

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 15, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Micro Interventional Devices, Inc.
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Serial No. 85446955
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Susan A. Smith of Kenyon & Kenyon, LLP for Micro Interventional Devices, Inc.

William M. Rossman, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).
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Before Grendel, Wellington, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On October 13, 2011, applicant Micro Interventional Devices, Inc. applied to register the mark MICRO INTERVENTIONAL DEVICES, in standard characters, for “medical, surgical implants made of artificial material,” in International Class 10.¹ On August 3, 2012, applicant disclaimed the exclusive right to use the word DEVICES apart from the mark as a whole.

The examining attorney has refused registration on the ground that the applied-for mark is merely descriptive of applicant’s services pursuant to

¹ Application Serial No. 85446955, filed pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b) (intent to use).

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Applicant timely appealed, and briefing is complete.

Description of the Record

The examining attorney made the following evidence of record:

- Dictionary definitions, including:
 - micro – “Very small or microscopic”²
 - intervention – “the act or fact of interfering so as to modify” and “any measure whose purpose is to improve health or alter the course of disease”³
 - device – “a machine or tool used for a specific task; contrivance”⁴
 - implant – “something (as a graft or device) implanted in tissue”⁵
- Examples of uses of the phrase “interventional device(s)” in medical journals and on third-party websites in association with implants and other medical devices;⁶ and
- Fourteen existing registrations for medical apparatus in Class 10 that include disclaimers of the word “micro,” as well as one registration that includes the word “micro” and is registered pursuant to Section 2(f).⁷ In one of the registrations of record, for the mark AXCANDIS MICRO VASCULAR INTERVENTIONS, the identified goods include

² February 9, 2012 Office action at 11-12 (from education.yahoo.com/reference/dictionary).

³ *Id.* at 4-7 (from medical-dictionary.thefreedictionary.com).

⁴ *Id.* at 8-10 (from collinsdictionary.com).

⁵ Examining attorney’s brief, 9 TTABVUE 5. We grant the examining attorney’s request that we take judicial notice of the definition of the noun “implant” from the Merriam-Webster online dictionary. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1642 n.4 (TTAB 2011).

⁶ *See* February 9, 2012 Office action at 2-3; September 3, 2012 final Office action at 2-21; April 10, 2013 denial of request for reconsideration at 2-6.

⁷ *See* September 3, 2012 final Office action at 22-75. The mark registered pursuant to Section 2(f) is MICRO PES, Registration No. 2705680. *Id.* at 25-26.

goods identical to applicant's and the entire phrase "Micro Vascular Interventions" is disclaimed.⁸

Applicant submitted the following evidence:

- Printouts of the first two pages of results of a search on Google.com for the phrase "MICRO INTERVENTIONAL DEVICES," which appear to show references only to applicant;⁹
- A printout from the Trademark Electronic Search System (TESS) database of a registration for the standard character mark MICRO SKIN for "ostomy pouches" in Class 10, registered on the Principal Register without disclaimer;¹⁰
- Printouts from the TESS database showing three lists of third-party applications and registrations, as follows:
 - The first 100 of 2,608 results of a search for "live.ld. and micro.bi. not micro.ds";¹¹
 - The first 100 of 270 results of a search for "010.ic. and live.ld. and micro.bi";¹² and
 - The nineteen results of a search for "010.ic. and live.ld. and micro.bi. and micro.ds."¹³

Applicant submitted the first of the three lists of third-party registrations with its August 3, 2012 response to Office action, and the second and third with its request for reconsideration. The examining attorney objected to the lists in its denial of

⁸ *Id.* at 51-52, Registration No. 4152262. The identified goods include "surgical implants made of artificial material, namely medical stents and arterial and vascular grafts, medical implants comprised of artificial material and instruments for the minimal invasive surgery, in particular implants made of degradable and non-degradable materials."

⁹ August 3, 2012 response to Office action at 2-4; March 4, 2013 request for reconsideration at 2-4.

¹⁰ March 4, 2013 request for reconsideration at 5-6, Registration No. 4173724.

¹¹ August 3, 2012 response to Office action at 5-8.

¹² March 4, 2013 request for reconsideration at 7-9.

¹³ *Id.* at 10-11. We note that copies of fifteen of the registrations on applicant's list were made of record by the examining attorney with the September 3, 2012 final Office action. *See supra* note 7.

applicant's request for reconsideration, but did not object to the first list in the September 3, 2012 final Office action.

The examining attorney's failure to advise applicant of the insufficiency of the first list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 1207.03, 1208.02 (3d ed. rev. 2 June 2013). Because applicant was not so advised, in our discretion, we will consider all three lists of third-party registrations "for whatever limited probative value such evidence may have." *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).¹⁴

With its reply brief, applicant also attempted to submit (1) a chart listing sixteen registrations for Class 10 goods incorporating the term "micro" in addition to the registration for MICRO SKIN referenced *supra*, (2) copies from the TESS database of nine of those sixteen registrations, and (3) printouts from applicant's website, microinterventional.com. This evidence is untimely and therefore not part of the record for this case. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013).¹⁵

¹⁴ We note, however, that the mere submission of a list of registrations does not make the listed registrations of record and the Board does not consider any information regarding those registrations other than that provided in the lists. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP § 1208.02.

