

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85758912
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 117
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>Responsive to the Office Action dated August 11, 2013, having a six month period for response ending February 11, 2014, Applicant requests the Application be returned to the Examining Attorney for reconsideration in light of the following remarks. Applicant notes to the Examining Attorney that a Notice of Appeal has been filed. REMARKS Section 2(e)(1) Merely Descriptive Refusal The Examining Attorney has refused registration of Application Serial No. 85758912 for the mark PATIENT SPECIFIC IMMERSION for use with "patient supports for medical use, namely, mattresses and components therefor" alleging the mark is merely descriptive. Applicant again respectfully submits that its mark is suggestive rather than merely descriptive of its goods. A mark is merely descriptive only if it "forthwith conveys an immediate idea" of the ingredients, quality, characteristics, functions or features of the products or service. <i>Stix Prods., Inc. v. United Merchs. &amp; Mfrs., Inc.</i>, 295 F. Supp. 479, 488; 160 U.S.P.Q. 777 (S.D.N.Y. 1968) (emphasis added). If a mark requires a modicum of imagination to determine the goods or services, it is suggestive; it must be an immediate and direct conveying of the meaning to be merely descriptive. <i>BellSouth Corp. v. Planum Tech. Corp.</i>, 14 U.S.P.Q.2d 1555, 1556 (T.T.A.B. 1988). And, this is true even where the mark "suggests both the product's form and usage, but requires some imagination to surmise the nature of the product." <i>W.W.W. Pharm. Co., Inc. v. The Gillette Co.</i>, 808 F. Supp. 1013, 1022 (S.D.N.Y. 1992), aff'd, 984 F.2d 567, 25 U.S.P.Q.2d 1593 (2nd Cir. 1993). "PATIENT SPECIFIC IMMERSION" does not forthwith convey an immediate idea of the nature of Applicant's goods. As explained in Applicant's prior response, Applicant has developed a hospital bed mattress, and uses the mark as a creative way to refer to the adaptive cushioning system that forms part of the mattress. PATIENT SPECIFIC IMMERSION does not convey an immediate idea of these goods, nor does it immediately indicate to a consumer the function, use, or purpose of the Applicant's product. Whether or not a mark is descriptive is determined "in connection with the goods of the applicant." 15 U.S.C. § 1052. And, it clearly requires at least a modicum of imagination to determine the products based on Applicant's mark. See <i>Application of Kopy Kat, Inc.</i>, 498 F.2d 1379 (C.C.P.A. 1974). Moreover, even were all three elements of Applicant's mark merely descriptive, combining multiple descriptive elements can result in a composite mark that is not merely descriptive. See <i>Ass'n of Co-op. Members, Inc. v. Farmland Indus., Inc.</i>, 684 F.2d 1134, 1140 (5th Cir. 1982) ("The whole, in trademark law, is often greater than the sum of its parts."); <i>Marcia v. Microsoft Corp.</i>, 335 F. Supp. 2d 507, 514 (D. Ver. 2004) ("Marks are considered as wholes and the consolidation of two descriptive terms may result in a composite mark that is suggestive."). As such, even were all three elements of Applicant's mark merely descriptive, the mark as a whole is suggestive because the mark as a whole does not forthwith convey an immediate idea of the nature of Applicant's goods. The fact that the term</p>	

