

**THIS OPINION IS NOT A  
PRECEDENT  
OF THE TTAB**

Hearing:  
December 7, 2010

Mailed:  
April 5, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
Trademark Trial and Appeal Board

\_\_\_\_\_  
Inviro Medical Devices Ltd.  
v.  
DuoProSS Meditech Corporation

\_\_\_\_\_  
Cancellation No. 92046702  
of Registration No. 2897833; and,  
Counterclaim to cancel Registration Nos. 2970944, 2778604,  
2967982, 2944686 and 3073371

\_\_\_\_\_  
Duane M. Byers of Nixon & Vanderhye, P.C. for Inviro Medical  
Devices, Inc.

Thomas J. Moore of Bacon & Thomas, PLLC for DuoProSS Meditech  
Corporation.

\_\_\_\_\_  
Before Walters, Taylor and Mermelstein, Administrative Trademark  
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Inviro Medical Devices, Ltd. petitioned to cancel a  
registration owned by DuoProSS Meditech Corporation for the mark



for "Safety syringe for medical use."<sup>1</sup>

\_\_\_\_\_  
<sup>1</sup> Issued October 26, 2004, and claiming February 1, 2003 as the  
date of first use of the mark anywhere and July 1, 2003 as the  
date of first use of the mark in commerce.

As grounds for cancellation, petitioner has alleged that respondent's mark so resembles its previously used and registered SNAP marks, set forth below, as to be likely, when applied to the same, similar, or identical goods identified in respondent's registrations, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

Registration No. 2970944<sup>2</sup>

SNAP (in typed format) for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles";

Registration No. 2778604<sup>3</sup>

SNAP (in typed format) for "medical devices, namely, medical, hypodermic, aspiration and injection syringes";

Registration No. 2967982<sup>4</sup>

SNAP (in typed format) for "medical devices, namely, medical, hypodermic, aspiration and injection syringes";

Registration No. 2944686<sup>5</sup>

**Snap!**

for "medical devices, namely, medical, hypodermic, aspiration and injection syringes; and

---

<sup>2</sup> Issued July 19, 2005 and claiming April 2000, as the date of first use of the mark anywhere and in commerce.

<sup>3</sup> Issued October 28, 2003, Section 8 Affidavit accepted, and claiming April 2000, as the date of first use of the mark anywhere and in commerce.

<sup>4</sup> Issued July 12, 2005 and claiming April 2000, as the date of first use of the mark anywhere and in commerce.

<sup>5</sup> Issued April 26, 2005 and claiming April 2000, as the date of first use of the mark anywhere and in commerce.

Registration No. 3073371<sup>6</sup>

SNAP SIMPLY SAFER (in standard characters) for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes.

Respondent has denied the essential allegations in the petition for cancellation and has filed counterclaims to cancel petitioner's pleaded registrations. As grounds for the counterclaims, respondent has alleged that each of petitioner's SNAP marks is "merely descriptive" of the goods identified in the registration, and has not acquired distinctiveness. In addition, respondent alternatively alleges, with regard to the marks in Registration Nos. 2944686 and 3073371, that the term "Snap" in each mark merely describes the goods of the registration, has not acquired distinctiveness and, in the absence of a disclaimer of "Snap," was granted contrary to the requirements of 15 U.S.C. § 1052 (e)(1). Finally, with regard to Registration No. 2967982, respondent additionally alleges that it appears to be a duplicate of Registration No. 2778604. Petitioner has denied the salient allegations of the counterclaims.<sup>7</sup>

---

<sup>6</sup> Issued March 28, 2006 and claiming June 1, 2003, as the date of first use of the mark anywhere and in commerce.

<sup>7</sup> Although petitioner did not assert any formal affirmative defenses, we consider respondent to have been put on notice of petitioner's assertion of acquired distinctiveness, based on its denials of respondent's allegations that petitioner's involved marks (the subject of Registration Nos. 2970944, 2778604, 2967982, 2944686 and 3073371) have not acquired distinctiveness.

On April 20, 2009, petitioner filed an unconsented withdrawal of its petition for cancellation. The petition was dismissed with prejudice on April 30, 2009 order. However, respondent elected to continue to prosecute the counterclaims to cancel petitioner's pleaded registrations. Thus, respondent's counterclaims are the only claims considered in this final decision.

In addition, a review of Registration No. 2967982 reveals that it is indeed a duplicate of Registration No. 2778604. Indeed, petitioner has indicated in its brief that Registration No. 2967982 "appears to be duplicative of Inviro's Registration No. 2778604, because of the USPTO's apparent error in creating duplicative child applications. Inviro is willing to surrender the '982 registration if the Board believes it is appropriate to do so." Br. pp. 1 at fn.1 and 25. Because the Office does not issue duplicate registrations,<sup>8</sup> and because petitioner by agreeing to surrender the registration has essentially consented to judgment on this claim, we sustain respondent's counterclaim against Registration No. 2967982 on the ground that it is a

---

In any event, the record shows that the claim clearly was tried by the consent of the parties. See Fed. R. Civ. P. 15(b).

