

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
10 December 2009
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Metalwerks PMD, Inc.

Serial No. 77362611

Lynn J. Alstadt of Buchanan Ingersoll & Rooney PC for
Metalwerks PMD, Inc.

Eugenia K. Martin, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Drost, Zervas, and Kuhlke, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 2, 2008, applicant Metalwerks PMD, Inc.
filed an intent-to-use application to register the mark
STENTALLOY (in standard character form) on the Principal
Register for wrought and unwrought metal alloys in sheet,
bar, coil, wire, strip and plate form having mechanical
properties, purity and corrosion resistance suitable for
use in medical devices in Class 6. Serial No. 77362611.

The examining attorney has refused to register applicant's mark on the ground that it is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act. 15 U.S.C. § 1052(e)(1). The examining attorney's argument is that the "word 'alloy' describes the specific goods themselves, as identified by the Applicant - metal alloys... [T]he word 'stent' is descriptive because it identifies the purpose of the alloys, namely, for use in medical devices, a class of goods which includes stents." Brief at unnumbered pp. 3-4. "The goods are alloys for use in stents." Brief at 5.

Applicant maintains that the examining attorney has "redefined the goods as 'alloys suitable for use in stents'... The goods recited in the present application are alloys having specific properties, not stents, or stents made from an alloy, or alloys formed into stents. The word 'stent' does not describe these properties." Brief at 2.

After the examining attorney made the refusal final, applicant appealed to this board.

For a mark to be merely descriptive, it must immediately convey "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). See also *In re MBNA America Bank*

N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) ("A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service"); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). To be merely descriptive, a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. Int'l Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). While we must consider the mark in its entirety, it "is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in its entirety." *In re Hester Industries, Inc.*, 230 USPQ 797, 798 n.5 (TTAB 1986).

The examining attorney has submitted a definition of stent as "*Medicine/Medical*. A small, expandable tube used for inserting in a blocked vessel or other part." www.dictionary.com. A stent is a type of medical device. Applicant has also identified its goods as "metal alloys." An alloy is "a substance composed of two or more metals, or a metal or metals with a nonmetal, intimately mixed, as by fusion or electro-deposition." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. *University of*

Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Applicant argues that the term stent "does not describe a wrought or unwrought alloy because a stent could be molded or extruded plastic." Brief at 3. The evidence (emphasis added) does show that medical stents can be made of plastic or metals and that metal stents are often, if not normally, made from metal alloys.

Nitinol¹ alloy stents are in frequent use in recanalizing malignant airway stenoses.
www3.interscience.wiley.com/journal

Coronary Stenting with Magnesium-Alloy Absorbable Metal Stent...
The alloy stent is made of 93% magnesium and 7% rare-earth metals.
www.medscape.com

Presenting data on a new bioabsorbable magnesium-alloy stent, investigators showed that the bare-metal stents met its primary end point...
www.theheart.org

Cobalt-chromium-molybdenum alloy stent and stent-graft...
Other materials used for self-expanding stent filaments are 316 stainless steel and MP35N alloy...
Pat. No. 4,800,882 relates to a stent assembled from a drawn stainless steel wire. Other known stents are fabricated from drawn, extruded, or rolled nickel-titanium alloy ribbon.
www.freepatentonline.com

¹ Nickel-titanium alloy. <http://jtcs.ctsnetjournals.org>.

The authors developed ABI alloy, which mechanically resembles stainless steel 316. The main elements of ABI alloy are palladium and silver...
In the third examination, the *ABI alloy stent* model was compared with the nitinol stent...
The struts of the *ABI alloy stent* model are visible as black dots.
<http://radiology.rsnaajnl.org>.

Dr. Levy's team created a unique-water-soluble compound polyallylamine biphosphonate, that binds to the *stent's metal alloy* surface in a layer with the thickness of only one molecule.
<http://stokes.chop.edu>.

