

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86194044

MARK: DOUBLE DISC PUMPS

86194044

CORRESPONDENT ADDRESS:

MR. LESLIE BURRAGE
PENN VALLEY PUMP COMPANY, INC.
998 EASTON RD
WARRINGTON, PA 18976-1800

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Penn Valley Pump Company, Inc.

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

N/A

CORRESPONDENT E-MAIL ADDRESS:

lburrage@pennvalleypump.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE BELOW ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 6/8/2014

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the below issues. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

The Office of the Deputy Commissioner for Trademark Examination Policy accepted a Letter of Protest received in connection with this application. The evidence presented in the letter was forwarded to the trademark examining attorney for consideration. *See* TMEP §1715.

Based upon the evidence in the Letter of Protest and other evidence collected by the trademark examining attorney, the below specified action is issued. *See* TMEP §1715.02(b).

RESULTS OF THE SEARCH OF THE OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that

would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

SUMMARY OF ISSUES that applicant must address:

- Section 2(e)(1) Refusal – Merely Descriptive
- Information Requirement

SUMMARY OF ISSUE about which applicant is advised:

- Applicant's Applied-for Mark May Be Generic – Neither an Amendment to Claim Acquired Distinctiveness Under Section 2(f) Nor Amendment to Supplemental Register May Be Recommended

1. **SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE**

Registration is refused because the applied-for mark, **DOUBLE DISC PUMPS**, merely describes a feature, characteristic, purpose, function, and quality of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

Furthermore, the determination of whether a mark is merely descriptive is made in relation to an applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Here, applicant's applied-for mark is DOUBLE DISC PUMPS for use in connection with goods that applicant has identified as "Positive displacement pumps; Pump diaphragms; Sludge pumps." Per the attached dictionary definitions from *American Heritage Dictionary of the English Language*:

"Double," per the entry <https://education.yahoo.com/reference/dictionary/entry/double>, is shown to mean, in pertinent part, "composed of two like parts";

"Disc," at <https://education.yahoo.com/reference/dictionary/entry/disc>, is defined as a "variant of disk" which per the entry at <https://education.yahoo.com/reference/dictionary/entry/disk> shows that "disk" identifies "a thin, flat, circular object or plate"; and

"Pump," as shown by the attached from <https://education.yahoo.com/reference/dictionary/entry/pump>, means "a machine or device for raising, compressing, or transferring fluids."

Considered together, the definitions illustrate that "double disc pumps" are machines used to raise, compress or transfer fluids and the means to achieve this involves, at least in part, the incorporation of two parts which are thin, flat, circular plates. This understanding is further affirmed by the explanation of the nature of a "double disc pump" as found in U.S. Patent No. 6,315,532 issued on November 13, 2001 which is titled "Dual Disc Pump," invented by Derek Appleby and assigned to Alfa Laval Pumps Ltd. *Please see* the attached copy of U.S. Patent No. 6,315,532 from the USPTO database at <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&u=%2Fnetacgi%2FPTO%2Fsearch-adv.htm&r=0&p=1&f=S&l=50&Query=6315532%0D%0A&d=PTXT>. The "ABSTRACT" in the patent identifies a "dual disc pump in which the suction disc is phased to lag by more than 180° behind the pressure disc." This entry indicates that two "discs" are involved with the action of the "pump."

Material obtained from the Internet is generally accepted as competent evidence. *See In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Furthermore, later in the referenced patent, specifically under “Background of the Invention,” the following describes the basic principle behind the “double disc pump”:

Double disc pumps comprise a housing having a pumping chamber therein, an inlet and an outlet to the pumping chamber, first and second sets formed in said pumping chamber at spaced locations, a suction pumping disc reciprocable into and out of engagement with said first seat, a pressure pumping disc reciprocable into and out of engagement with said second seat and means to reciprocate said pumping disc out of phase with another.

