

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77140083
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;">This is in response to the Office Action which issued in connection with the application.</p> <p style="text-align: center;">REMARKS</p> <p>The Examining Attorney has refused registration on the basis that the mark is merely descriptive of the goods. Applicant respectfully requests reconsideration in the following remarks which demonstrate that its mark "GAMMATAG" is not merely descriptive, but is at most suggestive of its goods, and therefore entitled to registration on the Principal Register.</p> <p>A. Applicant's Mark Should Not Be Dissected</p> <p>Applicant respectfully submits again that the mark must be tested for descriptiveness by examining it as a whole rather than dissecting it into component parts. <u>Estate of P. D. Beckwith, Inc. v. Commissioner of Patents</u>, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."); <u>In re Shutts</u>, 217 USPQ 363 (T.T.A.B.) (SNO-RAKE held not to be merely descriptive of snow hand removal tool); <u>In re Colonial Stores, Inc.</u>, 157 USPQ 381 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products); <u>California Cooler, Inc. v. Loretto Winery, Ltd.</u>, 774 F.2d 1451, 1455, 227 USPQ 808, 810 (9th Cir. 1985); <u>Self-Realization Fellowship Church v. Ananda Church of Self-Realization</u>, 59 F.3d 902, 35 USPQ2d 1342, 1351 (9th Cir. 1995). The necessity of such an analysis is recognized in the TMEP which states:</p> <p>However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, <i>or if the composite has a bizarre or incongruous meaning as applied to the goods</i>. See <u>In re Colonial Stores Inc.</u>, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); <u>In re Shutts</u>, 217 USPQ 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).</p>	

TMEP §1209.03(d)(emphasis added).

The mere combination of "GAMMA" and "TAG" does not convey the exact nature of the goods. Although Applicant's mark is comprised of ordinary words, the combination of words renders Applicant's mark unique since the combination of the two words does not result in a designation that has a plain and readily understood meaning for any of the goods. In re Disc Jockeys, Inc., 23 USPQ2d 1715, 1716 (TTAB 1992), citing, In re Uniroyal, Inc., 215 USPQ 716 (TTAB 1982).

For example, in the Trademark Trial and Appeals Board's (Board) decision in In re Mobile Ray, Inc., 224 U.S.P.Q. (BNA) 247 (T.T.A.B. 1984), the Board found the mark "MOBILE RAY" for "providing x-ray examinations and other radiological services." The mark was found not to be descriptive, with the Board stating:

We find applicant's mark only suggestive of its services. We have no doubt that those who would avail themselves of applicant's services would, upon seeing the mark "MOBILE RAY", understand that the "MOBILE" portion of the mark suggests the fact that the services are rendered from a mobile unit or van and that the "RAY" portion of the mark suggests that x-ray examinations are included among the services offered. That applicant's mark, when viewed in conjunction with its services, would suggest these things to the ordinary user of the services does not, in itself, render applicant's mark merely descriptive.

Applicant's "GAMMATAG" mark is not a direct description of the goods. GAMMATAG creates a unitary mark that is at most suggestive of Applicant's goods. Therefore, the trademark "GAMMATAG" in its entirety is not descriptive.

B. Mark Which Is Deemed "Merely Descriptive" Must Immediately Convey An Idea About The Applicant's Goods or Services

Applicant's mark GAMMATAG and Design does not *immediately* convey an idea of the qualities or characteristics of Applicant's services *as applied to those goods*. As the Examining Attorney recognizes, Applicant mark is used in conjunction with RFID tags that are sterilizeable by gamma radiation. However, as the definition submitted and relied upon by the Examining Attorney indicated, the terms GAMMA and TAG have numerous other meanings and connotations. See also Exhibits A and B. For example, the use of "gamma" without also using "ray" or "radiation" tells the consumer little about the product since "gamma" has many different meanings.

As such mature thought and imagination are required in order to determine what features or characteristics Applicant's mark possesses. When these two unrelated terms are combined one does not *immediately* know the precise nature of Applicant's goods. Therefore, it can in no way be said that Applicant's mark *immediately* conveys any idea about Applicant's services, as is required for the mark to be deemed "merely descriptive."

