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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Neurobotics, L.L.C.

Serial Nos. 78596887 and 78596957¹

Louis M. Heidelberger of Reed Smith LLP for Neurobotics, L.L.C.

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Before Drost, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Neurobotics, L.L.C., applicant, seeks registration on

the Principal Register of the mark NEUROBOTICS (in standard

character format) for the following goods and services:

Augmented surgical interface control systems, namely, medical apparatus and instruments for use in general surgery and for use in the training and simulation of surgery; surgical systems with surgical equipment in the nature of augmented surgical interfaces which incorporate surgical

¹ Inasmuch as the issues raised by the appeals in both of the above-noted applications are similar, the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application serial No. 78596887, unless otherwise noted; however, we have, of course, considered all arguments and evidence filed in each case.

instruments, medical tissue imaging apparatuses, surgical instrument motion actuators, position controllers and operator interface components, namely, surgical and medical apparatus and instruments for use in general surgery; medical devices for performing microsurgery, namely, medical apparatus and instrument for controlling the motion of surgical instruments within a surgical field, and surgical instruments for use in association with such medical apparatus and instruments; medical tools and instruments for use in conjunction with surgical procedures performed utilizing augmented surgical interfaces, namely, medical apparatus and instruments for accurately locating and positioning augmented surgical interfaces with respect to a surgical field; augmented surgical systems for assisting in the performance of surgical procedures, namely, medical apparatus and instruments for use in general surgery; surgical and medical apparatus and instruments in the nature of operator input medical apparatuses and operator displays that allow an operator of an augmented surgical interface to control the physical positioning of surgical equipment in a surgical field, augmented surgical apparatus and instruments for controlling the position of and moving surgical instruments within a surgical field, and surgical instruments for use in association with augmented surgical equipment; surgical systems for providing training and simulation capabilities with respect to surgical procedures using augmented surgical interfaces, namely, augmented surgical interface medical apparatus and instruments having internal capabilities for generating feedback to an operator simulating the displays and control feedbacks which would be encountered during actual performance of a surgical procedure using the augmented surgical interface; augmented surgical interface control system, namely, computer hardware and software and surgical and medical apparatus and instruments for use in general surgery, in International Class 9;² and

² Application Serial No. 78596887, filed March 29, 2005, alleging a bona fide intention to use the mark in commerce under Section

consulting and engineering services, namely design and development of surgical systems; design and development services for others of medical apparatus providing enhanced surgical capabilities; design and development services for medical systems providing enhanced surgical simulation and training capabilities; consulting services for others for the development of medical systems in the nature of augmented surgical equipment, in International Class 42.³

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods and services⁴ or, in the alternative, that it is deceptively misdescriptive of its goods and services, and under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark is deceptive. When the refusals were made final, applicant appealed and briefs have been filed.

Descriptiveness

1(b) of the Trademark Act, 15 U.S.C. §1051(b).

³ Application Serial No. 78596957, filed March 29, 2005, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

⁴ Inasmuch as this application was filed under Section 1(b), based on an intention to use the mark in commerce, the examining attorney refused registration under Section 2(e)(1) based on mere descriptiveness; however, she also provided an advisory statement that the term is "probably generic for the overall genus of the services." This is merely an advisory statement, the question of genericness is not in issue on appeal. See TMEP § 1209.02 (5th ed. September 2007).

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), guoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract, but in relation to the goods or services for which

registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney contends that "[t]he term 'neurobotics' is used by third parties to describe a new field of science regarding the fusion of neuroscience and robotics for augmenting human capabilities [and] applicant's goods are augmented surgical interfaces and systems for assisting surgeries and for allowing the operator to control the physical positioning of surgical equipment, etc." Br. p. 13. In regard to the services the examining attorney argues that applicant's "services design and develop 'medical apparatus providing enhanced surgical capabilities,' and 'medical systems in the nature of augmented surgical equipment.'" '957 Br. p. 15.

