

This is in response to the Office Action issued March 16, 2018 related to U.S. App. No. 87/691,071 for the following design mark (“Applicant’s Mark”):



Applicant’s Mark is applied for in connection with the following goods and services, as amended:

IC 009: Computer programs, downloadable computer programs and mobile device software for searching data, for database management, for accessing and reviewing information in the fields science, technology and medicine; downloadable databases in the fields of science, technology and medicine; electronic downloadable publications, namely, books, journals and articles in the fields of science, technology and medicine

IC 035: Management and compilation of computerized databases; arranging of subscriptions for the on-line publications of others; **arranging of subscriptions for the publications of others in the nature of journals and reviews**; compilation and systemization of data in computer database

IC 041: Providing educational information **in the academic fields of science, technology and medicine for the purpose of academic study**; providing of training **in the fields of science, technology and medicine**; arranging and conducting of colloquiums, workshops, congresses, conferences, and symposiums **for educational purposes** in the fields of science, technology and medicine; publishing **of books, journals, articles and electronic publications**; providing **non-downloadable** electronic publications **in the nature of books, journals and articles in the fields of science, technology and medicine**; publication of **on-line** research materials ~~online~~—namely **on-line books, journals and articles**; providing on-line educational information from a computer database **in the academic fields of science, technology, and medicine for the purpose of academic study**

IC 042: Providing **an** on-line, searchable database in the fields of science, technology and medicine **for scientific research purposes**; scientific, medical and technological services, **namely, research and design in the fields of science, technology and medicine**; hosting of digital content on the internet; maintenance of databases for others; **providing a web** hosting **for scientific research purposes**; providing online searchable databases containing information on scientific, technological and medicine research and development; providing on-line information in the field of scientific, technological and medical research from a computer database or the internet; providing **a website featuring** on-line **non-downloadable software tools for** database-indexing and abstracting; providing online database search tools, **namely, provision of Internet search engines for searching online databases**

In the Office Action, the Examining Attorney required that Applicant clarify its identification of goods and amend the description of the mark, which it has done as part of this response. The Examining Attorney also required a disclaimer of the term NANO because is merely descriptive as used in connection with the applied-for services. Applicant respectfully disagrees with the disclaimer requirement for the reasons set forth below.

THE WORDING “NANO” IS NOT MERELY DESCRIPTIVE OF APPLICANT’S GOODS AND SERVICES, AND THEREFORE, A DISCLAIMER IS UNNECESSARY

According to the Trademark Act, an applicant is only required to disclaim an unregistrable component of a composite mark, which is considered “the name of the goods or services, other

matter that does not indicate source, matter that is merely descriptive or deceptively misdescriptive of the goods or services, or matter that is primarily geographically descriptive of the goods or services.” 15 U.S.C.A. § 1056; TMEP § 1213, 1213.03(a). In this case, the wording “NANO” is a registrable component of the mark, as this wording does not fall into any of the aforementioned categories of unregistrable matter. The wording “NANO” is instead suggestive when used in connection with Applicant’s goods and services, and therefore, a disclaimer of this wording is inappropriate and unnecessary.

Wording in a mark is descriptive only if it “immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used.” *In re Joseph Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987) (citing *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980)). To be characterized as descriptive, a term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. 55 (2d Cir. 1961). Further, not only must a mark immediately impart information about the goods or services, but also it must do so with a “degree of particularity.” *In re Intelligent Medical Systems, Inc.*, 5 U.S.P.Q. 2d 1674 (TTAB 1987); *See also Holiday Inns, Inc. v. Monolith Enterprises*, 212 U.S.P.Q. 949 (TTAB 1981).

Additionally, to be merely descriptive, a term must describe a *significant* attribute of its affiliated goods. *In re Eden Foods*, 24 U.S.P.Q.2d 1757, 1760 (TTAB 1992). *See also In re Reynolds Metals Co.*, 178 U.S.P.Q. 296 (CCPA 1973) (“Brown-in-Bag” not descriptive of transparent bags for browning meats and vegetables due to product’s other functions); *Gold Seal Co. v. Weeks*, 105 U.S.P.Q. 407 (D.D.C. 1955) (“Glass Wax” not descriptive because it does not describe a cleaner and polisher for metal and glass).

The wording “NANO” in Applicant’s Mark does not convey an immediate idea about Applicant’s goods or services with any degree of particularity, nor does it describe a significant attribute of Applicant’s goods or services. In other words, the wording “NANO” does not immediately bring to the mind of the consumer the amended identification of goods and services in Class 9, 35, 41, 42 covered by Applicant’s Mark. Instead, the wording “NANO” when applied to Applicant’s goods and services, requires imagination, thought, or perception to reach a conclusion as the nature of those goods and services. As such, this wording does not merely describe Applicant’s goods and services. Therefore, a disclaimer of this wording is not appropriate.