In traditional double disc pumps the pump is essentially glandless and gives indefinite dry running ability, combined with goods self-priming and solids handling. These pumps are ideal for medium flow sludge transfer duties and are widely used on unmanned primary sewerage treatment works. A double disc pump eliminates the need for shaft sealing and valve problems inherent in other types of pumps. In addition to sludge transfer, these pumps can handle liquids, slurries, large suspended solids, thixotropic media and liquid/gas mixtures.

Additionally, applicant itself has a patent, namely, U.S. Patent No. 7,559,753 which was issued on July 14, 2009, is titled “Double Disc Pump with Fixed Housing Block,” the inventor is named as Leslie J. Burrage who is the signatory attesting to the facts contained in the application at issue, and was assigned to Penn Valley Pump Company, Inc., the applicant in the instant application. Please see the attached copy of the patent. Please see the attached copy of the patent from the USPTO database at <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&u=%2Fnetacgi/nph-adv.htm&r=1&p=1&f=G&l=50&d=PTXT&s1=6315532&OS=6315532&RS=6315532>. Applicant’s patent references the above mentioned U.S. Patent No. 6,315,532 as one of the documents to which it cites. Further, under “Background of the Invention,” applicant states that “[d]ouble disc pumps are well-known, particularly those suited for feeding and transferring sludges and slurries. This type of pump utilizes a unique principle of operation where the discs perform the duties of both diaphragm and valve providing a double action, non-clogging pump action.” Further within the same explanation, the statement is made that “[i]t will be understood from this prior art pump that in order to obtain access to both discs the entire pump assembly including drive shaft connecting rods and all housing segments must be completely disassembled.” Applicant’s patent is affirming that “double disc pumps” are a known commodity and that such a machine is inclusive of double discs which permit the effective operation of the pumps.

To further demonstrate that a “disc pump” is a particular and recognized term by consumers that are in the market for goods such as applicant’s, the attached website pages from *Water Environment Federation, the water quality people* at <http://wefbuyersguide.com/> and in particular http://wefbuyersguide.com/Listing/Company/Pumps_Valves/Filter_Press_Feed/161326 give a brief history of the “disc pump,” with a nod to the invention of same by Sargent in 1850, the updating of the technology behind the goods by Nikola Tesla in the early 1900s, and finally in the 1970s, U.S. inventor Max Gurth opened the spacing between the discs in the pump which led to an increase in the pump’s efficiency and commercial viability as it could then compete with other pumps on the market.

This same entity, namely, Water Environment Federation, per the attached from applicant’s website and specifically the press release regarding applicant’s receipt of a prestigious award from the Water Environment Foundation which was issued on September 2, 2008, awarded applicant with “The Innovative Technology Award” in recognition of applicant’s “double disc pump technology,” which “although the theory of this pump design is not new,” applicant’s design is “more efficient, easier to work on, and capable of handling a much larger volume of solids as a lower RPM.” Please see the attached from applicant’s website from the “Literature” section at http://www.pennvalleypump.com/PDF/Innovative_Technology_Award_Solids_Handling_Disposal3.pdf.

Moreover, as illustrated by the following Internet evidence consisting of screenshots from pump manufacturers websites referencing the availability of “double disc pumps” that are not from applicant, “double disc pumps” are known items and the use of the wording “double disc pumps” immediately identifies and signifies to the consumer what the goods are. Please see the attached evidence from:

Wastecorp. Pumps, as seen at <http://www.wastecorp.com/>, offers a variety of pumps among which are “disc pumps.” While stating that it is not the originator of “disc pumps,” *Wastecorp.* has the “Sludge Pro disc pump” which is available in eight different configurations which include “double disc pumps.” *Wastecorp.* also proffers a chart to compare the positive aspects of its “double disc pumps” to the features of “Traditional Double Disc Pumps.”; and

Channel Pumps, as per the attached from <http://www.channelpumps.com/>, has multiple pumps inclusive of environmental pumps that are disc pumps available in a “double disc” model.

