

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masimo Corporation

Serial No. 77869629

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Before Seeherman, Cataldo and Shaw, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Masimo Corporation, a U.S. corporation, has applied to
register RAINBOW RESPOSABLE, in standard characters, as a
trademark for "medical devices, namely, patient sensors for
monitoring and measuring vital signs or blood properties."¹
The examining attorney has made final a requirement that

¹ Application Serial No. 77869629, filed November 10, 2009,
based on Section 1(b) of the Trademark Act (intent-to-use).

applicant disclaim the term RESPOSABLE on the basis that it is merely descriptive of applicant's goods, and applicant has appealed. The appeal has been fully briefed.

We begin with an objection raised by applicant in its reply brief. Applicant claims that the examining attorney submitted excerpts from articles with his brief, and that because these article excerpts were not of record prior to applicant's filing its notice of appeal, they are untimely and should not be considered. It appears that the objection may be due to a misunderstanding, in that the examining attorney stated in his brief, in listing the excerpts, that they were submitted with the Office action of September 13, 2010. Because the quoted excerpts were different from those that were part of the September 13, 2010 Office action, applicant believed that they were never made of record. However, the examining attorney merely misidentified the Office action by which the excerpts were made of record; they were submitted as part of the Office action of June 21, 2011. Accordingly, because the article excerpts reported in the examining attorney's brief were properly made of record, they have been considered.²

² To the extent that applicant takes issue with the fact that the articles were made of record by the Office action mailed June 21, 2011, which was after the filing of the notice of appeal on March 14, 2011, we point out that the application had been remanded to the examining attorney after the filing of the

Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), provides that the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1), prohibits the registration of a mark which is merely descriptive of the applicant's goods.

In support of his position that RESPOSABLE is merely descriptive of applicant's identified patient sensors, the examining attorney has submitted evidence from the Internet and the Nexis database, including the following:

Griff Industries Inc.
Medical Industry: Disposable Medical Products,
Resposable Medical Products
Griff Industries, Inc. now offers a line of
disposable medical products and resposable
medical products (limited reuse) for use in and
around the operating room.
www.ids-healthcare.com

Resposable Trocars
Description + Specs
Ethicon Endo-Surgery, Inc. offers three types of
resposable trocar systems
...
Resposable Accessories are designed to be used
solely with the resposable trocar systems ...
The housing is designed to be used solely with
the resposable trocar system.
[includes heading "Resposable Trocar Systems"
with list of products, and heading "Resposable
Accessories" with list of products]
www.ethiconendosurgery.com

appeal, at applicant's request, and therefore the examining attorney had jurisdiction over the application and could make additional evidence of record.

Exergen Resposable Reusable Disposable
Thermometer Probe Covers-1000 Ea

...

Exergen Thermometer Resposable Caps fits all
Temporal Scanner thermometers TAT-5000 series.
<http://shopping.yahoo.com>

Applied Medical banking on resposable product's
low cost to drive sales—Applied Medical
Resources—Product Strategies
Applied Medical Resources, Laguna Hills, Calif.,
is targeting vascular surgeons, operating room
supervisors and materials managers as key
prospects to purchase the company's new
resposable angioscope that was released in July.
Applied Medical's marketing effort is emphasizing
the product's low price and resposable
characteristic.
Health Industry Today, Sept. 1993

Determine if you can use supplies that are
reusable, resposable, or disposable to reduce
costs....
Healthcare Purchasing News, August 2005

... Johnson and U.S. Surgical by offering so-
called "resposable" products, which combine
reusable hand pieces with disposable
scissors,....
The Boston Globe, February 7, 2005

One noteworthy line of "resposable"
electrosurgical instruments is offered by
Megadyne Medical Products Inc. (Draper, UT).
Healthcare Purchasing News, August 2005

First to offer 'green' reusable and resposable
electrosurgical technologies that are both
environmentally and fiscally responsible....
[about Megadyne in Draper, UT]
Marketwire, October 6, 2009³

³ We note that an excerpt from US Fed News, June 15, 2011,
states: "USPTO ISSUES TRADEMARK: DA VINCI S HD SURGICAL SYSTEM,
ALEXANDRIA, Va. ... "adaptors to connect arms to instruments, and
a full line of resposable tools, namely, laparoscopes,
endoscopes, trocars, cannulas, cutters,..." It appears that the

There are even excerpts from various wire services showing that applicant uses "resposables" in a descriptive manner:

Masimo Corporation Earnings Conference Call
... The green designed-in ideas. For example,
the responsible sensor line that we've been
working on that is green at the...
FD (Fair Disclosure) Wire, February 15, 2011

Masimo Corporation Earnings Conference Call—Final
...unit-wise—but again, because of the mix that is
shifting from the disposables to the responsables
is the reason we saw the kind of growth we did.
Otherwise, the growth unit - ... customers from
disposables, which had an [ASV] of over \$100, to
responsables, which have an ASV of about \$50,
because the actual volume ... cannibalization
through the year and you may see more conversion
to responsible from disposable sensors.
FD (Fair Disclosure) Wire, May 4, 2010.

In addition to these uses of "responsible" in the medical field, the examining attorney has made of record examples of "responsible" for general consumer items, e.g.,
"Responsible Plastic Plates & Stemware Party Supplies,"
www.partypro.com, and "Yoshi Responsible Plastic Bowls,"

items in this excerpt may refer to the identification of goods in a trademark registration, but the excerpt is too truncated for us to actually conclude this. If, indeed, the USPTO is accepting "responsible" as an acceptable identification of reusable disposable medical devices, we are surprised that the examining attorney failed to make of record third-party registrations showing this term in the identifications. Nonetheless, the absence of such evidence does not hurt the examining attorney's position, as he has provided significant evidence of descriptive use of the term.

