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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re Masimo Corporation*

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Application No. 85041477  
Filed: May 18, 2010

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Oral Hearing: July 30, 2013

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Deborah S. Shepherd (counsel of record), Nicole A. Rossi (on the brief), Jeffrey Van Hoosear (oral argument), of Knobbe Martens Olson & Bear LLP, for applicant.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105, Thomas G. Howell, Managing Attorney.

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**Before Taylor, Mermelstein, and Bergsman, Administrative Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Alleging an intent to use the mark in commerce, applicant Masimo Corporation seeks registration of **RAINBOW 4D** for

Medical devices, namely, patient monitors and patient sensors for monitoring and measuring blood properties or respiratory events, in International Class 10.

Registration was refused in view of applicant's failure to supply a disclaimer of "4D," which the examining attorney maintains is merely descriptive of the identified goods. Trademark Act § 6(a), 15 U.S.C. § 1506(a) (disclaimer); § 2(e)(1), 15 U.S.C. § 1052(e)(1) (descriptive marks not registrable).

The refusal was made final, and applicant appeals.

We affirm.

### **I. Preliminary Issue**

Before turning to the merits of the case, we note that applicant attached to its appeal brief fifty pages of exhibits. It is usually pointless to attach evidence to a brief filed with the Board. With few exceptions, such exhibits are either untimely new evidence and therefore not properly of record, Trademark Rule 2.142(d), or they are duplicative of evidence already in the record and therefore unnecessary. “[I]n either event [they] should not be filed.” *In re Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (citing *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008)).

In *Houston*, we did not bother to strike the exhibits attached to applicant’s brief because they were merely duplicative of evidence which was properly in the record, so striking them would have made no difference. Not so in this case. Exhibits A and D to applicant’s brief appear to be definitions printed from the online OneLook Dictionary and Dictionary.com websites, respectively, and Exhibit E appears to be a “disambiguation” page from Wikipedia. While similar evidence was submitted during examination, *see* Req. for Recon., Exh. 1–3 (Oct 3, 2011), the versions submitted with applicant’s brief were re-printed from the respective websites shortly before applicant filed its brief. *See* Trademark Rule 2.142(d) (“The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board . . . after the appeal is filed.”). We decline to compare the two sets of documents to determine what, if anything, has changed, and instead we will consider only the timely-filed evidence. Further, Exhibits B and C to applicant’s brief appear to be ev-

idence which had not been submitted prior to appeal. This evidence is untimely. We will disregard it and any arguments based on it. *See id.* Finally, Exhibit F to applicant's brief (several third-party registrations), appears to correspond to properly-submitted evidence. *See* Req. for Recon., Exh. 4 (Oct. 3, 2011). This timely-submitted evidence has been considered, although it was unnecessary for applicant to submit it again with its brief.

## II. Disclaimers — Legal Standard

“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act § 6(a). Merely descriptive terms are unregistrable pursuant to Trademark Act § 2(e)(1), and are therefore subject to a disclaimer requirement if the mark is otherwise registrable. Registration may be refused for failure to comply with a valid disclaimer requirement. *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

In this case, the examining attorney asserts that “4D” is descriptive. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods on which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009–10 (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 under-

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stand 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).

### III. Discussion

#### A. Disclaimers and Unitary Expressions

Applicant argues that its mark is “unitary,” App. Br. at 8, 13, and that a disclaimer is therefore unnecessary. The examining attorney disagrees. Ex. Att. Br. at 8-9 (unnumbered).

While an applicant may be required to disclaim any unregistrable (in this case descriptive) part of a mark, it has long been recognized that the different parts of a trademark do not always create individual impressions. Two or more words or design elements can combine to form a single impression that is physically or conceptually inseparable. When that is the case, the elements comprising the expression are said to be “unitary,” and should be considered together, as a single unit. It is improper to require the disclaimer of part of a unitary expression, because such an expression must be considered as a whole.

Applicant’s mark is **RAINBOW 4D**. Applicant argues that

[t]he mark . . . is incongruous. The mark RAINBOW 4D combines the term RAINBOW, which is a spectrum of light, with the abstract term ‘4D.’ The term ‘4D’ adds an abstract element to the term ‘RAINBOW,’ a term which is familiar to most people but has many different meanings. The combination of the words ‘RAINBOW’ and ‘4D’ takes on its own new meaning.