These pages, in supplement to the entry from *Discflo Disc Pumps*, as shown by the attached screenshots from *Discflo* website at <http://www.discflo.com/index.php>, provide insight to the consumer awareness of “disc pumps” in general as the pumps offered are “disc pumps.” Per the attached from the USPTO database at <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi/nph-bool.html&r=1&f=G&l=50&co1=AND&d=PTXT&s1=discflo.ASNM.&OS=AN/discflo&RS=AN/discflo>, *Discflo* has a patent on a “rotary disc pump,” specifically U.S. Patent No. 7,097,416.

The same holds true with respect to *Mouvex* as the series of “Eccentric Disc Pumps” demonstrates on the attached pages from <http://www.psgdover.com/en/mouvex/home> and the brochure regarding the products at http://www.psgdover.com/assets/mouvex/Products_edmtASeries/leaflets/SerieAAnglais.pdf illustrate that “disc pumps” are a relevant commodity within the pump industry, especially as to industry use.

Also, the attached article from “Upstream Pumping Solutions,” The Flexibility of Disc Pumps, posted on August 2, 2011 by Leah Thompson, an explanation as to how “disc pumps” work is provided while offering the “disc pump” as the solution to pumping the many hard and abrasive challenges faced by the gas and oil industries. Please see the attached from <http://upstreampumping.com/article/production/flexibility-disc-pumps>.

To demonstrate that continued interest in the evolution of “disc pumps” is still relevant, the attached copy of the pending patent application from Charles David Gilliam entitled “Disc Pump,” assigned U.S. Application No. 20120014779, was filed on July 16, 2010 and published on January 19, 2012. The application is for a pump that incorporated discs into the design and is intended to improve upon previous designs by providing “improved pump performance without reducing the long-wear and high reliability” of attributes of described pumps and “may be of value in many industrial settings.” Please refer to the attached from <http://appft.uspto.gov/netacgi/nph-Parser?Sect1=PTO1&Sect2=HITOFF&d=PG01&p=1&u=%2Fnethtml%2FPTO%2Fsrchnum.html&r=1&f=G&l=50&s1=%2220120014779%22>.

Applicant should also be aware that, generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, as has been demonstrated by the above dictionary definitions, definitions from the referenced patents and supplemental evidence, both the individual components and the composite result are descriptive of applicant’s goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, applicant’s applied-for mark is DOUBLE DISC PUMPS. Applicant’s mark has thus combined DOUBLE, meaning “two,” with the DISC which is a “circular object or plate” which is further combined with PUMPS which are the machines used for “raising, compressing, or transferring fluids.” These terms succinctly and immediately describe and inform the consumer as to the exact nature of applicant’s goods in that the goods are pumps which rely upon double discs to perform the action for which they were purchased. This understanding is confirmed by the attached from a brochure on applicant’s website at <http://www.pennvalleypump.com>, in particular at <http://www.pennvalleypump.com/PDF/PV8001BROCH-woflap.pdf>, titled “The Operating Principle Behind the Double Disc™ Pump” which indicates that the pump “utilizes a unique principle of operation where the discs perform the duties of both diaphragm and valve, providing a double acting, non clogging, pumping action.” The picture depicting the action described by the accompanying text on Page 2 of the referenced brochure shows two (2) discs within the pump as being the referenced “discs,” specifically they are identified as the “suction disc” and the “discharge disc.” Additionally, on Page 3 of the brochure, a more detailed view of the entire pump is shown with the parts being purposefully labeled with the accompanying number, if applicable. “Reinforced Universal Disc (2)” is found among the parts. Taken together, all elements lead to finding applicant’s applied-for mark to be highly descriptive of the identified goods offered in connection with the mark.

Applicant’s goods are for a specific consumer and those consumers as applicant’s own website has identified are in the “municipal, industrial, chemical and food processing industries.” Please see the earlier identified website page from applicant at <http://www.pennvalleypump.com>. These are the very fields of interest in which the referenced “double disc pump” and “disc pump” suppliers also find themselves. Thus, the goods, with the applied-for mark on them, will immediately describe and identify to consumers the pertinent aspects of the goods.

