

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/447920

**APPLICANT:** Photon Imaging, Inc.

**CORRESPONDENT ADDRESS:**  
JEFFREY D. COHEN  
PO BOX 12865  
LA JOLLA CA 92039-2865

**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
**ecom108@uspto.gov**

**MARK:** PHOTON IMAGING

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

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

Serial Number 76/447920

The assigned examining attorney has reviewed the referenced application and determined the following.

**NO CONFLICTING MARKS NOTED**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

**DRAWING CONTAINS COLOR LINING**

As of October 30, 1999, the Office no longer requires the use of lining to indicate color. The Office will continue to accept drawings that show color by using the color linings formerly shown in 37 C.F.R. §2.52(e). TMEP §807.09(b). However, the applicant also has the option of identifying color in the mark by providing a clear and specific description of the color and where it appears in the mark. If the applicant wishes to delete the lining from the mark, the applicant must submit a new black-and-white drawing of the mark that meets the requirements of 37 C.F.R. §2.52(a)(2)(i), along with a description of what the color is and where the color appears in the mark. 37 C.F.R. §2.52(a)(2)(v); TMEP §807.09(c).

**DESCRIPTION OF MARK REQUIRED**

The applicant must submit a concise description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The statement may be in the following form, if accurate:

The mark consists of a circle containing the Greek letter, phi, adjacent to the wording "photon imaging" in a stylized font.

**UNACCEPTABLE RECITATION OF SERVICES**

The application lists the services "research and development for new products of others scientific research, and consultation in the field of x-ray,

that is unacceptable indefinite. TMEP section 1402.01. To follow are the examining attorney's suggestions concerning the applicant's recitation of services. The applicant may amend the application pursuant to the examining attorney's suggestions, if accurate:

"Research and development for new products for others, scientific research, and *technical* consultation in the *fields* of x-ray, gamma ray, beta ray, measurement, and imaging instrumentation" in International Class 42.

**If the applicant has access to the world wide web, it is strongly recommended that it review the Office's Trademark Manual of Acceptable Identifications and Classifications for Goods and Services at <http://www.uspto.gov/web/offices/tac/doc/gsmmanual>.**

### **APPLICANT MAY NOT EXCEED SCOPE OF PRESENT RECITATION OF SERVICES**

While an application may be amended to clarify or limit the recitation of services, additions to the recitation are not permitted. 37 C.F.R. Section 2.71(b). TMEP section 1402.06. Therefore, the applicant may not amend to include any services that are not within the scope of the present recitation.

### **APPLICANT MUST DISCLAIM DESCRIPTIVE WORDING "PHOTON IMAGING"**

Trademark Act Section 6(a), 15 U.S.C. Section 1056(a), states that the Commissioner may require the applicant to disclaim an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. Section 1052(e), bars the registration of a mark which is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive of the goods or services. Therefore, the Commissioner may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive. If an applicant does not comply with a disclaimer requirement, the examining attorney may refuse registration of the entire mark. TMEP section 1213.01(b).

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright&Cres Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b). The applicant has applied to register the mark "PHOTON IMAGING" for "research and development for new products of others scientific research, and consultation in the field of x-ray, gamma ray, beta ray, measurement and **imaging** instrumentation." The respective terms "PHOTON" and "IMAGING" are defined as follows:

**pho-ton** (fo'tɒn) *noun*

1. The quantum of electromagnetic energy, generally regarded as a discrete particle having zero mass, no electric charge, and an indefinitely long lifetime.<sup>[1]</sup>

**im-ag-ing** (im'i-jɪŋ) *noun*

*Medicine.* Visualization of internal bodily organs, tissues, or cavities using specialized instruments and techniques, such as ultrasonography, for diagnostic purposes.

*Computer Science.* To translate (photographs or other pictures) by computer into numbers that can be transmitted to a remote location and then reconverted into pictures by another computer.<sup>[2]</sup>

A search and review of the applicant's website indicates that the applicant is "dedicated to research and development and commercialization of 'next generation' medical diagnostic instruments for advancing diagnosis and treatment of cancer as well as advanced radiation measurement instrumentation for space and terrestrial scientific applications using the applicant's revolutionary imaging sensor technologies." The examining attorney's additional search of "PHOTON IMAGING" in a Lexis Nexis® database yielded numerous articles containing such terminology which evidence the descriptiveness of the wording as applied to (1) imaging processes to observe individual T-cells and B-cells in laboratory mice and rats as the cells moved within lymph nodes in the body and (2) as applied to cameras and other scientific instruments carried aboard spacecrafts to allow the imaging of X-ray sources and to distinguish their "color." Please see the attached excerpts from ten (10) representative articles.

Based on the foregoing, the wording "PHOTON IMAGING" in the applicant's mark is considered merely descriptive, as it describes a characteristic, function and feature of the relevant services in that the services relate to photon imaging instrumentation. The applicant must insert a disclaimer of "PHOTON IMAGING" in the application. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.09(a)(i).