<sup>8</sup> See TMEP Section 703. (7<sup>th</sup> ed. 2010).

duplicate registration.<sup>9</sup> The registration will be cancelled in due course.

Further, we note that although respondent is the "plaintiff" in the counterclaims to cancel petitioner's pleaded registrations, and petitioner is the "defendant," we will continue to refer to the petitioner/defendant as "petitioner" and to the respondent/plaintiff as the "respondent" throughout this opinion.

#### **EVIDENTIARY OBJECTIONS**

Petitioner objects to the documents attached to respondent's notice of reliance no. 2, consisting of screen shots taken of several web pages from the website [www.inviromedical.com](http://www.inviromedical.com), as well as any "use" of them in respondent's trial brief. Petitioner contends that the materials were not produced during discovery, do not include any indication of when they were printed or their full internet address, were not otherwise properly authenticated and constitute hearsay under Fed. R. Evid. 802. Petitioner also objects to respondent's notice of reliance no. 1, which consists of excerpts from a declaration of petitioner's testimony witness, Dr. Fraser Rosslyn Sharp (also referred to as Dr. F. Ross Sharp), the founder and a director of petitioner, submitted in connection with petitioner's motion

---

<sup>9</sup> Consequently, the counterclaim to cancel Registration No. 2967982 on the ground of mere descriptiveness is moot.

for summary judgment. Petitioner contends that the excerpts are not sufficient to authenticate the documents submitted under respondent's notice of reliance no. 2, and that it is improper to try to use a declaration rather than actual trial testimony from Dr. Sharp.

In response to petitioner's objections, respondent contends that Dr. Sharp testified that the Inviro Group, consisting of petitioner, Inviro Medical Inc. in the United States and Inviro Medical Inc. in Canada, controls the website at Inviromediacal.com. Reply br. p. 4 citing Sharp test. p. 56. Respondent thus maintains that the statements in web pages from Inviromedical.com should be attributed to the owner of the registrations [i.e., petitioner].

In *Safer, Inc. v. OMS Investments, Inc.* 94 USPQ2d 1031 (TTAB 2010) (decided after submission of respondent's notice of reliance), the Board changed its practice regarding authentication of internet evidence, holding that a document obtained from the internet may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e), so long as the date the internet document was accessed as well as its source (the internet address or URL) are provided and the party filing the notice of reliance indicates the general relevance of the document. Because the website respondent accessed is identified, we are

not particularly troubled by the incomplete address shown in the address line of some of the screen shots and find that the screen shots sufficiently identify the source of the web pages. We also find that respondent has indicated the relevance of the material. However, there is no indication in the notice of reliance or on the documents themselves as to when they were retrieved. Accordingly, even under *Safer's* more liberal authentication practice, the documents are not admissible by notice of reliance.

With regard to the excerpts from Dr. Sharp's summary judgment declaration, although they ordinarily are inadmissible under a notice of reliance in the absence of a stipulation in the record that any trial testimony may be submitted by declaration, we consider them admissible as an admission pursuant to Fed. R. Evid. 801(d)(2)(A)-(D). In any event, the information imparted in those statements regarding Dr. Sharp's position with petitioner and that the SNAP marks are used on petitioner's website, [www.inviromedical.com](http://www.inviromedical.com), was reiterated during Dr. Sharp's testimony deposition.

Furthermore, Dr. Sharp, on cross-examination during his testimony deposition, additionally indicated that the website [www.inviromedical.com](http://www.inviromedical.com) was controlled by the Inviro group which includes petitioner. Indeed, it is quite telling that petitioner did not deny that these web pages were from its website. Because petitioner has admitted that it is a member

of the Inviro group and that the Inviro controls the content of the website, [www.inviromedical.com](http://www.inviromedical.com), we consider the information imparted in the web pages as an admission by petitioner. See Fed. R. Evid. 801(d)(2)(A)-(D).

Accordingly, petitioner's objections to respondent's notice of reliance Nos. 1 and 2 are overruled and we have considered the Sharpe declaration excerpts and the web pages for whatever probative value they may have.<sup>10</sup> We hasten to add that this evidence is not material to our decision; it merely confirms and is cumulative of the other evidence of record. That is, our decision would be the same regardless of whether we consider this evidence.

#### **THE RECORD**

By operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the record includes the pleadings and the files of petitioner's pleaded registrations.

