

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark: CATS
Applicant: TONOMETER, LLC
Application Serial No.: 88/105,970
Examining Attorney: Tracy Cross, Law Office 109

AMENDMENTS TO APPLICATION

Elsewhere in this Response, Applicant has amended the identification of goods as suggested by the Examining attorney to resolve the indefiniteness issue identified. The identification of services now reads:

Tonometers; tonometer prisms; applanation tonometers; and structural parts therefor

RESPONSE REMARKS

In the Office Action dated December 22, 2018, the Examining Attorney refused registration of the CATS mark on the grounds that the mark is merely descriptive of the services covered under the application, and therefore is not registrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). Applicant respectfully disagrees with the Examining Attorney's determination that the CATS mark is merely descriptive, and requests reconsideration thereof.

An acronym or abbreviation cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym, abbreviation, or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents. *See Modern Optics Inc. v. The Univis Lens Co.*, 234 F. 2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956); *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*,

104 USPQ2d 1224, 1230-31 (TTAB 2012) (holding "CMS" not substantially synonymous with the grape varieties cabernet, merlot, and syrah and therefore not merely descriptive for wine); TMEP §1209.03(h). Accordingly, an acronym or abbreviation will only be considered substantially synonymous with descriptive wording if all of the following criteria are met:

- 1) the applied-for mark is an abbreviation, initialism, or acronym for specific wording;
- 2) the specific wording is merely descriptive of applicant's goods and/or services; and
- 3) a relevant consumer viewing the abbreviation, initialism, or acronym in connection with applicant's goods and/or services will recognize it as the equivalent of the merely descriptive wording it represents.

See TMEP §1209.03(h).

In refusing to register a mark under Section 2(e)(1), the Examining Attorney has an affirmative burden to establish a prima facie case that the CATS mark is generally understood as “substantially synonymous” with “correcting applanation tonometry surface,” which must in turn be descriptive of Applicant's goods. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (citing *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956)). (“[A]s a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.”). The Examining Attorney has not met that burden here because, assuming arguendo that CATS is an acronym for the specific wording “correcting applanation tonometry surface”, this specific wording is not merely descriptive of Applicant's

goods and a relevant consumer viewing the term CATS will not recognize the acronym as the equivalent of merely descriptive wording.

A mark is descriptive under the Trademark Act, 15 U.S.C. §1052(e)(1) only if the mark “immediately tells something about the goods or services.” See TMEP § 1209.01(a) and (b). If consumers must use some imagination to reach a conclusion about the meaning of the mark and the goods and services to be provided, then the mark is suggestive. See, e.g. *Triangle Publications v. Rohrlich*, 167 F.2d 969 (2d Cir. 1948) (finding the mark SEVENTEEN for a teenage fashion magazine not descriptive of the magazine or its subject matter); *Dial-A-Mattress Operating Corp. v. Mattress Madness*, 33 U.S.P.Q.2d 1961, 1966 (E.D.N.Y. 1994) (finding DIAL-A-MATRESS suggestive because even though “while certainly establishing a link between the telephone and bedding products, [the mark] does not begin to describe the nature, scope or extent of the services that name has come to represent”).

Neither Applicant’s CATS mark nor the associated “correcting applanation tonometry surface” wording immediately describes the ingredients, quality, characteristic, function, feature, purpose or use of Applicant’s goods, but rather alludes to Applicant’s goods and requires consumers to use some imagination or guesswork to reach a conclusion about the meaning of the mark and the goods being provided under it. Nothing in the CATS mark or the associated “correcting applanation tonometry surface” wording immediately conveys to consumers that the goods provided under the mark are tonometers, tonometry prisms, or parts therefor. It is unclear whether the wording refers to a good or a service, what is being corrected, or whether the surface is in association with a prism. The associated wording merely at most suggests to consumers that Applicant’s goods have *something* to do with tonometry. Consumers must use some imagination or guesswork to reach a conclusion regarding the specific nature of Applicant’s

goods. Thus, the second criterion for a merely descriptive acronym under TMEP §1209.03(h) is not met.

Additionally, the third criterion for determining whether an abbreviation or acronym mark is descriptive is also not met because a relevant consumer viewing the CATS mark would not necessarily recognize it as “the equivalent” of descriptive wording regarding applanation tonometers. The phrase "correcting applanation tonometry surface" was coined by Applicant, and has been used exclusively by Applicant and its privies in connection with Applicant's goods to be offered for sale under the mark. The Office Action itself demonstrates this because *every attached exhibit* shows the terms CATS and "correcting applanation tonometry surface" being used by Applicant's representatives or employees, or its subsidiary, CATS Tonometer LLC, to refer to Applicant's own goods. Thus, the exhibits collected in the Office Action demonstrate Applicant and its privies making *trademark use* of the CATS mark and the associated phrase. None of the exhibits shows the use of these terms by any entity not associated with Applicant or in reference to anything other than Applicant's goods, and thus, do not demonstrate that the terms are “commonly used” by the industry, or are generally understood by relevant consumers to refer generally to a class of goods.

