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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Fischer Medical Technologies, Inc.

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Serial No. 85465059

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Robert B. Berube of Marsh Fischmann & Breyfogle LLP for Fischer Medical Technologies, Inc.

Brenden McCauley, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Holtzman, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Fischer Medical Technologies, Inc. ("applicant") filed an intent-to-use application to register the mark MAMMOCAT, in standard character form, for "electromagnetic medical diagnostic and screening imaging apparatus, and medical instruments for use in performing biopsies," in Class 10. The goods are used for "diagnostic mammography."[1] "Mammography" is "radiography of the mammary

[1] Applicant's webpage for the Radiological Society of North America annual meeting website (rsna2012.rsna.org) attached to the April 1, 2013 Office action.

gland."[2] "Radiography" is the production of "a photographic image produced by the action of x-rays or nuclear radiation."[3] In response to a request for information, applicant provided the following description of its product:

> … Applicant intends to use the subject mark comprise [sic] medical equipment that may be used in completing breast imaging and biopsy procedures and the goods employ computerized axial tomography or computed tomography technology.[4]

The Trademark Examining Attorney refused to register the mark on the ground that it is merely descriptive. Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e). According to the Trademark Examining Attorney, MAMMOCAT when used in connection with the goods in the application "describes a feature, characteristic or purpose of the goods, namely, CAT or computer axial tomography electromagnetic medical diagnostic and screening imaging apparatus, and medical instruments equipment for use in breast biopsies."[5] In his February 23, 2012 Office action, the Trademark Examining Attorney explained that MAMMOCAT "indicates the nature of the medical imaging, biopsy, related procedure apparatus and accessories for use in providing a computed tomography image of the breast."

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[2] **DORLAND'S ILLUSTRATED MEDICAL DICTIONARY**, p. 1101 (32nd ed. 2012) attached to the April 1, 2013 Office action.

[3] **THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (UNABRIDGED)**, p. 1593 (2nd ed. 1987). 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).

[4] Applicant's August 22, 2012 response to an Office action.

[5] Examining Attorney's Brief, unnumbered page 5. *See also* Examining Attorney's Brief, unnumbered page 6.

A term is merely descriptive if it "immediately conveys … knowledge of the ingredients, qualities, or characteristics of the goods … with which it is used." *In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services 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). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Chamber of Commerce*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.,* 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question 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 Services Inc.,* 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville,* 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.,* 226 USPQ 365, 366 (TTAB 1985).

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. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), *quoting, Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920). *See also In re Tower Tech, Inc.,* 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooking towers); *In re Sun Microsystems Inc.,* 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.,* 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in 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. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order 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, 498 (TTAB 1978). *See also, In re Shutts,* 217 USPQ at 364-65; *In re Universal Water Systems, Inc.,* 209 USPQ 165, 166 (TTAB 1980). In this regard, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *In re Shutts,* 217 USPQ at 365. *See also In re Tennis in the Round, Inc.,* 199 USPQ at 498 (the association of applicant's mark TENNIS IN THE ROUND with the phrase "theater-in-the-round" creates an incongruity because applicant's services do not involve a tennis court in the middle of an auditorium).

The following evidence has been made of record:

1. The term "mammo" is defined as "a combining form denoting relationship to the breast, or to a mammary gland."[6]

2. The medical dictionaries referenced in footnote 6 list the following "mammo" formative words:

a. Mammogen – "any substance or influence that promotes breast development";

b. Mammogenesis – "the development of the mammary glands to the functional state";

c. Mammogram – "a radiograph of the breast";

[6] **Dorland's Illustrated Medical Dictionary**, p. 1101 (32nd ed. 2012) attached to the April 1, 2013 Office action. *See also* **STEDMAN'S MEDICAL DICTIONARY FOR THE HEALTH PROFESSIONS AND NURSING**, p. 936 (6th ed. 2008) (April 1, 2013 Office action).

d. Mammograph – "radiograph of the mammary gland";

e. Mammoplasia – "the development of breast tissue";

f. Mammose – "having large breasts, or mammae";

g. Mammotomy – "mastotomy";

h. Mammotrophic – "having affinity for or a stimulating effect on the mammary gland."