"Yoshi Resposable Trays" and Yoshi Resposable Plastic Mugs," www.readygetsetparty.com.⁴

Applicant's primary argument in response to this evidence is that the term "resposable" does not appear in the dictionary.⁵ Applicant has submitted material from a "One Look," <http://onelook.com>, dictionary search for "resposable," which states that "no dictionaries indexed in the selected category contain the word *resposable*." This website also states that it is a search engine for words and phrases which will "shuttle you to the web-based dictionaries that define or translate that word," and that "more than 5 million words in more than 1000 online dictionaries are indexed by the OneLook® search engine." Applicant also submitted a listing from Wiktionary, <http://en.wiktionary.org>, which states, for "resposable," that "Wiktionary does not yet have an entry for

⁴ In the Office action mailed September 13, 2010, the examining attorney submitted evidence of the use of the term "reposable." Since he did not discuss this evidence in his brief, it is not clear why the examining attorney submitted this evidence, e.g., whether he was momentarily confused about what term actually appeared in applicant's mark, or whether he viewed "resposable" as a misspelling or alternate spelling of "reposable." In any event, we have not given this evidence any probative value.

⁵ Based on this, applicant argues, *inter alia*, that "resposable" is a word that it coined, and that consumers would not immediately and directly understand from this coined word a specific characteristic of the goods, or that, even if the term were considered to be a combination of "reusable" and "disposable," that meaning would not be understood immediately.

resposable," and a webpage from Urban Dictionary, urbandictionary.com, that, in response to a search for "resposable," lists a number of words beginning with the letters "resp" but "resposable" does not appear.

We would agree with applicant that, if the examining attorney's position were based solely on the fact that "resposable" is derived from the words "reusable" and "disposable," the combined term would be suggestive and not merely descriptive. However, the evidence submitted by the examining attorney shows that "resposable" has a recognized meaning in the medical field, and that the consumers for applicant's goods would be aware of this meaning. We disagree with applicant's assertion that the record "reveals only scant evidence of casual, mainly foreign usage of the term 'resposable.'" Brief, unnumbered p. 6. The probative value of articles from foreign publications is evaluated on a case-by-case basis, with consideration given to the nature of the involved goods or services and the growing availability and use of the Internet as a resource for news. TBMP § 1208.01. Because the involved goods are medical devices, the relevant purchasing public for these goods, i.e., doctors and other medical personnel, are more likely to be aware of the foreign publications and Internet websites in which resposable medical products are

mentioned. See *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003); see also *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark"). Further, the examining attorney has made of record evidence of the use of "resposable" in what appear to be websites of U.S. companies, and U.S. publications or wire reports regarding U.S. companies.

Nor do we accept applicant's speculation that the term "resposable" in the various material that the examining attorney made of record "could, in fact, have been a misspelling." Brief, unnumbered p. 6. We acknowledge applicant's claim that Internet content "is often posted, commented, replied, or 'tweeted' in haste," such that "errors—even misspellings—in casual online parlance are to be expected." Id. However, the material submitted by the examining attorney, as quoted herein, comes from business websites, newspapers and wire reports, not from tweets or blogposts or other postings where casual parlance would be expected.

Applicant also criticizes some of the evidence excerpted above, from ethiconendosurgery.com and shooping.yahoo.com, asserting that it is not clear from the webpages what the term "resposable" is used to mean. However, we view the fact that the term is not further defined as a recognition by the sellers of these goods that consumers would understand the term without any further explanation.

In view of the evidence submitted by the examining attorney, the fact that "resposable" does not yet appear in print dictionaries or in the online dictionaries that are searched by One Look does not persuade us that the relevant consumers would not be aware of the meaning of "resposable." We find that the relevant purchasers of "medical devices, namely, patient sensors for monitoring and measuring vital signs or blood properties," upon seeing the term "resposable" used in connection with such goods, would immediately and directly understand that these are disposable sensors that have more than a one-time use. That such a characteristic is significant for these goods is obvious from the various webpages that tout this quality as a selling point of various medical devices.

Applicant has raised the argument in its reply brief that RESPOSABLE is part of a unitary mark and therefore

need not be disclaimed. A reply brief is not the appropriate document for raising new claims, but is meant to respond to statements or arguments made by the examining attorney. In any event, aside from simply making this assertion, applicant has not given any cognizable reason why we should find the mark RAINBOW RESPOSABLE to be unitary. Although applicant states that when a mark comprises two or more terms that create an incongruity the mark is considered to be unitary, applicant's assertion, at page 9 that, because "a reusable and disposable rainbow does not exist," RAINBOW RESPOSABLE is incongruous, is not persuasive. Because RESPOSABLE has the meaning of a reusable disposable item, consumers would regard RAINBOW as the source-indicating element of the mark and RESPOSABLE as describing the goods.

After considering all of the evidence of record, and all of the arguments, including those not specifically discussed herein, we find that RESPOSABLE is merely descriptive of applicant's goods, and must be disclaimed.

Decision: The refusal of registration is affirmed. However, if applicant submits the required disclaimer within thirty days, this decision will be set aside and the application will be forwarded for publication.