

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK OFFICE**

IN RE APPLICATION:

Mark:	VETBIOTEK
Applicant:	Bell, Thomas
Serial No.:	86386574
Attorney File No:	VB.T.14001

AMENDMENT A

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1415

Dear Madam:

In response to the first Office Action issued by the United States Patent and Trademark Office, please amend the above-identified application as follows:

I. SECTION 2(E)(1) MERELY DESCRIPTIVE REFUSAL

The Examining Trademark Attorney has refused registration of the mark on the Principal Register on the basis the mark merely describes the goods of applicant.¹ Applicant respectfully disagrees and submits that the subject mark is not descriptive but fanciful. Also, assuming *arguendo*, that the mark is not fanciful, the subject mark is at worst suggestive because in order to

¹ *Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 et seq.*

reach the conclusion of the Examining Trademark Attorney, a mental process involving imagination, thought and perception is required to associate Applicant's mark with features of Applicant's goods. The mental process required by the prospective consumer is indicative of a suggestive mark instead of a mark which is merely descriptive.

It is well settled that a mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith or immediately conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services.² A fanciful mark comprises a term that has been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER). A mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates.³ There is a thin line of demarcation between a suggestive mark and a descriptive mark.⁴

A. Applicant's Mark is Fanciful

Applicant's mark is fanciful in nature because it comprises a term that has been invented for

² See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). The immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). See also, *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, unpub'd, Fed. Cir. February 13, 1991.

³ See, e.g., *In re Abcor Development Corp.*, *supra* at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984).

⁴ *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). See also *In re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978) (the mark THE MONEY STORE for financial service institution is suggestive.); *In re the House Store, Ltd.*, 221 USPQ 92 (TTAB1983) (the mark THE HOUSE STORE for retail store services which sells house furnishings is suggestive).

the sole purpose of functioning as a trademark. As a result, the subject mark is entitled to protection on the Principal Register of the United States Trademark Office.

B. Applicant Mark is Suggestive

Assuming arguendo, that the mark is not fanciful, the subject mark is at worst suggestive because in order to reach the conclusion of the Examiner a mental process involving imagination, thought and perception is required to associate Applicant's mark with features of Applicant's goods.

In support of the Section 2(e)(1) refusal, the Examining Trademark Attorney argues:

The applicant applied to register the mark VETBIOTEK for “Non-medicated” BIOTEK is novel spelling of the term BIOTECH which is short for biotechnology and means “the manipulation (as through genetic engineering) of living organisms or their components to produce useful usually commercial products (as pest resistant crops, new bacterial strains, or novel pharmaceuticals); also any of various applications of biological science used in such manipulation.” ... The term VET is an abbreviation for VETERINARY which is defined as “of, relating to, practicing, or being the science and art of prevention, cure, or alleviation of disease and injury in animals and especially domestic animals.” ... The combined wording indicates the goods are commercial biotechnology products for use on animals.

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, the goods in this case are biotech products for animals.

Applicant submits the Examining Trademark Attorney's argument requires a multi-stage reasoning process and the utilization of imagination in order to determine what attributes of the goods the mark indicates and thus Applicant's mark is suggestive. First, the consumer must dissect the mark into two separate parts, i.e., VET and BIOTEK. Applicant submits this first step is a multi-stage reasoning process in itself. Applicant submits that the consumer must use reason and imagination in dissecting the mark because the portion BIOTEK can not be found in a dictionary and the consumer is not likely to recognize the same. Applicant submits that the consumer is more likely

to dissect the mark into three parts; i.e., VET and BIO and TEK. The subject mark consists of three syllables, and assuming the consumer will dissect the mark as contended by the Examiner, he or she may recognize VET for veterinarian or veterinary, BIO for biology or biography, but the consumer will likely not recognize the letters TEK and will likely conclude that TEK has no meaning outside trademark significance. This process of reasoning is indicative of a suggestive mark, not a descriptive mark. Second, the consumer must reason that VET means “veterinary” and not “to investigate” or “veteran.” Third, the consumer must determine that BIOTEK, which can not be found in a dictionary, means, is synonymous with, or is the equivalent to the word, “biotech.” Fourth, the consumer must conclude that the wording “Biotech” is short for “Biotechnology.” Fifth, the consumer must determine that the word “biotechnology” means “the manipulation of living organisms or their components to produce useful usually commercial products” and that the word “veterinary” means “prevention, cure, or alleviation of disease and injury in animals.” Finally, the consumer must transpose the two elements of the mark; i.e., reverse VET BIOTEK to BIOTEK VET, to make the final conclusion that Applicant’s products are “biotech products for animals.” Applicant submits that a multi-stage reasoning process is required of prospective consumers before they may conclude that a product sold under the trademark VETBIOTEK, which is not found in the dictionary, are “biotech products for animals.”

