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

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| Proceeding | 85602143 |
| Applicant | Nanomech, Inc. |
| Applied for Mark | NSERT |
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| Submission | Reply Brief |
| Attachments | reply_brief.pdf(81097 bytes ) |
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| Date | 05/22/2014 |

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

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| In re application of: | Nanomech, Inc. |
| Serial No.: | 85602143 |
| Mark: | nSert |
| Filing Date: | 04/19/2012 |

# APPLICANT'S REPLY BRIEF

## I. REPLY TO EXAMINING ATTORNEY'S ARGUMENTS

The Examining Attorney raises four points in her appeal brief, to which the applicant respectfully replies, in turn, below.

### A. Relationship of the Term "insert" to the Applicant's Mark

The Examining Attorney strenuously asserts that the term "insert" is descriptive of the applicant's goods. The applicant does not contend otherwise, but this is not the issue before the Board; rather, the issue is whether the applicant's mark also has a second, non-descriptive meaning such that it qualifies as a double entendre.

### B. Non-Descriptive Meaning in Relation to the Goods

The Examining Attorney concedes that the letter "n" in the applicant's mark might be recognized by some persons as an abbreviation for "nano," but finds that the applicant's mark cannot be a double entendre because the term "Sert" in the applicant's mark has no separate meaning on its own. The Examining Attorney states that in order to find that a mark is a double entendre, the "entire word or phrase is analyzed to come

up with an alternative meaning—not just one letter or one word." The applicant respectfully submits that there is no requirement that every letter of a double entendre mark be used in conveying the mark's non-descriptive meaning. In the case of *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (T.T.A.B. 2008), the Board found that THE FARMACY was a double entendre for retail store services featuring natural herbs and organic products. This mark is a misspelling of the descriptive term pharmacy, but also has a second meaning from the word "farm," which implies something about the freshness of the goods sold. If one were to apply the same analysis to THE FARMACY as the Examining Attorney has applied to the applicant's mark, then THE FARMACY could not be a double entendre because the remaining portion of the mark after "farm"– the letters "acy"—have no separate meaning on their own. The Board in that case applied no such rule, but instead focused solely on whether the non-descriptive meaning of the mark would be understood by the relevant consumers. Likewise here, it simply does not matter that "Sert" has no separate meaning on its own, the only issue is whether "n" conveys a non-descriptive meaning to the applicant's customers.

C. Other "n" Marks

The applicant has cited a number of third-party registrations as evidence that others use the abbreviation "n" to suggest nanotechnology. The Examining Attorney argues that none of these registrations are "phonetic equivalents of words clearly shown to be basic components of any identified goods." This is perhaps true, but irrelevant because the applicant did not cite the registrations for this purpose. The third-party registrations are evidence that others have used the letter "n" in their marks for goods

related to nanotechnology, which supports the applicant's argument that the letter "n" would be recognized similarly in the applicant's mark.

The applicant also noted previously that its mark is part of a family of "n" marks, including nGuard and nGlide, the latter of which is a registered trademark. The Examining Attorney argues that these marks are not phonetic equivalents of descriptive terms. This is of course true, but again, the applicant was citing its family of marks only to show evidence of the use of "n" to suggest nanotechnology. The Examining Attorney further questions whether the applicant actually has a family of "n" marks, calling attention to an article downloaded from the Internet in which other marks owned by the applicant are mentioned. The applicant respectfully submits that a single article from a third-party website is insufficient basis on which to attack the validity of the applicant's trademark rights. The applicant is under no obligation to ensure that every one of its trademarks are presented in every article written by third parties about the applicant, nor does the fact that the applicant has other trademarks that do not use the "n" term undercut the fact that it does in fact have a family of "n" marks.

D. Sophistication of Consumers

The applicant has argued that its goods are, by their nature, sold to technically sophisticated consumers who would recognize the "n" meaning in the applicant's mark due to their technical background. The Examining Attorney finds that the applicant's customers are "owners and technicians of precision machine shops who manufacture components and production parts…." No evidence is cited for this proposition, but even if true, owners and technicians at precision machine shops are just the sort of

technically trained persons who would be familiar with the metric system of measurement and would recognize the connection between “n” and “nanotechnology.” The critical point—upon which the Examining Attorney and applicant agree—is that the applicant is *not* selling its goods to ordinary retail consumers, who would of course have no use for such goods; the applicant’s customers are persons with a technical background that would readily understand this second, non-descriptive meaning of the applicant’s mark.

## II. CONCLUSION

For the foregoing reasons, the applicant respectfully submits that the mark is not merely descriptive, and thus the refusal by the Examining Attorney to register the applicant's mark under Section 2(e)(1) should be reversed.

Respectfully submitted,

05/22/2014 /chuck dougherty/

Date

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## Index of Cited References