

This Opinion is Not a
Precedent of the TTAB

Mailed: February 17, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re K2M, Inc.
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Serial No. 85679575
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for K2M, Inc.

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Before Bucher, Wellington, and Kuczma,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

K2M, Inc. (“Applicant”) seeks registration on the Principal Register of the
following mark:



for use on “surgical implants made of artificial materials used in spinal surgery, namely, structural members used to connect pedicle screws in a spinal construct” in International Class 10.¹ Applicant has disclaimed exclusive use of the term TECHNOLOGY.

The Trademark Examining Attorney required Applicant, under Trademark Act § 6(a), 15 U.S.C. § 1056(a), to disclaim the exclusive right to use RAIL with respect to the identified goods, on the ground that it is an unregistrable component of Applicant’s mark, because it is merely descriptive of Applicant’s goods within the meaning of Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1).

When the requirement was made final, Applicant filed this appeal. Applicant and the Examining Attorney have filed briefs, including a reply brief from Applicant.²

The Director of the U.S. Patent and Trademark Office “may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act § 6(a), 15 U.S.C. § 1056(a). The Patent and Trademark Office may require a disclaimer as a condition of registration if the term at issue is merely descriptive of any of the identified goods or services. *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

A term is merely descriptive within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature,

¹ Application Serial No. 85679575 was filed on July 17, 2012, based on a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Citations to the examination record are to the Trademark Office’s online Trademark Status and Document Retrieval system (TSDR).

function, purpose or use of the goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of 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. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Finally, and with particular relevance to this proceeding and in response to arguments raised by Applicant, we note that it is well-settled that the fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Carlson*, 91 USPQ2d 1198, 1202 (TTAB 2009); *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1156 (TTAB 2008); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

We agree with the Examining Attorney that the term RAIL is merely descriptive of the goods identified in the application and must be disclaimed. The record shows that the term RAIL, as used in Applicant's mark and in the context of the identified goods, immediately informs consumers as to the nature or a feature of Applicant's

spinal surgical implants, namely, that they utilize a rail or have a rail-shaped structural member.

A “rail” is defined as “a structural member or support.”³ The Examining Attorney argues that this definition is apt because Applicant’s goods are actually defined as “structural members” and have a rail component to them. Applicant, on the other hand, notes that the same dictionary referenced by the Examining Attorney provides other meanings for “rail” and that “[i]n light of these various definitions, the word ‘rail’ would not immediately convey to individuals in the spinal surgery field that the product is a ‘structural member.’” Reply Brief, p. 2. In particular, Applicant points out that “rail” is also defined as “a bar extending from one post or support to another and serving as a guard or barrier” and as “a bar of rolled steel forming a track for wheeled vehicles.” *Id.*

The fact that the word “rail” has multiple meanings does not mean the term cannot be merely descriptive. Rather, we consider this term in the context of the identified goods, and the question is whether someone familiar with surgical spinal implants will immediately understand the term “rail” to convey information about the implants. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002). “That a term may have other meanings in different

³ In *Merriam-Webster.com*. Retrieved February 2, 2015, from <http://www.merriam-webster.com/dictionary/rail>. 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), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). A copy of the same dictionary entry was attached to the Office Action issued on December 31, 2013.

contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012). In this regard, the evidence shows that “rail” has been used by third parties to describe spinal implants and, in particular, components of the implants for providing structural support.

The following are excerpts from two patent applications:

[Application US 2011/0190889 “Lordotic Interbody Device With Different Sizes Rails”]⁴

Abstract

A vertebral implant for installation in a disc space is disclosed that includes a body defining a first vertebral support **rail** and a second vertebral support **rail** extending along the vertical axis. Each vertebral support **rail** is separated by a channel running...

[Application US 2012/0277875 “Spinal Fusion Cage Having Post-Operative Adjustable Dimensions”]⁵

Claims

1. A spinal implant characterized by: first and second spinal attachment members that comprise at least one inclined alignment **rail** that slides over at least one inclined channel; ... said first and second spinal attachment members to slide relative to one another via said at least one inclined alignment **rail** ...

(Bold added for emphasis.)

Applicant takes issue with the probative value of these patent applications, arguing that the spinal implants described in the applications are different from

⁴ Attached to Office Action issued on November 14, 2012. The application also appears to be referenced as “Application Number 12696140” at TSDR p. 5.

⁵ *Id.* at TSDR p. 5. In addition to the first claim, the term “rail” is used repeatedly in the following claims.

Applicant's spinal implants because they "do not interconnect pedicle screws, which are located outside the disc space" or that they "refer to particular parts of the implant that allow the vertical attachment [m]embers to slide over each other." Reply Brief, p. 3. Such a distinction by Applicant, however, does not obviate the relevance of these applications for purposes of demonstrating how consumers will perceive Applicant's use of the word "rail" in its mark. In other words, the fact that the support rails referenced in these patent applications are not used in the exact same manner as Applicant's implants, *i.e.*, they do have interconnecting pedicle screws, does not change how consumers will understand the word "rail." Simply put, the term "rail" is used generically by third parties to describe a structural component of spinal implants and the term will be understood in that same manner when used in connection with Applicant's spinal implants.

Applicant has submitted a declaration of Richard Woods, its Senior Vice President for Global Research, Development & Engineering, who avers, *inter alia*, that he has twenty years of experience and has "never heard the term 'rail' used to describe a member that interconnects screws implanted into the spine."⁶ Mr. Woods further declares that it is more common and appropriate to use the term "rod" and this is reflected by competitors' use (several exhibits involving competitors' products were attached to Mr. Woods' declaration). However, as noted above in our discussion of several principles concerning what constitutes a merely descriptive term, the fact that Applicant may be the first or only user of the term RAIL in

⁶ Declaration submitted with response to Office Action filed on May 14, 2013, at TSDR p. 6.

connection with spinal implants with interconnecting screws, does not mean the term is not merely descriptive.

Applicant has also asserted that the term RAIL is unitary with the entire mark and thus is not subject to a disclaimer requirement. In particular, Applicant states that the RAIL element “forms part of the Mark’s design” and is “part of and has the same color as the circle enclosing the Mark’s inner design elements.” Reply Brief, p. 4. We disagree. To be considered a unitary mark, the RAIL element must be so merged with other elements “that the mark has a distinct meaning of its own independent of the meaning of its constituent elements.” *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (EUROPEAN FORMULA above a circular design on a dark background was not a unitary mark). Here, there is no separate commercial impression created by the combination of the term RAIL with any of the other elements in the mark. For example, Applicant has not shown how RAIL 4D is unitary. Moreover, the fact that the entire literal portion of the composite mark, RAIL 4D TECHNOLOGY, appears in the same shade of blue as the outer circling line border does not render these terms a unitary phrase. Instead, the merely descriptive meaning of the term “rail” remains intact and a disclaimer of this term is appropriate.

In sum, we find that RAIL is merely descriptive of the identified goods within the meaning of Section 2(e)(1) and is therefore an unregistrable component of Applicant’s mark under Section 6(a).

Decision: The refusal to register based on the requirement, made under Trademark Act § 6(a), for a disclaimer of RAIL is affirmed. However, this decision will be set aside if Applicant submits the required disclaimer to the Board within thirty (30) days from the date of this decision. Trademark Rule 2.142(g) and TBMP § 1218 (2014). A proper disclaimer should read as follows:

No claim is made to the exclusive right to use the word
“Rail” apart from the mark as shown.