IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IAP	Serial No.	88/298,187
	Law Office	113
	Examining Attorney	Dana Dickson
	Filing Date	February 12, 2019
	Applicant	Essenlix Corporation
	RESPONSE	

In response to the Non-Final Office Action mailed April 10, 2019 the following response is provided.

I. Identification of Goods and Services

The Examining Attorney has indicated that Applicant's identification of goods and services in Class 1, 10, and 44 are indefinite.

In response to the Examining Attorney's assertion, the Applicant hereby requests that its Class 1, 10, and 44 identification of goods and services be amended, without prejudice, to include the underlined and remove the stricken through matter as follows.

IC 001: Assays for research purposes; Biological and chemical reagents used for non-medical research or laboratory purposes, namely, in vitro and in vivo scientific use, the testing of bodily fluids, and the detecting and analyzing of cells, proteins, small molecules, and nucleotides; ~~Biological and chemical test kits for personal wellness;~~ Biological and chemical test kits comprised of biological, chemical, and diagnostic reagents for the detection and identification of nucleic acids, namely, DNA and RNA in a sample, for laboratory or research use

IC 010: Medical diagnostic apparatus for testing cells, tissue, biomolecules, proteins, small molecules, and nucleotides; Medical devices for obtaining bodily fluid samples; Medical diagnostic instruments for the analysis of bodily fluids; Medical apparatus for diagnostic use,

namely ~~including~~, medical apparatus for diagnostic testing of health conditions, diseases, or abnormalities, namely, ~~in the fields of~~ cancer, blood abnormalities, immune diseases, neurological diseases, cardiovascular diseases, infectious diseases, viral diseases, genetic diseases, and endocrine diseases, and other tissue-based diagnostic testing, cytology, and cell based testing; Medical apparatus, devices, and instruments for wellness testing, health condition testing, and healthcare testing, namely, point-of-care diagnostic devices, at-home diagnostic devices, and portable health monitoring devices that detect health conditions and diseases in the nature of cancers, blood abnormalities, immune diseases, neurological diseases, cardiovascular diseases, infectious diseases, viral diseases and genetic diseases; Medical apparatus, devices, and instruments for the detection and identification of nucleic acids, namely, DNA and RNA in a sample, in the nature of apparatus for DNA and RNA testing for medical purposes; Biological and chemical testing kits for personal wellness in the nature of diagnostic test kits consisting primarily of medical diagnostic reagents and assays for the detection of cancer, blood abnormalities, immune diseases, neurological diseases, cardiovascular diseases, infectious diseases, viral diseases, and genetic diseases; Medical diagnostic instruments for the analysis of body fluids in the nature of biological and chemical test kits for the detection and identification of nucleic acids, namely DNA and RNA in a sample

IC 044: Medical services; Medical assistance; Medical consultations; Medical counseling; Medical information; Healthcare services in the field of digital healthcare services; Diagnostic services, namely, medical testing for diagnostic purposes; Wellness services, namely, providing wellness information; Medical services, medical assistance, medical consultations, medical counseling, medical information, healthcare testing, diagnostic testing, and wellness services~~, namely~~, all in the fields of cancer, blood abnormalities, immune diseases, neurological diseases, cardiovascular diseases, infectious diseases, viral diseases, genetic diseases, and other tissue-based diagnostic testing, cytology, and cell-based testing; Medical testing services for the detection and identification of cells, proteins, small molecules, and nucleic acids in a sample

Because the proposed amendments serve to clarify and limit, but in no way broaden, the identification of goods and services, in compliance with 37 C.F.R. § 2.71(a), Applicant submits that the amendments are permissible.

II. Misclassification of Goods

Based on the foregoing Amendments to the Identification of Goods and Services in International Classes 1 and 10, Applicant submits that the above objection is now moot.

III. Requirement of Additional Information

In response to the Examining Attorney's requirement of additional information, Applicant submits the following response.

