

2/12/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re California Ultrasound, Inc.

Serial No. 75/809,046

James C. Wray, Esq. for California Ultrasound, Inc.

Marlene D. Bell, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Hanak, Hohein and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

California Ultrasound, Inc. has filed an application
to register the phrase "WELLNESS THROUGH ULTRASOUND SCREENING"
for "medical testing and screening services, namely providing
ultrasound screening services."¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the

¹ Ser. No. 75/809,046, filed on September 27, 1999, which alleges a
date of first anywhere and first use in commerce of December 7, 1998.

basis that, when used in connection with applicant's services, the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" is merely descriptive of them.

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

It is well settled that a phrase or 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 forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. 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). It is not necessary that a phrase or 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 phrase or term describes a significant attribute or idea about them. Moreover, whether a phrase or 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 phrase or 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). Thus, "[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).

Applicant, citing "McCarthy on Trademarks, Section 11.10(1)," for the proposition that "[t]he combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is non-descriptive," contends that the phrase "WELLNESS THROUGH ULTRASOUND SCREENING," when considered as a whole, is suggestive of its ultrasound screening services rather than merely descriptive thereof. Noting, in particular, that none of the two searches of the "LEXIS/NEXIS" database conducted by the Examining Attorney revealed use "in any way by anyone" of the phrase "WELLNESS THROUGH ULTRASOUND SCREENING," applicant asserts that:

Nonuse of the mark by competitors is an indication that the mark is not descriptive because competitors do not need to use the mark in advertising their competing products. Thus, lack of use of Applicant's mark by competitors shows that Applicant's mark is suggestive of the qualities and characteristics of the services, not merely descriptive.

Applicant likewise argues that "[t]he evidence of record (applicant's specimens, dictionary definitions and Nexis stories) simply does not establish that the mark, when considered in its entirety, is merely descriptive given the absence of any evidence that "others in the relevant field have used or would need to use the four-word combination WELLNESS THROUGH ULTRASOUND SCREENING to describe their services." Any doubt as to whether such phrase is merely descriptive or suggestive of its ultrasound screening services, applicant insists, should be resolved in its favor by "allowing publication of the mark so that any third-party may file an opposition to develop a more comprehensive record. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992)."

The Examining Attorney, on the other hand, maintains that the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" merely describes "a feature and/or the purpose of the applicant's services." Specifically, she contends that:

Here, the applicant provides ultrasound screening, which is a test used to detect the presence of disease or infection, as a method of medical testing and screening services, to determine an individual's physical health and/or wellness. As such, the proposed mark is not suggestive as the applicant contends but is instead merely descriptive of the applicant's services.

In support of her position, the Examining Attorney has made of record the following relevant definitions from The

American Heritage Dictionary of the English Language (3rd ed. 1992):

"**wellness**," which is defined as a noun meaning "[t]he condition of good physical and mental health, especially when maintained by proper diet, exercise, and habits";

"**through**," which is listed as a preposition signifying, inter alia, "[b]y way of: *climbed in through the window*";

"**ultrasound**," which is set forth as a noun connoting, in "*Medicine*," "[t]he use of ultrasonic waves for diagnostic or therapeutic purposes, specifically to visualize an internal body structure, monitor a developing fetus, or generate localized deep heat to the tissues," with such term as an attributive noun being "[o]ften used to modify another noun: *ultrasound pictures; ultrasound waves; an ultrasound test*"; and

"**screening**," which is defined as a verb meaning "[t]o test or examine for the presence of disease or infection: *screen blood for the presence of a virus; screen patients in an epidemic zone.*"

In addition, the Examining Attorney has made of record excerpts from her searches of the "LEXIS/NEXIS" database, the most pertinent of which are as follows (**emphasis added**):

"Five cases of osteoporosis were uncovered, while 17 people were alerted to blood circulation problems found in the ankle brachial **ultrasound screening**." -- Sarasota Herald-Tribune, November 20, 1999;

"Doppler **ultrasound screenings** will be among the activities at the grand opening of Rosalind Hall's Downtown Fitness Center

...." -- Fort Pierce News, November 12, 1999;

"There will be a free **ultrasound screening** for osteoporosis" -- Times-Picayune, October 21, 1999;

"Chiropractor Jim Wagner recently opened the center, providing ... **ultrasound**, ... X-rays and **wellness** classes." -- The Capital (Annapolis, MD), April 20, 1997; and

"The center ... will provide outpatient medical services by family and specialty physicians, including **ultrasound**, electrocardiograms and health **screening** and **wellness** programs." -- Asbury Park Press (Neptune, NJ), November 19, 1996;

"Dr. Jason Birnholz used an ultrasound machine to save J.J Howard's twins after a life-threatening tumor was discovered. He said **ultrasound** serves as a "**wellness** check" for millions of couples each year." -- Chicago Sun-Times, April 9, 1995; and

"The center would provide outpatient laboratory services, stress testing, **ultrasound**, mammography, basic radiology, **wellness** services and outpatient rehabilitation services" -- Atlanta Journal & Constitution, June 15, 1993.