3. The term "CAT" is an abbreviation for "computerized axial tomography."[7] "Tomography" is defined as "a radiologic imaging that uses computer processing to generate an image of tissue density in slices through the patient's body."[8] "Computerized axial tomography" is commonly referred to as a "CAT Scan."[9]

4. The Xoran Technologies website (*xorantech.com*) advertising the xCAT ENT, "a portable, volume computed tomography system designed for high-resolution bone imaging of the sinuses, temporal bones and skull base."[10]

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[7] *Thefreedictionary.com* derived from **THE AMERICAN HERITAGE MEDICAL DICTIONARY** (2007) and **DORLAND'S MEDICAL DICTIONARY FOR HEALTH CONSUMERS** (2007) attached to the February 23, 2012 Office action.

[8] *Thefreedictionary.com* derived from **GALE ENCYCLOPEDIA OF MEDICINE** (2008) attached to the February 23, 2012 Office action. *See also Medical-Dictionary.thefreedictionary.com* attached to the February 23, 2012 Office action.

[9] *Medical-Dictionary.thefreedictionary.com* attached to the February 23, 2012 Office action. *See also RadiologyInfo.org* ("CT scanning – sometimes called CAT scanning – is a noninvasive medical test that helps physicians diagnose and treat medical conditions."); the Glen Falls Hospital website (*glennfallshospital.org*) Medical Imaging webpage (referencing "CAT Scan" as "an E-ray that scans an area one layer (slice) at a time."); Stanford Medicine website (*cancer.stanford.edu*), Diagnostic Imaging webpage ("Computed Tomography Scan (Also called a CT scan or computed axial tomography or CAT scan.)"), all attached to applicant's March 18, 2013 response to Office action.

[10] Applicant's March 18, 2013 response to Office action.

Applicant also included a copy of Registration No. 3363353 for the mark XCAT for "medical imaging devices, namely, computed tomography (CT) scanners for use in medical fields.");

5. Clarimed website (*clarimed.com*) advertising the IIuma Orthocat/Dentalcat computed tomography x-ray system.[11] Applicant also included a copy of Registration No. 3259317 for the mark ORTHOCAT for a "radiographic device for medical and dental use, namely, x-ray apparatus for medical and dental use";

6. Imaging Sciences International LLC i-CAT 3D imaging system website (*i-cat.com*) advertising i-CAT high definition 3D diagnostic imaging system.[12] Applicant also included a copy of Registration No. 4296216 for the mark I-CAT PRECISE for a "3D cone beam computed tomography dental imaging device" and Registration No. 3169125 for the mark I-CAT for "medical radiographic imaging equipment";

7. The Curve Beam website (curvebeam.com) advertising the pedCAT 3D imaging cat scan equipment specifically designed for the foot and ankle.[13] Applicant also included a copy of Registration No. 4155352 for the mark PEDCAT for "medical imaging devices, namely, compact cone beam computed tomography devices for 3-D imaging of feet in both load bearing and non-load bearing positions."

[11] Applicant's March 18, 2013 response to Office action.

[12] Applicant's March 18, 2013 response to Office action.

[13] Applicant's March 18, 2013 response to Office action

In this appeal, we have two descriptive terms – MAMMO for mammography and CAT for computerized axial tomography or CAT scan– combined to form a unitary term MAMMOCAT. When MAMMOCAT is used to identify "electromagnetic medical diagnostic and screening imaging apparatus, and medical instruments for use in performing biopsies," it means a mammographic cat scan. Both terms – MAMMO and CAT – retain their original descriptive meaning. The unitary term MAMMOCAT does not create a unique, nondescriptive term; nor does it have a bizarre or incongruous meaning. The relevant consumers do not have to exercise a multiple step reasoning process to understand the nature of the product at issue.

