole, or without a disclaimer in the case of the HOLOGIC 3D MAMMOGRAPHY and GENIUS 3D MAMMOGRAPHY applications. For simplicity in briefing, the examining attorney will primarily address the issue of descriptiveness with reference to Serial No. 86337802 for the mark 3D MAMMOGRAPHY for if the Board finds that this wording is not merely descriptive, then the requirement for disclaimers of these terms in the other two applications will be rendered moot.

II. STATEMENT OF FACTS

Application Serial No. 86337786 (HOLOGIC 3D MAMMOGRAPHY) and 86337802 (3D MAMMOGRAPHY) were both filed based on "intent-to-use" under Section 1(b) of the Trademark Act, 15 USC Section 1051(b), on July 15, 2014. Serial No. 86354289 (GENIUS 3D MAMMOGRAPHY) was filed on July 31, 2014 with the same filing basis. All three applications contained the same identification of goods, namely, "mammography imaging systems" in Class 10. As of this date, applicant has not filed an allegation of use in any of the applications. Registration was initially refused on October 30, 2014 based on the applied-for mark 3D MAMMOGRAPHY being merely descriptive of a feature, function, characteristic or

purpose of applicant's mammography imaging system. The grounds for the refusal were that the portion of the mark "3D" is a commonly understood abbreviation for "three-dimensional" and that "mammography" refers to "the radiological examination of the breasts to detect tumors." See the definitions attached to the October 30, 2014 Office Action from DICTIONARY.COM, AHDICTIONARY.COM and NLM.NIH.GOV (Medline database).[1] Additional evidence from FOXNEWS.COM, USATODAY.COM, STOPCANCERFUND.ORG, KOMEN.ORG, PHOENEXHOSPTIAL.COM, SAINTLUKESHEALTHSYTEM.ORG and EMORYHEALTHCARE.ORG were also attached to the October 30, 2014 Office Action which explained that "3D mammography" functions by taking images from three sides or positions of the patient to provide a three-dimensional image. These articles further explained that with such an image, the chance of detecting cancerous tumors is significantly increased.

Applicant, in its April 16, 2015 response, contended that the true generic name for the imaging system it manufactures is "tomosynthesis." Applicant produced a summary of a PubMed database search (without actually producing any articles obtained from the search) in which it alleges that the term "3D mammography" was mentioned in 76 articles but that there were 1249 articles that contained the wording "tomosynthesis." Applicant also included a Declaration from James Culley, the Senior Director of Corporate Communications for applicant, who stated that applicant "coined" the term "3D Mammography" in 2008 shortly after it introduced its mammography imaging system into Europe. Applicant did not enter the U.S. market until after the Food and Drug Administration approved the

[1] Additional dictionary definitions of "3D" were attached to the Final Action of May 20, 2015 from ABBREVIATIONS.COM, AHDICTIONARY.COM, COLLINSDICTIONARY (American English Edition) and MERRIAM-WEBSTER.COM as well as additional definitions of "mammography" from MERRIAM-WEBSTER.COM, MEDICAL-DICTIONARY.THEFREEDICTIONARY.COM and INFOPLEASE.COM.

system for use in 2011.[2] Culley also stated in the declaration that applicant found the term "tomosynthesis" hard to spell, pronounce and not memorable. The word "3D Mammography" was "coined" so that women could ask for, and doctors could prescribe, its "3D Mammography" brand of tomosynthesis. Culley also discounted the evidence in the first office action as being merely references to applicant's product. Applicant also attached 17 third party registrations for marks which contained "mammography" or "mammogram" on the Principal Register without disclaimers of the term and argued that this showed that it is the practice of the Trademark Office to treat "mammography" as a suggestive term.

A Final Office Action was issued on May 20, 2015 which contained more definitions of the terms "3D" and "mammography." Applicant's evidence was considered and discussed. Applicant's third party registrations are of no persuasive value as all of the registrations submitted used the term "mammogram" or "mammography" in the context of a unitary slogan; under Office practice, descriptive or generic terms are not disclaimed. See TMEP Section 1213.05(b). The refusal was maintained because the term "3D Mammography" merely describes the function or purpose of the goods, which is to provide a mammogram with three-dimensional characteristics of width, height and depth.

