**To:** Everest Biomedical Instruments Company (trademarks@patpro.com)

**Subject:** TRADEMARK APPLICATION NO. 78772030 - EEGSCREENER - KEDI EEGSUS

**Sent:** 8/29/07 11:43:33 AM

**Sent As:** ECOM116@USPTO.GOV

**Attachments:**
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## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/772030

**MARK:** EEGSCREENER

**CORRESPONDENT ADDRESS:**
MARK E. BOOKS, REG. NO. 40,918
POLSTER, LIEDER, WOODRUFF & LUCCHESI, L.
12412 POWERSCOURT DR STE 200
SAINT LOUIS, MO 63131-3615

**GENERAL TRADEMARK INFORMATION:**
**http://www.uspto.gov/main/trademarks.htm**

**APPLICANT:** Everest Biomedical Instruments Company

**CORRESPONDENT'S REFERENCE/DOCKET NO:**
KEDI EEGSUS
**CORRESPONDENT E-MAIL ADDRESS:**
trademarks@patpro.com

## REQUEST FOR RECONSIDERATION DENIED

**ISSUE/MAILING DATE: 8/29/2007**

Applicant is requesting reconsideration of a final refusal issued/mailed February 8, 2007.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, **the final §2(e)1 refusal to register** the proposed mark EEGSCREENER for "PATIENT MONITORING DEVICES, NAMELY, TRANSCEIVERS FOR DEVELOPING, PROCESSING, AND RECEIVING ELECTRONIC SIGNALS DEVELOPED BY THE HUMAN NERVOUS SYSTEM TO PRODUCE CLINICALLY VALID DATA TO BE USED BY MEDICAL PROFESSIONALS TO MAKE CLINICAL DECISIONS; AND RELATED SOFTWARE PACKAGES SOLD AS A UNIT THEREWITH" **is CONTINUED AND MAINTAINED**.

In the request for reconsideration, applicant argues that "EEG" has various meanings and "the term EEG in the single word EEGSCREENER has absolutely no meaning with respect to applicant's goods." Applicant argues, "it is not seeking out registration for a word but rather initials juxtapositioned with a word." Applicant further argues that neither EEG nor SCREENER is descriptive of applicant's goods. The examining attorney is not persuaded by applicant's arguments. Although "EEG" may have other meanings, this is not persuasive, as descriptiveness is considered in relation to the relevant goods. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974); TMEP §1209.03(e). Further, a mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *E.g.*, In *re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark so created imparts an incongruous meaning as used in connection with the goods. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods, the mark is merely descriptive. *E.g.*, *In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662. Therefore, merely positioning the words "EEG" and "SCREENER" next to each other with no space in between them does not obviate the §2(e)(1) refusal.

Applicant further states that the examining attorney "ignores the portion of the mark for which registration is sought is 'SCREENER' and not **SCREEN** as set forth in the rejection." Applicant has misinterpreted the explanation in the final refusal. The word "SCREENER" is the noun form of the word "SCREEN" which means, "to test or examine for the presence of disease or infection." See the Internet dictionary definition attached to the February 8, 2007 Office action. Thus, the word "SCREENER" means something that tests or examines for the presence of disease or infection. This meaning is further supported by the Internet website evidence attached to this Office action and the prior Office actions, which show the word "SCREENER" used in a descriptive manner to describe medical devices that test or examine for the presence of disease or infection.

Applicant further argues that the proposed mark does not suggest "the presence of 'disease or infection'" and that applicant's goods are intended to monitor patients under anesthesia. Applicant explains that the goods "never tests or examines for the presence of disease or infection." The examining attorney is not persuaded by applicant's arguments. The word "DISEASE" means "a disordered or incorrectly functioning organ, part, structure, or system of the body resulting from the effect of genetic or developmental errors, infection, poisons, nutritional deficiency or imbalance, toxicity, or unfavorable

environmental factors; illness; sickness; ailment," or "an impairment of health or a condition of abnormal functioning." See the attached Internet dictionary definition. Applicant's goods may be used to monitor patients under anesthesia in order to test and examine the patients' electroencephalograph or electroencephalogram to ensure that brain is not disordered or incorrectly functioning while the patient is under the anesthesia. In other words, even under applicant's argument, the proposed mark merely describes a purpose, characteristic, quality, function, feature, or use of applicant's goods. See the Internet website evidence attached to the February 8, 2007 Office action from applicant's website.

**Accordingly, applicant's request for reconsideration is *denied.*** The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/Laura A. Hammel/
Trademark Examining Attorney
Law Office 116
(571) 272-8260

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at http://tarr.uspto.gov. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Ascend Media

Sleep Review
THE JOURNAL FOR SLEEP SPECIALISTS



## Market Trend

Issue: January/February 2007

# What's New in PSG Diagnostics?

by Tor Valenza

**The latest trends in PSG devices.**



Which came first, the chicken or the egg? The same question might be asked of those involved in the development of new or improved polysomnography (PSG) diagnostic devices. Does the engineer's idea come first and then is offered to the market, or does the unfulfilled need expressed by a sleep tech in the trenches inspire the new device?

The simple answer is that it is a combination of both. Sleep medicine—and the devices that support it—is constantly evolving with new clinical diagnoses and scoring standards, as well as technological innovation. While technological advances in PSG may improve efficiency, treatment, and

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