During its assigned testimony period, respondent, as plaintiff in the counterclaim, introduced a notice of reliance on excerpts from a declaration of one of its directors, a notice of reliance on web pages taken from the website [www.inviromedical.com](http://www.inviromedical.com), and a notice of reliance on a

---

<sup>10</sup> Respondent indicated in its notice of reliance no. 2 that it is additionally relying on the web pages to show that petitioner has abandoned the use of the trademark SNAP. We have not considered the web pages for that purpose as the issue of abandonment is irrelevant to respondent's claims of mere descriptiveness at issue in this proceeding.



certified copy, showing current title and status, of its Registration No. 2897833 (the subject of the original petition to cancel). Respondent also introduced Exhibits A-D (consisting of a second copy of its Registration No. 2897833 and package inserts and instructional labels for syringes sold under petitioner's SNAP marks) during its cross-examination of petitioner's testimony witness, Dr. F. Ross Sharp.<sup>11</sup>

During its assigned testimony period, petitioner, as defendant in the counterclaim, introduced a notice of reliance on the deposition transcript of Dr. F. Ross Sharp with exhibits 1-10 and 1A and copies of registration certificates for its involved registrations, Nos. 3073371, 2967982, 2778604, 2944686 and 2970944, and portions of their file histories, and the testimony of F. Ross Sharp<sup>12</sup>, with exhibits 1-10 and 1A (consisting of a copy of a request for

---

<sup>11</sup> In addition, respondent's notice of reliance no. 4 on a copy of requests for admission to petitioner from respondent was stricken in an order issued August 20, 2009.

Petitioner also made several objections during the cross-examination of Dr. Sharp. However, petitioner did not reiterate these objections in its brief and, accordingly, they are considered waived.

<sup>12</sup> Although the entire transcript is marked as Confidential/Attorney's Eyes Only, respondent indicated in its brief that only pages 48-51, 53, 62-65 and 67-69 are so designated. Petitioner did not indicate otherwise and, in fact, referred to much of the deposition in its brief. Accordingly, for purposes of this decision, we treat the deposition as non-confidential except as noted above. However, within twenty days of the mailing date of this decision, petitioner must file a redacted copy of the deposition for the public record, failing which the entire deposition will be made available for public viewing.

reconsideration filed on February 6, 2002, in connection with application Serial No. 76975648 which matured into involved Registration No. 2778604, copies of the registration certificates for its pleaded registrations, a photograph of a syringe bearing the SNAP trademark,<sup>13</sup> a copy of packaging bearing the SNAP! and design trademark, a copy of respondent's notice of rebuttal trial deposition and a copy of stipulation for trial deposition in Canada).

Both respondent and petitioner filed briefs and respondent filed a reply brief. An oral hearing was held on December 7, 2010.

#### **STANDING**

Petitioner's filing of a petition for cancellation against respondent, since withdrawn, is sufficient to demonstrate respondent's interest in its counterclaims to cancel petitioner's pleaded registrations, and therefore to establish its standing. See, e.g., *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons, Inc.*, 14 USPQ2d 1879, 1880-1881 (TTAB 1990) (opposer, the party who originally brought the proceeding and put the validity of its registration at issue, may not deprive applicant of its standing by withdrawing its opposition); and *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840 (TTAB 1979).

#### **MERE DESCRIPTIVENESS/ARGUMENTS AND EVIDENCE**

---

We first consider respondent's claim that all of petitioner's marks, i.e., SNAP, **Snap!**, and SNAP SIMPLY SAFER, merely describe the medical devices, namely cannulae; medical, hypodermic, aspiration and injection needles; and medical, hypodermic, aspiration and injection syringes, identified under the marks. Respondent contends, with respect to all of the marks, that they are descriptive because SNAP immediately conveys important features of the goods, namely that the user of the syringes must snap off the plunger in order to achieve the primary purpose of preventing needle stick injuries, and that "[t]he syringes are a snap to use, as Dr. Sharp testified." Br. pp. 21-25.

With respect to the **Snap!** mark, respondent additionally argues:

The design portion of the trademark comprises an exclamation point with the upper portion tilted at about a 45 degree angle to the right, and with two accent marks at the left side of the space between the upper portion and the lower portion of the exclamation point. This clearly conveys the step of snapping off the plunger. Thus the entire trademark, both the word and design, are merely descriptive of the goods.

Br. p. 24.

With respect to the SNAP SIMPLY SAFER mark, respondent additionally argues:

The word SIMPLY immediately conveys the features and use of the goods. The syringes

---

<sup>13</sup> The trademark is not clearly visible in the copy.

are easy to use. Sharp transcript at page 32, line 19. The word SAFER immediately conveys a characteristic of the goods. The goods were designed to be safer and prevent needle stick injuries. The combination of these three clearly descriptive words into a single trademark SNAP SIMPLY SAFER has but one significant commercial impression, namely, the trademark immediately conveys the characteristics, features, purposes and uses of the safety syringes.

Br. p. 25.