Applicant argues that dissecting the mark MAMMOCAT into the terms MAMMO and CAT is not the only way the mark could be parsed and that, even if one parsed the mark into the terms MAMMO and CAT, both those terms have multiple meanings which require consumers to use logic and reason to understand the nature and attributes of the product.[14] However, because the test of whether a mark is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork, consumers are going to perceive MAMMOCAT as the combination of the terms MAMMO and CAT and understand them with regard to the medical services identified by applicant.

[14] Applicant's Brief, pp. 4-8.

Applicant argues that the third-party websites and registrations showing the use and registration of CAT formative marks, particularly, ORHTOCAT and pedCAT, emphasize that marks such as MAMMOCAT are suggestive.[15] However, the Board must consider each case on its own merits. Even if some third parties have used and registered marks with characteristics similar to MAMMOCAT, the USPTO's registration of such marks does not bind the Board in deciding this appeal. *In re Nett Designs Inc.,* 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant argues that the facts in this case are similar to the facts in *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 189 USPQ 348 (CCPA 1976) where the court held that the mark BIASTEEL for tires is not merely descriptive. In *Firestone*, the court noted that BIASTEEL was a coined word, not found in any dictionary, that no one else used the term BIASTEEL to describe their tires, and that there was no evidence that BIASTEEL connotes a particular tire or class of tires. 189 USPQ at 350. The court also noted that "prior decisions in this area are not very helpful in deciding the issue of descriptiveness. The final determination is many times quite subjective." *Id.* In *Firestone,* BIASTEEL was held not merely descriptive because there was a lack of evidence of the use of BIAS and STEEL together to describe tires. However, in this case, we find that the evidence introduced by the Trademark Examining Attorney is sufficient to show that the term MAMMOCAT is, in fact, merely descriptive even though there is no

[15] Applicant's Brief, p. 8.

evidence that third parties have used the terms MAMMO and CAT together. In fact, numerous cases have held that telescoping two words which as a whole are merely descriptive of the goods into a single term does not avoid a finding of mere descriptiveness for the combined term. *See, for example, In re Omaha National*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); (FIRSTIER, the equivalent of "first tier," is merely descriptive of banking services); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897, n. 2 (TTAB 2001) ("the compound term RUSSIANART is as merely descriptive as its constituent words, 'Russian art'"); *In re U.S. Steel Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE merely descriptive of wire rope); *In re Gagliardi Bros., Inc.*, 218 USPQ 181 (TTAB 1983) (BEEFLAKES is merely descriptive of thinly sliced beef); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED is merely descriptive of jellies and jams). In this regard, we note that there is no evidence in the record that MAMMOCAT has another meaning or would be perceived as anything other than a reference to a mammography CAT scan. *See In re Cox Enterprises,* 82 USPQ2d 1040, 1043 (TTAB 2007) (there is no evidence that THEATL, which is merely a compressed version of THE ATL without the space, has any meaning other than as a reference to Atlanta); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1755 (TTAB 1991) (MULTI-VIS is merely descriptive of multiple viscosity motor oil because "'multi-' is a combining form meaning 'multiple' and 'vis' is an accepted abbreviation for 'vicosity.'").

The fact that a term is not found in a dictionary is not controlling on the question of registrability if the Examining Attorney can show that the term has a

well understood and recognized meaning. *See In re Planalytics Inc.,* 70 USPQ2d 1453, 1456 (TTAB 2004); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977). *See also In re Gould Paper Corp.,* 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (SCREENWIPE held generic based in part on dictionary definitions for the words "screen" and "wipe").

Moreover, there is no requirement that the USPTO prove actual competitor use or need; it is well established that even if an applicant is the only user of a merely descriptive term, this does not justify registration of that term. *See In re BetaBattInc.*, 89 USPQ2d 1152, 1156 (TTAB 2008); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985).

In view of the foregoing, we find that the mark MAMMOCAT for "electromagnetic medical diagnostic and screening imaging apparatus, and medical instruments for use in performing biopsies" is merely descriptive.

Decision: The refusal to register is affirmed.