Moreover, Applicant submits that the Examining Trademark Attorney’s conclusion is based on the improper dissection of the subject mark. The question of mere descriptiveness is not to be resolved by separate analysis of each component of the mark. The whole mark, VETBIOTEK, must be considered in its entirety to determine whether registration is proper.⁵ When Applicant’s mark is

⁵ See *In re Matsushita Electric Corporation of America*, 1998 TTAB LEXIS 312 (Serial No. 74/672,187) citing *The Firestone Tire & Rubber Company v. The Goodyear Tire & Rubber Company*, 186 USPQ 557 (TTAB 1975); and *In re J. P. Stevens & Co., Inc.*, 160 USPQ 692 (TTAB 1969); see also *In re Gast Manufacturing Corporation*, 1997 TTAB LEXIS 182 (Serial No. 74/541,668).

evaluated in light of these principles, it is clear that the mark has not been proven to be merely descriptive of Applicant's products. When the words, VET and BIOTEK are combined, the significance of the term VETBIOTEK is at worst suggestive. This is because, as used in the mark, VET is an adjective modifying the noun BIOTEK. The mark VETBIOTEK is incongruous, in that the "biotechnology" which produces Applicant's goods is not itself a prevention, cure, or alleviation of disease and injury in animals. Applicant's goods may be said to be a cure for injuries, but the biotechnology that creates the goods does not.

The Board has described incongruity in a mark as one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark, and has noted that the concept of mere descriptiveness should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and mental pause."⁶

Applicant believes it is unlikely the Examining Trademark Attorney's interpretation of Applicant's mark will immediately come to mind when prospective purchasers encounter the mark VETBIOTEK used in association with Applicant's goods.⁷ Applicant believes the following cases are also supportive of Applicant's position.⁸

⁶ *In re Shutts*, 217 USPQ 363, 364-5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); see also *In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" is synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); cf. *In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of "mouse house," i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

⁷ *In re The Rank Organization Limited*, 222 USPQ 324, 326 (TTAB 1984).

⁸ *In re Grand Metropolitan Foodservice Inc.*, 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994) (MufFuns suggestive of mini-muffins); *In re Colgate-Palmolive Co.*, 406 F.2d 1385, 160 U.S.P.Q. 733 (CCPA 1969), reversing 151 U.S.P.Q. 587 (TTAB 1966)(CHEW 'N CLEAN held suggestive of a possible manner of use of dentifrice); *Glamorene Products Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. 145, 164 (SDNY 1975) (SPRAY 'N VAC held suggestive of a two-step, no-scrub

II. CONCLUSION

Any doubt as to whether Applicant's mark is merely descriptive or suggestive should be resolved in Applicant's favor by "allowing publication of the mark so that any third-party may file an opposition to develop a more comprehensive record."⁹

The necessity for analysis or the operation of imagination is required to connect the subject mark to the goods sold by Applicant. Thus, the subject mark cannot be descriptive and the subject mark is protectable and entitled to registration on the Principal Register of the United States Trademark Office. Applicant and the undersigned attorney thank the Examining Trademark Attorney for the helpful suggestions that have assisted in the preparation of this response.

The Applicant respectfully submits that the above amendments to the trademark application have overcome the objections set forth in the outstanding office action and the application is ready for approval. Favorable action is respectfully submitted. The undersigned attorney of record cordially

aerosol rug cleaner); *In re Molecudyne, Inc.*, 174 U.S.P.Q. 541 (TTAB 1972) (D*LETE held suggestive of applicant's liquid correction fluid); *In re Fifth Dimension, Inc.*, 160 U.S.P.Q. 212 (TTAB 1968) (STEP/SCAN held not merely descriptive of a switch which steps from external circuit but does not "scan"); *In re H. Goodman & Sons, Inc.*, 143 U.S.P.Q. 366 (TTAB 1964) (WET AND SET held not merely descriptive of chemically treated tissue paper for facilitating the curling of hair) and *Ex Parte Club Aluminum Products Co.*, 105 U.S.P.Q. 44 (Comr. 1955) (COOK-N-LOOK held not merely descriptive of transparent glass covers for cooking utensils); *In re Geo. A. Hormel & Co.*, 218 U.S.P.Q. 286 (TTAB 1983) (FAST 'N EASY held not merely descriptive of pre-cooked meats); *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 222 U.S.P.Q. 292 (11th Cir. 1984) (CITIBANK is suggestive for banking services, not generic or descriptive); *Glow Indus., Inc. v. Lopez*, 252 F. Supp. 2d 962 (C.D. Cal. 2002) (GLOW suggestive for perfume, shower gel and body lotion); *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described).

⁹ See *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *Remacle*, 66 USPQ2d at 1224. See also, *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"); see also, *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

invites any telephonic communications from the Examining Trademark Attorney which may assist in the allowance and publication of the subject mark.

Respectfully submitted,

FRIJOUF, RUST & PYLE, P.A.

/s/ Daniel R. Frijouf _____
Daniel R. Frijouf
Frijouf, Rust & Pyle, P.A.
201 East Davis Boulevard
Tampa, Florida 33606
(813) 254-5100
dan@frijouf.com
Attorneys for Applicant