App. Br. at 13; Reply Br. at 5–6 (“‘4D’ is . . . not associated with ‘RAINBOW’ and creates an incongruity”). We disagree.

Contrary to applicant’s argument, a mark is not unitary merely because its constituent parts have no relation to one another. Rather, such marks are categorically *not* unitary. While applicant’s two-word mark would be considered unitary if the combination of the words together lent a different or additional meaning to them, the mere use of two terms which are not connected in any respect does not form any impression other than that of two separate words. *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (“In a unitary mark, these observable characteristics [of the terms] must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements.”). In other words, a mark is unitary precisely because its elements *are* somehow (physically or conceptually) related.<sup>1</sup> Contrary to applicant’s argument, the *non*-relationship of two or more terms does not create a unitary expression because the impression formed by the combination of unrelated terms in a mark is no more (and no less) than the sum of its parts, and their combination does not change their impact upon the potential purchaser.

As applicant correctly notes, some unitary marks are described loosely as “incongruous.” This kind of incongruity is not easily defined, but what is clear is that it

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<sup>1</sup> For example, the word RAINBOW (as in applicant’s mark) is itself unitary, and it would be improper to require a disclaimer of “rain” or “bow,” even if one of them was found to be descriptive. For one thing, they are physically joined together. But they are also conceptually inseparable because “rain” and “bow” together form a word with a different meaning than the meaning of the separate (and otherwise unrelated) words.

does not arise from the use of wholly unrelated words. Instead, a mark is incongruous if the juxtaposition of its elements creates cognitive tension, such as when the combination of terms makes sense on one level, but clashes on another. This does not result from the use of random words which share no meaning at all, but rather from words whose meanings intersect, although not in the expected way.<sup>2</sup>

We find that **RAINBOW 4D** is not unitary. The terms 4D and RAINBOW have no different meaning together than they have separately, nor do the two terms together have any new or additional meaning when they appear together. Applicant does not allege any such meaning, only that “‘4D’ is . . . not associated with ‘RAINBOW’ and creates an incongruity.” Reply Br. at 6. Nonetheless, the mere fact that the words are not associated with each other is insufficient to create a unitary mark.

### **B. Meaning of “4D”**

The evidence of record makes clear that the term “4D” means “four-dimensional” or “fourth dimension.” ACRONYMFINDER *4D*, Req. for Recon., Exh. 3 (Oct 3, 2011) (<http://www.acronymfinder.com/4D.html> (October 3, 2011)) (“What does 4D stand for? . . . Four-Dimensional . . . Fourth Dimension”). As will be seen, in

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<sup>2</sup> The TMEP offers the example of URBAN SAFARI as an incongruous mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.05(d) (April 2013). In that example, each word carries a readily understood meaning. But those meanings both make sense and clash when used together: According to the dictionary, a SAFARI is a journey or expedition, especially in eastern Africa, and URBAN refers to a city or town. But although a city is a place which can be travelled, one does not usually think of a trip through a city as a SAFARI, because a safari is associated with wildlife and Africa. Conversely, while a city can be both dangerous and exciting, it is not at all like the savannah of Africa. The words fit together in some ways and they conflict in others, but they are not entirely unrelated.

this context<sup>3</sup> the four dimensions referred to comprise the three common physical dimensions (length, width, and height), plus time, which is treated as a dimension for some purposes. WEBSTER'S THIRD INT'L DICTIONARY 899 (1993) (*fourth dimension*).<sup>4</sup> This idea of time as a fourth dimension is similar to the concept of "space-time," which was fundamental to Einstein's theory of relativity developed a century ago. Resp. to Ofc. Action, Exh. B (March 7, 2011), Wikipedia, *Dimension* (<http://en.wikipedia.org/wiki/Dimension>) (March 4, 2011).

