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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dorr Arthritis Institute Medical Associates, Inc.

Serial No. 77803520

Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for Dorr Arthritis Institute Medical Associates, Inc.

Kaelie E. Kung, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).¹

Before Bucher, Zervas and Shaw, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Dorr Arthritis Institute Medical Associates, Inc. has
appealed from the final refusal of the examining attorney
to register on the Principal Register the term
ORTHOROBOTICS (in standard character form) as a trademark
for "medical surgery" in International Class 44.²

¹ Another examining attorney was assigned to this application prior to the appeal.

² Application Serial No. 77803520 was filed on August 13, 2009, based on applicant's assertion of its bona fide intention to use the mark in commerce.

The examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used on applicant's goods, the mark ORTHOROBOTICS would be merely descriptive of such goods.

After the examining attorney issued the final action, applicant filed an appeal and a request for reconsideration. The examining attorney denied the request for reconsideration, and subsequently both applicant and the examining attorney filed briefs. We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB

1973). "It is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork" See *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

According to the examining attorney, the term ORTHOROBOTICS is a combination of the abbreviation "ortho" for "orthopedic" and the word "robotics"; that both have significance in connection with applicant's services; that ORTHOROBOTICS "merely describes a characteristic or feature of applicant's service, namely, that applicant's orthopedic surgical services are performed through the use of robotic machinery or with the assistance of robotic devices," brief at unnumbered p. 2; and that the combination of "ortho" and "robotics" does not create a unique, incongruous or non-descriptive meaning in relation to the services, citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 1567 USPQ 382 (CCPA 1968) (composite term registrable as a unitary mark if it has a separate, non-descriptive meaning).

The examining attorney cites the following evidence as support for her refusal:

- entries for "ortho" from (i) www.acronymfinder.com, (ii) wikipedia.com, (iii) Jablonski, S., *Dictionary of Medical Acronyms & Abbreviations* (4th ed. 2001), and (iv) *Jablonski's Dictionary of Medical Acronyms &*

Abbreviations (2009 ed.) (accessed at credoreference.com), each showing "ortho" to be an abbreviation for "orthopedics";

- references to "ortho" as meaning "orthopedics" in the context of orthopedic surgical services. See webpages from St. Joseph Mercy Health System ("Ortho/Neuro Rehab"), Broward Health ("View the Ortho Physicians Directory"), the Champlain Valley Area Health Education Center ("An ortho tech could work in a hospital, a clinic") and Northwestern University Feinberg School of Medicine (with links to "Ortho Teaching Home");

- definitions of "robotics," including the definition in encarta.com as "the science and technology relating to computer-controlled mechanical devices such as the automated tools commonly found on automobile assembly lines";

- references to "robotics" in the context of orthopedic surgery, juxtaposed with "orthopedic," including the following:

- Advertising positions in "orthopedic robotics" from job-search-engine.com (juju);
- A "management bio" of the president of Curexo Technology Corporation identifying him as "[w]idely recognized ... a pioneer in the field of orthopedic robotics" (from "robodoc.com");

- A webpage from AubreyGroup listing "Orthopedic robotics" as an area in which its staff has experience (from aubreygroup.com); and
 - A webpage from Precision Orthopedics, "a dedicated group of world-class orthopedic surgeons," stating that "[t]hey use the most advanced computerized orthopedic robotics currently available in the world."
- various uses of "orthopedics" in the same article as "robotics":
 - A report entitled "Why Robotics Surgery has not been successful in Orthopedics" (from bharatbook.com);
 - A webpage from "USA Society for Computer Assisted Orthopaedic Surgery"; and
 - An article entitled "Computer-Assisted Orthopedic Surgery: Will OrthoPilot Replace Intraoperative CT?"
 - webpages from applicant's own website, including one that lists "Robotic Surgery" directly below the heading "[o]ur orthopaedic services."

Applicant makes several arguments in favor of registration. First, applicant argues that the examining attorney impermissibly dissected the mark into two components. We disagree. Her consideration of each component of the mark is "part and parcel of routine examination of a multiword mark. The examining attorney's refusal is based on the mark as a composite, not only on a theory that each of the terms would be subject to refusal

if used separately." *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1051 (TTAB 2006).