In contrast, a mark is deemed suggestive if it “connote[s], without describing, some quality, ingredient, or characteristic of the product.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996) (finding L’EGGS merely suggestive of pantyhose). *See also Synergistic Int’l, LLC v. Korman*, 470 F.3d 162, 172 (4th Cir.2006) (finding GLASS DOCTOR merely suggestive of window repair). One test that is often implemented by courts deems a mark as suggestive if it requires “imagination, thought, or perception . . . to reach a conclusion on the nature of the goods.” *In re Joseph Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987); *see also In re Tennis in the Round*, 199 U.S.P.Q. 496, 498 (“[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.”).

The crux of the Examiner's requirement for the disclaimer is the presumption that the Applicant's goods and services are in the field of nanotechnology and nanomedicine. As evidence of descriptiveness, the Examiner has provided dictionary printouts for the terms *nanotechnology* or *nanomedicine*. However, Applicant has not applied for the marks *NANOTECHNOLOGY* or *NANOMEDICINE* and nothing in the Examiner's evidence indicates that the term "NANO" is an abbreviation of either terms. In fact, the Examiner's own evidence fails to identify the standalone term "NANO" as an abbreviation for either *NANOTECHNOLOGY* or *NANOMEDICINE*. Contrary to the Examiner's contention and in accordance to the Examiner's evidence, *NANOTECH* is the shortened form for *NANOTECHNOLOGY*. (See excerpt from Examiner's evidence attached as **Exhibit A**.)

The term "NANO" has multiple meanings. For example, the most common meaning of term "NANO" is "one billionth (10⁻⁹) part of." (See printout from merriam-webster.com attached as **Exhibit B**). "NANO" is also frequently used in a combining form and combined with a variety of additional wording, including, *nanosecond*, *nanoparticle*, *nanotube*, *nanomachine*, and *nanoscale*. Even acknowledging the Examining Attorney's evidence and the contention that "NANO" is an abbreviation for *nanotechnology* or *nanomedicine*, "NANO" does not forthwith convey to consumers an immediate idea about the goods or services with any degree of particularity. The term is broad and ambiguous, especially when used in the context of Applicant's mark as a whole, and Applicant's goods and services. When used in connection with Applicant's services, "NANO," requires imagination, thought, or perception to reach a conclusion as to the nature of Applicant's goods and services. Therefore, the wording is suggestive, not merely descriptive.

Suggestive wording is wording that, when applied to the goods or services at issue, requires imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. See *In re Shutts*, 217 USPQ 363 (TTAB 1983) (*SNO-RAKE* held not merely descriptive of a snow removal hand tool); *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).

Under this test, the wording "NANO" is suggestive (at best), *not* descriptive, of Applicant's goods and services because such wording is broad, general wording too vague to convey an immediate idea of the nature of Applicant's particular goods. See *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988) (holding that TECHNOLOGY was not directly descriptive because it was too vague to convey an immediate idea of the applicant's particular goods).

In fact, there are numerous marks registered on the Principal Register that contain the wording “NANO,” including in the fields of nanotechnology and nanomedicine, without a disclaimer of such wording, or a Section 2(f) Claim of Acquired Distinctiveness. These registrations are similar to Applicant’s Mark in that such registrations are using the related wording in a suggestive manner. Further, a search of the TESS records for marks that incorporate NANO and are registered for nanomedicine-related goods and services revealed only two results, Reg. No. 4266230 for the mark NANO BIOTIX and Reg. No. 5268313 for the mark NANO MED TALKS. Applicant respectfully points out to the Examiner that neither of the marks had to disclaim the term “NANO” and both are registered on the principal register.

If the USPTO has registered marks containing similar designations as an applicant’s mark, this action is evidence that these terms are merely suggestive. *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 78 U.S.P.Q.2d 1454 (1st Cir. 2006). For example, each of the following marks is registered on the Principal Register without a disclaimer or a Section 2(f) Claim of Acquired Distinctiveness:

Reg. No.	Mark	Relevant Goods/Services
3385916	ACS NANO	16: Printed publications, namely, a scientific research journal containing articles and information in the field of nanoscience and nanotechnology 41: Providing an online scientific research journal containing articles and information in the field of nanoscience and nanotechnology
87495453	FROM NANO TO MACRO	42: Research and development of technology in the field of nanomaterials and/or nanotechnology .
4266230	NANO BIOTIX	42: Scientific and technological services, namely, research and design services in the field of integrated system architecture that allows for the rapid development of highly interactive and customizable learning applications for use in nanomedicine which is nanotechnology applied to medicine; scientific and technological evaluations, estimates and investigations provided by engineers, researchers in the field of nanomedicine ; technical project studies, namely, technical research in the field of nanomedicine; industrial analysis and research services in the field of nanomedicine; chemistry services, namely, chemistry consultation; expert appraisals in the field of engineering, namely, consultation in the field of engineering; technical research in the field of nanomedicine
5268313	NANO MED TALKS	41: Educational services, namely, providing classes, seminars, workshops, continuing professional education courses, presentations and retreats in the field of medicine, nanomedicine, technology, nanotechnology and innovation; medical training services; organization and conducting of conferences in the fields of medicine, nanomedicine, technology, nanotechnology and innovation; organization and conducting of congresses in the fields of medicine, nanomedicine, technology, nanotechnology and innovation; organization and conducting of seminars in the fields of medicine, nanomedicine, technology, nanotechnology and innovation; organization and production of television shows; presentation of live show performances; publication of magazines, books and manuals in the field of medicine; conducting of training courses in the field of technology and innovation 42: Scientific research particularly in the field of nanomedicine, nanotechnology applied to medicine; technological consulting services particularly in the field of nanomedicine, nanotechnology applied to medicine; evaluations and assessments in the nature of research in the field of

