

To: Lower Limb Technology, LLC (tmddocket@ip-lawyers.com)
Subject: TRADEMARK APPLICATION NO. 77586936 - LOWER LIMB - 7011-0007
Sent: 1/8/2009 2:33:43 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/586936

MARK: LOWER LIMB

77586936

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RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

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

APPLICANT: Lower Limb Technology, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :
7011-0007

CORRESPONDENT E-MAIL ADDRESS:
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OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 1/8/2009

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

Search Results

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Trademark Act Section 2(e)(1) Refusal

Applicant has applied for the mark "LOWER LIMB" for "Custom manufacturing of orthotic devices and prosthetic devices," in Class 40.

Registration is refused because the applied-for mark merely describes a feature of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Specifically, the proposed mark LOWER LIMB merely describes a feature of applicant's services, namely, custom manufacturing of orthotic devices and prosthetic devices in the nature of lower limbs.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or

services. TMEP §1209.01(b); see *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); see *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The examining attorney attaches and relies upon the following web page, namely, applicant's web site, namely, <http://lowerlimb.com/>, wherein it is stated that "Lower Limb Technology manufactures a variety of custom lower limb orthoses, including AFO's and KAFO's to meet the varied needs of your patients." Therein, it is also stated that "We now bring our expertise to custom lower limb orthoses."

Thus, the proposed mark LOWER LIMB merely describes a feature of applicant's services, namely, custom manufacturing of orthotic devices and prosthetic devices in the nature of lower limbs.

"A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods and/or services. See *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

A mark that combines descriptive words may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark's immediate association with the nursery rhyme "sugar and spice and everything nice"). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. See, e.g., *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely 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 created imparts an incongruous meaning as used in connection with the goods and/or services. TMEP §1209.03(d); e.g., *In re Copytele, Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *In re Associated Theatre Clubs*, 9 USPQ2d at 1662. Where, as in this case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive.

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Genericness Advisory

In addition to being merely descriptive, the applied-for mark appears to be generic in connection with the identified services and, therefore, incapable of functioning as a source-identifier for applicant's services. *In re The Am. Acad. of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001); see TMEP §§1209.01(c) *et seq.*, 1209.02. Under these circumstances, neither an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register can be recommended. See TMEP §1209.01(c).

Response

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

/efalk/
Erin Falk
U.S. Patent & Trademark Office
Trademark Examining Attorney

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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

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.

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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 1/8/2009 FOR
APPLICATION SERIAL NO. 77586936

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77586936&doc_type=OOA&mail_date=20090108 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **1/8/2009**.

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WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**