Consistent with the examining attorney's argument, the evidence shows that "4D" is commonly-used in connection with medical devices, which provide four-dimensional imaging. The examining attorney submitted the following evidence shedding light on the meaning of 4D in the field of medical imaging:

- **ABSTRACT**

Four-dimensional (4D) medical images, which are sequences of volume images over time, are represented by a great volume of information. One set of 4D medical images can easily take up hundreds of megabytes of storage volume. In this paper, we present a technique for compressing 4D medical images by combining motion compensation and lossless/near-lossless image encoding. Our technique incorporates a new fast 3D cube match algorithm that effectively exploits the redundancy between frames. The proposed scheme is validated by experiments on 4D cardiac images.

P. Yan & A. Kassim, *Lossless and Near-Lossless Motion-Compensated 4D Medical*

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<sup>3</sup> Both applicant and the examining attorney submitted information indicating that "4D" can also mean other things, including an herbicide or a system of geometry comprising four spatial dimensions. But these uses of "4D" have nothing to do with medical devices, and this evidence has little or no relevance to our decision. A term may be descriptive with respect to certain goods or services, despite having other meanings in other contexts. *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999).

<sup>4</sup> The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *see* FED. R. EVID. 201(b).

- **Abstract**

This paper reviews recent advances in 4D medical imaging (4DMI) and 4D radiation therapy (4DRT), which study, characterize, and minimize patient motion during the processes of imaging and radiotherapy. Patient motion is inevitably present in these processes, producing artifacts and uncertainties in target (lesion) identification, delineation, and localization. 4DMI includes time-resolved volumetric CT, MRI, PET, PET/CT, SPECT and US imaging. To enhance the performance of these volumetric imaging techniques, parallel multi-detector array has been employed for acquiring image projections and the volumetric image reconstruction has been advanced from the 2D to the 3D tomography paradigm. The time information required for motion characterization in 4D imaging can be obtained either prospectively or retrospectively using respiratory gating or motion tracking techniques. . . . In 4D US, volumetric ultrasonography can be employed to monitor fetal heart beating with relatively high temporal resolution. . . .

G. Li, & D. Citrin, *et al.*, *Advances in 4D Medical Imaging and 4D Radiation Therapy*, TECH. IN CANCER RESEARCH & TREATMENT (Feb. 2008).

- **Call for papers: 4D Medical Imaging and 4D Radiation Therapy**  
A special issue of International Journal of Biomedical Engineering and Technology

This special issue presents a collection of manuscripts that discuss novel and innovative applications of 4D medical imaging in radiation oncology, called 4D radiation therapy. It focuses on critical issues pertaining to 4D medical imaging, including time-resolved volumetric CT, MRI, MRSI, PET, PET/CT, and SPECT imaging and other emerging imaging modalities. Particular emphasis will be put on novel and unique applications of these 4D imaging modalities in 4D radiation therapy, including 4D simulation, 4D treatment planning, 4D pre-treatment verification, and 4D treatment delivery.

Subjects include, but are not limited to the following topics:

- 4D computed tomography (CT)
- 4D multi-detector-row CT (MDCT)
- 4D cone-beam CT (CBCT)
- 4D Magnetic resonance imaging (MRI)
- 4D magnetic resonance spectroscopic imaging (MRSI)
- 4D positron emission tomography (PET)



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- 4D single photon emission computed tomography (SPECT)
- 4D PET/CT
- 4D ultrasound (US)
- Other emerging imaging modalities
- 4D image reconstruction
- 4D image enhancement, registration, segmentation, and visualization
- 4D radiation therapy simulation
- 4D treatment planning
- 4D pre-treatment verification
- 4D treatment delivery

Inderscience News (March 26, 2007) (<http://inderscience.blogspot.com/2007/03/call-for-papers-4d-medical-imaging-and.html> (accessed Sept. 6, 2010)).

- One of the key factors contributing to this market growth is robust growth of 3D Medical Imaging Systems in the future. The Medical Image Processing Market has also been witnessing shift in demand to middle and lower end equipment in APAC. However expensive 3D and 4D enabled Medical Image Equipment could be a challenge to the growth of this market.

*Research and Markets: Global Medical Image Processing Market 2010–2014 — The Global Medical Image Processing Market Is Expected To Grow At A CAGR Of 8 Percent*, Business Wire (April 1, 2011).

