

**THIS DISPOSITION
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Oral Hearing:
February 12, 2002

Paper No. 13
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cordis Corporation

Serial No. 75/793,886

Norm D. St. Landau, Jennifer L. Dean and Adam L. Barea of
Drinker, Biddle & Reath for Cordis Corporation.

Linda M. Estrada, Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Cordis Corporation has filed an application to
register the mark CUSTOMCATH for "designing specialized
catheters for others and to specific customer needs."¹

The Trademark Examining Attorney has issued a final
refusal to register, under Section 2(e)(1) of the

¹ Serial No. 75/793,886, in International Class 42, filed September 7,
1999, based on an allegation of a bona fide intention to use the mark in
commerce.

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Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register.

The Examining Attorney submitted an excerpt from *The Dictionary of Medical Acronyms & Abbreviations*, 2nd ed. 1993, defining "cath" as "cathartic; catheter; catheterized"; and an excerpt from *The American Heritage Dictionary of the English Language*, 3rd ed. 1992, defining the adjective form of "custom" as "1. made to order; 2. specializing in the making or selling of made-to-order goods." The Examining Attorney argues that, in view of these definitions, and considering the identification of services, CUSTOMCATH is merely descriptive of applicant's services of providing made-to-order catheters. She notes that, as applicant indicated, its services are offered to physicians and applicant's catheters are custom-made to the physician's specifications; and that physicians will clearly understand "cath," in the context of applicant's mark and services, to be an abbreviation of "catheter."

In further support of her position, the Examining Attorney submitted copies of five third-party registrations which include disclaimers of "cath" in

connection with catheters and of "custom" in connection with design services; and excerpts of medical articles retrieved from the LEXIS/NEXIS database. However, only the following two article excerpts demonstrate use of "cath" as an abbreviation of "catheter":

A special coating on the catheter binds water, making the cath so slippery you do not need a lubricant for insertion. [RN, November 1, 2000.]

What they do is deliver the VEGF by catheter. They give you two caths - one now and one three months from now - and on one of those two you are going to get the VEGF. [Saturday Evening Post, March 1, 2000.]

The remaining excerpted articles show the term "cath" in the context of a trademark, or in an ambiguous context that may or may not be a trademark, and, thus, these remaining excerpts are not probative of the issue of descriptiveness.

Applicant contends that CUSTOMCATH is not merely descriptive because it "is susceptible of multiple meanings"; that the Examining Attorney's evidence does not establish that CUSTOMCATH is merely descriptive; and that applicant's evidence of third-party registrations supports its position that CUSTOMCATH is not merely descriptive. Applicant submitted copies of many third-party registrations for Principal Register marks

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including either "cath" or "custom," without disclaimers, for a variety of goods and services. Additionally, applicant provided excerpts of Internet web sites for several of these registrants.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We find the evidence of record sufficient to clearly establish that "cath" is a recognized abbreviation for "catheter," and that CUSTOMCATH is merely descriptive of applicant's services of designing specialized catheters for others and to specific customer needs. We are not persuaded otherwise by applicant's arguments to the contrary. Applicant argues that the unitary term CUSTOMCATH may have several connotations, such as "habitually inducing catharsis" or "made to order agents for purging the bowels." However, *when the mark is considered in connection with the identified services*, these suggested connotations are unlikely, rather the likely connotation, based on the ordinary meanings of these words, is a made-to-order catheter, which is the subject matter of applicant's design services. Applicant argues, further, that its services are limited to designing endocardial catheters. Not only is applicant's identification of services not so limited, but such a specialty does not obviate the descriptive character of the mark.

Because the record includes third-party registrations only for the individual components of the mark, a few with disclaimers and many without disclaimers, for a wide variety of goods and services, we

find this evidence ambiguous at best. Further, we do not have before us the records in those cases and we must decide each case on its merits. In any event, "third-party registrations simply are not conclusive on the question of descriptiveness, and a mark which is merely descriptive cannot be made registrable merely because other similar marks appear on the register." See, *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

In conclusion, considered in connection with applicant's services, the term CUSTOMCATH immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, that applicant designs customized catheters for others. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term CUSTOMCATH as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.