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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mogul Enterprises, Inc.

Serial No. 78120080

Mogul Enterprises, Inc. appearing *pro se*.

Lauriel F. Dalier, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Mogul Enterprises, Inc. has filed an application to register on the Principal Register the mark SLENDERCATH for "catheter for cardiac electrophysiology diagnostics and therapeutics," in International Class 10.¹

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

¹ Serial No. 78120080, filed April 8, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

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 that a mark is 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 and relevant purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977). See also *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ 1551, 1552-53

(Fed. Cir. 1991); and *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989).

If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant's favor. *In re Atavio, supra* at 1363.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In this case, the Examining Attorney contends that the size of a catheter is a significant feature determining its appropriate use and, thus, that the SLENDER portion of applicant's mark is merely descriptive; that CATH is a recognized abbreviation for "catheter," which is the generic name of the identified goods; and that the mark is merely the combination of these two respectively descriptive and

generic terms and, as such, is merely descriptive of the identified goods.

In support of her position, the Examining Attorney submitted excerpts from articles in the LEXIS/NEXIS database establishing that "cath" is a commonly used abbreviation for "catheter," and that the phrase "slender catheter" is commonly used to refer to a catheter that is slender. The following are several representative examples:

The problem is this: When heart attack patients are rushed to the nearest hospital, they may be hurried to the cardiac "cath lab," where a tiny tube, or catheter, is threaded into the blocked coronary artery and a tiny balloon is inflated to reopen the vessel. [*U.S. News and World Report*, May 6, 2002.]

By June 1, the hospital also plans to offer cardiac catheter services, expanding from the vascular cath services already available. [*Chicago Daily Herald*, April 13, 2002.]

Heart catheterizations, or "caths," can bring a Medicare payment of \$5,000 to \$15,000. [*The State*, Columbia, SC, April 1, 2002.]

Electrophysiologist Dr. Paul Sparks said a slender catheter was introduced through a pinhole-sized lesion in a person's leg and fed through a major vein up to the heart, during the procedure. [*Progress Leader*, September 17, 2002.]

The patient is mildly sedated, and a slender catheter is threaded through the groin up to the heart. [*The New York Times*, February 17, 2002.]

The implant begins with a trial run. In a one-hour procedure, pain specialists insert a slender catheter with an electrode tip into the space around the patient's spinal cord at mid-back level. It is hooked externally to a generator. The patient goes home and for several days monitors the effect of the electrical stimulation

on his angina. [*Pittsburg Post-Gazette*, October 30, 2001.]

The Examining Attorney also submitted the first page of the results of an Internet search, using the GOOGLE search engine, for the phrase "slender catheter" which returned 1,790 "hits." The following excerpts are several representative examples of those submitted:

Laser Catheter to Aid Coronary Surgery: Both laser and balloon angioplasty are performed by opening an artery - usually in the groin - and inserting a slender catheter into the blood vessel.

Southeast Alabama Medical Center: He will then thread a slender catheter (a hollow tube) into the patient's arteries.

Coronary Angiogram: A slender catheter (a thin, hollow plastic tube) is threaded through the largest artery in your body, the aorta, until it reaches the coronary arteries of the ...

Finally, the Examining Attorney submitted definitions excerpted from unidentified Internet websites² of "catheter" as, *inter alia*, "a tubular instrument to allow passage of fluid from or into a body cavity or blood vessel," and of "slender" as, *inter alia*, "small or narrow in proportion to the length or the height; not thick; slim; as a slender stem or stalk of a plant"; and, excerpted from an Internet

² Because these words are common terms in American English, we take judicial notice of these definitions. However, the Examining Attorney is advised that for evidence that is obtained from the Internet to be accepted as probative, it must include identifying information, such as the name of the website and the date the evidence was obtained therefrom.

website located at www.stands4.com, an excerpt stating that CATH stands for, *inter alia*, "catheter."

In its response, dated January 27, 2003, to the first office action, applicant made the following statement:

The Mark, SLENDERCATH™, is unique because it highlights a main design feature of our catheter product just as a Mark, SLIM-CATH®, highlights the same design feature of the competitive (C.R. Bard) catheter product. The SLENDERCATH™ is just as feature-descriptive as the SLIM-CATH® that has been obviously considered for registration for the competitive company and sets the preceden[t]. Another example is FAST-CATH®, which describes the catheter's design feature that enables the catheter to be fast to access anatomical sites. Still another example is STEEROCATH®, which describes the catheter's design feature that enables the catheter to steer to access anatomical sites.

In a subsequent response, applicant submitted information about the third-party registered marks SLIM-CATH, FAST-CATH and STEEROCATH, from an unidentified database and, with its brief, submitted copies of these registrations from the USPTO automated records. In order to make these registrations properly of record, soft copies of the registrations themselves, or the electronic equivalent thereof, *i.e.*, printouts of the registrations taken from the electronic records of the United States Patent and Trademark Office's (USPTO) own database, should have been submitted prior to appeal. *See, Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). However, the Examining Attorney did not object to the evidence or inform applicant as to the proper

means for submitting registrations; and she responded to applicant's arguments about the noted registrations. Therefore, we have considered the registrations submitted with applicant's brief as supporting the references thereto in applicant's earlier response.³

Having reviewed all of the evidence of record, we agree with the Examining Attorney that CATH is an abbreviation of "catheter," the generic name of the goods; that the shape and size of the catheter is a significant feature of the products and SLENDER is descriptive of the shape and size of applicant's goods; and that the phrase "slender catheter" is commonly used to refer to such goods. Therefore, in conclusion, we find that, when applied to applicant's goods, the term SLENDERCATH immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that the product is a catheter that is slender in form. 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 goods to readily perceive the merely descriptive significance of the term SLENDERCATH as it pertains to applicant's goods.

³ We have not considered third-party registrations submitted with applicant's brief which were not previously mentioned.

Applicant argues that its mark should be determined to be not merely descriptive in view of the above-noted third-party registrations. However, as the Board has previously stated, "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." Each case must be decided on its own merits. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 ("... the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board."). See also, *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

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