- Elective ultrasound clinics appropriate key elements of a more holistic approach in their mediation of the 3D/4D session. Positioned as a woman and mother-centered experience, elective ultrasound clinics distinguish the 3D/4D session sharply from the 2D medical diagnostics session. As noted by Womb With a View: “We will provide a mother-centered environment that focuses exclusively on the needs of the family without the interference of time-constraints, the complicating issues of medical insurance, or the need for a full . . .

*On a Trip to the Womb: Biotourist Metaphors in Fetal Ultrasound Imaging*, Contemporary Women’s Issues (June 2010).

- Veran Medical Enables Breakthrough 4D Navigation to Cancer Lesions at University of Virginia Hospital (PR Newswire)

Inside Health Media (June 25, 2009).

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- Vital Images' software will be marketed by Chindex to hospitals throughout the country. The Minneapolis company makes advanced visualization and analysis software that is used by radiologists, cardiologists, oncologists and other medical specialists to create 2D, 3D and 4D images of human anatomy from CT and MIR image data.

*The Daily Record News Briefs*, THE DAILY RECORD (Baltimore, MD) (June 18, 2009).

- . . . 3D/4D ultrasound, which provides a realistic image of the fetus. For the first time parents can view their unborn child in great detail. This provides an opportunity for parents and extended family to bond with the baby. Haywood Women's Medical Center offers a 3D/ 4D ultrasound package complete with a CD to enjoy for years to come.

Peggy Manning, *Images of Motherhood*, ASHEVILLE CITIZEN-TIMES (North Carolina) (April 23, 2009).

- Calypso® Medical Exhibits at American Urological Association Annual Meeting; The Highly Accurate Prostate Tumor Tracking Technology, Calypso® Medical's 4D Localization System, Will Be on Display at Booth #3924

Business Wire (April 23, 2009).

- "In this context, image guided technologies are proving their usefulness especially in fields such as neurosurgery and functional endoscopic surgery," says Frost & Sullivan Industry Analyst Pramodh Ishwara-krishnan. "With its 4D registration features, Veran Medical's IG4 system represents a complete solution for the early diagnosis of lung cancer."

*Frost & Sullivan Lauds Veran Medical for its IG4 Plug-n-Play Navigation System 4-D Registration for Accurate and Early Targeting of Lung Cancer*, PR Newswire (March 2, 2009).

- ViTALConnect is a Web-based tool that allows access to the 2D, 3D, and 4D medical images. Because of its Web connectivity, the solution helps with the use of common advanced visualization tools and allows radiologists, cardiologists, and referring physicians to collaborate from anywhere in real time.

*Working Smarter: From Software Solutions to Outsourcing Reads to Portable Imag-*

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*ing Equipment, Radiology Departments Across the Country Have Geared Up to Maximize Efficiency*, Ascend Media Medical Imaging (Aug. 1, 2008).

- . . . lab, and speckle tracking is the most exciting development in cardiac ultrasound for the evaluation of ventricular function in years,” said Dr. Gerard Aurigemma, professor of Medicine, University of Massachusetts and director, Non-Invasive Cardiology at the UMass Memorial Medical Center. “Toshiba’s 4D tracking offers estimation of left ventricular volumes, ejection fraction and direct measurement of global and regional myocardial function by means of speckle tracking and provides insights that echocardiographers have not had before. This type of analysis will be how the next generation of echocardiographers . . .

*Toshiba Introduces New Cardiovascular Ultrasound Product*, Product News Network (June 25, 2008).

- Spadola’s clinical interests include fetal anomalies, diabetes mellitus in pregnancy, peripartum mood disorders and multiple gestations. Her research areas include placental methylation, maternal fetal cell transfer, peripartum mood disorders, and 3D/4D ultrasound evaluations.

*Spadola, M.D., Joins Department of Obstetrics and Gynecology at Tate University of New York’s Upstate Medical Center*, Targeted News Service (April 22, 2008).

- . . . Huntington Hospital, part of the North Shore Health System, on Long Island. They participate in cancer conferences, cancer committees and community programs. New in-patient and out-patient consultations are seen immediately,” said Richard Byrnes, M.D., Medical Director.