This case is highly analogous to In re Hamilton Watch Co., 158 USPQ 300 (TTAB 1968). In that case, the Board in reversing an examiner's refusal to register the trademark "PRECISION METALS" stated:

[A]s applied to 'special metal alloys,' 'PRECISION METALS' suggests the high quality and care involved in the production of the goods; but it does not immediately or

with any degree of particularity describe their function, characteristics or use.

Id. at 301. The above-quoted language of Hamilton Watch is clearly apposite here as well. "GAMMATAG" like "PRECISION METALS", is suggestive and not descriptive of Applicant's services, as it fails to convey any definite information about them. Significantly, the fact that the term "metals" clearly described a characteristic of the goods ("special metal alloys") in In re Hamilton could not stand as a basis for refusing registration of the unitary mark "PRECISION METALS". *See also*, Bose Corp. v. International Jensen Inc., 22 USPQ2d 1704 (CAFC 1992) ("ACOUSTIC RESEARCH" held suggestive for stereo speakers and turntables); In re Morton-Norwich Products, Inc., 209 USPQ 791, 792 (TTAB 1981) (The mark "COLOR CARE" for bleach "intimates or suggests a characteristic of the product rather than being merely descriptive thereof"); In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978) ("THE MONEY SERVICE" suggestive of financial services).

C. Applicant's Mark Is Suggestive

To be refused registration under 2(e)(1) of the Act, a mark must be merely descriptive or generic of the goods or services. The statutory language imposes a stringent burden since the term "merely" is to be taken in its ordinary meaning of "only" or "solely" -that is, when considered with the particular goods or services, the mark, because of its meaning, does nothing but describe them. As is well recognized, to be regarded as "merely descriptive," a mark must have no significance other than as a descriptive term. Blisscraft of Hollywood v. United Plastics Co., 131 USPQ 55, 60-61 (2d Cir. 1961).

A suggestive mark, on the other hand, is one which "requires imagination, thought and perception to reach a conclusion as to the nature of the goods." Stix Products, Inc. v. United Merchants & Manufacturers, Inc., 160 USPQ 777, 785 (S.D.N.Y. 1968). *Accord*, The Comic Strip, Inc. v. Fox Television Stations, Inc., 10 USPQ2d 1608, 1611 (SDNY 1989) (holding the service mark "THE COMIC STRIP" for comedy clubs suggestive and thus inherently distinctive). A mark that is "merely suggestive of a possible desirable end result" and does not describe the goods with which it is used, cannot be denied registration on the Principal Register. In re Frank J. Curran Co., 189 USPQ 560 (TTAB 1975) ("CLOTHES FRESH" for clothes and shoe deodorant held to be suggestive).

For example, in Healing the Children Inc. v. Heal the Children Inc., 22 USPQ2d 1690 (W.D.Pa. 1992), the court considered whether the service mark "HEALING THE CHILDREN" was descriptive of organization whose activities included medical services for children. In finding the mark suggestive, the court stated:

In this case, "Healing the Children," does suggest an organization which benefits children in a salutary, curative, beneficial, or remedial way. But it is only with imagination that the consumer can determine that the organization's activities include coordinating medical teams which visit foreign countries to train local medical personnel and to provide acute care and diagnostic services for local children, and organizing transportation, visas, medical care, and foster care for children referred to plaintiff by cooperating foreign governments and private agencies. [Citation omitted.] We must therefore conclude that "Healing the Children" is a suggestive mark ...

Id. at 1693; Similarly, in In re TMS Corp. of America, 200 USPQ 57 (TTAB 1978), the Board

reversed the examining attorney's refusal to register "THE MONEY STORE" for financial services. The reasoning behind the Board's holding was that, although the mark "THE MONEY STORE" is composed of commonly used words of the English language, "its suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity." *Id.* at 59. See also Game Power Headquarters Inc. v. Owens, 37 USPQ2d 1427, 1431 (E.D.Pa. 1995) ("GAME POWER HEADQUARTERS" for video game sales and rental stores is suggestive, since term requires imagination, thought or perception to reach conclusion as to nature of services.