With regard to the meaning of the term "neurobotics" the examining attorney submitted the following evidence retrieved from various sources on the Internet:

Neurobotics...A new word is entering the vocabulary: Neurobotics. It means: The Fusion of Neuroscience and Robotics for Augmenting Human Capabilities...More particularly Neurobotics aims at: 1) systematically exploring the area of Hybrid Bionic Systems (HBSs) 2) deeply investigating the theme of human augmentation 3)

developing new integrated robotic artefacts, as much biomorphic as required to be effectively interfaced with the human body and brain. Three robotic platforms featuring different levels of hybridness (i.e., mechanical coupling with the human body) and of connectivity (to the human nervous system) will be developed to be used in experiments on human augmentation: biomimetic scalable artefacts to be remotely controlled by human operator; intelligent wearable artefacts loosely physically coupled with the human body; arm-hand sub-systems tightly physically coupled with the human body.

Robotic Nation Evidence, robotic nation.blogspot.com;

Neurobotics is a new field that lies at the intersection of Robotics and Neuroscience. Neurobotics is currently a small community but is growing rapidly in both engineering and science...Robotic systems are developed to augment, replace and rehabilitate damaged sensorimotor functions.

University of Southern California, www.cs.usc.edu;

NEUROBOTICS will consolidate the area of "human augmentation" and "hybrid bionic systems," whose state of the art is at present scattered and rather weak (Dairo et al. 1993).

EU FET Neurobotics, www.neurobotics.org;

NeuroBotics - Bioinspired computation for Robotics...International Workshop on NeuroBotics:... Substantial progress has been made recently in bio-inspired computation and robotics. This international workshop invites contributions to robotics which use methods of learning or artificial neural networks and/or are inspired by observations and results in neuroscience, cognitive science and animal behaviour.

www.mail-archive.com; and

Neurobotics will systematically explore the area of Hybrid Bionic Systems (HBSs) and will deeply investigate the theme of human augmentation. Starting from the most advanced state of the art in neuroscience, NEUROBOTICS will aim at developing new integrated robotic artefacts, as much biomorphic as required to be effectively interfaced with human body and brain.

Web.gbt.tfo.upm.es.⁵

In addition, the examining attorney submitted excerpted articles discussing the use of robots in surgery. See, e.g., Indianapolis Star, www.indystar.com ("Specialists work on new breed of surgical robots...The research of Purdue University mechanical engineering assistant professor William Peine and medical doctors is intended to make such futuristic-sounding procedures come true. They are working to create a new breed of cheaper, smaller, portable and adaptable surgical robots that could be common in operating rooms.") She also submitted dictionary definitions for the words neurosurgery, robot and robotics.

With regard to applicant's goods and services, the record includes a patent submitted by applicant that addresses applicant's medical apparatus:

...method and apparatus for controlling a surgical robot to mimic, harmonize and enhance

 $^{^5}$ While this may be a foreign website, it retains some probative value. See In re Remacle, 66 USPQ2d 1222, 1224 n. 5 (TTAB 2002).

. . .

the natural neurophysiological behavior of a surgeon.

The present invention was developed by a neurosurgeon and seeks to mimic the results of primate neurological research which is indicative of a human's actual neurological control structures and logic. Specifically, the motor proprioceptive and tactile neurophysiology functioning of the surgeon's hands and internal hand control system from the muscular level through the intrafusal fiber system of the neural network is considered in creating the robot and method of operation for the present invention. Therefore, the surgery is not slowed down as in the art, because the surgeon is in conscious and subconscious natural agreement and harmonization with the robotically actuated surgical instruments based on neurological mimicking of the surgeons' behaviour with the functioning of the robot. Therefore, the robot can enhance the surgeon's humanly limited senses while not introducing disruptive variables to the surgeon's naturally occurring operation of his neurophysiology. This is therefore also a new field, neurophysiological symbiotic robotics. The present invention relates to the field of robotic and computer assisted surgery...for

example, neurosurgery...