This center offers:

4D CT Simulation — Using sophisticated cameras to “see” respiratory motion.

*North Shore Radiation Therapy Opens on Long Island, Offers Cancer Patients Access to New, Advanced Cancer Treatments*, Business Wire (March 14, 2008).

- . . .this Frost & Sullivan study that just came out in September, the North American 3D/4D visualization market for medical imaging is a

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very good study. I highly recommend it to you, because I think it's — points out a number of trends in the marketplace.

*Mercury Computer Systems at American Electronics Association Classic Financial Conference*, FD (Fair Disclosure) Wire (Nov. 6, 2007).

- Toshiba America Medical Systems will highlight its 4D volume-imaging applications for ultrasound. The 4D applications were designed to improve transvaginal/ob, small parts, and abdominal imaging procedures by reducing variation in the acquired images. The systems give physicians the option to analyze data after a . . .

Kathlyn Stone, *Ultrasound Strums Familiar Chords in RSNA Exhibits; Better Images and Increased Mobility Dominate New Models, As Electronic Components Get Even Smaller*, DIAGNOSTIC IMAGING (Nov. 1, 2007).

- “There’s a growing need for transparent access to 2D, 3D and even 4D medical imaging data from anywhere inside or outside the hospital enterprise,” said Keith Dreyer, M.D., Ph.D., and Vice-Chairman of Radiology–Informatics at Massachusetts General Hospital and Assistant Professor of Radiology at the Harvard Medical School.

*Mercury Computer Systems Announces Wholly Owned Subsidiary, Visage Imaging, for the Life Sciences and Medical Businesses; New Entity Will Focus on Expanding Mercury’s Medical Imaging and Visualization Portfolio Through “Visioneering Science for Life”*, Business Wire (Aug. 14, 2007).

- Recent advancements in 3D/4D ultrasound expands the usefulness of ultrasound into areas like viewing the fetal heart and blood flow using even faster scanning speeds, according to GE Medical Systems, the maker of the 4D ultrasound system used in many physician’s offices.

Mary Jimenez, *Sneak Peek*, THE TIMES (Shreveport, Louisiana) (June 22, 2007).

- The practice has expanded with technology improvements that now allow high definition 3D snapshots of the fetus and even ‘4D’ video. Companies can make up to £250 (\$490) from one CD or DVD.

*Controversy Remains Over Keepsake Prenatal Ultrasound Images*, REUTERS HEALTH

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MEDICAL NEWS (Feb. 1, 2007).

- “Mercury’s advanced imaging and visualization solutions help radiologists and clinicians to quickly and easily navigate through 2D, 3D, and even 4D medical imaging data, to present the most consistent image data using analytical tools for quick and accurate diagnoses,” said Marcelo Lima, Vice President and General Manager of Commercial Imaging and Visualization at Mercury Computer Systems.

*Mercury Computer Systems to Demonstrate Groundbreaking Features of Visage CS and Visage PACS Solutions at RSNA 2006; Revolutionary Visage Imaging and Visualization Software Provides Stunning Image Quality, Blazing Load Times, a Cardiac Analysis Option, and More*, PR Newswire US (Nov. 16, 2006).

- Lexington Fetal Photography is the city’s first business offering color photography of babies still in the womb, images captured using powerful 3D and 4D ultrasound.

Barbara Isaacs, *Color Ultrasound Comes to Town; Parents-to-be Can Now See Babies in 3D or 4D at a Price*, THE LEXINGTON HERALD LEADER (Kentucky) (March 13, 2006).

- Mad River Community Hospital has acquired the iU22 ultrasound system from Philips Medical Systems that features what it calls 4D, or real-time 3D imaging technology.

In a press release, Mad River Hospital said the new technology “allows patients to view the fetus and internal organs as if they were being held in the hands.

*Mad River Hospital Adds New Ultrasound Imaging Technology*, EUREKA TIMES-STANDARD (California) (May 23, 2005).

- The patients had been trained to follow customized verbal breathing instructions (“breathe in, breathe out”) during their radiotherapy simulations. . . . The same instructions were used during PET/CT studies performed with Advantage 4D software (General Electric Medical Systems).

