

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dune Medical Devices Ltd.

Serial No. 77377330

Gary D. Krugman, Jody H. Drake and Shahrzad Poormosleh of
Sughrue Mion, PLLC for Dune Medical Devices Ltd.

J. Brendan Regan, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Bucher, Cataldo and Wolfson, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Dune Medical Devices Ltd. seeks registration on the
Principal Register of the mark **MARGINPROBE** (*in standard
character format*) for a "medical device, namely, a tissue
characterization device for use in surgical procedures" in
International Class 10.¹

The Trademark Examining Attorney refused registration on
the ground that the term is merely descriptive under Section
2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

¹ Application Serial No. 77377330 was filed on January 22, 2008
based upon applicant's allegation of priority under Section 44(d) of
the Act based upon Israeli application No. 202736 filed on July 29,
2007.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board.

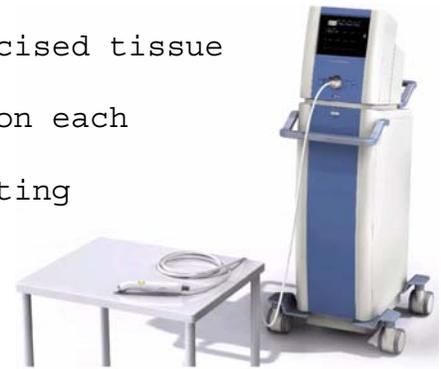
We reverse the refusal to register.

Applicant argues that even if the individual words "margin" and "probe," used in the context of the named goods, may convey snippets of information, when the two are combined into a composite term, the resulting designation is at worst, suggestive. Applicant lists nine third-party registrations where individual Trademark Examining Attorneys of the U.S. Patent and Trademark Office in the past have evidently deemed "-probe" formative marks (e.g., ones that are structured much like applicant's mark) to be inherently distinctive. Applicant also points out that the involved mark was registered in Israel, Korea, Japan and in the European Union. Finally, applicant reminds us that any doubt on the issue of descriptiveness should be resolved in favor of applicant, with the mark being published for opposition so that any third party who believes it may be damaged by the registration of applicant's mark can file an opposition.

Applicant's tissue characterization device

As described and pictured in this record, the involved device is a system having several components. According to the record, with this device (pictured herein), during the removal

of cancerous cell tissue like a breast lumpectomy, the surgeon can apply the head of the probe to the excised tissue in order to run a series of measurements on each resection surface of the specimen, collecting electromagnetic signature data on the exposed surfaces of tissue. Applicant's proprietary system characterizes that signature and compares the responses to an internal database of known signatures in healthy and cancerous tissues. With an indication of cancerous cells at the "margin" edges of the excised tissue, the surgeon can move immediately to excise additional tissue. According to applicant's literature, this intraoperative assessment allows the surgeon to balance the imperative towards aggressive treatment with the desire to conserve tissue. This device helps to detect "clean margins" - no cancer cells at multiple sites along the surface of the removed tissue - during the surgical procedure. Without such technology, if later a pathologist discovers histologically that cancer is present at the border of the specimen (a "positive margin"), patients will generally require reoperation, with the attendant costs, emotional distress and possible scarring.²



² The Trademark Examining Attorney provided informative excerpts for the record about applicant's system from www.cbronline.com, www.allbusiness.com and www.dotmed.com with the Office action of September 22, 2009. In its responses to Office actions, applicant also provided additional clarifying information for the Trademark Examining Attorney.

“Merely descriptive” under Section 2(e)(1) of the Act

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. See *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of “credit card services.” The Court found that a “mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service.”]. Hence, the ultimate question before us is whether the term MARGINPROBE conveys information about a significant feature, function or characteristic of applicant’s goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: “Whether a given mark is suggestive or merely descriptive

depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'"].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor*, 200 USPQ at 218 ["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"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE is merely descriptive of "real estate advertisement services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is



likely to have on the average purchaser encountering the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [the term "first tier" describes a class of banks]; *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) [COASTER-CARDS descriptive of a coaster suitable for direct mailing].



The word "Probe"

Without a doubt, one of the primary components of the MarginProbe system is a "probe." The actual tip of the probe (at right) is the required interface between the excised human tissue and the computerized heart of the system. The external console component houses applicant's proprietary software that captures the signal, compares it to the internal database and then characterizes the



specimen, reporting results on the high-resolution display. The display provides a red (cancerous) or blue (healthy) indicator for the surgeon. Without the probe, this system is inoperable. The record supports the conclusion that the term "probe" is used extensively as a noun in the treatment of breast cancer. Hence, the word "probe" alone, when used as a noun, is descriptive of a critical component of the involved system.

The word "Margin"

The word "margin" is also not an arbitrary designation in the context of this system. As stated by applicant, "the word 'margin' has th[is] meaning: the distance between the tumor and the resection surface, as defined by permanent pathology. A margin has a numeric value in [millimeters]."