One result of the present invention, and associated discoveries, was that preservation of the hand tremor motion was unexpectedly found to be necessary, to an extent, to maintain a natural and efficient synergy between the human surgeon and the robotics in order to maintain the normal pace of surgery. This is because the present invention inventively recognizes that the surgeon's own neurophysiology beneficially uses tremor motion, and moreover the human body expects and anticipates the tremor to exist for calibration purposes...

Therefore, in summary, the present invention in its various controller robot embodiments includes the following features which are adjustable by the surgeon to his individual requirements: Hand tremor sensing, management, modulation and smoothing with scaling capability in all natural and anatomical degrees of freedom directions...

Applicant argues that:

The NEUROBOTICS mark does not have any significance with respect to the goods [services] offered in association with Applicant's mark, and the Examining Attorney fails to provide even one iota of evidence otherwise. The references cited by the Examining Attorney relate to the use of neuroscience theories for the development of artificial intelligence to allow automation of tasking in robots, which is guite distinct from Applicant's equipment for use in surgery. As noted, Applicant's goods [services] relate to augmented surgical interfaces [the development of augmented surgical interfaces] for neurosurgical applications. The equipment does not utilize artificial intelligence as a substitute for a human operator, and accordingly is not "robotic." Furthermore, although the term "neurosurgical" would be descriptive of the purpose of the equipment developed by Applicant, deletion of the "surgical" portion of that term clearly requires any consumer viewing the mark to take a mental step, just as the Examining Attorney did, before associating "NEUROBOTICS" with equipment for performing surgical procedures, and in particular, neurosurgical procedures.

Applicant's Br. p. 8 and in brackets `957 Br. p. 7.

The evidence of record, shows the development of a relatively new field called "neurobotics" that encompasses a wide range of applications. The field of neurobotics is essentially directed at integrating human and robotic capabilities in a variety of ways which clearly encompasses applicant's surgical goods as described in the patent and

the design services related to such goods. As stated in the excerpt from Robotic Nation, one of the types of apparatus sought to be developed within this field is a "biomimetic scalable artefact to be remotely controlled by a human operator." Biomimetics is defined as "the study and development of synthetic systems that mimic the formation, function, or structure of biologically produced substances and materials and biological mechanisms and processes." Random House Unabridged Dictionary (2006), available at dictionary.com.⁶ As stated in the patent addressing applicant's medical apparatus:

The present invention was developed by a neurosurgeon and seeks to mimic the results of primate neurological research which is indicative of a human's actual neurological control structures and logic. And the surgeon is in conscious and subconscious natural agreement and harmonization with the robotically actuated surgical instruments based on neurological mimicking of the surgeons' behaviour with the functioning of the robot.

Applicant's identification of its goods which is replete with surgical instruments designed to augment the surgeon's capabilities falls squarely within the definition

⁶ The Board may take judicial notice of dictionary definitions. 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).

of neurobotics in this record: The Fusion of Neuroscience and Robotics for Augmenting Human Capabilities.

Based on this record, we find that the examining attorney has made a prima facie case, which has not been rebutted by the applicant, that the term NEUROBOTICS is merely descriptive of a significant feature of applicant's goods and services, namely, devices and design services that mimic human neurological control structures and logic to create surgical robots that augment the human surgeon's capabilities.

For completeness we address the other refusals in the alternative.

Deceptive Misdescriptiveness

The test for deceptive misdescriptiveness has two parts. First it must be determined if the matter sought to be registered misdescribes the goods or services. If so, then it must be ascertained if it is also deceptive, that is, if anyone is likely to believe the misrepresentation. In re Quady Winery Inc., 221 USPQ 1213, 1214 (TTAB 1984). See also In re Phillips-Van Heusen Corp., 63 USPQ2d 1047 (TTAB 2002).

It has already been established that the term "neurobotics" is descriptive of biomimetic apparatus designed to augment human capability and that this includes

surgical equipment and design services with that feature. Thus, if applicant's goods and services do not include that feature then the term "neurobotics" is misdescriptive of them.