According to the Examining Attorney, the above evidence confirms that applicant "has merely put together the descriptive terms WELLNESS, THROUGH, ULTRASOUND and SCREENING to create its mark." While acknowledging that "[a] mark that combines descriptive terms may be registrable if the composite creates a ... separate, nondescriptive meaning,"² the Examining

² See, e.g., *In re Ampco Foods, Inc.*, 227 USPQ 331, 333 (TTAB 1985).

Attorney urges that, "i[n] this case, the combination of WELLNESS THROUGH ULTRASOUND SCREENING does not lend itself to any other meaning or significance other than identifying a feature and/or purpose of the Applicant's services." The Examining Attorney points out, in this regard, that "[n]o novel spellings or unique juxtapositions are apparent in the mark to support a finding of a nondescriptive or suggestive meaning."

Furthermore, the Examining Attorney correctly notes that, while the registrability of a phrase or term "created by combining two or more unregistrable words depends on whether in combination, a new and different commercial impression is created, and/or the [phrase or] term so created imparts a bizarre or incongruous meaning as used in connection with the goods [or services],"³ she maintains that such is clearly not the case here. She consequently concludes that the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" is merely descriptive of applicant's ultrasound screening services.

In the present case, we agree with the Examining Attorney that, when used in connection with applicant's "medical testing and screening services, namely providing ultrasound screening services," the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" immediately describes, without conjecture or

speculation, significant information concerning a feature or purpose of such services, namely, that they are designed to achieve for the users thereof the state of wellness through ultrasound screening. In addition to the dictionary definitions and "LEXIS/NEXIS" excerpts noted above, which make clear that the meaning of the individual terms which form the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" retain their ordinary meaning when used in combination, applicant's specimens of use of such phrase demonstrate the merely descriptive significance thereof. The specimens, which consist of various pieces of promotional literature, explain that applicant's services provide "WELLNESS THROUGH ULTRASOUND SCREENING." Among other things, its advertising states that "[w]e provide non-invasive, completely painless screenings using the most advanced Ultrasound and Doppler technology"; that applicant's "[g]oal is to Screen At-Risk People in an Effort to Prevent Stroke and Vascular Disease"; that as "SOUTHERN CALIFORNIA'S OLDEST AND LARGEST SCREENING SERVICE," applicant provides "STROKE/CAROTID VASCULAR SCREENING," an "ABDOMINAL AORTIC ANEURYSM (AAA) SCREENING TEST," an "ANKLE BRACHIAL INDEX (ABI)" (which "test screens for blocked leg arteries using blood pressure readings

³ See, e.g., In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988); and In re Metcal Inc., 1 USPQ2d 1334, 1336 (TTAB 1986).

obtained with a hand held Doppler") and an "OSTEOPOROSIS SCREENING TEST"; and that (**bold in original**):

For more information about these PAINLESS AND NON-INVASIVE TESTS, ... CALL TODAY and register for our next screening event -- **maintain your wellness through ultrasound screening!**

Plainly, when viewed in the context of applicant's ultrasound medical testing and screening services, there is nothing about the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" which, to purchasers and potential consumers thereof, is ambiguous, incongruous or susceptible, perhaps, to any plausible meaning other than immediately conveying information as to what applicant's services provide for its customers. Nothing requires the exercise of imagination, cogitation or mental processing or the gathering of further information in order for such customers to readily understand that wellness through ultrasound screening is a principal feature or purpose of applicant's services.

Finally, even if applicant, as it appears from the lack on this record of any use of the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" by third parties, is the first to use such phrase in connection with ultrasound screening services, that fact does not justify registration thereof where, as here, the phrase is merely descriptive of applicant's services. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ

Ser. No. 75/809,046

505, 507 (CCPA 1980) at n. 8; and In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Accordingly, because the phrase "WELLNESS THROUGH ULTRASOUND SCREENING" conveys forthwith significant information concerning a feature or purpose of applicant's "medical testing and screening services, namely providing ultrasound screening services," it is merely descriptive thereof within the meaning of the statute.

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