As evidentiary support, respondent has submitted copies of package inserts and disabling instructions used in connection with petitioner's goods, reproduced below:



14

<sup>14</sup> Sharp test. exh. B. Respondent's submission consists of a single page with six identical inserts printed thereon. We have only reproduced only a single insert.

### SNAP! Disabling Instructions

After dose is delivered, WITH PLUNGER FULLY DEPRESSED activate safety mechanism:

1. **ROTATE PLUNGER CLOCKWISE ONE HALF TURN** to release needle.
2. **PULL BACK ON PLUNGER UNTIL IT STOPS** observing withdrawal of needle into the barrel.
3. **SNAP OFF PLUNGER!** permanently disabling syringe.

### Syringe Disposal

**Discard the used Inviro SNAP! Safety Syringe in an appropriate safety disposal container.**

Part # PP-0014-00, Rev #B



SNAP SIMPLY SAFER

15



Respondent also submitted excerpts from petitioner's website, [www.inviomedical.com](http://www.inviomedical.com). Produced below is the page discussing the "snap" disabling feature:



16

<sup>15</sup> Sharp test. exh. D. We note that exhibit C is almost identical to exhibit B; the main difference is in the shading of the illustrations.

<sup>16</sup> Resp. not. of rel. no. 2.

In response, petitioner contends that respondent has not met its burden of showing that its SNAP, **Snap!**, and SNAP SIMPLY SAFER marks are merely descriptive. Respondent particularly argues:

[T]here is an element of incongruity between the meaning of "snap" and its use in connection with Inviro's products. While the term snap, when used in the idiom "it's a snap" connotes ease of doing something, use of the mark is creative in that it requires the consumer to consider "snap" in its slang connotation to come to that conclusion and the public would have to connect the innovative design of the products to their ease of use. The product itself is not "easy." Rather, the innovative design results in the user's experience being easier.

Br. p. 15. Petitioner also explains with regard to the disabling feature

Inviro's safety syringes under its SNAP marks utilize a plunger that is easily breakable and that makes the product safe to use. There is a recessed or weakened portion of the plunger that, upon pressure by the nurse, breaks and keeps the needle within the barrel portion of the syringe so that the nurse is not stuck by a used needle. This "easy to use" product (which is therefore, "a snap to use") prevents needle stick injuries by easily trapping the used needle inside the syringe barrel after its use. Inviro's products do not contain any snap cover, retractable snap spring, snap assembly or stretched elastomer that snaps back.

Br. p. 15. Petitioner further argues that by its use of the term SNAP on its website, it has "played upon" its SNAP

trademark and has suggestively referred to the easily breakable action of the syringe plunger.<sup>17</sup>

Petitioner also contends that while the record contains "ample" evidence of trademark use of its SNAP, **Snap!** and SNAP SIMPLY SAFER marks and thus its marks would be perceived as source identifying, the record does not contain empirical evidence showing that consumers perceive the marks as descriptive; and that the registration by the USPTO of other SNAP marks for various medical equipment in Class 10, without requiring a disclaimer of the term SNAP or proof of secondary meaning, as well as the lack of third party uses of the term "snap" to describe safety syringes, supports petitioner's position that SNAP is not descriptive.<sup>18</sup>

With respect to the mark **Snap!**, petitioner additionally argues that its mark, as a whole, is not a

---

<sup>17</sup> This argument is not especially helpful in the absence of examples of how the mark is used on petitioner's website, including how a "marketing spin" apparently "play[s] upon" the SNAP trademark when suggestively referring to the breakable portion of applicant's syringe plunger.

<sup>18</sup> Petitioner arguments that respondent's use of its BAKSNAP and design mark infringes on its marks and trades on its goodwill will not heard in light of petitioner's withdrawal of its petition for cancellation, notwithstanding petitioner's claim that the poor economy caused it to abort its action. In any event, the Board does not hear infringement matters as its jurisdiction is limited to the right to registration.

In addition, petitioner's arguments that the European Union Trademark Office approved its application for registration of its SNAP mark without a descriptiveness refusal is unavailing; we are concerned with the perception of petitioner's marks in the United States. *Miles Labs., Inc. v. Int'l Diagnostic Tech., Inc.*, 220 USPQ 438, 445 (TTAB 1983) (foreign registrability determinations irrelevant).

visual representation of its syringes or a significant characteristic of them. The mark is a "suggestive play on the idiom 'it's a snap', which requires a customer to recognize the innovative design of the product and to understand why it is relatively easy to use. The design elements ... simply reinforces [sic] the word 'snap.'" Br. p. 20.

With respect to the SNAP SIMPLY SAFER mark, petitioner additionally argues that the commercial impression of the mark is susceptible to more than one connotation and is not merely descriptive, but rather suggestive. Petitioner explains that consumers of its goods would have to go through a thought process linking the innovative design to the "ease of use" characteristic to come to that conclusion.

