

This is in response to the Office Action dated January 29, 2018. The Examining Attorney has maintained the descriptiveness refusal under 15 U. S. C. § 1052(e)(1) (Section 2(e)(1)). In the alternative, the Examining Attorney now refuses registration on the basis that the mark is deceptively misdescriptive under Section 2(e)(1). Applicant respectfully submits that the Examining Attorney has not met her burden to prove that the term “WEDGE” is merely descriptive as applied to applicant’s goods, and that the term is at the very least suggestive. Applicant continues to assert that the mark is arbitrary with respect to the goods given the derivation of the mark and applicant’s process in choosing the mark. But even if the mark is not arbitrary, the term “WEDGE” in this context is, at a minimum, suggestive and not descriptive of the goods, as it cannot be shown that purchasers of applicant’s goods would immediately understand the term “WEDGE” to refer to a feature or purpose of applicant’s goods.

1. Applicant’s mark is not merely descriptive under the applicable standard

The Examining Attorney has not met her burden to establish that the term “WEDGE” is merely descriptive. *In re Remacle*, 66 U.S.P.Q.2d 1222 (TTAB 2002) (“[T]he Examining Attorney has the burden of establishing that the mark is merely descriptive, and that burden has not been met.”). As noted above, the Examining Attorney has concluded that the term “WEDGE” is merely descriptive of applicant’s goods, asserting that “WEDGE” is descriptive of a type of catheter and does not create a “unique, incongruous, or nondescriptive meaning in relation to the goods.” The Examining Attorney relies primarily on the evidence she relied on in the initial Office Action, which as applicant observed in its earlier response, refers to one particular type of catheter – namely, a wedge-pressure catheter that is used only in a pulmonary artery pressure measuring procedure. In that context, the term “wedge” refers not to the shape or purpose of the catheter, but to the particular type of pressure being measured, referred to as “wedge pressure.” This does not establish that the term “WEDGE” is descriptive of medical catheters in general, or applicant’s endovascular catheters in particular. On the contrary, the term in the context cited by the Examining Attorney refers to only a single, very specific type of catheter that is used for a single, very specific procedure and would not be understood to describe other types of medical catheters. If “WEDGE” was descriptive of catheters in general, as asserted by the Examining Attorney, there would be no reason to use the term “wedge pressure” in describing the catheters identified in the Examining Attorney’s evidence.

The Examining Attorney also provides a single reference to an “endo-wedge” technique that includes the use of a balloon catheter. While the purpose of the catheter in this technique is not clear, Applicant respectfully submits that this single use of the term “wedge” in connection with a surgical technique that includes use of a balloon catheter is insufficient to establish that the term is used descriptively to refer to catheters. Almost any medical procedure requires the use of some kind of catheter. To conclude that the use of a term in the name of a medical procedure that makes use of a catheter renders the term descriptive of the catheter ignores the ubiquitous use of catheters in all but the most non-invasive medical procedures. While the phrase “endo-wedge” might be descriptive of the technique, it does not follow that the term has any descriptive meaning with respect to the balloon catheter used in the procedure.

A term is “merely descriptive” if it conveys an immediate idea of an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. TMEP § 1209.01(b). Moreover, the immediate idea must be conveyed with some “degree of

particularity.” *In re Entenmann’s Inc.*, 1 USPQ2d (1750, 1752 (TTAB 1990), *aff’d* 928 F.2d 411 (Fed. Cir. 1991). Applicant asserts that the mark WEDGE is not descriptive under the appropriate standard.

Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). In this case, the issue is simply whether it can be shown that the term “WEDGE” directly conveys information about applicant’s medical catheters to applicant’s consumers – the interventional radiologists, vascular surgeons and neurosurgeons who conduct the procedures in which applicant’s product is used.

The Examining Attorney did not provide any evidence of consumers’ perception of the term “WEDGE” in connection with the goods, nor has she adequately explained how the dictionary definition she relies on demonstrates the alleged descriptiveness of “WEDGE” as applied to applicant’s products. The limited evidence and arguments of the Examining Attorney do not meet her burden to prove that the term “WEDGE” is merely descriptive. On the contrary, the additional evidence relied on by the Examining Attorney in the current Office Action actually supports the conclusion that the mark is, at most, suggestive. The Examining Attorney cites a dictionary definition of “wedge” as meaning to “press closely,” which she states is “similar to the purpose of applicant’s goods.” Applicant submits that this definition as the Examining Attorney seeks to apply it to applicant’s goods demonstrates exactly the type of “mental leap” that distinguishes a suggestive mark from a descriptive mark. The use of the term “WEDGE” does not *immediately* convey information regarding applicant’s goods, nor does the meaning ascribed by the Examining Attorney actually apply to applicant’s goods and services. Rather, it requires thought or imagination to reach a conclusion regarding the nature of the goods from the mark.


