

**To:** Besmertnik, Seth Jared ([sbsmertnik@aol.com](mailto:sbsmertnik@aol.com))  
**Subject:** TRADEMARK APPLICATION NO. 78424946 - MINDMD - N/A  
**Sent:** 1/6/05 7:05:53 PM  
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**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/424946

**APPLICANT:** Besmertnik, Seth Jared

**\*78424946\***

**CORRESPONDENT ADDRESS:**  
Besmertnik, Seth Jared  
3rd Floor  
235 East 34th St  
New York, NY 10016

**RETURN ADDRESS:**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** MINDMD

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

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**  
[sbsmertnik@aol.com](mailto:sbsmertnik@aol.com)

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 78/424946

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

Search

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.

Proposed Mark is Descriptive

The examining attorney refuses registration on the Principal Register because the proposed mark is merely descriptive of the identified services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.* The applicant's proposed mark is the term "MINDMD" for the providing of health care information, healthcare information by telephone, telemedicine, psychological counseling, nutrition counseling, and medical counseling and managed health care services.

The applicant's proposed mark is a telescoped term consisting of the terms "MIND" and "MD." "Mind" is defined as the collective conscious and unconscious processes in a sentient organism that direct and influence mental and physical behavior and as the thought processes characteristic of a person or group; psychological makeup.[1] "MD" is defined as a reference to "medical doctor." [2] Taken as a whole the proposed mark can be interpreted as a medical doctor for treating the collective consciousness that influences mental and physical behavior. This appears merely descriptive of the applicant's provision of medical information and psychological counseling services. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function,

791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re BrightCrest Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

A Lexis/Nexis search illustrates the descriptive nature of the proposed mark. A search of U.S. news articles for the term "mind md" or "mind doctor" found over six hundred stories. Articles found within this search illustrate the descriptive nature of the term as applied to the identified services (See attached for random examples). Based on the above, the mark can not be registered on the Principal Register.

The case at hand is similar to the issue faced in *In re Gould Paper Corp.*, 5 USPQ2d 1110 (CA FC 1987). In *Gould* the Trademark Trial and Appeal Board's decision to uphold the refusal of "SCREENWIPE" for television and computer screen cleaning wipes on the basis of descriptiveness was upheld. The court in *Gould* stated that it agreed with the Board's conclusion that because Gould's wipes are used on television and computer screens, and the combination of "SCREEN" and "WIPE" does not render Gould's mark unique or incongruous, the common descriptive aspect of applicant's mark is not lost in the combined form (*Id.* at 1112). Based on the above, the mark can not be registered on the Principal Register.

#### Other Considerations

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If applicant chooses to respond to the refusal to register, the following issue must also be addressed.

#### The Recitation of Services is Indefinite

The wording used as the recitation of services is unacceptable as indefinite. It is unclear from the current wording exactly what services are used in conjunction with the mark. The applicant may amend this wording to, if accurate:

**Providing of health care information, providing health care information by telephone, telemedicine, psychological counseling, nutrition counseling, and medical counseling and managed health care services in Class 44.** TMEP Section 1402.01 and 1402.03(a).

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification. If the applicant fails to respond to this issue the application may proceed with the wording in non-italicized print only.

#### Trademark Office Relocation/Change In USPTO Trademark Contact Information

USPTO Trademark Operations will be moving to the new Alexandria, Virginia campus in October and November 2004. During that time, you are strongly encouraged to communicate with the USPTO through the Trademark Electronic Application System (TEAS) which can be found at [www.uspto.gov](http://www.uspto.gov).

Effective October 4, 2004, all Trademark-related paper mail must be sent to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

The undersigned examining attorney's Law Office will move on November 2, 2004. To reach the undersigned examining attorney by phone after that date call (571) 272-9353.

To submit a **fax** response to this Office action after that date, send your response to the Law Office fax number, namely (571) 273-9108.

If the applicant has any questions or needs assistance in responding to this office action, please telephone the assigned examining attorney.

/Jason F. Turner/  
Examining Attorney  
Law Office 108  
(571) 272-9353  
(571) 273-9108 (Fax)  
(703) 305-8747 (Steno)

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

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm> and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) CANNOT currently be filed via TEAS.

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.**

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"mind md" or "mind doctor"

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May 9, 2004 Sunday

**SECTION:** TRAVEL LEISURE; Pg. 8E

**LENGTH:** 934 words

**HEADLINE:** Author explores dark side of immense wealth

**BYLINE:** Jay MacDonald, Freelance OK

**BODY:**

...Novelists have largely abandoned working people, but I think that's generally the academic influence," he says. "I was talking to my **mind doctor** up in New York and at one point he asked me, 'What do you think it's like to treat people who have absolutely ...

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