Last, petitioner argues that even if its SNAP marks are found to be merely descriptive, the SNAP marks have acquired distinctiveness. As support for its claim, petitioner has submitted the testimony of its founder and a current director, Dr. F. Ross Sharp. In his deposition, Dr. Sharp stated that petitioner has used its SNAP and **Snap!** marks with its products continuously since 2000.<sup>19</sup> Sharp test. p.

---

<sup>19</sup> Although petitioner, in its brief, contends that it has used the SNAP and SNAP! and design mark since April 2000, and April 2000 is claimed as the date of first use of the mark in petitioner's Registration Nos., when Dr. Sharp was asked "[h]ow long has Inviro used the SNAP trademarks with its various products," he responded "I think since about 2000." Sharp test.



43. Dr. Sharp also stated that petitioner prominently "used" the marks in various ways, including on the products themselves, labels and packaging for the products, instructional sheets for the products, informational brochures, product lists, websites and instructional videos, as well as in presentations to syringe manufacturers in the U.S., Europe and Asia, major pharmaceutical companies, philanthropic organizations, hospital groups, individual hospitals, nurses, clinics, financial institutions, interested prominent citizens and major purchasing groups and distributors. Sharp test. pp. 38, 40-42 and 45, exhs. 7, 8, B, C and D. Dr. Sharp further stated that there are millions of syringes sold each year bearing the SNAP trademark and that petitioner has spent a lot of time and money publicizing its SNAP marks in connection with the need for safer syringes. Sharp test. pp. 43-44.

---

p. 43. Under these circumstances, we consider petitioner to have proven use of its mark since December 31, 2000. Cf. EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc., 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period); and Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905, 911 n.2 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969, is the date of first use).

Petitioner also states that it has used its SNAP SIMPLY SAFER mark since 2003. Although Dr. Sharp, during his deposition, read from the registration certificate (No. 3073371) and indicated that it "states the first use date as April, 2000 and in commerce April, 2000," he personally did not attest to those dates. As such, the asserted first use date for petitioner's SNAP SIMPLY SAFER mark has not been demonstrated. This failure, however, is not outcome determinative.

Petitioner supported its position with the testimony, and exhibits identified, *supra*, of its founder and a director, Dr. F. Ross Sharp, who primarily attests to the circumstances surrounding the founding of petitioner, the development of petitioner's cannulae, syringes and needles, the adoption and intended connotation of petitioner's involved SNAP marks and the circumstances concerning the use of the SNAP marks since their adoption.

#### **Applicable Law**

A term is merely descriptive of goods, and therefore unregistrable under Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's or registrant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a particular term is merely descriptive is determined not in the abstract, but in

---

relation to the goods for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use. In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002) ("The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.").

In the case before us, in issue are marks that consist of a single-word, include a design, and are in the nature of a slogan. With particular regard to the design-included mark, a visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under Section 2(e)(1) of the Act. See In re Society for Private and Commercial Earth Stations, 226 USPQ 436 (TTAB 1985) (representation of satellite dish held merely descriptive of services of an association promoting the interests of members of the earth station industry); In re Underwater Connections, Inc., 221 USPQ 95 (TTAB 1983) (pictorial representation of a

---

compressed air gas tank held merely descriptive of travel tour services involving underwater diving).

With respect to the slogan, a slogan, phrase or any other combination of words may act as a trademark so long as the slogan or combination is used in such a way as to identify and distinguish the user's goods or services from those of others. However, a slogan or phrase may be merely descriptive and, thus, unregistrable on the Principal Register in the absence of acquired distinctiveness, if it directly refers to a characteristic of the goods with which it is used. The mere descriptiveness analysis is the same for a slogan as it is with any other proposed mark. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §7:22 (4<sup>th</sup> ed. updated 2009).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, 200 USPQ at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a

mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

The burden of persuasion in this case rests with respondent, who claims that petitioner's marks are descriptive, and respondent must overcome the registrations' presumptions of validity by a preponderance of the evidence. *Cold War Museum, Inc. v. Cold War Air Museum, Inc.* 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009). Once this is established petitioner bears the burden of establishing acquired distinctiveness. Cf. *Yamaha Intl. Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004-1008 (Fed. Cir. 1988) ("Furthermore, the applicant has the ultimate burden of showing acquired distinctiveness regardless of whether the lack of inherent distinctiveness or the applicability of Section 2(e) was shown by opposer during the opposition or conceded by the applicant prior to the opposition."). In this regard, petitioner must show that its marks had acquired distinctiveness by their dates of registration. *Harsco Corp. v. Electrical Sciences Inc.*,

9 USPQ2d 1570, 1571 (TTAB 1988) ("We believe that the critical date is the date of registration, because if a mark which is not registrable in the absence of proof of distinctiveness was not in fact distinctive at the time of the issuance of a registration thereof, then the registration was invalidly issued."). Finally, "the greater degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." In re Bongrain Int'l (Am.) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990).