Material obtained from applicant’s website is acceptable as competent evidence. *See In re N.V. Organon*, 79 USPQ2d 1639, 1642-43 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1302-03 (TTAB 2006); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1898 (TTAB 2001); TBMP §1208.03; TMEP §710.01(b).

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*,

58 USPQ2d 1523, 1527 (TTAB 2001).

Thus, in the instant case, applicant's applied-for mark, DOUBLE DISC PUMPS, is the combination of words which describe the features and qualities of applicant's goods a manner that succinctly and immediately informs the consumer that the identified goods of applicant are machines with two similar, if not identical, round objects which are used for raising, compressing or transferring fluids. As a result, the combined wording in applicant's applied for mark merely describes a feature, characteristic, purpose, function, and quality of applicant's identified goods.

Accordingly, applicant's applied-for mark, **DOUBLE DISC PUMPS**, is refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act as being merely descriptive of applicant's goods.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

ADVISORY: APPLIED-FOR MARK MAY BE GENERIC

In addition to being merely descriptive, the applied-for mark appears to be generic in connection with the identified goods and, therefore, incapable of functioning as a source-identifier for applicant's goods. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991); see TMEP §§1209.01(c) *et seq.*, 1209.02(a). Under these circumstances, neither an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register can be recommended. See TMEP §1209.01(c).

If applicant responds to the above refusals, applicant must also respond to the requirements set forth below:

2. INFORMATION REQUIRED

In order for the trademark examining attorney to properly assess the nature of the wording in applicant's applied-for mark, **DOUBLE DISC PUMPS**, or the wording "disc pump," applicant must provide the following information regarding the goods and wording appearing in the mark:

(1) Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of applicant's website as it relates to the goods. Merely stating that information about the goods is available on applicant's website is insufficient to make the information of record.

If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product or services will differ. If the goods feature new technology and information regarding competing goods is not available, applicant must provide a detailed factual description of the goods.

Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade.

Conclusory statements will not satisfy this requirement.; and

(2) Applicant must respond to the following questions and requests:

- Is the "double disc" or "double disc pump" technology patented apart from U.S. Patent No. 7,559,753?
- If so, is the patent owned by applicant?
- Applicant must provide a copy of the patent, if additional technology is patented by applicant.
- Applicant must explain how a "double disc pump" operates.
- Applicant must explain how a "disc pump" operates.
- Applicant must explain the differences in operation between "double disc" and "disc" pumps.
- Is applicant aware of the same or similar technology used by applicant's "double disc pump" being used by competitors and if so, how do competitors refer to the technology?

See 37 C.F.R. §2.61(b); *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004); TMEP §§814, 1402.01(e).

Failure to comply with a request for information can be grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d at 1651; *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814.

RESPONSE GUIDELINES

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office Action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office Action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office Action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

TEAS PLUS APPLICANTS – TO MAINTAIN REDUCED FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE

Applicants who filed their application online using the lower-fee TEAS Plus application form must (1) continue to submit certain documents online using TEAS, including responses to Office Actions (see TMEP §819.02(b) for a complete list of these documents); (2) accept correspondence from the USPTO via e-mail throughout the examination process; and (3) maintain a valid e-mail address. *See* 37 C.F.R. §2.23(a)(1), (a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these three requirements must submit an additional fee of \$50 per international class of goods. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. However, in certain situations, authorizing an examiner's amendment by telephone will not incur this additional fee.

APPLICANT MAY WISH TO HIRE TRADEMARK COUNSEL

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a private attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office Action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06.

For attorney referral information, applicant may consult the American Bar Association's Consumers' Guide to Legal Help at <http://www.abanet.org/legal/services/findlegalhelp/home.cfm>, an attorney referral service of a state or local bar association, or a local telephone directory. The USPTO may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

Further action on the subject application awaits applicant's response to above detailed issues.

Sincerely,

/Kathleen L. Kolacz/
Kathleen L. Kolacz
Trademark Examining Attorney
Law Office 117
phone: (571) 272-3650
email: kathleen.kolacz@uspto.gov