When a mark merely suggests some quality or ingredient of the goods, it is merely suggestive, and is entitled to registration as an arbitrary or fanciful mark. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d 1081 (1992). The test for determining whether a term is descriptive or suggestive is to determine whether it requires imagination, thought or perception to reach a conclusion as to the nature of the goods, and is thus only descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the goods. *In re Abcor Development Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (CCPA 1978). The term “WEDGE” may at most suggest one or more of the dictionary definitions of the word as applied to applicant’s goods.

Here, the definitions relied on by the Examining Attorney are too attenuated to support the assertion that the applied-for mark immediately describes a feature of the goods and services. By the Examining Attorney’s reasoning, the term “WEDGE” would be descriptive in almost any

situation - any time it could suggest a feature of purpose of a product. This is not how the Office has treated the term in other cases.

In fact, the Office has registered numerous WEDGE and WEDGE-formative marks on the Principal Register for products where the relationship of the term “wedge” to the products can be assumed to be similar to that in the present case. Following is a list of other WEDGE marks or marks that consist of the term WEDGE combined with a clearly descriptive or generic prefix where the term has a similarly suggestive relationship to the goods. Some of the marks are registered for medical devices in Class 10. Others cover goods in other classes. These marks all are or have been registered or published for opposition on the Principal Register without a claim of acquired distinctiveness or a disclaimer of “WEDGE”:

MARK	REG/SER, NO./DATE	RELEVANT GOODS	OWNER
WEDGE	2007724 Registered Oct 15, 1996	Electrosurgical resection devices for urological procedures	Boston Scientific Corporation Natick MA
SAFETYWEDGE	1819434 Registered Feb 1, 1994	Apparatus for the prevention of bodily vessel rupture from catheter balloon inflation	Biosensors [sic] Europe S.A. Lausanne, Switzerland
OSTEO-WEDGE	85152829 Registered July 2, 2013	Medical apparatus, namely, bone stabilization device	Graham, Michael E. Macomb MI
WEDGE	1953006 Registered Jan 30, 1996	Veterinary mouth props	Scheels, John L. New Berlin WI
HEAD WEDGE	2754819 Registered Aug 26, 2003	Medical devices, namely, emergency head immobilizers	Amby inc. Glen BURnie MD
CERAWEDGE	4741516 Registered May 26, 2015	Surgical, medical, dental and veterinary instruments and apparatus, namely, . . . ceramic goods for surgical, medical, dental and veterinary purposes, in particular compounds of ceramics in the form of sintered bodies and granulates for use as bone replacement materials, implantation materials and prostheses specifically orthopedic joint implants made of artificial materials, prosthetic and filling materials, namely, artificial materials for use in the replacement of bones; . . . implants comprising natural, non-living materials in the nature of compounds of ceramics in the form of sintered bodies and granulates for surgical, medical, dental and veterinary purposes	BoneArtis AG Brunner SWITZERLAND
ACTIV-WEDGE	4979796 Registered June 14, 2016	Foam positioning pads for medical and physical therapy use	Pilates Therapeutics LLC Alameda CA
Hemorr Wedge	5092991 Registered Nov 29, 2016	Therapeutic hot and cold therapy packs; Medical devices for use in treating hemorrhoids	Oxley, John E Wilmington DE

