

Response to Office Action

In the Office Action, the Examining Attorney refuses registration of the present application, asserting that Applicant's mark is merely descriptive as applied to the associated services. Applicant respectfully disagrees for the following reasons and requests reconsideration.

A mark is merely descriptive if it immediately conveys information about an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. T.M.E.P. §1209.01(a)-(b). In contrast, a suggestive mark, as applied to the associated goods or services, requires imagination, thought or perception to reach a conclusion as to the nature of those goods or services. T.M.E.P. §1209.01(a). A designation does not have to be devoid of all meaning in relation to the goods/services to be eligible for registration on the Principal Register. *Id.* Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning.

Determining whether a mark is descriptive or suggestive is not always readily apparent, and most courts employ the "imagination" test to make such determination. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§11.67-11.68 (4th ed. 2009); *see also Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 160 U.S.P.Q. 777 (S.D.N.Y. 1968). "If a consumer must use more than a small amount of imagination to make the association [of a product attribute], the mark is suggestive and not descriptive." *See Rodeo Collection, Ltd. v. West Seventh*, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987). For example, the Court of Appeals for the Ninth Circuit considered whether the mark "RODEO COLLECTION" was descriptive as applied to a collection of shops and restaurants comprising a shopping center. The court stated,

"A person would not be likely to picture a shopping center upon first hearing the name 'RODEO COLLECTION.' One must use some imagination to associate the word 'collection' with the collection of shops and restaurants that make up the

shopping center. The remoteness of that association indicates that a competing shopping center would not need to use the term ‘collection’ in order to identify its own shopping center.”

Id. at 1207.

Similarly, the District Court for the District of Rhode Island considered this very issue in *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc. et al.*, 219 U.S.P.Q. 167 (D.R.I. 1983). As an initial matter, the court explained that “the line between descriptive and suggestive terms is often blurred, and the categorization of a name as ‘descriptive’ or ‘suggestive’ cannot be divined by the application of any hard and fast rules, but must be decided on a case-by-case basis.” *Id.* at 172. The court provided examples of descriptive marks, such as “VISION CENTER” for a place where one purchases eyeglasses and “HOTRAY” for electric food warmers. *Id.* (internal citations omitted). With respect to suggestive marks, the court pointed out that the mark “ULTRASUEDE” is suggestive of suede-like fabrics and the mark “BEETLE” is suggestive of plastic fishing lures. *Id.* (internal citations omitted).

After laying the foundation for the blurry descriptive/suggestive distinction, the court considered whether the service mark “RAILROAD SALVAGE” was generic, descriptive, or suggestive of the associated services, which consisted of purchasing undeliverable goods from railroad companies and selling those goods to purchasers at a discount. The court considered the plain meaning of “RAILROAD,” which is a “permanent road having a line or rails fixed to ties on a level or graded roadbed and providing a track for cars,” and the plain meaning of “SALVAGE,” which is “something extracted ... as valuable or having further usefulness.” *Id.* at 173. The court found that “the plain meaning of the words, when coupled, does not denote basic services provided by the [owner of the mark].” *Id.* Furthermore, “although the name depicts, in some general manner, the source of ... the goods sold by the [owner of the mark], it does not fully or precisely limn” the services offered by the owner of the mark. *Id.* Ultimately, the court held that “the nomenclature at issue here necessitates some use of the consumer’s imagination in order to determine the nature of the [mark owner’s] services, and is distinctive.” *Id.*

In the present case, the meaning of Applicant's mark must be evaluated on the basis of the definition that would be readily understood by the relevant consuming public. Applicant has consulted the Merriam Webster Online Dictionary, which is a renowned and reliable source for dictionary services. The term "LOWER" is defined as, *inter alia*, "situated or passing little above a reference line, point or plane." The term "LIMB" is defined as, *inter alia*, "one of the projecting paired appendages (as wings) of an animal body used especially for movement and grasping..." or "a leg or arm of a human being." See *Exhibit A (printouts from Merriam Webster Online Dictionary)*. Combining the two terms connotes a limb extending from the lower part of a human or animal.

Applying the "imagination" test to the present case reveals that Applicant's mark is suggestive, not descriptive, of the services listed in the application, which are custom manufacturing of orthotic devices and prosthetic devices. More specifically, consumers encountering the mark "LOWER LIMB" will not immediately receive any idea of the nature of Applicant's services. See T.M.E.P. §1209(a)-(b). Stated another way, consumers encountering the mark will not picture Applicant's services upon first hearing "LOWER LIMB." See *Rodeo Collection*, 2 U.S.P.Q.2d at 1207. Rather, consumers must understand that "LOWER LIMB" refers to a body part and then make the mental leap that Applicant manufactures custom orthotic devices and prosthetic devices, some of which may be suitable for use in connection with that body part. See *id.* at 1206.

Moreover, "the plain meaning of the words, when coupled, does not denote basic services provided by" Applicant. See *Railroad Salvage*, 219 U.S.P.Q. at 173. Clearly, a consumer encountering Applicant's mark "LOWER LIMB" must "use more than a small amount of imagination" to arrive at the nature of Applicant's services. See *id.* Furthermore, the remoteness of that association indicates that a competing manufacturer of custom orthotic and prosthetic devices would not need to use the term "LOWER LIMB" in order to identify its own services. See *Rodeo Collection*, 2 U.S.P.Q.2d at 1207. Accordingly, Applicant's mark is at least suggestive, and not descriptive, of its services.

With respect to the potential genericness advisory, the Court of Appeals for the Federal Circuit has stated that “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. Int’l Assoc. of Fire Chiefs, Inc.*, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986). In fact, generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. T.M.E.P. § 1209.01(b). Members of the relevant public would describe the genus or type of Applicant’s services as “custom manufacture of orthotic and prosthetic devices,” not as “lower limbs,” as advised by the Examining Attorney.

Therefore, in light of the foregoing, Applicant respectfully requests withdrawal of the Section 2(e)(1) descriptiveness refusal and allowance of the present application.