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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Advanced Cardiovascular Systems, Inc.

Serial No. 75/687,509

Michael W. Hicks of Blakely, Sokoloff, Taylor & Zafman for
Advanced Cardiovascular Systems, Inc.

Hanno Rittner, Trademark Examining Attorney, Law office 115
(Tomas Vleck, Managing Attorney).

Before Cissel, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 21, 1998, Advanced Cardiovascular Systems,
Inc. (applicant) filed a trademark application to register
the mark STEELCORE (typed form) for goods identified as
"medical guide wires" in International Class 10.¹

The Examining Attorney refused to register the mark on
the ground that the mark, when applied to the goods, is

¹ Serial No. 75/687,509. The application alleges a date of first
use and a date of first use in commerce of February 1, 1999.

merely descriptive under Section 2(e)(1) of the Trademark Act. 15 U.S.C. § 1052(e)(1). When the Examining Attorney made the refusal to register final, applicant filed a notice of appeal. Both applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.

The Examining Attorney's position is that the term "core" is used to describe guide wires. Since applicant's advertising describes its wires as having a stainless steel shaft, the term STEELCORE is merely descriptive of applicant's goods. The Examining Attorney relies on dictionary definitions, LEXIS/NEXIS articles, information from websites, and information provided by applicant to support the refusal.

Applicant, on the other hand, argues that its mark is at most suggestive of the goods, that the Examining Attorney has failed to show use of the term STEELCORE by others in relation to the identified goods, and that the term does not have a clear meaning. Therefore, applicant concludes by arguing that the Examining Attorney has not met the Office's burden of showing that applicant's mark is merely descriptive.²

² Applicant also objects to two Internet printouts submitted by the Examining Attorney. Applicant submits that the documents

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). A term may be descriptive even if it only describes one of the qualities or properties of the goods or services. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether

should not be considered because they were submitted after the record was closed, the evidence went beyond the issue for which applicant sought remand, and it was unfair to applicant since applicant did not have the right to respond to the Examining Attorney's new evidence with its own evidence. Applicant's objection is not well taken. The Examining Attorney submitted the evidence after applicant's request for remand was granted and applicant submitted additional evidence. This is the proper procedure. TBMP § 1207.02 ("If a request to remand for additional evidence is granted, the nonrequesting party may submit additional evidence in response to the evidence submitted with the request.") The Examining Attorney's evidence relates to the issue for which remand was granted (the descriptiveness or suggestiveness of the term). There is also nothing unfair in the process. The Examining Attorney has the burden to establish that the term is descriptive. In the examination process, the Examining Attorney has the last opportunity to submit evidence as a matter of right at the final Office action stage. Here, if applicant desired to submit additional evidence to respond to the Examining Attorney's evidence, it could have filed another request for remand, which it did not do.

the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

Inasmuch as the evidence of record supports the Examining Attorney's determination that the term STEELCORE is merely descriptive for medical guide wires, we affirm the Examining Attorney's refusal to register.

The Examining Attorney originally made of record evidence from the National Library of Medicine MEDLINE database to show that the term "core" is used to describe the center of guide wires. A sample of the evidence follows.

A simple method to redirect malpositioned central venous catheters using a guide wire with movable core is described. (222-4).

To prevent the catheters from being obstructed by the particles, a core shaft wire was passed through the channels of the particles. (696-9).

A new mechanically related 20 MHZ intravascular ultrasound guide wire (0.032 inch) with a transducer core was placed through the central lumen of a peripheral arterial balloon-expandable stent. (1213-6).

It involves passage of a tapered, movable-core, J-tipped guide wire across the right ventricle into the pulmonary artery.... (264-5).

A curved, tapered, solid-core movable J guide wire was developed for use in percutaneous transfemoral pulmonary angiography. (864-5).

The Examining Attorney also made of record Internet printouts that show that applicant itself, in a press

release dated October 13, 1997, describes its product as follows:

The ACS HI-TORQUE ALL STAR Guide Wire is a second generation ACS HI-TORQUE EXTRA S'PORT Guide Wire - the most popular stent delivery wire on the market. It features a softer, less traumatic tip for good lesion access, and has a large diameter stainless steel inner core that offers good support and vessel-straightening for stenting.