Applicant filed a Request for Reconsideration on August 13, 2015 generally maintaining that the applied-for mark, "3D Mammography," is not generic or merely descriptive for the goods. The applicant also argued for the first time, that its imaging system is not really a 3D imaging system, but a 2.5-D imaging system. Applicant explained that what its machine does is compile a set of multiple images which have

[2] While applicant has maintained that it is in fact selling the machines in the United States and has been for some time, applicant has yet to provide an allegation of use and specimens showing how the mark is used in connection with such goods.

tiny or miniscule gaps between each image; therefore, the word “3D Mammography” does not merely describe any feature or characteristic of the goods. Applicant included a single highly technical article written about the scientific mechanics of applicant’s machinery. Applicant dismissed the examining attorney’s evidence as being either articles that are about applicant’s machine in particular, or examples of media misuse of their applied-for trademark. On September 12, 2015 the Request for Reconsideration was denied. Attached to the denial of the Request for Reconsideration was a representative sample of several Lexis/Nexis database news articles about “3D Mammography.”[3] These articles show that doctors and hospitals, providers of mammography services, publicly described the function of the machinery as producing a three-dimensional image of the breast. The articles further tout these three-dimensional images as providing better resolution and being more likely to detect tumors than 2D mammograms. This evidence was included to rebut applicant’s contention that doctors and clinicians use the term “2.5-D Mammography” to refer to tomosynthesis and that the relevant consumers would generally understand the terms “3D Mammography” as meaning something other than a mammogram that has a three-dimensional appearance.

III. ISSUE

The sole issue on appeal is whether the term “3D Mammography” is merely descriptive of a feature, function, purpose or characteristic of applicant’s identified goods, “mammography imaging systems” under Section 2(e)(1).[4] While applicant has dedicated much of its argument in its brief toward the issue of whether the term is generic for the goods, that is not the issue for this Board to decide in these cases. The examining attorney refused the applied for mark because it is merely descriptive under Section

[3] The Lexis/Nexis articles attached at the end of the September 12, 2015 Office Action were a representative sample of news articles which appeared in U.S. Publications since September 11, 2010. The examining attorney endeavored to omit multiple articles from or about the same source and wire services articles.

[4] Whether the term "3D Mammography" is generic is not at issue because applicant has not applied for registration of the mark on the Supplemental Register, nor could it at this point as it has yet to file an allegation of use in the 3D MAMMOGRAPHY application. A mark in an application under Trademark Act Section 1(b), 15 USC Section 1051(b), is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. Further, applicant has not requested registration under Section 2(f).

2(e)(1), and not because the applied for mark is generic under Section 23(c) of the Trademark Act, 15 USC Section 1091(c). Likewise, with regard to the HOLOGIC 3D MAMMOGRAPHY and GENIUS 3D MAMMOGRAPHY applications, a disclaimer of the term "3D Mammography" is required because it is merely descriptive of the identified goods under Section 2(e)(1), and not because the term is generic. See 15 U.S.C. Section 1056(a). This is an important distinction because the examining attorney does not need to show that the wording “3D mammography” identifies a genus of goods, only that it is merely descriptive of a feature, characteristic, function or purpose of the goods. The examining attorney contends that the evidence of record amply demonstrates that the applied-for mark, 3D MAMMOGRAPHY, is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 USC Section 1052(e)(1), and that the refusal to register on this basis should be affirmed in each application.

IV. ARGUMENT

A mark is merely descriptive if “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods or services.” *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); *see DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)). Determining the descriptiveness of a mark is done in relation to an applicant’s goods, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

In this appeal, the marks are 3D MAMMOGRAPHY, HOLOGIC 3D MAMMOGRAPHY and GENIUS 3D MAMMOGRAPHY. In each application the goods are identified as “mammography imaging systems.” Ample evidence in the record shows that the abbreviation “3D” would generally be understood by consumers as a reference to “three-dimensional.” Specifically, there are at least five on-line dictionary definitions from standard American English dictionaries defining “3D” as something which has the form **<u>or appearance</u>** of height, width and depth. See the definitions attached to the May, 20, 2015 Office Action at pages 17, 21, 23 and 26. A “mammogram” is nothing but an X-ray image of the breast and “mammography” is the process of taking such an image. See the definitions attached to the October 30, 2014 Office Action at page 2 and the May 20, 2015 Office Action at pages 2 and 5. Both of the individual terms have been in the English lexicon for decades prior to 2008 when applicant is alleged to have “coined” the term. See the attachment from MERRIAM-WEBSTER.COM attached to the May 20, 2015 Office Action (Pages 2 and 18).