¹⁵ We hasten to add that consideration of this evidence would not change the decision.

Analysis

A mark is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of an ingredient, quality, characteristic, function, feature, purpose, or use of the goods with which it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular mark is merely descriptive must be determined 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 possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. *See DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Eng'g Sys. Corp.*, 2 USPQ2d 1075, 1076 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could

include patents for tracking the status of the records by means of the Internet); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, consultation, and listing services); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1318 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Putman Publ'g Co.*, 39 USPQ2d 2021, 2022 (TTAB 1996) (FOOD & BEVERAGE ON-LINE merely descriptive of online news and information service for the food processing industry). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. In other words, we must consider the issue of descriptiveness by looking at the mark in its entirety.


Applicant has conceded the common, descriptive nature of DEVICES by disclaiming exclusive rights in that term apart from the mark as a whole. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). The examining attorney has made of record dictionary definitions of the other two terms in applicant's mark, MICRO and INTERVENTION, as well as evidence showing descriptive or generic use of the phrase "interventional devices" in the context of medical devices. Based on this evidence, and viewing the mark as a whole, we find that all three constituent terms of applicant's mark retain their descriptive significance in relation to applicant's goods, evoking no new or unique commercial impression in

combination. *Cf. In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products).

Applicant argues that the examining attorney improperly dissected its mark into its component parts, and that when considered as a whole, the mark is suggestive of “medical, surgical implants made of artificial material” rather than descriptive of applicant’s goods. Applicant’s argument is based in part on the fact that there is no record evidence of any use of the entire phrase MICRO INTERVENTIONAL DEVICES other than by applicant.¹⁶ It is well-established, however, that a lack of third-party use is not dispositive, and a mark may be merely descriptive even if applicant is the first or only user of it. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Both applicant and the examining attorney submitted evidence and argument as to whether the word “micro,” as the leading component of the applied-for composite mark, is merely descriptive of the identified goods. The examining attorney cites *In re Tekdyne*, 33 USPQ2d 1949, 1950 n.2 (TTAB 1995), in which applicant conceded that the term MICRO “means small not only in the medical field, but in many other fields,” and we affirmed a refusal to register MICRO-RETRACTOR as merely descriptive of surgical clamps. Applicant, in turn, cites *In re Micro Instrument Corp.*, 222 USPQ 252 (TTAB 1984), in which a descriptiveness

¹⁶ *See, e.g.*, Reply Brief at 5, 7-8.

refusal was reversed for the mark  for “automatic machines for the mass repetitive production of component parts and parts therefor designed and manufactured to purchasers’ specifications.” The Board wrote:

In the case before us, there is no evidence of trade usage or understanding of the term “micro” as readily identifying either miniature tool parts or miniature tooling operations and certainly not a large machine or machinery aggregation which performs the operations that can produce very small parts or fine machining work; *nor is the term “micro” accompanied by a second highly suggestive or descriptive term that would make the association or nex[us] with miniature tooling or miniature component capability a clear one.*”

Id. at 254-55 (emphasis added) (footnote omitted). In contrast, the applied-for mark here does include a second highly descriptive or generic phrase. Applicant also cites *In re Scott Paper Co.*, 180 USPQ 283 (TTAB 1973), in which we reversed a refusal to register MICRO-WIPES for disposable wipes, finding the term “merely suggestive of an article which is smaller than normal size and which performs a wiping operation.” In addition, applicant argues that the lists of TESS search results it submitted show that the term “micro” is disclaimed in only a small minority of applications and registrations, in Class 10 as well as other classes.

We do not view the cases cited by applicant (dating back nearly 30 years and more) or the record evidence as establishing a practice on the part of the Office to treat the term MICRO as suggestive rather than descriptive for medical devices. The lists of search results submitted by applicant convey only limited information, but they do show that many of the results are for applications rather than

registrations, which have no evidentiary value concerning how the Office has treated the term MICRO. TBMP § 1208.02 (“Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed.”). In addition, some of the listed marks are for single words incorporating “micro” (e.g., MICROSTEED, MICROSLIDE, MICROVISK) rather than “micro” standing alone, possibly distinguishing them from applicant’s mark.

With respect to the registrations of record for MICRO-formative marks for medical apparatus, at least fourteen include disclaimers of the word “micro.” Moreover, we view MICRO SKIN, the only mark of record registered on the Principal Register without a showing of acquired distinctiveness in which “micro” is not disclaimed, as distinguishable from the applied-for mark because it appears to have a suggestive quality in association with ostomy pouches.

More importantly, even if applicant had succeeded in establishing that the Office commonly treats the term “micro” as suggestive of Class 10 goods, prior decisions in other applications are not binding on the Board, and each case must stand on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977).

We have carefully considered applicant’s arguments and evidence, but have not found them persuasive. Viewing applicant’s mark MICRO INTERVENTIONAL DEVICES as a whole, we find that each of its constituent terms retains its descriptive meaning in combination. The phrase conveys information about the

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identified goods “medical, surgical implants made of artificial material,” that is, that they are very small interventional devices. We therefore find applicant’s mark to be merely descriptive within the meaning of Section 2(e)(1) in association with applicant’s goods.

Decision: The examining attorney’s refusal to register applicant’s mark under Section 2(e)(1) of the Trademark Act is affirmed.