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- At each acquisition, 4 CT slices are generated. . . . Advantage 4D (General Electric Medical Systems) CT software sorts the CT data into corresponding phases of the respiratory cycle.

Yusuf E. Erdi, Sadek A. Nehmeh, *et al.*, *The CT Motion Quantitation of Lung Lesions and Its Impact on PET-Measured SUVs*, 45 J. NUCLEAR MED. 1287 (Aug. 2004).

- In preliminary results, the Advantage 4D technology developed by GE Medical Systems has limited the exposure of radiation to healthy tissue surrounding a tumor by allowing radiation oncologists to precisely visualize and assess its structure and movement.

*Pennsylvania Business News in Brief*, Associated Press State & Local Wire (Feb. 18, 2004).

Applicant points out that some of these articles refer to “3D/4D,” which, it is argued, “creates a different commercial impression than just the term ‘4D.’” App. Br. at 7. We disagree. In the context of the cited articles, we think it is far more likely that these references to 3D and 4D together would be considered as a reference to either 3D or 4D technology (or both of them), and not to something different than either of them. Applicant also argues that some of the articles are about particular problems in implementing 4D imaging systems, which, according to applicant, “demonstrates that ‘4D’ technology is an abstract concept which lacks practical application or meaning.” App. Br. at 6. This is clearly incorrect. In fact, the evidence quite obviously indicates that 4D medical technology is actually in clinical use. Despite the fact that scientists and engineers continue to improve its accuracy and utility through further research, we have no doubt that such medical devices exist

and that the term “4D” is used to describe them.

Further, citing a non-precedential Board decision,<sup>5</sup> applicant argues that one of the examining attorney’s articles has “little persuasive value” because it “was written in Singapore.” App. Br. at 6. We disagree; what matters is not where the article was written, but where it was published. But even if it were clear that this article was not published in the United States (and that is not clear at all), our *precedential* case, *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002), overruled an essentially identical objection, finding that “it is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. *Id.* at 1224 n.5; see *In re Bayer Aktiengesellschaft*, 488 F3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (citing *Remacle* with approval). Applicant’s objection is accordingly overruled.

In addition to the articles discussed above, the examining attorney submitted six registrations on the Principal Register in which “4D” is disclaimed apart from the mark as shown. In each case the registration lists goods or services related to medical imaging. While we cannot assume that the public is aware of disclaimers

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<sup>5</sup> More than one-third of the cases (eleven out of thirty) cited by applicant in its opening and reply briefs are non-precedential decisions of the Board. Although they are not binding authority, parties before the Board may cite such decisions for whatever persuasive value they may have. Notice, *Citation of Opinions to the Trademark Trial and Appeal Board*, Official Gazette (Jan. 23, 2007). However, we do not encourage the practice. *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120–1121 (TTAB 2012). When a non-precedential opinion is cited, the immediate impression is that there is no precedent in support of the point. That sometimes turns out to be incorrect, but it requires the Board’s effort to find the precedential authorities which should have been cited in the first place. We have considered applicant’s citations, but we see no need to discuss them.

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residing in the records of the USPTO, these disclaimers nonetheless represent the concession of the respective registrants — who are presumably knowledgeable in the field — that the term 4D is at least descriptive of the identified goods or services. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (“We also agree with the observation of the board that, when appellant . . . disclaimed said term in applications for registrations of compound marks, it . . . admitted the merely descriptive nature of the mark. . .”). These registrations support the examining attorney’s position that “4D” is descriptive of medical imaging goods and services.

Applicant disagrees, citing seven third-party registrations comprising the term “4D,” in which the term was *not* disclaimed. We find only one of these registrations relevant.

To begin with, we have not considered Reg. No. 3123380 (for **4D**), which has been cancelled under Trademark Act § 8. A dead registration is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). Next, we note that the term “4D” in Reg. No. 3976607 (for **4D-NUCLEOFECTOR**) is physically joined by a hyphen with another word, forming a unitary expression. Thus, unless the entire expression was considered descriptive — and there is no indication that it is — a requirement to disclaim “4D” would have been inappropriate. *E.g. “X” Labs., Inc. v. Odorite Sanitation Serv. of Balt., Inc.*, 106 USPQ 327, 329 (Comm’r 1955). Finally, the goods and services identified in the ’380 and ’607 Registrations, as well as those in Reg. Nos. 3516889 (for **4D**



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**MEDICAL**), 3151119 (for **4D**), 3872152 (for **4D BROADCAST PLATFORM**), and 3883850 (for **4D POWER**), are unrelated to the field of medical imaging or the specific goods identified in the subject application. Whether 4D was disclaimed in any of those registrations is not probative of whether it is descriptive with respect to the different goods in this application.

