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

Proceeding	78349181
Applicant	Active Ankle Systems, Inc.
Applied for Mark	DORSAL NIGHT SPLINT
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Date	11/20/2006

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

Applicant: Active Ankle Systems, Inc. )  
)  
Mark: DORSAL NIGHT SPLINT )  
)  
Serial No.: 78/349,181 )  
) ON APPEAL  
Filed: 01/08/2004 )  
)  
Trademark Examining Attorney: )  
Lana H. Pham )  
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**APPLICANT'S REPLY BRIEF ON APPEAL**

Respectfully submitted,

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Applicant Active Ankle Systems, Inc., by counsel, submits this Reply Brief on appeal from the Examining Attorney's final refusal to register Applicant's mark on the Supplemental Register pursuant to Section 23 of the Lanham Act (issued in the Office Action dated 11/02/2005), and from the Examining Attorney's denial of Applicant's May 2, 2006 Request for Reconsideration (issued in the Office Action dated June 2, 2006).

### **INTRODUCTION**

The Board is presented with a valuable opportunity to clarify the law of genericness in a manner beneficial to applicants, trademark professionals, and the Trademark Office. This appeal, as with the prosecution of the application leading up to it, has been fraught with a great deal of inefficiency resulting from the Office's failure to take clear and consistent positions on the issues of law and fact presented in this case. At virtually every step along the way, the Office has engaged in an impermissible process of burden shifting, by failing to take positions on matters relating to the issue of genericness, on which the burden of proof lies with the Office. Such an approach not only fails to honor this Board's clearly-stated procedural approach in assessing cases of alleged genericness, it is a disservice to applicants who seek to protect their marks through registration.

The brevity of the Examining Attorney's appeal brief belies the tortuous prosecution suffered by Applicant in this case, which became unnecessarily complicated due to the panoply of grounds asserted in support of refusal. Applicant submitted a detailed 24-page Main Brief on Appeal, setting forth the issues on appeal and addressing the various flawed grounds of refusal. In stark contrast, the Examining Attorney's 6-page Appeal Brief fails to dispute (much less acknowledge) many of Applicant's arguments traversing the refusal. The Board should find that the Office has effectively conceded some grounds of the final refusal and that only a few disputed grounds of refusal remain for resolution by the Board.

Furthermore, it is inappropriate for the Examining Attorney, at the eleventh hour on appeal, to reveal the Office's position regarding significant legal issues in this case. This case signals an opportune time for the Board to restate its expectations as to how refusals on grounds of genericness must be

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