

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

NOVEMBER 17, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Olympus America Inc.**

Serial No. 74/482,275

Edward W. Greason, William T. Boland, Jr. and Allen J. Baden of
Kenyon & Kenyon for applicant.

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Before Sams, Hanak and Hohein, Administrative Trademark Judges.

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

Olympus America Inc. has filed an application to
register the term "BX" for "microscopes."¹

¹ Ser. No. 74/482,275, filed on January 24, 1994, which alleges a date of first use anywhere of January 27, 1993 and a date of first use in commerce of April 22, 1993.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the term "BX" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.² We reverse the refusal to register.

The Examining Attorney, relying upon a listing of the term "BX" in 1 Acronyms, Initialisms & Abbreviations Dictionary (18th ed. 1994) at 555 as meaning "Biopsy [*Medicine*]" and nine excerpts from a search of such term in the Lexis/Nexis "MEDLINE" database³ in which it is used as a shorthand for "biopsy,"⁴

² Applicant, in a communication filed with a certificate of mailing dated August 1, 1996, indicated that "it previously has submitted a Request for Oral Hearing of Appeal (filed December 20, 1995)," no such request is in the record file. Nevertheless, inasmuch as applicant's communication was submitted within the time permitted for requesting an oral hearing, the Board on October 22, 1996 issued an order scheduling an oral hearing in this matter for March 20, 1997 at 10:00 a.m. Neither applicant's counsel nor the Examining Attorney, however, entered an appearance, so the scheduled hearing was canceled.

³ The following examples (**emphasis added**) are representative:

[P]redictors of progression of IgA nephropathy (IgAN) were investigated by multivariate life table analysis, using Cox's proportional hazard model, in 225 patients with IgAN diagnosed by renal **biopsy (Bx)**. . . . Mean age at **Bx** was 32.5 years. -- Clinical Nephrology, April 1994; and

[P]atients were divided into the following two groups: Group A . . . cases in which there were fewer intraglomerular C3-D at the second **biopsy (2nd- Bx)** than at the first **biopsy (1st- Bx)**; and Group B . . . , those in which the amount of C3-D at the 2nd- **Bx** was greater than or equal to that at the 1st- **Bx**. -- American Journal of Kidney Disease, March 1994.

argues that as applied to microscopes which are used, inter alia, for viewing biopsy specimens, it is clear that "the term 'BX' has recognized generic significance as an acronym equivalent of the term 'biopsy.'" In view thereof, and since applicant's goods "are expensive, specialized instruments of little or no use to those without the medical, scientific and/or technical training and expertise required for their use," the Examining Attorney maintains that "such expert consumers will be well aware of the significance of the term 'BX' as a shorthand for 'biopsy' and will, furthermore, have little difficulty in making the connection required to recognize the merely descriptive significance as applied to the goods when using them to review biopsy specimens."

Applicant, while admitting in its supplemental brief that the evidence furnished by the Examining Attorney shows that "BX is a known acronym for 'biopsy,'" nevertheless contends that, at most, such term would be suggestive to only a limited class of purchasers and/or users of its microscopes. Referring to both a

⁴ We judicially notice, for instance, that The Random House Dictionary of the English Language (2d ed. 1987) at 211 defines "biopsy" as "Med.--n. 1. the removal for diagnostic study of a piece of tissue from a living body. 2. a specimen obtained from a biopsy." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., In re Hartop & Brandes, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962); Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

brochure for its goods⁵ and the results of its search of the Nexis database,⁶ applicant asserts in particular that (footnote omitted):⁷

The brochure refers to the "BX Microscope Series" or simply the "BX Series," thus employing BX as a trademark, and not as the name of the goods. Furthermore, the brochure does not in any way link "BX" with biopsy, or intimate that the microscopes discussed therein are intended specifically or primarily for use in biopsies. The word "biopsy" is mentioned nowhere in the brochure's 23-page discussion of Applicant's microscopes. The brochure consistently uses the generic term "specimen" to refer to the samples to be analyzed using Applicant's microscopes.