That leaves Registration No. 3458302 (for **CINEMA 4D**, “CINEMA” disclaimed).<sup>6</sup> In addition to other goods which might possibly be relevant, this registration identifies “computer software for visualization and use in medical analysis, medical research studies, and teaching health professionals, health personnel, and medical students.” While the wording is somewhat oblique, this identification of goods might be construed to be related to some of the same goods or services for which 4D is descriptive pursuant to the evidence set out above. We do not have before us the application file of the ’302 Registration, so it is unclear what evidence was presented. But it is only one registration, and it is certainly no more conclusive of the issue before us than are the six registrations submitted by the examining attorney, which support his position that 4D is descriptive of such goods. In any event, we are not bound by the decisions of examining attorneys in other applications. *Houston*, 101 USPQ2d at 1542. Our task is not to justify or harmonize the existence of every registration; we need only determine whether, based on the evidence of rec-

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<sup>6</sup> Although applicant is correct that the ’302 Registration issued without a disclaimer of “4D,” we note that “CINEMA” was disclaimed by the registrant. Thus, had both “CINEMA” and “4D” been considered descriptive, the likely result would have been a refusal to register on the ground of descriptiveness, rather than a requirement to disclaim “4D.”

ord in *this* application, the examining attorney was justified in requiring the disclaimer of “4D” with respect to applicant’s goods.

We conclude that the evidence of record clearly demonstrates that 4D is merely descriptive of medical imaging devices, which display three-dimensional images over time, and that it would be immediately recognized as such by purchasers of such goods, without further thought or conjecture. Although applicant argues that various items of evidence are ambiguous as to the context or meaning of “4D,” Reply Br. at 1, we do not rely on any single piece of evidence. Considered in its totality, the evidence is clear. Further, while the evidence shows ample mention of 4D medical imaging (particularly ultrasound) in the popular press, the likely purchasers of applicant’s goods are doctors and hospitals, not the general public. We have no doubt that they would immediately understand the significance of 4D with respect to such goods.

### **C. Applied to Applicant’s Goods**

Despite objecting to some of the examining attorney’s evidence and arguing that it does not show that “‘4D’ has a well understood and recognized meaning,” Reply Br. at 1, applicant appears to recognize that “4D” holds at least some descriptive meaning in the field of medical imaging. App. Br. at 6 (noting that one piece of evidence “addresses the use of 4D imaging in the [field of] radiotherapy.”); *id.* at 7 (“[T]he term ‘4D ultrasound’ refers to the addition of the element of time to a regular ultrasound and results in creating a video of a baby.” “Most of the articles use the term ‘4D’ in conjunction with imaging.”). But whatever it thinks about the descriptiveness of “4D,” applicant maintains that its goods are *not* imaging devices. *Id.*

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at 6–8; Reply Br. at 2.

The question of what applicant’s goods are (and are not) must be answered by reference to the goods for which registration is sought. The identification of goods must be given its ordinary meaning, and is not limited by the goods on which applicant actually uses or intends to use the mark. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993) (“Registrability is determined based on the description in the application, and restrictions on how the mark is used will not be inferred.”).

The application indicates that applicant intends to use its mark on:

Medical devices, namely, patient monitors and patient sensors for monitoring and measuring blood properties or respiratory events, in International Class 10.

Although applicant’s identification of goods does not explicitly include “medical imaging devices,” we must nonetheless consider whether such devices are included in the identified “patient monitors and patient sensors. . . ,” because if “4D” is descriptive of any of the goods included within the identification of goods, it must be disclaimed. *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975) (citing *In re Am. Soc’y Clinical Pathologists, Inc.*, 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1971)).

