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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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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Serial Nos. 86337802, 86337786,
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Marks: 3D MAMMOGRAPHY
HOLOGIC 3D
MAMMOGRAPHY
GENIUS 3D
MAMMOGRAPHY

Filing Dates: July 15, 2014
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Applicant: Hologic, Inc.

Examining Attorney: Jeffrey J. Look

Law Office: 108

APPLICANT'S REPLY
BRIEF

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Cases:

Educ. Dev. Corp. v. Economy Co., 562 F.2d 26, 195 U.S.P.Q. 482 (10th Cir. 1977)

In re ActiveVideo Networks, Inc., 111 U.S.P.Q.2d 1581 (T.T.A.B. 2014)

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)

Secondary Sources:

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2015)

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'S REPLY BRIEF

Applicant's 3D MAMMOGRAPHY, HOLOGIC 3D MAMMOGRAPHY, and GENIUS 3D MAMMOGRAPHY marks (referred to collectively as "Applicant's Mark") are suggestive, inherently distinctive, and entitled to registration. The Examining Attorney's argument relies on a secondary and irrelevant definition of "3D," and a small number of articles that purport to show descriptive use of Applicant's Mark, but he essentially ignores the highly technical nature of Applicant's product and the technical sophistication of its target customers. Thus, Applicant's Mark should be approved for publication.

1. The Term "3D" Has a Specific and Generally Understood Meaning Among Radiologists and Hospital/Clinic Staff Who Purchase Radiological Equipment.

The Examining Attorney's argument relies on a partial lay definition of "three-dimensional" that includes images that give the appearance of height, weight, and depth. This argument again fails to acknowledge that the relevant purchasers of Applicant's product, radiologists and hospital/clinic personnel who purchase radiological equipment, have a very different understanding of the term. As explained in Applicant's Ex Parte Appeal Brief at p. 6–7, "3D" in the professional radiological context deals with imaging produced by CT and MRI technology. Tomosynthesis, the generic name for Applicant's technology, is a method for performing high-resolution limited-angle tomography at radiographic dose levels. Due to the limited angle, a limited depth of field is obtained; hence, why scientists refer to tomosynthesis as producing a 2.5D image.

Since the fact of this technical distinction is unassailable, the Examining Attorney instead argues that Applicant offered no more than a single article to prove that its customers view Applicant's Mark as other than a descriptive term. But Applicant did not offer an "article" as proof of this proposition. Rather, Applicant produced the official statement of the American

College of Radiology (the “ACR”), the premier medical imaging professional society, comprised of over 37,000 members, namely that “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). The ACR’s statement reflects the consensus of its members and it is reasonable to conclude from the statement that radiology professionals understand that tomosynthesis is not 3D imaging. As a result, Applicant’s customers will employ the steps in reasoning necessary to ascertain the precise nature of Applicant’s product, thus rendering Applicant’s Mark suggestive.

To counter the consensus understanding of 37,000 radiology professionals, the Examining Attorney offers excerpts from two news broadcasts and seven news articles that purport to show that the professionals who comprise Applicant’s target market view Applicant’s Mark as descriptive. Examining Attorney’s Appeal Brief, p. 15–17. In each instance, the article is presented in a manner that obfuscates context. For example, in the first cited report from ABC-8 WQAD, Dr. Roopa Goswami states: “The strength of Tomosynthesis or 3D mammography is that you get multiple images....” *Id.* at p. 15. While the Examining Attorney cites this as an example of descriptive use, it is equally plausible that the reference to “tomosynthesis” was descriptive and the use of “3D mammography” was in reference to Applicant’s Mark. The report does not offer sufficient context from which the Board can reach a reasonable conclusion one way or the other. The same can be said for the “News Transcript” article (“also known as 3D mammography” is just as likely to be a reference to Applicant), the “Arkansas Democrat-Gazette” article (given the state of the market, the tomosynthesis system purchased in 2012 was almost certainly Applicant’s), and the others that may well be specific

references to Applicant's tomosynthesis system. *Id.* at p. 16–17. The Examining Attorney suggests that the Board cannot assume that these are not references to Applicant since there are now other companies selling competing systems, but he has not produced any evidence that any of those companies use “3D MAMMOGRAPHY” to describe their products. As a whole, the nine cited reports and articles do not present probative evidence that the relevant purchasing public considers Applicant's Mark to be a descriptive term rather than a distinctive trademark.

The overwhelming preponderance of evidence before the Board shows that Applicant's Mark is suggestive and distinctive to the majority of the relevant consumer group and that it is entitled to registration.