1) Applicant does not have fact sheets, instruction manuals, brochures, advertisements, and pertinent screenshots of Applicant's website as it relates to Applicant's goods and/or services in the application, including any materials using the terms in the applied-for mark.

2) To the best of Applicant's knowledge, there is no documentation for goods and services of the same type. Applicant's goods and services relate to a new and proprietary technology which includes a physical device employing nanotechnology to detect biomolecules and biochemicals in various small volume samples, such as blood, urine, sweat, and condensate.

3) Applicant submits that:

    1. Applicant's goods are not related to immunosuppressive acidic protein.
    2. Applicant's services are not related to immunosuppressive acidic protein.
    3. Applicant's competitors do not use the wording "IAP" or "immunosuppressive acidic protein" to advertise similar goods and/or services.
    4. Applicant expects that its consumers will be those in need of, or those having a desire of, monitoring their health or someone else's health.
    5. Applicant expects to offer its goods and services online, in pharmacies, and in clinics.
    6. The wording "IAP" in the applied-for mark means **I**ntelligent **A**daptive **P**aradigm.

IV. Section 2(e)(1) Refusal – Merely Descriptive

The Examining Attorney has initially refused registration pursuant to Trademark Act Section 2(e)(l), 15 U.S.C. Sec. 1052(e)(l), alleging that the applied-for mark merely describes a feature of applicant's goods and/or services. A term is merely descriptive if it possesses no significance or meaning other than to bring to mind immediately and directly a particular or specific characteristic, feature or aspect of a product or service to which the mark is applied. *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980) (emphasis added). The PTO has the burden to establish a prima facie case that a mark is merely descriptive. Any doubt on the question of descriptiveness should be resolved in favor of Applicant. *In re Pennwalt Corporation*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972).

Applicant submits that its IAP mark does not immediately convey any information to the consumer about Applicant's goods and/or services, and therefore is not merely descriptive. Applicant respectfully requests that the refusal be withdrawn in light of the following remarks.

A. Applicant's Mark Is Not Substantially Synonymous with the Wording it Stands For

As a general rule, an acronym or initialism ***cannot*** be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents. (Emphasis supplied). 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 varietals cabernet, merlot, and syrah and therefore not merely descriptive for wine); *In re Thomas Nelson, Inc*., 97 USPQ2d 1712, 1715 (TTAB 2011) (holding NKJV substantially synonymous with merely descriptive term "New King James Version" and thus merely descriptive of bibles). A mark consisting of an abbreviation, initialism, or acronym will be considered substantially synonymous with descriptive wording if: (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 an abbreviation, initialism, or acronym

of the merely descriptive wording that it represents. See *In re Thomas Nelson, Inc*., 97 USPQ2d at 1715-16 (citing *In re Harco Corp*., 220 USPQ 1075, 1076 (TTAB 1984)). Thus, without additional evidence, an applicant's proprietary use of an acronym is not sufficient to establish that the acronym is readily understood to be substantially synonymous with the descriptive wording it represents. *Modern Optics*, 234 F.2d 504, 506, 110 USPQ 293, 295 (finding the record unconvincing that CV is a generally recognized term for multifocal lenses and lens blanks). See also *In re BetaBatt Inc*., 89 USPQ2d 1152 (TTAB 2008) (DEC found to be routinely used as an abbreviation for "direct energy conversion"); *Capital Project Mgmt. Inc. v. IMDISI Inc.*, 70 USPQ2d 1172 (TTAB 2003) (TIA found to be substantially synonymous with "time impact analysis"); *In re The Yacht Exch., Inc*., 214 USPQ 406 (TTAB 1982) (MLS held descriptive for multiple listing services for yachts and boats); cf. *In re Harco Corp*.,220 USPQ 1075 (TTAB 1984) (record insufficient to establish that CPL would be commonly understood as no more than an abbreviation of "computerized potential log").

