

\*\*Please place on Upper Right Corner\*\*  
\*\*of Response to Office Action ONLY.\*\*  
Examining Attorney: CARL, FRED  
Serial Number: 76/641892



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of  
MUSCULOSKELETAL TRANSPLANT  
FOUNDATION  
Serial No.: 76/641,892  
Filed: June 29, 2005  
For the mark: BIOACTIVE SYNTHETIC GRAFT

Examining Attorney CARL III  
Law Office 108

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451



12-11-2006  
U.S. Patent & TMO/TM Mail Recd Dt #74

Sir:

**RESPONSE**

Responsive to the Office Action dated June 7, 2006 in the above-identified Application,  
Applicant responds as follows:

**REMARKS**

The channels of trade for the goods are to surgeons and hospitals for application or  
implantation in or on human patients.

Applicant disagrees with the Trademark Examining Attorney's rejection of the mark under  
2(e)(1) as being merely descriptive of the goods. A mark is merely descriptive if it forthwith  
conveys an immediate idea of the ingredients, qualities, or characteristics of the goods. *Abercrombie*

*& Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976). Furthermore, the mark must convey the information with a degree of particularity. *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981). The mark comprises three separate words, "BIOACTIVE", "SYNTHETIC" and "GRAFT". There is the fact that each word has a meaning and that "synthetic" and "graft" have multiple meanings which requires the purchaser to make a mental interpretation of each word and application of the same in combination to the goods and thus requires a multistage reasoning requirement. A surgeon, the end user and purchaser of the goods would not normally associate the word "BIOACTIVE" with the word "GRAFT" as typically grafts which are synthetic would be inactive to preclude immune rejection. It is clear that such a mental exercise would not result in the combination word mark being merely descriptive in relation to the present goods. Furthermore, the Examining Attorney has cited several articles directed as basis for the 2(e)(1) rejection. The fact that these articles include "BIOACTIVE" in their body referencing glasses, sometimes referred to as ceramics does not merely describe a whole class of goods contrary to the Trademark Attorney's assertion. The Applicant's argument is not that one could cobble together an inappropriate meaning but that one could not cobble together a meaning which would be descriptive.

If a multistage reasoning process or imagination is required to determine the attributes or characteristics of the product, as is present in this case the mark is suggestive rather than merely descriptive. *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). Moreover, the burden is on the Examining Attorney to establish that a term for which registration is sought is merely descriptive. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPA2d 1141 (Fed. Cir. 1987). Any doubt must be resolved in favor of the applicant. *In re Gourmet Bakers*, 173 USPQ

565 (TTAB 1972).

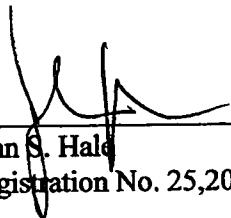
It may be that there is a thin line of demarcation between a suggestive word or phrase and a merely descriptive one. This determination involves a good measure of subjective judgment. *In re Atavio*, supra., at 1363. The distinction between suggestive and descriptive is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985). As previously noted, to the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive one, such a doubt is resolved in the applicant's favor. *In re Atavio*, supra.

The present mark does not convey immediate information as to the goods and is suggestive and not merely descriptive as an ordinary consumer or individual would not make a correlation between the mark and the goods and indeed probably does not have the basis of any information to make such a decision. The mark is at worst suggestive and not descriptive as it requires a mental interpretation as the mark does not immediately suggest the subject matter of the goods.

In view of the amendments complying with the Office Action and since the Office records have been searched and no similar registered or pending mark has been found that would bar registration under trademark Act Section 2(d) favorable reconsideration and passage to publication is respectfully requested.

Respectfully submitted,

GIPPLE & HALE



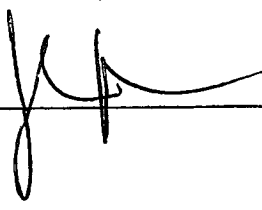
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**CERTIFICATE OF MAILING**

I hereby certify that this RESPONSE is being deposited with the U.S. Postal Service, First Class, to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, this 7<sup>th</sup> day of December, 2006.

Signature:  \_\_\_\_\_