		nanoscience and nanotechnology , particularly applied to medicine; consulting in the field of engineering in the nature of preparation of reports relating to research in nanoscience and nanotechnology ; provision of medical information regarding medical nanotechnology research
4897974	N FIRST NANO	07: Manufacturing machinery, namely, chemical vapor deposition machines for use in manufacturing in the nanotechnology , solar, energy, microelectromechanical systems, and semiconductor industries. 42: Technology consultation in the field of material processes.
3278680	NANO-SYNERGY	42: CHEMICAL COMPOSITION OPTIMIZATION SERVICES, NAMELY APPLYING NANOTECHNOLOGY WITH ANY COMPOUND MOLECULE, MIXTURE OR FLUID SO AS TO RESULT IN AN END PRODUCT OF SMALLER PARTICLE SIZE TO YIELD GREATER EFFICIENCY, EFFICACY, ACTIVITY OR PENETRATION WITHOUT ALTERING ITS ATOMIC, MOLECULAR OR CHEMICAL STRUCTURE
3361623	NANO AND GIA	42: Chemical research; Chemistry consultation; Computer consultation; Computer software consultancy; Computer software consultation; Consultancy in the field of software design; Consultation in the field of physics; Consultation services in the fields of selection, implementation and use of computer hardware and software systems for others; Consulting services in the field of design of newsletters; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Industrial research in the field of materials design for electronics, photonics and renewable energy; Information technology consultation; Laboratory research in the field of electronics, photonics and renewable energy; Material testing; Materials testing and analyzing; Materials testing and evaluation; Product research; Product research and development; Research and development and consultation related thereto in the field of electronics, photonics and renewable energy; Research and development for new products for others; Research in the area of semiconductor processing technology; Research in the field of chemistry; Research in the field of physics; Scientific research; Scientific research and development; Technical consultancy in relation to the production of semiconductors; Technological consultation in the technology field of electronics, photonics and renewable energy; Technology consultation and research in the field of electronics, photonics and renewable energy; Technology consultation in the field of electronics, photonics and renewable energy
5179473	NANO-CHECKER	09: Research laboratory analyzers for measuring, testing and analyzing blood and other bodily fluids
4825089	NANO SERIES	09: Pressure sensors for chemical solution; flowmeters for chemical solution
4176959	NANO-ID	09: Air quality particle analyzers for sensing and characterizing particles including particle counters, particle mass analyzers, particle spectrometers, particle mobility classifiers and particle size classifiers
4546013	NANO SHIELD	09: Electron microscopes and parts thereof
3835902	NANO-ID	09: Calibrated collection instrument for collecting, sorting, and size separating aerosol particulate samples from clean room or industrial work environments for occupational and industrial hygiene air monitoring purposes
4091352	NANO-CYTE	09: Precision instruments for manipulation, stabilization, positioning and viewing of nanoscale objects
3789493	NANO-DRIVE	09: Precision instruments for manipulation, stabilization, positioning or viewing of microscopic objects

TESS records of the aforementioned registrations are attached as **Exhibit C**.

The Examining Attorney has the burden of establishing a *prima facie* case of descriptiveness. *In re Gyulay*, 820 F.2d 1216, 3 U.S.P.Q. 1009 (CAFC 1987). It is respectfully pointed out that all doubts should be resolved in favor of the Applicant. According to the Board, in cases where the question to be resolved is one of descriptiveness, all doubt is to be resolved in favor of publishing the mark so that it would be left up to members of the relevant industry to raise the issue as to whether applicant's wording is merely descriptive. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84 (T.T.A.B. 1983) (doubts under § 2(e) about the merely descriptive nature of a term are resolved in favor of the applicant, unlike the situation in resolving § 2(d) likely confusion disputes); *In re The Nobel Co.*, 225 U.S.P.Q. 749 (TTAB 1985); *In re LRC Products*, 223 U.S.P.Q. 1250, 1252 (TTAB 1984); and *In re Hospital Supply Corp.*, 219 U.S.P.Q. 249, 251 (TTAB 1983).

For the above reasons, applicant submits that the disclaimer requirement is not appropriate. The term NANO does not immediately describe the covered goods and services. Instead, the wording is used in a suggestive manner in connection with Applicant's goods and services. Plus, the USPTO has registered a number of marks featuring or comprised of NANO in the field of science, including nanotechnology and nanomedicine, on the Principal Register, and has also held that the wording NANO is not descriptive, even in connection with similar goods and services. These factors support the suggestive nature of Applicant's Mark, and therefore Applicant requests that the disclaimer requirement be withdrawn.

In conclusion, Applicant respectfully requests that the application be allowed to proceed to publication.