The applied-for mark IAP is an acronym for "INTELLIGENT ADAPTIVE PARADIGM". The relevant inquiries are, therefore, whether "Intelligent Adaptive Paradigm" is merely descriptive of applicant's goods and/or services and, if so, whether a relevant consumer viewing IAP with applicant's goods and/or services will recognize it as an acronym of "Intelligent Adaptive Paradigm." Applicant respectfully submits that the wording "Intelligent Adaptive Paradigm" is not merely descriptive of the Applicant's goods and/or services, and alternatively, even if it is, that a consumer viewing IAP with Applicant's goods and/or services will not recognize it as an acronym of the wording "Intelligent Adaptive Paradigm."

Here, the Examining Attorney has provided no evidence showing that "Intelligent Adaptive Paradigm" is descriptive of Applicant's goods and/or services or that IAP is readily understood to be substantially synonymous with "Intelligent Adaptive Paradigm." Indeed, Applicant's use of IAP is proprietary and the first time it has been used as such. Therefore, absent evidence to the contrary, Applicant submits that the applied-for mark IAP is not substantially synonymous with the wording it stands for and cannot be merely descriptive.

B. The Examining Attorney Has Not Met the Required Burden

The Examining Attorney has not met the burden of proving that the wording INTELLIGENT ADAPTIVE PARADIGM is merely descriptive of Applicant's goods and services. Pursuant to T.M.E.P. § 1209.02, "[i]f the examining attorney refuses registration, he or she should support the refusal with appropriate evidence." The evidence submitted by the Examining Attorney does not show that the mark INTELLIGENT ADAPTIVE PARADIGM is merely descriptive of Applicant's goods and services or is a term of art in Applicant's industry.

Indeed, the Examining Attorney has submitted no evidence whatsoever that shows INTELLIGENT ADAPTIVE PARADIGM is merely descriptive of the Applicant's goods and services. Therefore, Applicant respectfully submits that the PTO has not met its burden of showing that the wording for which the applied-for mark IAP stands for is merely descriptive of Applicant's goods and services.

C. Any Doubt with Respect to the Proper Categorization of a Mark Must Be Resolved in Favor of Applicant

In determining whether Applicant's mark is merely descriptive or suggestive, all doubts must be resolved in favor of the Applicant. *In re Shutts*, 217 U.S.P.Q. 363, 365 (TTAB 1983). In *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972), the Trademark Trial and Appeal Board observed:

> It has been recognized by this and other tribunals that there is no easy applicable objective test to determine whether or not a particular mark, as applied to specific goods, is merely descriptive or merely suggestive. The distinction between marks which are 'merely descriptive' and marks which are 'suggestive' is so nebulous that more often than not it is determined largely on a subjective basis with any doubt on the matter being resolved on applicant's behalf on the theory that any person who believes that he would be damaged by the registration will have an opportunity under Section 13 to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.

Id. at 565, [Emphasis Added]. *See also In re In Over Our Heads, Inc.*, 16 USPQ2d 1653, 1655 (TTAB 1990) (*citing Gourmet Bakers*).

Accordingly, to the extent that there continues to be any doubt as to whether the applied-for mark IAP is merely descriptive of Applicant's goods and/or services, the best course of action is to pass the mark to publication with the knowledge that if a party does believe it will be damaged by the registration of Applicant's mark, an opposition proceeding can be brought and a more complete record can be established.

D. Conclusion – Mark Not Merely Descriptive

In view of the foregoing remarks, and in light of the treatment of similar marks by the PTO, Applicant submits that its IAP mark is not merely descriptive of Applicant's goods and services and thus is eligible for registration on the Principal Register. In view of the above arguments, Applicant respectfully requests that the Section 2(e)(l) rejection to Applicant's mark be withdrawn and that the herein application be allowed to pass to publication.

CONCLUSION

In light of the remarks set forth above, Applicant respectfully requests that the refusal to register the applied-for mark under Section 2(e)(1) be withdrawn and that the Applicant's mark be allowed to register.