The examining attorney addresses this question in his brief:

The applicant asserts that its goods do not create images. However, the examining attorney can only determine the descriptiveness of a term based on the identification of goods as set out in the application. The applicant offers “medical devices, namely, patient monitors and patient sensors for monitoring and measuring blood properties or respiratory events.” Medical professionals and consumers encountering the applicant’s mark would assume the applicant is measuring blood properties or respiratory

events by utilizing “4D” technology. “4D” technology may be utilized using an actual image of a patient or one that is virtual and simulated by data that is gathered from numerical readings taken from a patient by way of a sensor and tabulated numerically on a monitor.

Ex. Att. Br. at 5.

Although neither applicant nor the examining attorney attempted to define “patient monitors and sensors,” we found several relevant definitions in medical dictionaries of which we take judicial notice:

: one that monitors; *especially* : a device for observing or measuring a biologically important condition or function  
<a heart *monitor*>

MERRIAM WEBSTER MEDICAL DICTIONARY (Medical), <http://www.merriam-webster.com/medical/monitor> (last visited Sept. 29, 2013).

**monitor** /mon i tor/ (mon´it-er)

1. to check constantly on a given condition or phenomenon, e.g., blood pressure or heart or respiratory rate.
2. an apparatus by which such conditions can be constantly observed or recorded.

DORLAND’S MEDICAL DICTIONARY FOR HEALTH CONSUMERS (2007), <http://medical-dictionary.thefreedictionary.com/monitor> (last visited Sept. 29, 2013). A virtually identical definition was found in the MILLER-KEANE ENCYCLOPEDIA AND DICTIONARY OF MEDICINE, NURSING, AND ALLIED HEALTH (7th ed. 2003), available at the same URL.

**monitor** mon i tor (mŏn’ĩ-tər)

*n.*

A usually electronic device used to record, regulate, or control a process or system.

AMERICAN HERITAGE STEDMAN'S MEDICAL DICTIONARY (2002), <http://dictionary.reference.com/browse/monitor?s=t> (last visited Sept, 29, 2013).

While these definitions are each worded somewhat differently, they are generally consistent in concept, and in the absence of a better definition proposed by applicant or the examining attorney, we will construe the identification of goods accordingly. We thus conclude that a “patient monitor[.]” includes, *inter alia*, an apparatus or device to observe or record a biological condition or phenomenon.

Turning again to the evidence submitted by the examining attorney, it is clear that many of the 4D medical imaging devices discussed in the webpages and articles clearly fit the definition of a “patient monitor,” *i.e.*, a device to observe or record a biological condition or phenomenon. Indeed, the entire point of medical imaging devices is to observe biological conditions or phenomena, and it is obvious from the evidence that many — possibly all — of the devices or apparatus discussed in the evidence can also record what they observe on CDs, DVDs and other media.

The last piece of the puzzle is the specific purpose of applicant's identified goods, *i.e.*, “for monitoring and measuring blood properties or respiratory events.” On this point, the evidence of record indicates that among other things, 4D imaging can be used to observe fetal blood flow, Mary Jimenez, *Sneak Peek, supra*, “left ventricular volumes,” *Toshiba Introduces New Cardiovascular Ultrasound Product, supra*, and phases of the respiratory cycle, Erdi, Nehmeh, *et al., supra, i.e.*, for monitoring and measuring blood properties or respiratory events, *i.e.*, blood properties or respiratory events.

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In light of the evidence of record, we conclude that 4D medical imaging devices fall within applicant's identification of goods.

#### **IV. Conclusion**

After consideration of the evidence and argument of record, we conclude that "4D" is merely descriptive of a feature, function, or characteristic of applicant's goods, and must therefore be disclaimed. Trademark Act § 6(a).

**Decision:** The refusal to register in the absence of a disclaimer of "4D" is AFFIRMED.

However, this decision will be set aside if, within thirty days of the mailing date of this order, applicant submits to the Board a disclaimer of "4D." See Trademark Rule 2.142(g); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1218 (June 2013). The disclaimer should be worded as follows:

No claim is made to the exclusive right to use 4D apart from the mark as shown.

TMEP § 1213.08(a)(i) (April 2013).