Applicant clarifies that a pathologist can later take the excised tissue and provide a definite measurement of the distance of tumor cells from the outer layer of cells on the specimen. By contrast, in real time in the operating room, the MarginProbe system provides only a binary indicator (blue or red) on the condition of the tissue on the resection surface.

In fact, judging by the briefs in this case, it seems that applicant and the Trademark Examining Attorney agree on all the aforementioned, underlying facts of this case.³ In fact,

³ It seems there are two different way to discuss margins: either as a measurement or in the binary - that is, positive or negative.

applicant concedes that "the separate terms "Margin" and "Probe" may have individual meanings" in the context of these goods. Where they disagree is the legal characterization of applicant's adopted source-indicator when these two arguably descriptive terms are combined. The sole issue before us then, is whether the composite mark also has a merely descriptive significance.

MarginProbe

The Trademark Examining Attorney argues that with this new combination of terms, each component retains its merely descriptive significance in relation to the goods and so the combination results in a composite that is itself merely descriptive, citing to a series of precedential cases.⁴ The

Depending upon the type of tumor, medical personnel may use one or both ways of discussing it - but always the first question is positive or negative. We should note at this point that whether the display of the assessment device merely shows a picture of tissue on the resection surface in contrasting blue and red colors, or if the technology permitted a display of detailed measurements of any positive margin to the nearest nanometer, is neither a relevant nor a determinative factor in this decision.

⁴ *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006) [THE BREATHABLE MATTRESS merely descriptive of "beds, mattresses, box springs and pillows"]; *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun Microsystems Inc.*, 59 USPQ 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news and information services for the food processing industry]; *In re Copytele, Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays]; *In re Entenmann's, Inc.*, 15 USPQ2d 1750 (TTAB 1990) [OATNUT merely descriptive of bread containing oats and hazelnuts], *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991); and *In re Associated Theatre*

Trademark Examining Attorney initially determined that " ... applicant's device, insofar as it is a tumor detector, is by that very fact a margin detector – in the form of a probe; thus, a "*margin-detecting probe*."

In response, applicant argues that prospective purchasers would need to exercise mature thought or follow a multi-stage reasoning process in order to determine what product characteristics the term indicates, and hence that the term is suggestive rather than merely descriptive.

Applicant argues that: "The combination 'margin probe' has no meaning or usage in the industry (in the context of lumpectomy procedures) or in the medical devices industry. The term 'probe the margin' has no meaning and is never used in the industry in the context of lumpectomy procedures or in the medical devices industry."⁵ Indeed, there is no indication in the record that anyone else in the field of surgical lumpectomies or in the medical devices industry uses the combination "margin probe."

The initial queries of the Trademark Examining Attorney do highlight several possible connotations of the term "probe." In addition to the noun form discussed above, the word "probe" may also be used as a verb, meaning "to examine or explore with a

Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988) [GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services].

⁵ Applicant's response to Office Action, March 17, 2010, at 1.

probe.”⁶ Applicant indicates that its product does not “probe the margin” of cancerous cells, but is “pressed against [a] freshly excised ... specimen” in order to “detect the presence of tumor cell clusters on these surfaces.”⁷ If indeed “probe the margin” has no meaning, then relevant purchasers of applicant’s product would be unlikely to immediately recognize the word “probe” as a verb. This incongruity (i.e., that the device has a probe, which does not probe) imparts applicant’s mark with a non-descriptive, albeit highly suggestive, quality. See *In re Pennwalt Corporation*, 173 USPQ 317, 318 (TTAB 1972) [holding mark DRI-FOOT for an anti-perspirant deodorant for feet registrable, as DRI-FOOT “is obviously not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described”].

Whether the word “probe” is thought of as a noun or as a verb in this context, we find that it follows uneasily immediately behind the word “margin.” We agree with applicant that the fact that there appears to be no competitive need to use this term in describing similar goods is relevant to our determination herein. See *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983) [SNO-RAKE is not merely descriptive of a snow removal hand tool, the head of which has a solid uninterrupted construction

⁶ THE RANDOM HOUSE DICTIONARY, 2011, taken from www.dictionary.com.

⁷ Applicant’s response to Office Action, March 17, 2010, at 1.

without prongs]; and *In re Trek 2000 International, Ltd.*, 97 USPQ2d 1106, 1113 (TTAB 2010) [no competitors use THUMBDRIVE].

In response to the initial refusal, applicant clarified that applicant's " ... probe does not actually determine margins or obtain margins. Rather, the probe assesses whether or not a tissue is normal or abnormal for future potential measurement and excision via lumpectomy." With additional information, the Trademark Examining Attorney reasoned that inasmuch as the real time purpose of the *probe* in the operating room was "providing *margin* information," these two words when combined were still merely descriptive.

