

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76635543
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>REQUEST FOR RECONSIDERATION</u></p> <p>In the second Official Action dated October 27, 2006, the Examining Attorney again refuses registration under Section 2(e)(1). In addition the refusal is made final. Based upon the information and the reasons presented below, Applicant respectfully requests that the Examining Attorney reconsider and withdraw her Section 2(e)(1) refusal. Applicant's mark is not merely descriptive of its collective membership.</p> <p style="text-align: center;"><u>I. APPLICANT'S MARK IS NEBULOUS AND HIGHLY SUGGESTIVE:</u></p> <p>Applicant's mark "DENTAL BENEFIT SERVICE" is a "hitherto unused and somewhat incongruous word combination whose import would not be grasped without some measure of imagination and 'mental pause.'" <i>In re Shutts</i>, 217 USPQ 363, 364-365 (TTAB 1983). In that respect the Examining Attorney is respectfully reminded that a composite mark may be distinctive even though its separate parts are descriptive.</p> <p style="text-align: center;">The whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark.</p> <p style="text-align: center;"><i>Association of Cooperative members, Inc. v. Farmland Industries, Inc.</i>, 684 F.2d. 1134, 216 USPQ 361 (5th Cir. 1982), quoted with approval in <i>Taco Cabana Int'l, Inc. v. Two Pesos, Inc.</i>, 19 USPQ 2d 1253, 1258 (5th Cir. 1991), aff'd 505 U.S. 763, 120 L. Ed. 2d 615, 112 S. Ct. 2753, 23 USPQ2d 1081 (1992).</p> <p>Using this reasoning, it has been held that the mark SUGAR & SPICE on bakery products, despite being composed of descriptive terms, resulted in a distinctive composite mark. See <i>In re Colonial Stores, Inc.</i>, 157 USPQ 382 (C.C.P.A. 1968). Similarly, the combination of the two words MOUSE SEED for rodent exterminators was held to result in a non-descriptive, suggestive mark. See <i>W.G.</i></p>	

Reardon Laboratories, Inv. v. B&B Exterminators, Inc., 71 F. 2d 515 (4th Cir. 1934). Similarly, the mark SEASON-ALL was held to be non-descriptive for aluminum storm windows because of its suggestive qualities. See *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 119 USPQ 61 (2d Cir. 1958). Accordingly, the law supports the registration of marks like Applicant's where it can be shown that the combination of the terms in question creates a suggestive mark by causing mental pause on the part of the consumer, and/or by causing the consumer to use imagination.

The Trademark Trial and Appeal Board recognized this aspect of the law in *In re Shutts supra*, where the Board held that the mark SNO-RAKE was not merely descriptive when used in connection with a snow removal hand tool. Similarly - and with particular relevance in this case due to the connection with health care - the Board discussed the relevant legal test when stating the following:

The mark AIR-CARE is, moreover, not merely descriptive as applied to applicant's services. The literal meaning of the mark, namely, 'care of the air', may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant's services, but it does not, in any clear or precise way, serve merely to describe applicant's preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment.

Airco Inc. v. Air Products & Chemicals, Inc., 196 USPQ 832 (TTAB 1977).

Applicant's mark "DENTAL BENEFIT SERVICE" is suggestive because, as discussed in Applicant's previous response, it does not merely describe Applicant's collective membership. Rather, the mark is nebulous, and consumers encountering the mark would be subjected to a moment of mental pause or mental gymnastics when connecting the mark to that collective membership. This, in turn, indicates that the "DENTAL BENEFIT SERVICE" mark is nebulous and highly suggestive.

In sum, a consumer encountering Applicant's mark must think for a moment about Applicant's collective membership before grasping any meaning associated with the mark. As a result, Applicant's mark is not *merely* descriptive. It is nebulous, and the Examiner's refusal should be withdrawn.

II. THERE IS NO COMPETITIVE NEED FOR APPLICANT'S MARK:

In addition to the foregoing, the Examining Attorney is respectfully reminded of the reason why descriptive marks are not registerable. The major reasons for not protecting such marks are:

- (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods or services; and
- (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products or services.

In re Abcor Development Corp., 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978).

In this case, none of the above harms are present, so there would be no harm in protecting Applicant's collective membership mark. Specifically, registration of Applicant's "DENTAL BENEFIT SERVICE" mark would not permit Applicant to inhibit competition in the indication of any type of collective membership. Competitors could use another term to distinguish their collective memberships. Furthermore, in view of Applicant's arguments in its previous response, wherein it distinguished its mark in the marketplace, there is no possibility of harassing infringement suits by the Applicant against others. In fact, prudence and pragmatism would suggest that others should steer clear of Applicant's mark if for no other reason than to distinguish their own products and services in the marketplace.

Accordingly, since there is no competitive need for Applicant's mark in the marketplace, registration would not offend the rule in *Abcor*, and the Examiner should reconsider and withdraw her refusal.

CONCLUSION

In view of the foregoing, Applicant respectfully requests the withdrawal of the Section 2(e)(1) refusal, and the approval of its application for publication. Further action is respectfully solicited.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Steven D. Lustig for Barth X. deRosa/
SIGNATORY'S NAME	Steven D. Lustig for Barth X. deRosa
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	04/27/2007
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Apr 27 16:00:51 EDT 2007
TEAS STAMP	USPTO/ROA-66.7.44.242-200 70427160051121855-7663554 3-370b268a6962451d1c271bb 9ac69ef2c65a-N/A-N/A-2007 0427155346920493

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OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **76635543** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

In the second Official Action dated October 27, 2006, the Examining Attorney again refuses registration under Section 2(e)(1). In addition the refusal is made final. Based upon the information and the reasons presented below, Applicant respectfully requests that the Examining Attorney reconsider and withdraw her Section 2(e)(1) refusal. Applicant's mark is not merely descriptive of its collective membership.

I. APPLICANT'S MARK IS NEBULOUS AND HIGHLY SUGGESTIVE:

Applicant's mark "DENTAL BENEFIT SERVICE" is a "hitherto unused and somewhat incongruous word combination whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983). In that respect the Examining Attorney is respectfully reminded that a composite mark may be distinctive even though its separate parts are descriptive.

The whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark.

Association of Cooperative members, Inc. v. Farmland Industries, Inc., 684 F.2d 1134, 216 USPQ 361 (5th Cir. 1982), quoted with approval in *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 19 USPQ 2d 1253, 1258 (5th Cir. 1991), aff'd 505 U.S. 763, 120 L. Ed. 2d 615, 112 S. Ct. 2753, 23 USPQ2d 1081 (1992).

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Response Signature

Signature: /Steven D. Lustig for Barth X. deRosa/ Date: 04/27/2007

Signatory's Name: Steven D. Lustig for Barth X. deRosa

Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 76635543

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