A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "PHOTON IMAGING" apart from the mark as shown.

### **REQUIREMENT FOR PARTICULAR INFORMATION**

In the event that the applicant does not believe that the wording "PHOTON IMAGING" is descriptive of its services, the applicant must indicate the relevance of the wording "PHOTON IMAGING" individually and collectively in its mark including whether such term has any

significance in relation to the services. The applicant must also indicate whether the terms "PHOTON" and "IMAGING," individually or collectively, are an ingredient, quality, characteristic, function, feature, purpose and/or use of the services. 37 C.F.R. Section 2.61(b); TMEP Section 808.03(c).

Additionally, the applicant must submit information for the identified services. This may take the form of a fact sheet, an instruction manual, and/or advertisements or promotional materials. If such materials are not available, the applicant must submit a detailed description of the services, including but not limited to their nature, purpose, prospective purchasers, and channel of trade. This information is necessary to evaluate accurately and fully the registrability of the applicant's proposed designation. 37 C.F.R. Section 2.61(b); TMEP sections 1103.04 and 1105.02. If the applicant does not provide the information required herein, registration may be refused. The Trademark Rules of Practice have the effect of law and failure to comply with a request for information is grounds for refusal of registration. See, e.g., *In re Joseph Edward Page*, 1999 TTAB LEXIS 229 (TTAB 1999); *In re Babies Beat, Inc.*, 13 USPQ2d 1729 (TTAB 1990); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (TTAB 1978); *In re Air Products and Chemicals, Inc.*, 192 USPQ2d 84, 85-86 (TTAB 1976); and *In re Morrison Industries, Inc.*, 178 USPQ 432, 433-34 (TTAB 1973).

If the applicant elects to disclaim the wording "PHOTON IMAGING," the applicant need not comply with this requirement.

#### **UNACCEPTABLE SPECIMEN**

The specimen does not show use of the mark for any services identified in the application, as it consists of a sheet of letterhead that does not reference the applicant's services. The applicant must a specimen showing use of the mark for the services specified. 37 C.F.R. Section 2.56. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen was in use in commerce at least as early as the filing date of the application. 37 C.F.R. Section 2.59(a); TMEP section 905.10. The applicant should note that, because it is claiming color as a feature of its mark, the substitute specimen must show the claimed color where indicated in the mark description.

#### **ACCEPTABLE SPECIMENS**

Acceptable specimens may include newspaper and magazine advertisements as well as other types of advertising such as brochures, billboards, handbills, direct-mail leaflets, and the like. However, printer's proofs for advertisements, publicity releases to news media, or printed articles resulting from such releases, are not accepted because they do not show use of the mark by the applicant in the sale or advertising of the services.

Letterhead stationery or business cards bearing the mark may be accepted if the services are clearly indicated thereon. For instance, letterhead that contains the mark and the additional phrase "Leather Tanners to the Nation for Half a Century," or even a term such as "Real Estate Brokers," may be accepted as support for leather tanning services or real estate brokerage services, respectively. However, letterhead stationery or business cards which bear only the mark and a company name and address are not adequate specimens (unless the mark itself has a descriptive portion which clearly identifies the services being provided), because such items are not evidence that the mark is used in the sale or advertising of the particular services recited in the application. See *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982); *Amica Mutual Ins. Co. v. R.H. Cosmetics Corp.*, 204 USPQ 155, 162 (TTAB 1979); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977); *In re Piece Goods Shops, Inc.*, 178 USPQ 512 (TTAB 1973).

#### **NOTE: MARK DIFFERS ON DRAWING AND SPECIMEN**

The applicant should note that the mark differs on the drawing and the unacceptable specimen. The drawing displays a plain Greek letter, "PHI," in a circle, and the drawing displays a more stylized Greek letter, "PHI," in a circle.

#### **FEE INCREASE EFFECTIVE JANUARY 1, 2003 (FOR INFORMATION ONLY)**

Effective January 1, 2003, the fee for filing an application for trademark registration will be increased to \$335.00 per International Class. The USPTO will not accord a filing date to applications that are filed on or after that date that are not accompanied by a minimum of \$335.00.

Additionally, the fee for amending an existing application to add an additional class or classes of goods/services will be \$335.00 per class for classes added on or after January 1, 2003.

#### **CHANGE OF ADDRESS (FOR INFORMATION ONLY)**

Applicants may now file address change correspondence via a new form on TEAS. Address changes may be performed on up to 20 cases at a time. The Trademark Office strongly encourages applicants to use this form, available online at: <http://etead.uspto.gov/V2.0/ca200/WIZARD.htm>

If the applicant has any questions or needs assistance in responding to this Office Action, please telephone the undersigned examining attorney.

Sonya B. Stephens  
Trademark Attorney  
Law Office 108  
(703)308-9108 ext 227 (phone)  
(703)746-8108 (fax)  
ecom108@uspto.gov (e-mail prosecution)

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecrep.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

\*\*\*\*\*022862\*\*\*\*\*

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