First, the Office Action cites an article from theophthalmologist.com for the proposition that "CATS is a recognized acronym for 'correcting applanation tonometry surface'". But this article was authored by Dr. Sean McCafferty, who is Applicant's founder and CEO. As the article notes about the author, Sean McCafferty:

Sean McCafferty

Sean McCafferty is Founder, President and CEO of Intuor Technologies, LLC. After an undergraduate degree in mechanical engineering, he worked as a product development engineer before attending Ohio State University's Medical School and completing a residency in ophthalmology at the University of Arizona. Subsequently, he completed an MSc in optical engineering expressly to allow his ideas to become reality in terms of products for the ophthalmic industry

Attachment 9. Thus, the first exhibit cited in the office action demonstrates Applicant's CEO making trademark use of the CATS mark and the associated phrase. See Attachment 7 (referring to "our CATS prism"). This exhibit does not demonstrate that CATS is generally recognized as an acronym for the associated phrase, or that the phrase or the mark is used by anyone other than Applicant or its representatives.

The other exhibits are similar. The archived piece from ophthalmologytimes.com refers to Applicant and to studies by Dr. McCafferty on prisms to be sold under the mark by Applicant. See Attachment 11. The archived paper from BMC Ophthalmology shows the CATS mark being used in a trademark sense to refer specifically to Applicant's goods. See Attachment 35 (under the heading "Competing interests": "Authors, Sean McCafferty and Jim Schwiegerling have a vested interest in Intuor Technologies, which owns the technology being tested in this manuscript.") Similarly, the article from tucson.com is about Dr. McCafferty and patented goods that Applicant sells under the CATS mark. See Attachment 40 (Stating that Dr. McCafferty founded Applicant as a vehicle for new startup ventures, one of which is CATS Tonometer LLC); Attachment 41 ("Nannon Roosa, Intuor's chief operating and financial officer, said the CATS Tonometer prism can be fitted on any of the thousands of Goldmann tonometers in use worldwide...") The webpages from CATS Tonometer, LLC's webpage also show trademark use of CATS by Applicant's own subsidiary LLC. See Attachment 72 (referring to "our CATS Tonometer PrismTM"); Exhibit 1 (CATS Tonometer, LLC's Articles of Organization showing ownership by Applicant). Thus, the Exhibits collected by the Examining Attorney demonstrate

only trademark use of the mark by Applicant and its privies to refer specifically to Applicant's own goods. The Office Action fails to show that CATS is generally understood by members of the consuming public as equivalent to a descriptive phrase. Accordingly, the Office Action fails to show that the mark is merely descriptive.

Finally, any doubt regarding whether a mark is descriptive or suggestive should be resolved in Applicant's favor. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1145 (Fed. Cir. 1987); *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983). Therefore, if there is any doubt whether the CATS mark is merely descriptive or suggestive, the mark should be found to be suggestive.

RESPONSE TO QUESTIONS

Applicant's answers to the specific questions raised in the Office Action are as follows:

1. Do applicant's competitors use CATS to advertise similar goods and/or services?

Applicant's answer: No. Both CATS and "correcting applanation tonometry surface" are coined terms used only by Applicant and its representatives and subsidiaries to refer to Applicant's own goods.

2. Who is the typical consumer of applicant's goods and/or services?

Applicant's Answer: The typical consumers of Applicant's goods are ophthalmologists and other clinicians involved in the treatment of ocular health issues.

3. Where are Applicant's goods typically purchased?

Applicant's Answer: Applicant's goods are not yet available for purchase. Once the goods are available for purchase, they will be available for purchase directly from Applicant.

CONCLUSION

Applicant submits that it has complied with the Examining Attorney's requirements and has overcome the Examining Attorney's grounds for refusal. Therefore, Applicant respectfully requests that the refusal to register be withdrawn and that the application be allowed and published.

Respectfully Submitted,

Dated: June 26, 2019

By: /s/ Michael J. Curley
Michel J. Curley
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EXHIBIT 1

**AZ CORPORATION COMMISSION
FILED**

SEP 02 2015

FILE NO. L-2030891-6



05213092

**ARTICLES OF ORGANIZATION
OF
CATS Tonometer, LLC**

1. The name of the limited liability company is:

“CATS Tonometer, LLC”

2. This limited liability company is organized to transact any and all lawful business for which a limited liability company may be organized under Arizona law.

3. The address of the known place of business/registered office of the company is:

6422 E. Speedway Blvd.
Tucson, Arizona 85710

4. The name and business address of the agent for service of process:

Rusing Lopez & Lizardi, P.L.L.C.
6363 North Swan Road, Suite 151
Tucson, Arizona 85718

5. This limited liability company is perpetual in duration.

6. Management of this limited liability company is vested in a manager or managers. The names and addresses of the initial managers of the company are:

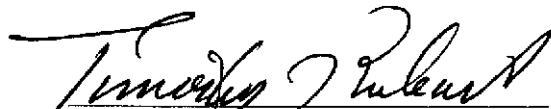
Nannon Roosa
4988 N. Ventana Ridge
Tucson, AZ 85750

Sean McCafferty, MD
5971 E. Jakemp Trail
Tucson, AZ 85747

7. The names and business addresses of each person who owns a 20% or greater interest in the company is:

Intuor Technologies, LLC
6422 E. Speedway Blvd.
Tucson, AZ 85710

IN WITNESS WHEREOF, these Articles of Organization have been executed on this 2nd day of September, 2015.



Timothy J. Reckart, Organizer

Rusing Lopez & Lizardi, P.L.L.C., having been designated to act as Statutory Agent, hereby consents to act in that capacity until removal or resignation is submitted in accordance with Arizona Revised Statutes.

RUSING LOPEZ & LIZARDI, P.L.L.C.

By: 

Timothy J. Reckart, Member