

## **REMARKS**

This responds to the Office Action dated 13 March 2019. Applicant thanks the Examining Attorney for the examination of this application and notes that the Examining Attorney's search revealed no similar registered or pending marks.

### **I. DESCRIPTIVENESS REFUSAL**

In the Office Action, the Examining Attorney refused registration on the Principal Register on grounds that the mark is merely descriptive of the goods and services recited in the application. Applicant respectfully traverses this refusal based upon the following arguments and authority.

#### **A. MINIBUNION FUNCTIONS AS A DOUBLE ENTENDRE**

A "double entendre" is a word or expression capable of more than one interpretation. TMEP §1213.05(c). For trademark purposes, a "double entendre" is an expression that has a double connotation or significance as applied to the goods or services. *Id.* The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. Because the term MINIBUNION has a double connotation as it relates to the relevant goods (i.e. surgical implants comprising artificial material and associated surgical instrument sets), Applicant respectfully requests that the Examining Attorney withdraw the refusal.

The Examining Attorney proposed one possible meaning of the term MINIBUNION, as it relates to the surgical implants: the term "mini-bunion . . . refers to a bony bump at the base of the toe." Another possible meaning (and the suggestive meaning as used by Applicant) is that the term MINIBUNION suggests to the user that the small surgical implants and instruments used in association with a minimally invasive bunion system. That is, the term "minibunion" refers to a

type of minimally-invasive bunion surgery that is performed with smaller incisions. So it does not refer to a small bunion, but rather, a minimal or “mini” incision. *See, e.g.* <https://www.aofas.org/annual-meeting/exhibit-hall/industry-symposia>, where it says, “This interactive system will feature the MINIBunion Minimally Invasive Bunion System.” This suggests another meaning of the trademark related to a minimally invasive procedure to correct bunions. Since at least this second definition is not descriptive but merely suggestive, this mark should be allowed.

This case is similar to *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of “LIGHT” apart from the mark “LIGHT N’ LIVELY” for reduced calorie mayonnaise, stating as follows:

The mark “LIGHT N’ LIVELY” as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term “LIGHT” per se. That is, the merely descriptive significance of the term “LIGHT” is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilted cadence which encourages persons encountering it to perceive it as a whole.

*See also In re Symbra’ette, Inc.*, 189 USPQ 448 (TTAB 1975) (holding SHEER ELEGANCE for panty hose to be a registrable unitary expression; thus, no disclaimer of “SHEER” considered necessary). As described in more detail below, the term MINIBUNION’s suggestive-meaning shows it is a double entendre under the trademark laws and should, therefore, be allowed to register on the Principal Register.

#### **B. The MINIBUNION Mark Is Suggestive of Applicant’s Goods**

The Examining Attorney has refused registration of Applicant’s MINIBUNION mark under 15 U.S.C. § 1052(e)(1) “because the applied-for mark merely describes a feature, characteristic, or purpose of applicant’s goods.” As discussed below, Applicant respectfully submits the Examining Attorney’s refusal is improper.

## 1. MINIBUNION is Suggestive Under the Imagination Test

Perhaps the most commonly-used test for determining whether a mark is descriptive or suggestive is the so-called degree of imagination test. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:67 (4th Ed. 2007). The degree of imagination test provides:

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.

*Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

Thus, under the degree of imagination test, the determinative question is how immediate and direct the thought process is from seeing/hearing the mark to the particular product or service. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 350 (9th Cir. 1979); *see also* MCCARTHY at § 11:67. A term is suggestive, not descriptive, if one must exercise “mature thought or follow a multi-stage reasoning process” to determine attributes of the product or service. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496 (T.T.A.B. 1978); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 USPQ2d 1204, 1206 (9th Cir. 1987) (“If a consumer must use more than a small amount of imagination to make the association [of product attribute], the mark is suggestive and not descriptive.”); *see also* MCCARTHY at § 11:67. Further, a strong indication of suggestiveness is if the mental leap between the mark and the product or service is not almost instantaneous. *Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991); *see also* MCCARTHY at § 11:67.

For example, in *In re Nobile Co.*, 225 USPQ 749, 750 (TTAB 1985) the Board held that NOBURST was suggestive as opposed to merely descriptive for a product that reduces the likelihood that water pipes would burst because the Board did not believe this conclusion is readily

arrived at by merely observing the mark on the goods, but that it required “interpretation by the viewer.”

In this case, one viewing or hearing the MINIBUNION mark will not immediately formulate in his or her mind that the mark is in any way tied to “surgical implants/instruments comprising artificial material and associated surgical instrument sets.” Quite to the contrary, a consumer would be required to go through a multi-stage reasoning process, and would have to guess as to the goods or services associated with the mark.

Even if purchasers who encounter Applicant’s mark MINIBUNION immediately believe the term MINIBUNION relates to the small size of person’s bunion, they would have an incorrect understanding of Applicant’s goods. Page 2, Office Action. To the contrary, Applicant’s goods involve surgical implants used in association with a minimally invasive bunion system. *See, e.g.* <https://www.aofas.org/annual-meeting/exhibit-hall/industry-symposia>, where it says, “This interactive system will feature the MINIBunion Minimally Invasive Bunion System.” Thus, the degree of imagination test confirms that MINIBUNION is suggestive, not descriptive, because it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.