Second, applicant argues that the examining attorney inappropriately dismissed "many" other meanings of "ortho." According to applicant, "ortho" is a prefix with multiple meanings, pointing to the wikipedia.com entry for "ortho" which states "ortho" "may refer to" several terms in a variety of fields, such as medicine and theology. Those terms which are not in the medical field but involve pesticides, aerial photography and electronics, are clearly irrelevant to the issue *sub judice*. The references to "ortho" in the medical field, aside from "Orthopedic, the study of the musculoskeletal system," are also irrelevant because they have nothing to do with "medical surgery." See, for example, "ortho-DOT" a psychedelic drug and "Ortho-cept," an oral contraceptive drugs.³ In contrast, the uses of "ortho" on the webpages submitted by the examining attorney in the context of surgery, and particularly orthopedic surgery, demonstrate a clear and immediate association of "ortho" with "orthopedic," and in

³ The argument applicant makes that consumers would associate "ortho" with "orthodontics" until such consumers investigated applicant's services in greater detail is particularly untenable - the mark must be considered in the context of the services, and there is no reason apparent to us that consumers in need of medical surgery, would consider "orthorobotics" to refer to

the same way that "orthopedic" is used on applicant's webpage in connection with its medical surgery services.⁴ Hence, we are not persuaded by applicant's arguments regarding the abbreviation "ortho" for "orthopedic."

Applicant also submitted approximately a dozen registrations for ORTHO-formative marks for goods and services related to orthopedics to show that "the Office has consistently found that 'ortho' is at least suggestive." Brief at 8. None of the registrations includes a disclaimer of the "ortho" component of the marks. However, most of the marks are one-word marks, which the reviewing examining attorneys may have viewed as unitary and not requiring a disclaimer of the "ortho" component. See TMEP § 1213.05(a) (8th ed.). One registration has been cancelled; another - ORTHO ENTERPRISES - is registered on the Supplemental Register and hence supports the examining attorney's position. On balance, only two registrations support applicant's argument, namely, the registrations for ORTHO GRIP for "hand manipulated orthopedic surgical devices" and ORTHO

robotics in the context of orthodontics, rather than robotics in the context of orthopedic surgery.

⁴ At p. 3 of its reply brief, applicant maintains that the review of several different web pages on its website is required to understand "ortho" or "robotics." Applicant ignores that "ortho" is a recognized abbreviation for "orthopedics," see *supra*, and "robotics" is a defined term, see *infra*.

XPRESS for services including "... providing post-operative rehabilitation services to patients and medical practitioners; providing information to medical practitioners in the field of prescribing orthopedic products to patients; [and] rental of orthopedic products." Two registrations hardly establish a "pattern and practice of the Office." Also, third-party registrations are not conclusive on the question of descriptiveness; each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re theDot Communications Network LLC*, 101 USPQ2d 1062 (TTAB 2011).

Third, regarding the term "robotics," applicant argues that "robotics" is inherently vague; and that "'robotics' is not a specific reference to any type of service, but generally refers to 'the use of computer-controlled robots to perform manual tasks.'" Brief at 7. Applicant relies on a dictionary.com definition of "robotics" in the record, namely, "the use of computer-controlled robots to perform manual tasks"; and points out that the mark must describe applicant's services with particularity in order to be descriptive. We are not persuaded by this argument in view

of the more specific definitions of "robotics" that the examining attorney included in the record and in view of the unambiguous uses of "robotics" in the context of orthopedic surgery in the webpages of record, including on applicant's website.

Fourth, applicant argues that the examining attorney failed to identify any meaning for ORTHOROBOTICS as a whole. The fact that the examining attorney did not produce evidence showing use of ORTHOROBOTICS does not mean that the term is not descriptive. See *In re American Society of Clinical Pathologists, Inc.*, 442 F.2d 1404, 169 USPQ 800 (CCPA 1973). The meaning is apparent from the combination of "ortho" and "robotics."

The record reflects that "ortho" is an accepted and well-used abbreviation for "orthopedic" in the context of medical surgery; and that "robotics" is well used in the context of medical surgery, and, in fact, orthopedic surgery. The combination of "ortho" and "robotics" does not create a unique, incongruous or non-descriptive meaning in relation to the services. We therefore find that purchasers of medical surgery services would immediately perceive the combination as referring to the use of robotic devices in the context of orthopedic surgery.

Finally, applicant urges us to resolve any doubt on the issue of mere descriptiveness in its favor. We do not have any doubts on this issue.

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.