Marks comprising more than one element must be considered as a whole and should not be dissected; however, a trademark examining attorney may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012) (reversing Board’s denial of cancellation for SNAP! with design for medical syringes as not merely descriptive when noting that the Board “to be sure, [could] ascertain the meaning and weight of each of the components that ma[de] up the mark”). Here the terms "3D" and "mammography" when used together immediately and directly convey to the consumer of the product information about the purpose, function or feature of applicant’s mammography imaging system. The entire purpose of applicant’s mammography imaging

system is to create mammograms, which are X-ray images of the breast. Applicant contends that the true scientific name for the system is "tomosynthesis" and that this is the generic name for the goods. However, the issue here is whether the term "3D Mammography" describes a purpose, function or characteristic of the goods. In any event, there can be more than one generic or merely descriptive term for the goods. *In re 1800Mattress.com IP, LLC*, 586 F. 3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1464 (TTAB 2015).

Until recent years, doctors could only offer a mammography that produced a conventional two-dimensional image. According to applicant, it has pioneered the technology to enable doctors to offer mammography patients an image that is enhanced. While at one time, applicant may have been the only provider of such equipment, it appears that this is no longer the case. Regardless, even if applicant is the sole source or the leading source of such equipment in the industry, this does not necessarily mean the applied-for mark is not merely descriptive. The fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; when, as in this case, the evidence shows that the term is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

Applicant has argued in its brief that its customers are very sophisticated professionals who operate in the field of medicine and that these consumers know and understand the wording "3D Mammography" to be a branded product offered exclusively by the applicant. Applicant has accused the examining attorney of ignoring the technical meaning of the term "tomosynthesis." However, applicant has offered no substantive evidence that its target customers know and understand the wording "3D

Mammography" as more than a merely descriptive term for a characteristic, function or purpose of the goods. Applicant points to a single scientific journal article explaining that its mammography imaging system really only produces a 2.5-D image with miniscule gaps between the individual images as proof that all doctors and hospital administrators understand that the wording "3D Mammography" functions as a suggestive mark, and that applicant is the sole source of that product. The applicant faults the examiner for considering the relevant public to include members of the "general public" who do not directly purchase their machines.

Applicant's argument is similar to one this Board rejected in *In re ActiveVideo Networks, Inc.,* 111 USPQ2d 1581 (TTAB 2014). In the *ActiveVideo Networks* case, the mark was CLOUDTV for a computer software platform which allowed content providers and their customers the ability to stream content to Internet-connected devices. Applicant argued that the relevant public for determining whether the mark is either merely descriptive or generic were sophisticated operators of multiple cable or satellite television systems, Internet service providers, CE manufacturers, content providers, web developers and software programmers and that it was inappropriate to consider the "general public." While the Board noted that the applicant's customer base were technically savvy and probably the most prominent of applicant's customers, hundreds of thousands, if not millions, of consumers within the United States will have seen the designation CLOUDTV on their television screens. "Accordingly, we find that the relevant public consists of a very broad group of persons, ranging from the executives of MSOs to the ordinary consumers of TV content and other multimedia products." *In re ActiveVideo Networks* at 1602. Similar to the *ActiveVideo Networks* case, the understanding of the general public to consider in this case is women desiring breast cancer screenings.

Ultimately it is the woman desiring a mammogram who pays the cost of the applicant's machinery either directly to her medical provider or indirectly through her health insurer or a combination of both. If these consumers do not request a 3D mammography from their doctors or hospitals, the doctors or hospitals to which applicant sells its machinery would be less inclined to purchase one. Applicant's Senior Director of Corporate Communications, James Culley, acknowledged as much in his declaration attached to applicant's response of April 16, 2015 where he said "we wanted to make it easier for women to identify Hologic's unique breast cancer screening exam. We coined the trademark so that women could ask for, and doctors could prescribe, the 3D MAMMOGRAPHY brand of breast tomosynthesis." Therefore, it is proper to consider the general public to determine the meaning of the mark to these consumers. The meaning of the wording "3d mammography" to member of the consuming public can be gleaned from evidence such as the articles and printouts from nationally circulated publications and websites like FOX NEWS, KOMEN.ORG, USA TODAY, SAINTLUKESHEALTHSYTEMS.ORG articles attached to the October 30, 2014 Office Action where the following statements were made:

1. Tomosynthesis works very similar to conventional digital mammography in that the breast is compressed while an X-ray takes an image of the tissue. Yet rather than simply taking one 2D image, the X-ray beam moves slightly over the woman's head, taking multiple images that are reconstructed by a computer into a 3D image. The result is a much more detailed representation of what a woman's breast tissue looks like. See the Fox News article entitled *"3D Mammograms Can Better Detect Invasive Cancers, Reduce Call-Back Rates,"* originally published June 25, 2014 on FoxNews.com at pg. 10 of the October 30, 2014 Office Action.