#### **Findings of Fact**

Based on the record, we find the following facts. Petitioner, based on a concern by petitioner's founder and a nurse he was working with over the "terrible toll" of infectious diseases to healthcare workers, "developed a number of different types of safety syringes." Sharp test. p. 12-13 and 17. These syringes include those of the type identified under the SNAP marks. Sharp test. p. 61. The syringes come with instructional labels entitled "SNAP! Disabling Instructions," which state, in part, "3. Snap off plunger." Sharp test. p. 59-61 and exhs. C and D. Package inserts for the syringes filed as specimens in the underlying application for Registration No. 29444686 states, in part: "3. SNAP OFF PLUNGER!." Petitioner's website prominently pictures a broken plunger and the word "Snap."

Petitioner's witness, Dr. Sharp, testified that ... "the disabling of the syringe involved a number of steps, one of them is breaking the plunger." Sharp test. p. 61. The word "snap" is defined as 4: To break suddenly : break in two."<sup>20</sup>

### Decision

#### SNAP - Registration Nos. 2778604 and 2970944

Based on these findings, we hold that the term SNAP merely describes a significant feature or function of petitioner's cannulae, syringes and needles, namely that to safely disable them, one must snap off the plunger.

Despite acknowledging that its "safety syringes under its SNAP mark utilize a plunger that is easily breakable and that makes the product safe to use,"<sup>21</sup> petitioner insists that "there is no true snap feature of Inviro's products" and, therefore, its SNAP marks are not merely descriptive. Br. p. 15. Instead, according to petitioner, its mark is intended to convey "ease of use," i.e., that petitioner's syringes are a "snap to use." Br. p. 6, Sharp test. 28-30. Because we have found that SNAP clearly has a merely

---

<sup>20</sup> Merriam-Webster Online Dictionary, 11<sup>th</sup> Edition, [www.merriamwebster.com/dictionary/snap](http://www.merriamwebster.com/dictionary/snap), retrieved March 21, 2011.

The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Foot Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>21</sup> Br. p. 15.

descriptive meaning in relation to petitioner's goods, we construe this statement by petitioner as an assertion that petitioner's SNAP mark has a second meaning that is non-descriptive and, is therefore, registrable. See *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994). We thus consider whether SNAP has a second meaning that evokes a double meaning such that purchasers will readily appreciate that the mark is a double entendre.

"Double entendre" is defined as "ambiguity of meaning arising from language that lends itself to more than one interpretation." Webster's Third New International Dictionary (1993) at p. 678. As stated in TMEP § 1213.05(c) (emphasis supplied), "[a] 'double entendre' is a word or expression capable of more than one interpretation. For trademark purposes, a 'double entendre' is an expression that has a double connotation or significance *as applied to the goods or services*. ... The multiple interpretations that make an expression a 'double entendre' must be associations that the public would make fairly readily, and *must be readily apparent from the mark itself*."

A mark thus is deemed to be a double entendre only if both meanings are readily apparent from the mark itself. If the alleged second meaning of the mark is apparent to purchasers only after they view the mark in the context of advertising materials or other matter separate from the mark



itself, then the mark is not a double entendre. See *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (THE GREATEST BAR held laudatory and merely descriptive of restaurant and bar services; the Board stating that "[i]f the alleged second meaning of the mark is apparent to purchasers only after they view the mark in the context of the applicant's trade dress, advertising materials or other matter, then the mark is not a double entendre"); and *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSSERVICE held merely descriptive for banking services, despite applicant's argument that the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association).

Here, although petitioner upon adoption of its SNAP mark may have intended that the mark convey the meaning "ease of use" in regard to its cannulae, syringes and needles,<sup>22</sup> there is no indication in the record that purchasers of petitioner's goods would, upon seeing the mark itself, understand this meaning. Further, while the record reflects that petitioner promotes the ease of use of the design of its goods, and includes some evidence that at one time some nurses recognized such ease of use, this evidence predates petitioner's adoption of its SNAP mark and, additionally, has little probative value as to how the mark,

---

<sup>22</sup> Sharp test. pp. 18-32, and exh. 1A.

and not the goods, is perceived by the relevant purchasing sector. Moreover, as petitioner affirmatively stated in its brief:

While the term snap, when used in the idiom "it's a snap" connotes ease of doing something, use of the mark is creative in that it requires the consumer to consider "snap" in its slang connotation to come to that conclusion and the public would have to connect the innovative design of the products to their ease of use.