"immersion" has been used in an article about a mattress does not mean that the term immersion is a merely descriptive term for mattresses. See *In re Vaughan Furniture Co., Inc.*, 24 U.S.P.Q.2d 1068 (T.T.A.B. 1992) (reversing an Examiner's refusal to register the mark PINE CRAFTS despite the Examiner producing articles about furniture that included the term "crafts"). The articles cited by the Examining Attorney do not support the claim that "immersion" is merely descriptive of Applicant's products; rather that the term mattress and the term immersion have been used together in the same article. Further, this evidence is even less compelling given that the articles are, in a number of cases, a mix of incoherent words. For example, one of the evidentiary articles includes the following sentence, which is indicative of the article as a whole: "designers are nanjing me as they're significantly empowering for nepal items." These articles are not compelling in showing that Applicant's mark is merely descriptive of its products. The fact that the terms "patient specific" have been used in articles about mattresses likewise does not mean that the terms are merely descriptive when used for mattresses. *Id.* The Examining Attorney has seemingly taken the position that Applicant's mark is merely descriptive when used in conjunction with custom built or disposable mattresses. However, Applicant's goods are neither disposable nor custom-built for each end-user. Instead, a modicum of imagination is required to determine Applicant's products based on the mark. Finally, there is at least good faith doubt about where the mark PATIENT SPECIFIC IMMERSION falls on the descriptive/suggestive line. As held many times by the Board, any doubt about whether Applicant's mark is suggestive or merely descriptive should be resolved in Applicant's favor. See, e.g., *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791, 791 (T.T.A.B. 1981) (COLOR CARE suggestive of laundry bleach not harmful to color fabrics, noting "there is a thin line between a suggestive and a merely descriptive designation, and where reasonably [people] may differ, it is the Board's practice to resolve the doubt in the Applicant's favor and publish the mark for opposition"); *In re Intelligent Med. Sys.*, 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987) (INTELLIGENT MEDICAL SYSTEMS suggestive of computerized thermometers); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT not merely descriptive of antiperspirant deodorant for feet). In view of these remarks, it is respectfully submitted that Application be returned to the Examining Attorney for reconsideration and that the mark be allowed for publication.

#### **SIGNATURE SECTION**

<b>RESPONSE SIGNATURE</b>	/Kenneth A. Coleman/
<b>SIGNATORY'S NAME</b>	Kenneth A. Coleman
<b>SIGNATORY'S POSITION</b>	Attorney of record, Michigan bar member
<b>DATE SIGNED</b>	02/11/2014
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES

#### **FILING INFORMATION SECTION**

<b>SUBMIT DATE</b>	Tue Feb 11 16:59:18 EST 2014
<b>TEAS STAMP</b>	USPTO/RFR-67.59.3.59-2014 0211165918758079-85758912 -50080ede8120ac5fcf6b8db2 8fa876851c9c923556bbe1ab6 97b036617bf1683f-N/A-N/A- 20140211163648192550

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **85758912** has been amended as follows:

### **ARGUMENT(S)**

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

Responsive to the Office Action dated August 11, 2013, having a six month period for response ending February 11, 2014, Applicant requests the Application be returned to the Examining Attorney for reconsideration in light of the following remarks. Applicant notes to the Examining Attorney that a Notice of Appeal has been filed. REMARKS Section 2(e)(1) Merely Descriptive Refusal The Examining Attorney has refused registration of Application Serial No. 85758912 for the mark PATIENT SPECIFIC IMMERSION for use with "patient supports for medical use, namely, mattresses and components therefor" alleging the mark is merely descriptive. Applicant again respectfully submits that its mark is suggestive rather than merely descriptive of its goods. A mark is merely descriptive only if it "forthwith conveys an immediate idea" of the ingredients, quality, characteristics, functions or features of the products or service. *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488; 160 U.S.P.Q. 777 (S.D.N.Y. 1968) (emphasis added). If a mark requires a modicum of imagination to determine the goods or services, it is suggestive; it must be an immediate and direct conveying of the meaning to be merely descriptive. *BellSouth Corp. v. Planum Tech. Corp.*, 14 U.S.P.Q.2d 1555, 1556 (T.T.A.B. 1988). And, this is true even where the mark "suggests both the product's form and usage, but requires some imagination to surmise the nature of the product." *W.W.W. Pharm. Co., Inc. v. The Gillette Co.*, 808 F. Supp. 1013, 1022 (S.D.N.Y. 1992), *aff'd*, 984 F.2d 567, 25 U.S.P.Q.2d 1593 (2nd Cir. 1993). "PATIENT SPECIFIC IMMERSION" does not forthwith convey an immediate idea of the nature of Applicant's goods. As explained in Applicant's prior response, Applicant has developed a hospital bed mattress, and uses the mark as a creative way to refer to the adaptive cushioning system that forms part of the mattress. PATIENT SPECIFIC IMMERSION does not convey an immediate idea of these goods, nor does it immediately indicate to a consumer the function, use, or purpose of the Applicant's product. Whether or not a mark is descriptive is determined "in connection with the goods of the applicant." 15 U.S.C. § 1052. And, it clearly requires at least a modicum of imagination to determine the products based on Applicant's mark. See *Application of Kopy Kat, Inc.*, 498 F.2d 1379 (C.C.P.A. 1974). Moreover, even were all three elements of Applicant's mark merely descriptive, combining multiple descriptive elements can result in a composite mark that is not merely descriptive. See *Ass'n of Co-op. Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1140 (5th Cir. 1982) ("The whole, in trademark law, is often greater than the sum of its parts."); *Marcia v. Microsoft Corp.*, 335 F. Supp. 2d 507, 514 (D. Ver. 2004) ("Marks are considered as wholes and the consolidation of two descriptive terms may result in a composite mark that is suggestive."). As such, even were all three elements of Applicant's mark merely descriptive, the mark as a whole is suggestive because the mark as a whole does not forthwith convey an immediate idea of the nature of Applicant's goods. The fact that the term "immersion" has been used in an article about a mattress does not mean that the term immersion is a merely descriptive term for mattresses. See *In re Vaughan Furniture Co., Inc.*, 24 U.S.P.Q.2d 1068 (T.T.A.B. 1992) (reversing an Examiner's refusal to register the mark PINE CRAFTS despite the Examiner producing articles about furniture that included the

term "crafts"). The articles cited by the Examining Attorney do not support the claim that "immersion" is merely descriptive of Applicant's products; rather that the term mattress and the term immersion have been used together in the same article. Further, this evidence is even less compelling given that the articles are, in a number of cases, a mix of incoherent words. For example, one of the evidentiary articles includes the following sentence, which is indicative of the article as a whole: "designers are nanjing me as they're significantly empowering for nepal items." These articles are not compelling in showing that Applicant's mark is merely descriptive of its products. The fact that the terms "patient specific" have been used in articles about mattresses likewise does not mean that the terms are merely descriptive when used for mattresses. Id. The Examining Attorney has seemingly taken the position that Applicant's mark is merely descriptive when used in conjunction with custom built or disposable mattresses. However, Applicant's goods are neither disposable nor custom-built for each end-user. Instead, a modicum of imagination is required to determine Applicant's products based on the mark. Finally, there is at least good faith doubt about where the mark PATIENT SPECIFIC IMMERSION falls on the descriptive/suggestive line. As held many times by the Board, any doubt about whether Applicant's mark is suggestive or merely descriptive should be resolved in Applicant's favor. See, e.g., In re Morton-Norwitch Prods., Inc., 209 U.S.P.Q. 791, 791 (T.T.A.B. 1981) (COLOR CARE suggestive of laundry bleach not harmful to color fabrics, noting "there is a thin line between a suggestive and a merely descriptive designation, and where reasonably [people] may differ, it is the Board's practice to resolve the doubt in the Applicant's favor and publish the mark for opposition"); In re Intelligent Med. Sys., 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987) (INTELLIGENT MEDICAL SYSTEMS suggestive of computerized thermometers); In re Pennwalt Corp., 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT not merely descriptive of antiperspirant deodorant for feet). In view of these remarks, it is respectfully submitted that Application be returned to the Examining Attorney for reconsideration and that the mark be allowed for publication.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Kenneth A. Coleman/ Date: 02/11/2014

Signatory's Name: Kenneth A. Coleman

Signatory's Position: Attorney of record, Michigan bar member

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.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85758912

Internet Transmission Date: Tue Feb 11 16:59:18 EST 2014

TEAS Stamp: USPTO/RFR-67.59.3.59-2014021116591875807

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