2. Special imaging machines can take multiple, standard two-dimensional (2D) digital mammograms. Computer software combines the 2D X-ray images into a three-dimensional (3D) image (called breast tomosynthesis). Radiologists must have special training to read these 3D images. See the article *"Emerging Areas in Early Detection"* as posted on the Susan G. Komen website, KOMEN.ORG at pg. 17 of the October 30, 2014 Office Action.

3. Q. What is a 3-D mammogram? A. The technology, called tomosynthesis, provides three-dimensional images of the breast by using a technology similar to CT scans, or computed tomography, says Carol Lee, a radiologist at New York's Memorial Sloan-Kettering Cancer Center and the chair of the American College of Radiology's breast imaging commission. The imaging machine moves around the breast in an arc, taking multiple X-rays that a computer forms into a 3-D image. See the article entitled "*New 3-D Mammograms Have Benefits, Risks,"* originally published on October 9, 2012 at pg. 37 of the October 30, 2014 Office Action.

4. A new kind of mammography called tomosynthesis or 3-D mammography, overcomes this challenge by capturing multiple images to create a 3-D image of your breast. The Saint Luke's East Hospital Breast Center was the first center in the Kansas City metropolitan area to offer 3-D mammograms, or breast tomosynthesis, for breast cancer screening with the Selenia Dimensions digital mammography system. See the article "3-D Mammography" as posted on the SAINTLUKESHEALTHSYSTEM.ORG website at pg. 31 of the October 30, 2014 Office Action.

Additionally, numerous articles were attached from the Lexis/Nexis database at the end of the September 12, 2015 Office Action from a cross section of newspapers and Internet news organizations from around the country. These articles are relevant in that they expose the wording "3-D Mammography" to the general public as a descriptive designation for a type of mammogram which produces a three-dimensional image. The following are illustrative of the articles included. It is noteworthy that the following articles are either written by doctors or quote doctors who specialize in this field of medicine. These articles are pertinent to determining the understanding of the terms by those who applicant claims is their primary customer base. In short, the doctors interviewed are explaining their understanding of the terminology "3-D mammography" to potential patients.

1. **ABC-8 WQAD (Davenport Iowa); August 5, 2015:** Genesis has a new 3D mammogram machine that takes multiple images of a woman's breast, giving them a better picture. "The strength of Tomosynthesis, or **3D mammography** is that you get multiple images through the breast, which decreases the overlap, and decreases the amount of benign or normal breast tissue that overlaps and can look like something else," said Dr. Roopa Goswami, a Diagnostic Radiologist at Genesis Imaging in Davenport…. Research shows 3D mammograms increase cancer detection rates by

41-percent. The 3D image makes it less likely for radiologists to miss fine details that are sometimes overlooked in a normal mammogram.

2. **News Transcript (Manalapan, NJ);** *"Choosing the right outpatient radiology center"* June 18, 2015: 3-D mammography -- Digital breast tomosynthesis (tomo), also known as **3D mammography**, is a revolutionary new screening and diagnostic breast imaging tool to improve the early detection of breast cancer. During the mammography exam, the technologist positions the patient to image the breast from different angles and compresses the breast with a paddle to obtain optimal image quality. During the 3D part of the exam, an x-ray arm sweeps over the breast, taking multiple images in seconds. Images are displayed as a series of thin slices that can be viewed by a radiologist as individual images or in a dynamic interactive animation. **3D mammography** complements standard 2D mammography. No additional breast compression is required in the 3D portion of the exam, and it only takes a few more seconds.

3. **Arkansas Democrat-Gazette (Little Rock);** *"Doctors debate worth of screenings Mammograms don't always catch cancer;"* April 26, 2015: Dr. Christie Phelan, radiologist at the Northwest Breast Imaging Center at Willow Creek in Johnson, said the clinic added digital **3D mammography** in late 2012 and used the machine for about 90 percent of all screenings. The clinic also has one traditional mammogram. Phelan said the clinic charged the same price for two-dimensional or three-dimensional mammograms until January when some insurance companies began to reimburse for the enhanced screening. Digital tomosynthesis takes multiple X-ray pictures of each breast from many angles. The images are sent to a computer that creates the three-dimensional images.