Br, p. 14. Because of the incongruity in the "ease of use" meaning that may be attributed to SNAP in relation to petitioner's goods, purchasers of petitioner's cannulae, syringes and needles would not, upon seeing the mark SNAP itself, readily understand this connotation. Accordingly, the mark is not a double entendre.<sup>23</sup>

We next consider petitioner's claim that its SNAP mark has acquired distinctiveness. Evidence of acquired distinctiveness can include the length of the use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. See *In Re Bongrain*, supra. Here, petitioner used the mark for less than five years prior to either registration date. Accordingly, the presumptions of acquired distinctiveness pursuant to Trademark Act Section 2(f) do not attach. See

---

<sup>23</sup> We thus find respondent's contention that the mark is "doubly descriptive," because it also describes a second significant attribute of petitioner's goods, namely that they are a snap to use, unpersuasive.

15 U.S.C. § 1052(f). The record contains no evidence of advertising expenditures, surveys or affidavits from third-parties asserting source recognition. Further, although petitioner indicated that millions of syringes bearing the SNAP trademarks are sold each year, that figure is without any context, such as market share and, thus, is not particularly probative. Similarly, petitioner's blanket statement regarding the various ways it uses its SNAP marks has little value. That is, petitioner has not explained the extent of the exposure, such as length of time, or how such exposure translates into source-identifying recognition. Notably, exhibit No. 7, the only exhibit of record purportedly showing use of the SNAP trademark (alone) on or in connection with the goods is illegible. Petitioner's evidence simply fails to establish the creation of any secondary meaning in its SNAP mark as of the date of registration.

With respect to petitioner's reliance on various third-party registrations of marks for medical devices that do not include disclaimers of the term "SNAP," we note that each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and the determination of registrability of those particular marks cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ 1564, 1566

(Fed. Cir. 2001). See also, TMEP §1213.01(a) regarding USPTO disclaimer policy.

Last, the fact that petitioner may be the first and only user of a merely descriptive designation does not justify registration if the significance conveyed by the term is merely descriptive. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). Moreover, it is not necessary that the term be in common usage in a particular industry before it can be found to be merely descriptive. See *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

In sum, based on this record, respondent has established that the designation SNAP as used on medical devices, namely cannulae, syringes and needles, is merely descriptive and petitioner has not established that SNAP has acquired distinctiveness in connection with the identified goods.

Registration No. 2944686

We find unavailing respondent's arguments that the mark **Snap!** as a whole is merely descriptive. First, the mark is not merely a visual representation of applicant's cannulae, syringes and needles, or of a significant characteristic thereof. Although it includes the merely descriptive literal element SNAP, the design element does not consist of a realistic depiction of a breaking syringe.

Rather, the design is of a fanciful exclamation point with the upper portion tilted at about 45 degrees to the right, and with two accent marks at the left side of the space between the upper portion and the lower portion of the exclamation point. This fanciful design only suggests the breaking of something. We thus find that the mark, as a whole, is not a merely descriptive illustration of an important feature or characteristic of applicant's cannulae, syringes and needles.

Registration No. 3073371

We likewise find that respondent has failed to establish that the mark SNAP SIMPLY SAFER merely describes a significant characteristic, feature or function of petitioner's cannulae, syringes and needles. We agree with respondent and find, for the reasons discussed above, that the word "Snap" merely describes a significant feature or function of petitioner's goods. The word "Safer" may also be suggestive. However, we are not persuaded on this record that the term "Simply" merely describes an attribute of petitioner's goods. Moreover, the combination of the terms "Simply" and "Safer" not only creates a rhyming pattern that results in a distinctive impression separable from the word "Snap," but also forms a phrase that does not merely impart information about a significant characteristic of the goods. Rather, the term "Simply" modifies "Safer" such that the

phrase SIMPLY SAFER may be perceived as a general claim of superiority regarding the safety of petitioner's syringes and thus amounts to puffery.<sup>24</sup> When the term SNAP is combined with the phrase SIMPLY SAFER to create the combined phrase SNAP SIMPLY SAFER, the phrase SIMPLY SAFER modifies the term SNAP, yet still imparts that same broad claim of superiority, only this time relating to the specific plunger-breaking feature of petitioner's goods described by the term "Snap." While "SNAP SIMPLY SAFER" may have some suggestive significance, the record fails to establish that it would be perceived by the purchasing public as merely descriptive of a particular characteristic of petitioner's cannulae, syringes and needles. That is to say, only after some degree of thought, imagination or a multistage reasoning process would a purchaser encountering cannulae, syringes and needles sold under the mark SNAP SIMPLY SAFER believe that the mark, as a whole, merely describes something specific about petitioner's cannulae, syringes and needles.

For these reasons, we find that respondent has failed to carry its burden to show that members of the purchasing

---

<sup>24</sup> See McCarthy On Trademarks and Unfair Competition §27:38 (2009) ("'Puffing' is exaggerated advertising, blustering, and boasting upon which no reasonable buyer would rely and is not actionable under § 43(a). 'Puffing' may also consist of a general claim of superiority over a comparative product that is so vague, it will be understood as a mere expression of opinion").

public will view petitioner's mark SNAP SIMPLY SAFER as merely describing a feature, characteristic or quality of petitioner's goods.

