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Subject: U.S. TRADEMARK APPLICATION NO. 76701339 - THE EYE CANCER  
FOUNDATION - P-3856-3 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76701339

**MARK:** THE EYE CANCER FOUNDATION



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** THE EYECARE FOUNDATION,  
INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

P-3856-3

**CORRESPONDENT E-MAIL ADDRESS:**

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, The Eyecare Foundation, Inc., has appealed the final refusal of registration under Section 2(e)(1) of the Trademark Act of 1946, as amended, 15 U.S.C. Section 1052(e)(1) (hereinafter the "Act") on the ground that the proposed mark is merely descriptive of a feature of the applicant's services in both Classes 36 and 44.

FACTS

On January 25, 2010, the applicant applied to register THE EYE CANCER FOUNDATION for use with charitable services, namely, charitable fundraising and providing grants to physicians for research on eye cancer and eye diseases in Class 36, as well as charitable services, namely, providing healthcare counseling and support to

people with eye cancer and providing medical information to people with eye cancer and other eye diseases and their families about their diseases and possible treatment options via the Internet, in Class 44.

The examiner initially refused registration on April 26, 2010 under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the ground that the proposed mark is merely descriptive of the services, and provided a caveat that the proposed mark was possibly generic for the services. This refusal was premised on evidence that the applicant's foundation services provide fundraising and counseling services in the field of "eye cancer." The examiner also required a claim of ownership to a related registration and an amended identification of services.

In response, on May 10, 2010, the applicant amended its identification of services, disclaimed the word FOUNDATION and deleted the wording "eye cancer" and "and other" from the description of services. Thus, the description of services was amended to: charitable services, namely, charitable fundraising and providing grants to physicians for research on eye diseases, in Class 36, and providing medical information to people with eye diseases and their families about their diseases and possible treatment options via the Internet; providing a charity-based, Internet database of patient medical information in the field of eye diseases where patients can inquire about medical issues and procedures from other patients and can relay information about their medical experience for support and community, in Class 44. The applicant argued that deleting

the wording “eye cancer” from the description of services rendered the mark suggestive, and not descriptive, of the services, because they no longer pertain to “eye cancer.”

The examiner issued a final refusal under Section 2(e)(1) on May 27, 2010 based on evidence that eye cancer is considered an eye “disease,” and therefore, deleting this wording from the description of services did not obviate this refusal. The examiner referenced websites, dictionary definitions and sample registrations that were already of record as well as additional evidence provided therewith. On June 9, 2010, the applicant requested copies of referenced dictionary definitions that were not physically attached to the May 27, 2010 Office action and submitted a declaration from the applicant’s president. Since the applicant’s request was made in response to a final refusal, it was treated as a request for reconsideration. TMEP section 715.03.<sup>1</sup> The examiner denied reconsideration on June 11, 2010 because the applicant’s request did not present any new facts or arguments.

On June 25, 2010, the applicant filed a written request for clarification of the citation for the definition of the word FOUNDATION in the record. The examiner denied reconsideration again on June 30, 2010 because the request did not raise any new facts or arguments. In response to the applicant’s request, and to be sure that the record

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<sup>1</sup> TMEP section 715.03 provides, in pertinent part: “The examining attorney should construe any document filed after final action that responds to the outstanding refusals or requirements as a request for reconsideration. If the request for reconsideration does not overcome or resolve all outstanding refusals and requirements, the examining attorney must issue a written action that advises the applicant of the status of the application. The Office action should discuss any new evidence submitted with a request for reconsideration.”

contained complete dictionary definitions with correct citations, the examiner provided additional definitions of the word FOUNDATION under TMEP section 715.03.<sup>2</sup> On July 12, 2010, the applicant filed a nonresponsive “preliminary response” maintaining that the examiner made an “untimely attempt to expand the record on appeal” by submitting the additional dictionary definitions of the generic term FOUNDATION. This appeal was filed on July 28, 2010.

## ARGUMENT

### I. The Proposed Mark is Merely Descriptive of the Services

The proposed mark THE EYE CANCER FOUNDATION is merely descriptive of the applicant’s services because it immediately tells consumers a feature of the services. As outlined below, this wording immediately tells consumers that the applicant’s foundation provides charitable fundraising and grants for research on eye diseases, such as eye cancer, and provides medical and patient-related information about eye diseases, such as eye cancer, even if it also provides such information about other more common eye diseases.

### 2. The Examining Attorney’s Definitions of FOUNDATION are Timely

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<sup>2</sup> TMEP section 715.03 provides, in pertinent part: “Regardless of whether an applicant submits new evidence with a request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. TBMP §1207.04.”

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