4. **The Journal (Ogdensburg, NY),** January 1, 2015: Claxton-Hepburn Medical Center's Connection for Women is pleased to announce the addition of digital tomosynthesis, more commonly known as **3D mammography**. The Connection for Women, a designated Breast Imaging Center of Excellence by the American College of Radiology, is the only women's imaging center north of Syracuse to now offer the new state-of-the-art digital tomosynthesis. All mammography patients at Claxton-Hepburn are now being screened using the new **3D mammography** machines…. Debbie King, radiology manager at Claxton-Hepburn stated, "The enhanced visualization that **3D mammography** provides translates into specific important benefits for our patients.

5. **Telegraph Herald (Dubuque, IA);** "*Technology for cancer diagnosis;"* January 1, 2015: Now there is a new breakthrough in mammography technology that has proven to pick up more cancers while reducing the number of call-backs for additional tests. It is **3D mammography**, and it has demonstrated a 41 percent increase in the detection of invasive breast cancers, as reported in the Journal of the American Medical Association….The use of **3D mammography** also can cut recall rates by as

much as 15 percent…. Finley Hospital's Wendt Cancer Center cancer expert Dr. Bobby Koneru concurs: "**3D mammography** is an exciting new tool that can help us detect breast cancer at an earlier stage. While it is especially beneficial for women with a history of breast cancer and those with dense breast tissue, 3D mammograms are appropriate for all women who need a standard mammogram."

6. **The Union Leader (Manchester, NH);** *"A woman's guide to dense breasts;"* October 23, 2014: Breast tomosynthesis, or **3D mammography**, is a new mammography technology that was approved by the FDA in 2011. With tomosynthesis, the radiologist views each individual layer of breast rather than a shadow of the entire breast. To produce the 3D images, a tube revolves around part of the breast in a short arc while sending out multiple X-rays in low doses. A computer reconstructs the data gathered in a way that allows viewing of thin layers of tissue… Dr. Steven Poplack, co-director of breast imaging at Dartmouth-Hitchcock Medical Center in Lebanon, recommends **3D mammography** for dense breasts. "Breast structures are clearer on a 3D mammogram," said Poplack.

7. **Federal Way Mirror (Washington);** ***"3D mammography*** *technology available at St. Francis Hospital;"* October 4, 2013: Traditional 2D digital mammography continues to be the standard of care for breast screenings. The new **3D mammography** technology combines with conventional 2D mammography to provide an enhanced 3D image of the breast…. "**3D mammography** will soon become the standard of care for women in Pierce and South King counties," said Khai Tran, MD, Medical Director at Carol Milgard Breast Center and Franciscan's Women's Health and Breast Center at St. Francis Hospital in Federal Way.

8. **The Union Leader (Manchester NH);** *"Hospitals across the state have adopted 3D mammography in fight against cancer;"* August 18, 2013: The Elliot Breast Health Center at River's Edge and Elliot Breast Health Center at Londonderry will both offer **3D mammography** starting in September…. Feldman said early detection means increased chance of survival. "As a doctor specializing in breast radiology, I see patients daily that would benefit from early detection from screening **mammography**. Tomosynthesis, also referred to as **3D mammography**, is the latest among the technological advances that offer doctors a better way to screen patients for breast cancer."

9. **Bonney Lake & Summer Courier-Herald (Washington);** *"Franciscan Health, Multicare offers 3D mammography;"* June 7, 2013: "We are ecstatic to be able to offer **3D mammography** to our patients," said Khai Tran, M.D., medical director of the breast center. "Our primary goal has always been to detect breast cancer as early as possible…. We are excited to be the first in Pierce County to provide **3D mammography** and support our mission of providing cutting-edge breast health services to all women in our community," said Jacquelyn Ostrom, executive director of the breast center.