As Applicant noted in its previous response, there are a number of registrations on the Principal Register that include the term "Gamma" that were registered with out a finding of secondary meaning. See Registration Nos. 3,148,283 for GAMMA-CHECK; No. 3,091,205 for GAMMA-HOL SPRAY; NO. 3,316,467 for GAMMA-SHRED, and No. 2,861,011 for GAMMA-CLEAR. Likewise, a number of registrations have issued for marks that include the term "TAG" for RFID goods or related goods. These include the following:

1. PROOFTAG, No.: 3,451,064, for Smart card, plastic card and encoded label readers; optical card and encoded label readers; data-processing units; recorded media programs, namely, software for use in game software, recorded computer programs, software packages, recorded programs and downloadable electronic publications, for use in access cards or tickets to computer databases or to physical locations, payment cards, identity cards, election cards, health cards; magnetically encoded identification cards; magnetically encoded cards consisting of a random arrangement of matter making it possible to present volume information to a reader (Class 9);

Non-magnetic encoded identification labels of plastic; non-magnetic encoded labels of plastic consisting of a random arrangement of matter making it possible to present volume information to a reader (Class 20);

Providing computer software design, quality control, and engineering services for others; surveying services; engineering consultancy services; technical project studies, in the field of installation of product identification systems for others, technical authentication of non-counterfeit products (Class 42)

Product authentication services in the field of product identification and authentication, identity document security, data integrity and authenticity, storage and transport security (Class 45).

2. CARBOTAG, Application No. 78/897,283, for tagged gas and oil well fracture stimulation proppants for use in gas and oil well diagnostics

3. CELLTAG, No.: 3,240,512, for electronic tracking and monitoring device comprised of a cellular and satellite transmitter to be secured on a non-incarcerated criminal offender to monitor and report location (Class 09).

4. SPORT TAG & Design, No. 3,107,967, for scoring system for all types of racing events consisting primarily of tags/transponders, computer hardware, and computer software for tracking finish time and performance statistics of race participants (Class 09).

5. SAFETAG, No. 3,094,054, for medical devices comprised of radio identification tags, scanners, and software used to determine whether all of the medical apparatus, instruments and sponges have been removed from a patient after surgery has been completed (Class 10).

6. RADIOTAG, No. 3,016,206, for tracking services for retrieval of encoded products (Class 45).

See. Exhibit B. Clearly, "GAMMATAG" is no more descriptive than any of the above-cited marks.

See also Cheng v. Thea Dispeker Inc., 35 USPQ2d 1493, 1496 (SDNY 1995) ("BRAVO

BROADWAY!" suggestive when used to identify musical entertainment services); Dial-A-Mattress

Operating Corp. v. Mattress Madness Inc., 33 USPQ2d 1961 (EDNY 1994) ("DIAL-A-MATTRESS" for services selling mattresses by telephone order is suggestive); Wynn Oil Co. v. Thomas, 5 USPQ2d 1944, 1950 (6th Cir. 1988) ("CLASSIC CAR WASH" suggestive as applied to car washing services).

D. The Evidence Submitted by The Examiner is Not Dispositive

The Examining Attorney has submitted a internet evidence to support its claim that GAMMATAG is descriptive. However, Applicant notes that this evidence is not dispositive because as far as Applicant can ascertain, all of the cited references refer to Applicant or its AdvantaPure division. There is no indication that third parties require GAMMATAG to refer to their products nor is the term found in any dictionaries.

E. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examining Attorney pass this application to publication and, in due course, registration

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/07/30/20080730192622696861-77140083-003_001/evi_146145188126-191910015_._Exhibit_A_-_GAMMATAG.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR002.JPG
	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR003.JPG
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/07/30/20080730192622696861-77140083-003_002/evi_146145188126-191910015_._Exhibit_B_-_GAMMATAG.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR004.JPG
	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR005.JPG
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/07/30/20080730192622696861-77140083-003_003/evi_146145188126-191910015_._EXHIBIT_-_C_-_GAMMATAG.pdf
CONVERTED PDF FILE(S) (10 pages)	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR006.JPG
	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR007.JPG
	\\TICRS\EXPORT2\IMAGEOUT2\771\400\77140083\xml1\RFR008.JPG

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.