It is no surprise that Applicant's brochure makes no mention of "biopsies." Applicant's microscopes, as is evident from the brochure, are intended to be used in a broad array of settings for a virtually limitless number of applications. The brochure states that "the BX Series is the ideal choice to meet the uncompromising ... requirements of research scientists and clinical laboratories, both now and into the 21st century."

As the brochure also makes clear, Applicant's microscopes are not specifically

⁵ Portions of the brochure, which contain facsimiles of applicant's goods, were submitted as specimens when the application was filed.

⁶ Specifically, a search on October 27, 1995 of the "ALLNWS" file of the "NEWS" library using the search request "BX W/40 MICROSCOP!" retrieved only a single story, entitled "Molecular genetics of the bithorax complex in *Drosophila melanogaster*," which appeared in the July 1, 1983 edition of the journal Science.

⁷ Although both the brochure and the search results were introduced as attachments to applicant's initial brief and, thus, were technically untimely under Trademark Rule 2.142(d), we have considered such evidence inasmuch as a remand of the application was subsequently requested and granted in order for the Examining Attorney to meet such evidence through the introduction of the previously noted excerpts from his Nexis/Lexis search of the "MEDLINE" database.

targeted to those medical technicians who analyze tissue obtained via biopsies for diagnostic purposes. Those clinicians performing that specific function represent but one small subset of the entire set of possible users of Applicant's microscopes. Accordingly, Applicant's brochure in no way suggests that the mark "BX" has any connection with the term "biopsy," nor does it employ the mark in a way that would indicate that "BX" describes, or even suggests, anything about the features or functions of Applicant's products.

In further support of its argument that "BX" is not [merely] descriptive of microscopes, Applicant notes that a NEXIS search ... for incidences of "BX" within 40 words of "microscope," turned up only a single reference. In that single reference, "BX" was used as an abbreviation for bithorax mutant, and not as an acronym for "biopsy."
....

Applicant, in addition, contends that even to medical technicians, a multi-step process of mental reasoning would be required in order to derive any informative content inasmuch as the term "'BX' does not directly and immediately connote anything about the nature of Applicant's microscopes." In consequence thereof, applicant insists that such term is not merely descriptive of its goods.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor

Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

On the other hand, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage 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.*, supra 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). Any doubt as to whether a mark is merely descriptive or suggestive is resolved, in accordance with the Board's policy, in favor of the applicant by allowing publication of the mark for opposition. See, e.g., In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981) and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

While the record reflects that the term "BX" signifies, as applicant concedes, the word "biopsy" and it is plain that microscopes, like many other laboratory instruments, would frequently be employed in the diagnostic study of tissue samples, we concur with applicant that medical technicians, researchers and scientists would not immediately or directly regard the term "BX" as describing any significant attribute or function of applicant's goods. Instead, the purchasers, users and/or prospective customers thereof would have to pause and reflect on the significance of the term "BX" in order to understand that applicant's products may be particularly useful in or conducive to the performance of a biopsy. However, as pointed out by applicant, nothing in its product brochure supports such an

interpretation, nor is there anything in the scientific or medical literature which indicates that certain microscope designs or features specifically lend themselves to or are more suitable for the kind of diagnostic study of tissue samples which is known as a biopsy or, for short, BX. The record, on the contrary, demonstrates that there is apparently no such instrument as a biopsy or BX microscope, nor is there anything which shows that knowledgeable and highly trained medical and scientific personnel, who would be aware that the term "BX" typically connotes the word "biopsy," would view such term descriptively in relation to applicant's microscopes or would otherwise regard it as lacking in trademark significance.

Consequently, we agree with applicant that actual and prospective customers and users for its products would be left to speculate as to what particular function(s) or other aspect(s) thereof the term "BX" refers. Only after reflection, or through the exercise of a multistage reasoning process, would such persons possibly conclude that applicant's microscopes may somehow be especially useful for biopsies. The term "BX" is therefore suggestive rather than merely descriptive of applicant's goods.

Decision: The refusal under Section 2(e)(1) is reversed.

J. D. Sams

Ser. No. 74/482,275

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board