It is noteworthy that in none of the articles does anyone refer to machinery as "2.5-D Mammography," and in the vast majority in the record, applicant is not even mentioned by name. Applicant has dismissed much of the evidence as simply media misuse of their distinctive coined trademark, yet applicant has produced no evidence that it has specifically objected to the alleged misuse. Citing to *Charette Corp. v. Bowater Comm. Papers, Inc.,* 13 USPQ 2d 2040 (TTAB 1989), applicant further argues that the articles should be given no weight because they are insufficient to prove what impact that they articles may have had on consumers in the marketplace. However, this case is inapposite because the issue involved a Section 2(d) likelihood of confusion issue where the applicant attempted to use Lexis/Nexis articles to show that the term "Proprint" was widely used by others *as a trademark* for printing services. In the instant case, the issue is whether "3-D mammography" is merely descriptive under Section 2(e)(1) of the Trademark Act.

The precedent of this Board is well settled that evidence of the public's understanding that a designation primarily refers to generic or merely descriptive feature of specific goods may be obtained from any competent source, such as dictionaries, trade journals, magazines, catalogs, newspapers, and other publications. *See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985). In addition, material obtained from third-party Internet websites is generally accepted as competent evidence. *See In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1465-66 (TTAB 2015); TBMP §1208.03; TMEP §710.01(b). Further, research databases such as LEXIS/NEXIS® are also considered a source of competent evidence. *See In re Medical Disposables,* 25 USPQ2d 1801 (TTAB 1801); *In re Leatherman Tool Grp., Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988); TMEP §1209.01(c)(i).

Applicant has used the analogy of a deck of cards to support its argument that the wording "3-D Mammography" is not merely descriptive of any feature, function, purpose or characteristic of its mammography imaging system.[5] Applicant states that a stacked deck of cards have minute gaps between each individual card and that like a deck of cards, applicant's mammography imaging system takes a series of 2-Dimensional images that have minute gaps between each image hence it is not truly a three-dimensional image. However, this disregards the commonly understood meaning of the wording "3D." As mentioned before, dictionaries define the term as meaning something which either has a three-dimensional form or **an image or picture which appears to have depth and thickness in addition to height and width**. Using applicant's deck of cards analogy, if the deck of cards where sealed in the box, the box of cards would have a pure three-dimensional form. However, if the cards are removed from the box and placed next to it, the stack would still be three-dimensional notwithstanding the fact that there are minute gaps between the individual cards. The stack would still have an appearance of height, width and depth. Consumers, whether they are doctors, hospital administrators or the average woman seeking a mammogram, understand "3D" to mean anything that appears to have depth or thickness in addition to height and width. Therefore, there is nothing bizarre or incongruous about the combination of the terms "3D Mammography" which would cause a consumer to speculate about the meaning of the composite.

As for the third party registrations submitted by applicant containing the term "mammography" on the Principal Register without any disclaimers, this evidence is of no persuasive value. In most cases, the

[5] Applicant has not correctly used the identification of goods as listed in each of the applications. Applicant states in its Brief at Page 7 that the applied-for goods are identified as "a tomosynthesis system for breast imaging." The actual identification is "mammography imaging system."

term is incorporated into a unitary slogan which, under Office Practice, would not require disclaimer of the descriptive term apart from the unitary slogan. See TMEP Section 1213.05(b). In any event, 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.

V. CONCLUSION

The evidence in the record clearly shows that the wording "3D Mammography" is merely descriptive of a feature, characteristic, function or purpose of applicant's mammography imaging system. The goods are designed to produce a mammogram image that appears to have a three-dimensional appearance of height, width and depth. This Board should consider the meaning of the mark through the common ordinary meaning of the individual terms "3D" and "Mammography." In addition, the evidence and articles of record clearly show that doctors understand the terms "3D Mammography" to mean a mammogram that has a three-dimensional appearance as this is how they explain it to their patients.

The consuming public has come to understand that “3D Mammography” is different from “2D Mammography” because the image has depth or a three-dimensional appearance that an ordinary two-dimensional mammogram does not. The fact that applicant may have until recently been the only source of 3D mammography equipment does not mean that the mark is not merely descriptive, nor does it render a word or term incongruous or distinctive; as in this case, the evidence shows that “3D Mammography” is merely descriptive of a feature, characteristic, function or purpose of the goods. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

For these reasons, the examining attorney urges this Board to affirm the refusal to register Serial No. 86337802 (3D MAMMOGRAPHY) in its entirety under Section 2(e)(1) of the Trademark Act and that it affirm the refusal to register the marks in Serial Nos. 86337786 (Hologic 3D Mammography) and 86354289 (Genius 3D Mammography) for failure to disclaim the merely descriptive wording “3D Mammography” apart from the marks. *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Respectfully submitted,

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