The *titanium alloy intratracheal stent* adequately fulfilled the requirements of a temporary intraluminal airway splint...
<http://jtcs.ctsnetjournals.org>

The Absorbable *Magnesium-Alloy Stent*
www.circ.ahajournals.org

Evaluation of new plastic stents for malignant biliary obstruction...
www3.interscience.wiley.com/journal

Prospective evaluation of a new, self expanding *plastic stent* for inoperable esophageal strictures...
It would be ideal if optimal dysphagia relief were achieved that combined the advantages of the plastic and metallic stents... We report our experience with this new self-expanding *plastic stent*, the cost of which is half that of *metal stents*.
<http://resources.metapress.com>

Plastic stents for heart patients
Researchers ... in Japan have developed biodegradable *plastic stents*... The development was led by Hideo Tamai, who was searching for an alternative to the *metallic stents* currently used.
www.designnews.com

The evidence shows that stents are made of metal alloys and that there is nothing unusual about the use of

the term "alloy stent" to describe a stent made with a metal alloy. While applicant's goods are not stents themselves, they are metal alloys in sheet, bar, coil, strip and plate form that are suitable for medical devices. Applicant identifies its goods as metal alloys having the "mechanical properties, purity and corrosion resistance suitable for use in medical devices." Thus, applicant's term describes alloys that can be used to make a particular type of stents, i.e., stents made from metal alloys. *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1380 (TTAB 2006) (The term biological preparations for use in the manufacture of biopharmaceutical and biotechnology products "can encompass preparations that are used to make armed antibodies, and therefore it directly conveys information about a significant feature of the preparations... Thus, ARMED ANTIBODIES directly describes a characteristic of these goods").

We add that we have considered not only the meaning of the individual terms but the mark as a whole because the combined terms may have a non-descriptive meaning. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products inasmuch as it is suggestive of a nursery rhyme). Furthermore, we must determine whether a mark is merely

descriptive by considering the mark in relation to the particular goods for which registration is sought and not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"). It is clear that in the context of metal alloys for use in medical devices, the purchasers of metal alloys would understand that the term STENTALLOY is merely descriptive of these alloys that could be used to manufacture metal stents.

Applicant also argues that "there is no evidence of any use of 'stentalloy' or 'stent alloy.'" Brief at 4. We point out that there are many uses of record of the term "alloy stent." The reverse of the order in this case is not significant because the terms "alloy stent" or "stent alloy" for metal alloys that can be used to make stents would have the same meaning. Also, the absence of a space between the words is not significant. *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) ("We find, first, that the compression of the words URBAN HOUSING into a single term, URBANHOUSING, still conveys the commercial impression of two words. In other words, consumers would recognize the

mark as consisting of the separate elements URBAN and HOUZING"); *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) ("THEATL is simply a compressed version of the descriptive term THE ATL without a space between the two words. Without the space, THEATL is equivalent in sound, meaning and impression to THE ATL and is equally descriptive of applicant's goods").

Even if applicant is the only user of the term, that fact does not mean that its mark is suggestive rather than merely descriptive. *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) ("The fact that AGENTBEANS does not appear in a dictionary is not determinative. Likewise, the fact that applicant may be the first and/or only entity using the phrase AGENTBEANS is not dispositive where, as here, the term unequivocally projects a merely descriptive connotation") (citation omitted); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985) ("A descriptive term used first or even only by an applicant is not registrable as long as the relevant purchasing public perceives of the term as describing the good"); and *In re Gould*, 173 USPQ 243, 245 (TTAB 1972) ("The fact that applicant may be the first and possibly the only one to utilize this notation in connection with its services cannot alone alter the basic

descriptive significance of the term and bestow trademark rights therein").

Here, when the term STENTALLOY is used in the context of metal alloys used to make medical devices, it will immediately describe a feature or purpose of applicant's goods, i.e., that they have the "mechanical properties, purity and corrosion resistance suitable for use in medical devices" such as stents. *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999) ("If applicant produced goods related to the medical field, or specifically related to physicians, then the term 'DOC' would be readily understood by the public as referring to 'doctor.' However, here applicant's goods are computer software for document management, and 'DOC' will be readily understood as referring to documents").

Decision: The examining attorney's refusal to register applicant's mark STENTALLOY under Section 2(e)(1) of the Trademark Act is affirmed.