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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Siemens Medical Solutions USA, Inc.

Serial No. 78974960
Filed: September 14, 2006

Marie Anne Mastrovito, Abelman, Frayne & Schwab for Siemens
Medical Solutions USA, Inc.

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**Before Quinn, Holtzman, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant seeks registration of SILICON ULTRASOUND (in
standard characters) for "ultrasound devices, namely,
medical ultrasound apparatus, ultrasound transducers made
out of silicon wafer" in International Class 10.¹

Registration has been finally refused pursuant to
Trademark Act § 2(e)(1); 15 U.S.C. § 1052(e)(1), on the
ground that applicant's mark is primarily merely
descriptive of the identified services.

We affirm.

I. Descriptiveness

A. Applicable Law

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order

¹ Based upon the allegation of a *bona fide* intent to use the mark in commerce.

to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); see also *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980). Even where individual terms are descriptive, combining them may evoke a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, without the combination of terms creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech.*, 64 USPQ2d at 1317-1318.

B. Discussion

Applicant's goods are identified as "ultrasound devices, namely, medical ultrasound apparatus, ultrasound transducers made out of silicon wafer." It is thus undisputed that ultrasound equipment can be made using "silicon," and that applicant's goods actually employ silicon. The record further makes clear that "silicon" is not merely an incidental component of applicant's ultrasound apparatus. In fact, the use of silicon in ultrasound transducers is central to a new generation of ultrasonic imaging technology:

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Sensant Corp ... is shipping its broadband silicon ultrasound imaging probes.... Sensant's silicon-based transducers provide improvements in the ability to capture and display a more informative diagnostic image. For example, silicon-based ultrasound images of breast or abdominal anatomy depict clearer tissue borders and improve image contrast. Also, the technology better visualizes contrast agents that depict blood flow in and around a tumor, a critical indicator in the diagnosis of cancer. How it works: Tiny silicon structures - known as capacitive microfabricated ultrasonic transducers (cMUT) - give silicon ultrasound the acoustic response that forms the basis for better medical images. These structures resemble tiny silicon drums, each smaller than the width of a human hair, fabricated on the surface of a silicon wafer. The flexibility of the cMUT design, coupled with on-chip electronics, provide the core technology for major advances in both 2-D and 3-D ultrasonic imaging.

www.medicalimagingmag.com (Oct. 1, 2007).

Siemens is highlighting the Encompass II release for its Sequoia scanner.

. . .
The firm also discussed its silicon ultrasound transducer technology development program, aided by its June 2005 acquisition of Sensant. Siemens expects silicon ultrasound transducers will yield efficient volumetric 4D imaging for a wide range of applications, and allow for visualizing a greater level of detail within both conventional and volumetric 4D ultrasound images. Commercialization is expected within two years.

www.auntminnie.com (Oct. 1, 2007).

Applicant urges that SILICON ULTRASOUND is at most suggestive of the identified goods. Applicant first argues that "without additional explanatory wording[,] applicant's mark cannot be understood." App. Br. at 3-4. This

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argument reflects a misunderstanding of the proper test for descriptiveness. The test is not whether a prospective consumer would be able to guess at the nature of the goods from the mark alone, but whether the mark - with reference to the identified goods - describes any feature, function, or characteristic of them. *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Moreover, when assessing the descriptiveness of a mark, we must consider who the potential purchasers are and how sales would be made in light of the nature of the goods. *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792, 1794-95 (TTAB 1996). In this case, purchasers of applicant's goods would not be ordinary consumers who may be unaware of developments in medical imaging, but rather doctors - particularly radiologists and other medical imaging specialists. These goods are by their nature expensive and technical, and the fact that they are used for medical diagnosis, App. Br. at 2, makes it very unlikely that they would be purchased without careful investigation into their features and suitability for the intended purpose. We have no doubt that such purchasers would be aware of (or quickly learn) the significance of the mark as applied to the identified goods.

Applicant also argues that the mark is incongruous. App. Br. at 4. We disagree. The examining attorney's evidence demonstrates that the mark is not comprised of two separate terms with contrary (or contradictory) meanings. Rather, the words SILICON and ULTRASOUND are used together to describe precisely the type of ultrasound apparatus identified in the current application.

In this regard, applicant contends that the mark is not descriptive because read literally, it "mean[s] a non[-]metallic sound wave used in medical exams." App. Br. at 5. This absurd interpretation is only reached by plucking words from the record dictionary evidence without reference to how those words would be understood or how they are actually used. As applicant admits, "sound waves are not generally thought to be metallic or non-metallic," a fact which would obviously be known to any purchaser of the identified goods. On the contrary, prospective purchasers would not understand the word "silicon," as used in the mark to refer to a sound wave, but would understand it instead to refer to a component of the ultrasound apparatus. We need not guess whether this would be so. The evidence of record quoted above uses the terms in just this way when actually describing these goods.

Applicant further argues that "third parties are not using and do not need to use" the mark. App. Br. at 7. Again we disagree. Although third party use can be evidence of descriptiveness, the opposite is not necessarily true; a mark may be found descriptive even if applicant is the first - or only - user of it. *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983). Here, it appears that silicon ultrasound technology is a relatively recent development in the field, and the fact that others are not widely using the term² is of little or no significance.

Finally, applicant points out that any doubt on the issue of descriptiveness must be resolved in favor of applicant. App. Br. at 8. While applicant is correct, we harbor no such doubts in this case.

II. Conclusion

After careful consideration of the record evidence and argument, we conclude that applicant's mark is merely descriptive of a feature, function, or characteristic of applicant's identified goods.

Decision: The refusal to register under Trademark Act § 2(e)(1) is accordingly affirmed.

² Indeed, it is not clear whether applicant itself is using the mark yet. The subject application was filed under the intent-to-

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use provisions of the Trademark Act and an allegation of use has not yet been filed.