We find that applicant's device, as described herein, is a medical device designed to detect abnormal human tissue. A manufacturer or merchant of a competing device might need to use the terms "cancer detector" or "tumor probe" to describe its product. We concede that applicant's mark conveys some meaning concerning the product. While the composite term suggests the function and characteristics of applicant's medical device, we are also struck by the vagueness⁸ or incompleteness⁹ of the

⁸ As a judge of this Board said more than twenty-five years ago: "we agree with applicant that the term **SPEEDI BAKE** only *vaguely* suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread ... [I]t is our view that **SPEEDI BAKE** falls within the category of suggestive rather than descriptive marks and that no disclaimer of the term is necessary." (*emphasis* supplied)



In re George Weston Limited, 228 USPQ 57, 58 (TTAB 1985).

combined term. That is, knowing well the descriptive meanings of each of the words in the context of these goods, it has understandably proven challenging for the Trademark Examining Attorney to create congruity between the bare juxtaposition of these two words and the function or characteristics of the involved goods. Yes, the involved mark suggests cancer detection using a portable probe. Yes, it suggests an assessment device that provides information about the presence of malignant tissue. But we find that given the syntax of the combination of these two words, the term does not directly tell consumers a characteristic or function of the goods - that is, "it possesses redeeming features which raise doubt" about refusing its registration under the terms of Section 2(e)(1). *In re Pennwalt Corp.*, 173 USPQ at 318 [the term DRI-FOOT is highly suggestive of anti-perspirant deodorant for feet, but the

⁹ " ... [T]he *meaning is not so direct, revealing or informative of applicant's product as to be merely descriptive* thereof. The mark tells us that applicant's product comprises a blend of grape and some type of berry juice. But which berry, strawberry, boysenberry, raspberry, hip of the rose or perhaps cranberry? As applicant states "a term which leaves so much unsaid is scarcely merely descriptive." Further, as stated by the court in *Audio Fidelity, Inc. v. London Records, Inc.* [citation omitted]:

"The fact that a mark is suggestive and that persons in the trade are capable of analyzing a mark and recognizing that suggestion, does not render the mark descriptive."

RJR Foods, Inc. v. Queen Spray Cranberries, Inc., 174 USPQ 244, 245-46 (TTAB 1972) [**GRAPE-BERRY** for beverage consisting of concord grape juice, some type of berry juice, water, and other ingredients held not merely descriptive because the mark failed to indicate with particularity which type of berry juice was in the beverage] (*emphasis* supplied).

registration of DRI-FOOT could not preclude the use by competitors of the ordinary descriptive phrase "keeps feet dry"]. By analogy, competitors employing similar, advanced technologies in the future would be able to use "margin assessment probe" to describe similar products.

Hence, it is our view that the term MARGINPROBE is suggestive of applicant's medical device system. The combination of "Margin" and "Probe" to form the mark "MarginProbe" suggests some sort of device with a probe, and anyone trained in the field of oncology might well suspect it has some relationship to the specialized use of the word "margin" as a medical term of art. Yet, applicant appears to have coined a somewhat nebulous term whose meaning would not be grasped without some cogitation. That is, when viewed in connection with applicant's goods, we find that MARGINPROBE does not immediately evoke a descriptive function or characteristic of the product. Probes are an integral part of many medical devices and also function as part of composite marks therefore. Applicant confirms that the term "margin" has never been inherently associated with tissue characterization devices. The only evidence made of record by the Trademark Examining Attorney consists of dictionary definitions and information regarding applicant and its product. The Trademark Examining Attorney has not made of record any evidence that "margin probe" is used by anyone in the industry, or that the term itself has a meaning beyond that applied as a mark to applicant's goods.

We should add that we do not find persuasive applicant's argument that the involved mark has been registered in Israel, Korea, Japan and the European Union. As one can readily observe from a review of the nuanced nature of the disagreements that fill this record, the most able of English-speaking counselors are challenged to defend the placement of the involved mark on one side or the other of a most contentious but still subjective line in U.S. trademark law.

We acknowledge that "positive margin detector," "cancer detector," "tumor probe" or even "margin assessment probe" would be merely descriptive of applicant's goods, but that does not make MARGINPROBE merely descriptive. *In re Shop-Vac Corp.*, 219 USPQ 470, 471-472 (TTAB 1983) [WET/DRY BROOM suggestive for domestic electric vacuum cleaners]. Under Section 2(e)(1) of the Act, difficult fact patterns, such as this mark, involve shades of gray but our determinations are necessarily reduced to a binary decision. Hence, we recognize that the suggestive/descriptive dichotomy requires the drawing of fine lines based upon a good measure of subjective judgment where reasonable persons may indeed differ. *See In re Shutts*, 217 USPQ at 365.

In view of the foregoing, we find that applicant's mark MARGINPROBE is suggestive, not merely descriptive, if used in connection with this medical device. At the very least, we have doubts about the "merely descriptive" character of MARGINPROBE,

and in determining whether a mark is merely descriptive, such doubts are to be resolved in favor of applicant. *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In such a case, it is the practice of this Board to pass the application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, merely descriptive, and that such a mark on the Principal Register will hinder competition in this field, may oppose and present evidence on this issue to the Board in the context of an *inter partes* case.

Decision: The refusal to register under Section 2(e)(1) of the Lanham Act is hereby reversed.