## **2. MINIBUNION is also Suggestive Under the Competitor’s Need Test**

Another common test used in determining suggestiveness is the competitor’s need test. Under this test, if the suggestion the mark makes is so remote and subtle that competitors will not likely need to use the mark to describe their goods, then the mark is suggestive. *Glen Raven Mills Inc. v. Ramada International Inc.*, 852 F. Supp. 1544, 1555 (N.D. Fla. 1994). The more imagination required to associate a mark with a product, the less likely competitors will need the term to describe their products. *Union Carbide Corp. v. Ever Ready, Inc.*, 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976); *Aluminum Fabricating Co. v. Season-All Window Corp.*,

359 F.2d 314, 119 U.S.P.Q. 61 (2nd Cir. 1958) (Season-All for aluminum storm windows suggestive and non-descriptive); *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 172 U.S.P.Q. 491 (C.C.P.A. 1972) (SKINVISIBLE for transparent medical adhesive tape not needed by competitors such as opposer).

Applicant's competitors engaged in selling goods relating to surgical implants most certainly do not need to use MINIBUNION to adequately describe their goods. MINIBUNION has no particular meaning in this industry and consumers would only, if ever, make a connection to Applicant's goods after a multi-stage reasoning process. Companies could use many descriptive terms, rather than the suggestive mark MINIBUNION, to describe their products.

Furthermore, just because MINIBUNION is suggestive to customers of certain elements of Applicant's surgical implants does not mean the mark should be considered merely descriptive. *See In re Reynolds Metals Co.*, 480 F.2d 902 (C.C.P.A. 1973) (the Brown-In-Bag for transparent plastic bags held to be suggestive, because competitors are not prevented from informing buyers that goods may be browned in their bags even though the term informs buyers by suggestion). Thus, the competitor's need test supports a conclusion that MINIBUNION is suggestive.

### **3. The MINIBUNION Mark is Not Merely Descriptive**

For a mark to be unregistrable as merely descriptive pursuant to Section 2(e), it must "immediately convey to one seeing or hearing it, a thought of [applicant's] product [or service]." *In re Hutchinson Technology*, 852 F.2d 552, 555 (Fed. Cir. 1988) (citing *In re Bed and Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986)). Conversely, as set forth above, a suggestive mark requires some degree of imagination, thought and perception to reach a conclusion concerning the goods or services. *Stix Products, Inc.*, 295 F. Supp. at 488. Thus, in contrast to a suggestive mark, a merely descriptive mark will immediately bring to the forefront of a consumer's mind the product

or service in question. *See In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); *see also* TMEP § 1209.01(a).

Because, as discussed above, the MINIBUNION mark does not immediately bring to the forefront of the consumer's mind Applicant's products (surgical implants), the mark is not merely descriptive. Accordingly, Applicant respectfully requests the Examining Attorney to withdraw the descriptiveness refusal.

**C. All the Doubts Surrounding Registrability of the Mark Should be Resolved in Applicant's Favor**

It is well settled "an applicant need not conclusively establish distinctiveness but need only establish a prima facie case to warrant publication of a mark for opposition." *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988) (quoting *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. 916, 919 (T.T.A.B. 1983)). Moreover, any doubt with respect to whether a mark is descriptive or suggestive must be resolved in favor of the applicant, and borderline cases should pass to publication. *See In re Grand Metropolitan Foodservice Inc.*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994) (MUFFUNS for muffins not merely descriptive); *In re Priefert Mfg. Co., Inc.*, 222 U.S.P.Q. 731, 733 (T.T.A.B. 1984) (HAY DOLLY not merely descriptive of trailer for hauling hay); *In re Hormel & Co.*, 218 U.S.P.Q. 286, 287 (T.T.A.B. 1983) (FAST'N EASY not merely descriptive of "pre-cooked meats"); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (T.T.A.B. 1972) (DRI-FOOT not merely descriptive of anti-perspirant deodorant for feet).

Applicant's mark is at most suggestive. Nevertheless, in the event any doubt remains, such doubt should be resolved in Applicant's favor. Applicant respectfully requests the refusal be

withdrawn and the Examining Attorney pass the mark to publication to determine if anyone would truly be damaged by registration of MINIBUNION.

## **II. REQUIREMENT FOR ADDITIONAL INFORMATION**

In response to the Examining Attorney's request for additional information, Applicant is using "Minibunion" to describe a minimally-invasive technique, and associated surgical instruments and implants, for correcting bunion deformities of the foot. See, for example, <https://www.nbcdfw.com/news/health/Doctor-Invents-Surgery-to-Cure-Bunions-511745141.html>. Applicant's goods are marketed to surgeons who will use Applicant's instruments and implants to perform bunion correction surgery. Typical channels of trade include a network of sales representatives that can supply instruments and implants, as well as answer questions about indications and use.

## **CONCLUSION**

For the reasons set forth above, Applicant respectfully requests the Examining Attorney to withdraw the mere descriptiveness refusal and approve the present application for publication and ultimate registration. If there remain any unresolved matters, Applicant respectfully requests the Examining Attorney to telephone the undersigned attorney to expedite the handling of this matter.