With regard to the next inquiry, whether consumers would believe the misrepresentation, applicant argues that its customers are doctors and medical facilities and "surgeons are highly educated individuals and are not likely to be confused when utilizing applicant's medical apparati [sic] into believing that there is some connection with the purported field associated with the study of robots." Br. pp. 10-11. In addition, applicant argues that "there is no reason to believe that physicians and hospitals would even know of the purported 'emerging field' of 'neurobotics,' let alone envision any relation between such purported field and Applicant's medical apparati [sic] [and] there is no reason to believe that research scientists in the field of robotics would believe any connection exists with a company providing medical apparati [sic]." Br. p. 12. Finally, applicant argues that "for a mark to be deceptive, the deception must be intentional" and, referencing a prior abandoned application not of record, states that applicant "adopted its mark at least as early as January, 2002" and the date of filing, presumably

of the abandoned application, "precedes any evidence of record of NEUROBOTICS having any meaning beyond Applicant's coined term...[thus] there can be no deceit." Br. p. 11.

The examining attorney argues that it is because of the sophistication of the purchasers that deception is likely, noting that "[s]urgeons and other related medical professionals, looking for the cutting edge of technology regarding augmented surgical and medical devices and seeing the proposed mark NEUROBOTICS, will assume the applicant will use this new field of science in developing and designing their products." Br. p. 19. She further argues that "[t] his is supported by evidence that even the applicant is developing goods using a combination of neuroscience and robotics. As already shown, third parties describe this combination of sciences as `neurobotics.' If goods similar to applicant's can and do possess the quality, function, composition or use that applicant's mark misdescribes, it is reasonable to infer that purchasers will believe the misdescription. In re Budge Mfg. Co., 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988)." Br. pp. 19-20.

First, with regard to the issue of intent, this is not part of the test. The case cited by applicant, In re Sweden Freezer Mfg. Co., 159 USPQ 246, 249 (TTAB 1968),

does not stand for the proposition that intent is a required element. In that case, the Board states that there have been cases wherein "deception is not present where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible." Id. at 249. The Board went on to state that it did not find deception because there was nothing in the record to support a finding that "SWEDEN" was known for the goods in issue in that case. Id. Moreover, applicant's "adoption" of the mark based on a prior filed application is not relevant to this application. Cf. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (The Board must decide each case on its own merits).

As noted by the examining attorney, there is evidence in the record of surgical robots and even applicant's patent highlights its use of neuroscience to develop its surgical device to augment the surgeon's capabilities. Thus, we may infer that at least some of the potential purchasers would be familiar with this term and understand its value with regard to the goods and services and, thus, would be deceived. While applicant asserts that sophistication of the purchasers would prevent deception,

there is nothing in the record to support such a conclusion.

Deceptiveness

The test for determining whether a mark is deceptive under Section 2(a) has been stated by the Court of Appeals for the Federal Circuit as: 1) is the term misdescriptive of the character, quality, function, composition or use of the goods or services; 2) are prospective purchasers likely to believe that the misdescription actually describes the goods or services; and 3) is the misdescription likely to affect the decision to purchase. Budge Manufacturing Co., Inc., 8 USPQ2d at 1260.

The first two factors have already been established in connection with the refusals under Section 2(e)(1) discussed above. What remains is to determine whether the misdescription is likely to affect the decision to purchase.

Based on the patent it is clear that the biomimetic feature of the goods and its augmentation of the surgeon's capability would be highly desirable. In addition, the evidence submitted by the examining attorney referencing use of robotics in surgery supports a finding that robotics in surgery is desirable. We find this sufficient to establish that the presence of this feature would

materially affect the purchasing decision. Thus, we conclude that the proposed mark NEUROBOTICS is deceptive in connection with the identified goods and services.

Decision: The refusals to register under Sections 2(e)(1) and 2(a) of the Trademark Act are affirmed.