WEDGE	1040072 Expired March 4, 1997	Patient supporting or turning frames	Stryker Corporation Kalamazoo MI
WEDGE	0944145 Expired July 12, 1993	Pulmonary function testing equipment- namely, spirometers	Med-Science Electronics, Inc. St. Louis MO
WEDGE	4610497 Registered Sep 23, 2014	Blades for electric hair clippers	Wahl Clipper Corporation Sterling IL
WEDGE	3864773 Registered Oct 19, 2010	Radios; radios incorporating clocks' radios incorporating clocks and CD players	SCI Direct, LLC North Canton, OH
WEDGE	87702328 Office Action issued March 13, 2018 2(d) refusal – no descriptiveness refusal	Monitoring and control equipment for construction sites; communication and operation equipment for construction sites	WesternOne Inc. Vancouver, BC CANADA
WEDGE	5460021 Registered May 1, 2018	Bullets	Ranier Ballistics, LLC Fife, WA
WEDGE	2786909 Registered Nov 25, 2003	Musical instruments, namely, drums and percussion instruments, optional fittings for drums attached to a drum hoop	Yamaha Corporation Shizouka JAPAN
WEDGE	2632255 Registered Oct 8, 2002	Bodyboards	Wahm-O Holding, Ltd. Kowloon HONG KONG
WEDGE	1455516 Registered Sept 1, 1987	Exercise equipment – namely hand exerciser	Impex, Inc. Pomona CA
WEDGE	1370876 Registered Nov 19, 1985	Metal horseshoes for racing and running horses	Thoro'bred Racing Plate Co., Inc. Anaheim CA
WEDGE	77698552 Abandoned – failure to file Statement of Use Sept 26, 2011	Mouth guards for athletic use	Bite Tech, Inc. Minneapolis MN
WEDGE	77393412 Abandoned – failure to file Statement of Use March 30, 2009	Computer hardware and computer peripheral devices	Dell Inc. Round Rock TX
	1936901 Cancelled – not renewed Aug 26, 2006	Tire repair plugs	31, Inc. Newcomerstown OH
WEDGE	1816981 Canceled – not renewed Oct 23, 2004	Artificial fishing lures and parts thereof	Stanley Jigs, Inc. Huntington TX
WEDGE	1713431 Canceled – not renewed March 17, 1999	Quartz floodlights	Cooper Industries, Inc. Houston TX
WEDGE	1645142 Canceled – Section 8 Nov 25, 1997	Bicycle seats	Trico Sports Pacoima CA
WEDGE	0134928 Canceled – not renewed July 3, 2013	Rubber erasers	Dixon Ticonderoga Company Heathrow FL

Copies of the TESS records for these marks are attached for the Examining Attorney's reference.

While applicant understands that the existence of third-party registrations is not conclusive on the question of descriptiveness, applicant respectfully submits that the examples it has provided strongly suggest that the Office does not consider the term "WEDGE" descriptive when used in connection with medical devices, or in other contexts where the term might be assumed to have some significance with respect to the goods but is not found to be descriptive of them, in which case, the mark is entitled to registration on the Principal Register. These examples demonstrate that the Examining Attorney has failed to consider and treat the instant application consistently with prior registered marks where the relevant circumstances are the same or highly similar.

2. Applicant's mark is not deceptively misdescriptive

Because the mark is, at most, suggestive and not descriptive, it cannot be deceptively misdescriptive. The mark does not meet the first part of the test set out in the Office Action because it does not describe a significant aspect of the goods that the goods could plausibly possess but in fact do not. Here, the mark may be suggestive of one or more features or uses of the product, but does not describe any particular feature or use. Furthermore, the Examining Attorney has provided no evidence that the mark conveys any information that would be relevant in the purchasing decision or that would cause the highly sophisticated and discerning purchasers of applicant's products to view the mark as descriptive of the goods. Applicant's customers will not view the mark as descriptive, and therefore the mark cannot be considered misdescriptive.

3. Doubt must be resolved in favor of applicant.

Finally, because the distinction between merely descriptive and suggestive terms is "nebulous," and because competitors have the opportunity to oppose registration once a mark is published, any doubt as to whether a mark is merely descriptive or suggestive is to be resolved in favor of the applicant. *See In re Schutts*, 217 USPQ at 364 (invoking rule that doubt as to whether a mark is descriptive should be resolved in favor of applicant); *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 Murad, Inc.*, 2010 TTAB LEXIS 31 (TTAB 2010). Because applicant's mark is susceptible to multiple meanings or interpretations, and thus, does not *immediately* convey to the consumer what the related goods or services are, and because the term requires the consumer to make a "mental leap" to connect the term to applicant's branded goods and services, applicant requests that any doubt as to whether WEDGE is merely descriptive likewise be decided in its favor.

For these reasons, applicant respectfully requests that the Examining Attorney withdraw the objections under Section 2(e)(1) and approve the mark for publication.