Applicant's other promotional literature clearly demonstrates that its goods have a steel "core" (".018' diameter and stainless steel shaft ensure desired support with no compromise to flexibility or torqueability"). Sometimes, applicant uses the term "shaft" to refer to the center of its guide wires. The Examining Attorney has submitted definitions of "shaft" as "a long, generally cylindrical bar, especially one that rotates and transmits power, as the drive shaft of an engine," and "core" as "the central or innermost part"³ to show that the terms would be used to describe the center of applicant's guide wires.

Also, the Examining Attorney has included evidence that competitors use very similar terms to describe their guide wires:

³ We can and do take judicial notice of these definitions submitted by the Examining Attorney. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). While applicant suggests that these definitions should have been submitted earlier, there is nothing improper with the Examining Attorney making this request in the Appeal Brief.

"AGILITY's performance in tortuous neurovasculature cases is quite remarkable," Mr. Albiani continued. "The unique construction of our one-piece stainless steel core wire, coupled with a lubricious exterior hydrophilic coating, enable the AGILITY™ 10 Steerable Guideline to deliver excellent torque response to the distal tip." Johnson & Johnson website.

Another site, www.devicelink.com, has a notation under Spring Guidewire Configuration Capabilities describing a guide type with a "Fixed Core, movable core, and custom designs" and material including "304 V stainless steel."⁴

Finally, we note that applicant itself admits that "[i]n the present case, it is clear that Applicant's mark consists of two undeniably descriptive words, 'steel' and 'core.'" Response dated February 28, 2000, p. 3.

While admitting the descriptiveness of the individual terms, applicant argues that the Examining Attorney 'relies on a non-existent literal application of the mark to Applicant's goods and does not try to present a true figurative analysis, likely as it would show a multi-thought process." Applicant's Br., p. 9. See also Applicant's Reply Br., p. 7 ("STEELCORE is a coined term invented for the sole purpose of functioning as a

⁴ While we have considered these materials, to which applicant has objected, we do not hesitate to note that the outcome in this case would be the same even if we did not consider this evidence.

trademark"). Applicant also criticizes the Examining Attorney for not producing evidence of descriptive use of the mark by others in the industry. Further, applicant points out that a "search consisting of a combination of the term 'steelcore,' either alone or in connection with the term 'guide wire' on various relevant NEXIS databases only yielded documents demonstrating Applicant's proprietary use of the mark." Applicant's Br., p. 3.

In response to applicant's arguments, we agree that even if the individual terms are descriptive, we must determine if the mark in its entirety is descriptive of the goods because when combined, the terms may not be merely descriptive. We find in this case that when the terms are combined, they have exactly the same descriptive meanings. The term STEELCORE unequivocally describes medical guide wires that have steel shafts or cores.

While applicant argues that the "evidence of record fails to establish that the term STEELCORE has a meaning in the relevant trade," Applicant's Br., p. 7, it is clear that the centers of guide wires are frequently referred to as "cores" and that the inner part of applicant's guide wires are made of stainless steel. It does not require any "leap of faith," as applicant suggests, to reach the conclusion that "STEELCORE" describes a feature of a

medical guide wire having a steel center or core. Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 807, 120 USPQ 293, 294 (CCPA 1959); Gyulay, 820 F.2d at 1217, 3 USPQ2d at 1009. The term STEELCORE immediately conveys to potential purchasers the fact that the goods have a steel center or core, which is a feature of the goods.

While applicant combines the terms "steel" and "core" without a space, the resulting combination does not convert a merely descriptive term into a suggestive term. See Abcor, 200 USPQ at 218. The commercial impression of the combined term remains the same, i.e., guide wires having a steel center. In addition, there is no requirement that before a mark can be held merely descriptive, the Examining Attorney must find descriptive uses of the exact term in the industry. Id. (GASBADGE at least descriptive of gas monitoring badges without any evidence of use of the term by the industry).

When the admitted descriptiveness of the individual terms is considered in light of the evidence, the Examining Attorney's refusal to register the mark on account of descriptiveness must be affirmed. The evidence shows that

the center of a medical guide wire is referred to as a core. The core of applicant's guide wires is made of stainless steel. Nothing is left to the imagination when the two descriptive terms are combined into applicant's term STEELCORE and applied to medical guide wires having a steel center or core.

Decision: The Examining Attorney's refusal to register the mark STEELCORE under Section 2(e)(1) of the Trademark Act on the ground that it is merely descriptive of the goods, medical guide wires, is affirmed.