2. *The Significance of Applicant's Mark to the General Public at Large is Irrelevant.*

Failing to establish that Applicant's Mark is descriptive in the relevant professional marketplace, the Examining Attorney inappropriately expands the definition of that market to include the general public at large. He cites *In re ActiveVideo Networks, Inc.* in support of his expansive view of the relevant market, but that case is inapposite. 111 U.S.P.Q.2d 1581 (T.T.A.B. 2014). *ActiveVideo* involved streaming video technology that was imbedded in televisions and other devices sold to the general public. In adopting an expansive view of the relevant market, the Board noted, “On the other hand, hundreds of thousands, if not millions, of consumers within the United States will have seen this designation 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.” *Id.* at 1602. This case does not involve a common consumer product. Applicant intends to use its Mark in association with a sophisticated and expensive medical device that will never be sold outside of a highly sophisticated and specialized marketplace. Thus, the

perception, if any, of the general public at large is irrelevant to the issue before the Board. *See Edu. Dev. Corp. v. Economy Co.*, 195 U.S.P.Q. 482, 485 (10th Cir. 1977).

In a further attempt to pull the general public into the discussion, the Examining Attorney asserts that because the patient or her insurer ultimately pays the bill for a breast exam, the patient is the actual purchaser of the tomosynthesis device used in her exam. This argument requires an untenable leap of logic. Of course the patient does not actually purchase a tomosynthesis device, so to bridge the gulf between the purchase of the device and the payment for services that employ the device the Examining Attorney offers the bald assertion that hospitals and clinics would not buy Applicant's products if their patients were not requesting them. Obviously, if that were the case, Applicant would have never sold a single tomosynthesis device as the patient population was unaware of them until hospitals and clinics began to deploy them.

As further support for "patient request" argument, the Examining Attorney offers a creative but unpersuasive interpretation of a portion of the declaration of Applicant's Senior Director of Corporate Communications, James D. Culley, Ph.D. (the "Culley Declaration"), wherein Dr. Culley states that "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 tomosynthesis." *See* April 16, 2015 Response to Office Action, TSDR p. 12–32. To the Examining Attorney, this is evidence that the patient is involved in the decision to purchase a tomosynthesis device. In reality, Dr. Culley simply provided a real-life example of the definition of a trademark.

These arguments ultimately lead back to the articles cited in the various Office Actions. Again, via the Culley Declaration, Applicant established that a very small subset of articles that

reference tomosynthesis include the term “3D MAMMOGRAPHY,” and that those articles cherry picked by the Examining Attorney actually refer to Applicant’s technology or, in a few cases, merely represent third-party misuse of Applicant’s Mark. *See* Applicant’s Ex Parte Appeal Brief, p. 11–12.¹ In at least one case, the excerpt from the article cited from SAINTLUKESHEALTHSYSTEM.ORG, the Examining Attorney’s chosen article refers specifically to Applicant’s Selenia Dimensions digital mammography system. Examining Attorney’s Appeal Brief, p. 15, item 4.

The Board should not consider the perceptions of the general public in assessing the suggestive nature of Applicant’s Mark. The Examining Attorney provides no reason to expand the definition of the relevant market and, in any event, fails to offer sufficient evidence to prove that even the general public considers Applicant’s Mark descriptive. Given the doubt engendered by the lack of compelling evidence of descriptiveness, any doubt should be resolved in favor of Applicant. *See In re Women’s Publ’g Co.*, 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:51 (4th ed. 2015).

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Board reverse the Examining Attorney’s refusal to register Applicant’s Mark and permit the application to advance to publication.

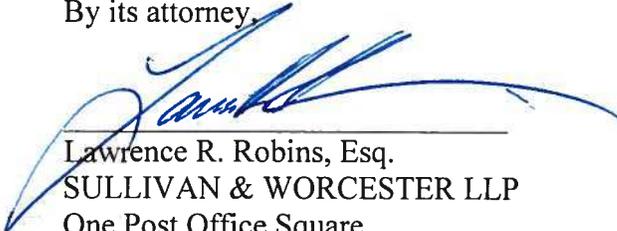
¹ The Examining Attorney correctly noted that this is an intent to use application, and to date Applicant has not used its Mark on an actual product. However, Applicant consistently uses its Mark in a trademark sense in promoting its technology and certainly maintains a bona fide intent to use the Mark on products.

Respectfully submitted,

HOLOGIC, INC.

By its attorney,

Dated: January 19, 2016



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