**WHETHER A DISCLAIMER OF SNAP IS REQUIRED IN REGISTRATION NOS. 2944686 and 3073371**

We now consider respondent's alternative claim that Registration Nos. 2944646 and 3073371 should be cancelled because the subject marks were granted contrary to the requirements of 15 U.S.C. § 1052(e)(1), because the term "Snap" in the marks is merely descriptive of the goods, has not acquired distinctiveness, and there is no disclaimer of "Snap."

"The Director may require the applicant [or registrant] to disclaim an unregistrable component of a mark otherwise registrable." Section 6 of the Trademark Act of 1946, 15 U.S.C. §1056. However, if the purportedly unregistrable component is part of a unitary mark, a disclaimer is not required. TEMP §1213.05 (5<sup>th</sup> ed. 2007).

A mark or portion of a mark is considered 'unitary' when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements.

TEMP §1213.05. In other words, a composite mark is unitary when its components create a single and distinct commercial impression or an inseparable whole. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 221 USPQ2d 1047, 1052

(Fed. Cir. 1991) (the mark has a distinct meaning of its own independent of its component parts). If the mark is unitary, then it cannot be divided into registrable and unregistrable parts. When the composite mark is a unitary mark, a disclaimer is not necessary because the purportedly descriptive matter does not comprise an unregistrable component of a mark otherwise registrable. *Dena Corp. v. Belvedere International Inc.*, 221 USPQ2d at 1051-1052.

Whether a composite mark is unitary is a subjective determination based on the commercial impression engendered by mark. *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). *See also Dena Corp. v. Belvedere International Inc.*, 221 USPQ2d at 1052; *In re Magic Muffler Service, Inc.*, 184 USPQ 125, 126 (TTAB 1974) (the determination of whether a mark is unitary is based on reaction of the average purchaser to the display of the mark).

Registration No. 2944686

With respect to the **Snap!** mark, we find that the visual presentation of the literal and design elements combine to form a unitary whole. We find so because they are on the same plane, are in the same font and are located next to one another without any spacing. *See e.g.*, TMEP §1213.05(f) (7<sup>th</sup> ed. 2010), and the authorities cited therein. Accordingly, no disclaimer is required and



respondent's claim for cancellation based on the absence of a disclaimer is dismissed with prejudice.

Registration No. 3073371

With respect to the mark SNAP SIMPLY SAFER, for the reasons enumerated above, we are not persuaded that combining the individual terms "SNAP," "SIMPLY," and "SAFER" into the composite SNAP SIMPLY SAFER results in a phrase that is more than the sum of its parts, such that the word SNAP need not be disclaimed. That is, the descriptive significance of the term "SNAP" is not lost in the term as a whole. We find it severable and, accordingly, a disclaimer of SNAP is required. *Cf.*, *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006) (GALA ROUGE for wine not unitary; requirement for disclaimer of "ROUGE" affirmed); *In re IBP, Inc.*, 228 USPQ 303 (TTAB 1985) (IBP SELECT TRIM for pork considered not unitary; refusal of registration in the absence of a disclaimer of "SELECT TRIM" affirmed); and *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (PHACTS POCKET PROFILE, for personal medication history summary and record forms, considered not unitary; refusal to register in the absence of a disclaimer of "POCKET PROFILE" affirmed).

For those reasons, respondent's claim that the mark SNAP SIMPLY SAFER is improperly registered in the absence of a disclaimer of SNAP is sustained.

**Decision:** The counterclaim against Registration No. 2967982 on the ground that the registration is a duplicate of Registration No. 2778604 is sustained and Registration No. 2967982 will be cancelled in due course.

The counterclaims against Registration No. 2944686 for the mark **Snap!** on both the grounds of mere descriptiveness and that the mark is improperly registered in the absence of a disclaimer are dismissed with prejudice.

The counterclaims against Registration Nos. 2778604 and 2970944, both for the mark SNAP, on the ground that the mark is merely descriptive are sustained and Registration Nos. 2778604 and 2970944 will be cancelled in due course.

The counterclaim against Registration No. 3073371 for the mark SNAP SIMPLY SAFER on the ground that the mark as a whole is merely descriptive is dismissed with prejudice. The alternative counterclaim on the ground that the mark is improperly registered in the absence of a disclaimer of SNAP is sustained. However, if petitioner submits a disclaimer of SNAP within twenty days of the mailing date of this decision, the decision as to Registration No. 3073371 will be set aside.<sup>25</sup>

---

<sup>25</sup> The standard printing format for the required disclaimer text is as follows: No claim is made to the exclusive right to use "Snap" apart from the mark as shown. TMEP 1213.08 (a)(i) (5<sup>th</sup> ed. 2007).