

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK APPLICATION - PRINCIPAL REGISTER

Ser. No.	88446144
Mark	METAL-FREE
Goods	<u>Class 10</u> : Medical devices, namely, spinal implants composed of artificial materials; Surgical and medical apparatus and instruments for use in spinal surgery
Amended	<u>Class 10</u> : Medical devices, namely, spinal implants composed of primarily non-metal materials
Owner	Spinal Elements, Inc.

RESPONSE TO OFFICE ACTION

This Response is filed in reply to the Office Action issued August 19, 2019, in the subject application. The Examining Attorney raised issues regarding Section 2(e)(1) and the description of goods. Each of these issues are addressed in this Response (below and/or via TEAS).

I. Section 2(e)(1)

The Examining Attorney raised an issue regarding Section 2(e)(1) on the alleged basis that Applicant's mark is "merely descriptive" of Applicant's goods and should be refused registration. Applicant respectfully disagrees.

A. METAL-FREE is a double entendre because it is an expression capable of more than one interpretation.

A double entendre is an expression capable of more than one interpretation as applied to the relevant goods. TMEP 1213.05(c). Applicant contends that its mark is capable of more than one suggestive interpretation.

First, Applicant's mark is capable of interpretation as a directive. For example, the verb "metal" can connote using metal. As such, consumers could interpret Applicant's mark as a call-out to METAL (*verb*) – FREE in relation to an alternative approach away from the conventional metal spinal hardware (e.g., rods and screws). This interpretation also demonstrates that the expression is suggestive because it requires imagination, thought, or perception to reach a conclusion as to the nature of the spinal implants under this possible interpretation.

Second, Applicant's mark is capable of interpretation as wordplay. For example, the term METAL is a homophone with MEDDLE. As such, consumers could interpret Applicant's mark as wordplay to MEDDLE-FREE. This interpretation also demonstrates that the expression is suggestive because it requires imagination, thought, or perception to reach a conclusion as to the nature of the spinal implants under this possible interpretation.

Moreover, both of these possible interpretations rely on associations that consumers could make based on the common terms metal and meddle as apparent from the mark itself. See TMEP1213.05(c) for examples of double entendres, including: *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008) (holding THE FARMACY registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition).

B. The USPTO has allowed trademarks such as Applicant's mark as registrable on the Principal Register.

Attached as Exhibit A and shown below are registrations demonstrating that the USPTO believes an expression, such as “___-FREE”, is capable of registration on the Principal Register for the respective goods. The USPTO considered each of the below as suggestive.

Mark	Reg. No.	Register	Disclaimer?	Acquired Distinctiveness?	Relevant Example Goods	Owner
RUST FREE	5550526	Principal	RUST	NO	[Liquid rust and stain remover]	PMS Products, Inc.
CORROSION FREE	5818753	Principal	CORROSION	NO	[Rust preventatives, namely, rust and corrosion preservatives in the nature of coatings]	Wanna Winna Inc.
LICEFREEE	5804672	Principal	NO	NO	[Lice treatment preparations]	Tec Laboratories Inc.
STAINFREE	5632993	Principal	NO	NO	[Pet stain removers; Biotechnological cleaning solution for eliminating odors, breaking down organics, and removing stains]	Fruit of Nine, Inc.

II. Conclusion

Applicant respectfully contends that its mark is registrable and requests that the present application be allowed to proceed to publication for opposition.