

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
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Arlington, Virginia 22202-3513

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THIS DISPOSITION IS NOT
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TTAB MARCH 10,00

Opposition No. 103,836

Eclipse Surgical Technologies,
Inc.

v.

PLC Medical Systems, Inc.

Before **Seeherman, Hanak and Wendel**, Administrative Trademark
Judges.

By the Board:

Opposer has filed an opposition to the registrations being
sought by applicant for each of the following marks for
"transmyocardial revascularization system, namely, a laser,
control circuits, power supply, computer, monitor, and optical
delivery system, namely, a laser handpiece and an articulating
laser beam delivery arm connected to the handpiece" in Class 10:

¹ Application Serial No. 74/704,768 filed on July 24, 1995, and
claiming a bona fide intention to use the mark in commerce.

² Application Serial No. 74/700,843, filed on July 13, 1995, and
claiming a bona fide intention to use in commerce.

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The words "transmyocardial revascularization" have been disclaimed in both applications. As a basis for the opposition, opposer alleges that the term TMR is the common acronym for "transmyocardial revascularization," is descriptive of applicant's goods, and must be disclaimed.

Opposer previously filed a motion for summary judgment arguing that applicant's marks must be refused registration because TMR comprises the dominant portion of applicant's marks, is descriptive and cannot be disclaimed. In a decision rendered on June 2, 1998, the Board entered judgment, sua sponte, in applicant's favor on "the issue that entry of a disclaimer of the letters TMR would be a permissible remedy, in the event that TMR is found to be merely descriptive of applicant's goods, and that the marks would not be unregistrable as a whole." The Board then allowed opposer time to clarify its position with respect to this issue, and indicate whether it wished, in its summary judgment motion, to pursue its original assertions that registrations should not be permitted without a disclaimer of TMR in the two applications. Opposer responded on July 1, 1998, indicating that it wishes to pursue its original assertions; and applicant filed a response thereto.

Opposer's motion seeking summary judgment that TMR must be disclaimed is accompanied by copies of the drawing pages containing applicant's mark from their application files; opposer's responses to applicant's first set of interrogatories; copies of examples of opposer's advertisements, news releases and

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prospectuses showing use of the term TMR; copies of articles from numerous publications showing use of the term TMR; copies of third-party advertisements and news releases; applicant's answers to opposer's first requests for admissions; opposer's first request for production of documents; and copies of some of applicant's advertising materials, annual reports, and fact sheets.

In support of its motion, opposer argues that TMR is a descriptive acronym for "transmyocardial revascularization," and that TMR is not entitled to trademark protection because it describes the function that applicant's goods perform. Opposer requests that the Board require applicant to disclaim the acronym TMR in its two pending applications.³ Opposer argues that it, applicant and others in the field, use TMR to identify transmyocardial revascularization surgery and systems utilizing lasers to perform such surgery. Opposer notes that applicant has admitted that TMR is a common acronym for "transmyocardial revascularization" in applicant's responses to opposer's first requests for admissions.⁴

³ Technically, the Board does not impose a requirement for a disclaimer. If the Board finds that a component term of a mark is merely descriptive within the meaning of Trademark Act Section 2(e)(1), it will find that a registration cannot issue unless a disclaimer of said term is submitted.

⁴ Request No. 1: Admission is requested that among those persons associated with transmyocardial revascularization, "TMR" is used as an acronym for transmyocardial revascularization. Answer: Admitted. Request No. 2: Admission is requested that Applicant is aware that others have used "TMR" as an acronym for and to describe transmyocardial revascularization. Answer: Admitted. Request No. 3: Admission is requested that Applicant has used "TMR" as an acronym for and to describe transmyocardial revascularization. Answer: Admitted.

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Applicant's response is accompanied by opposer's responses to applicant's first set of interrogatories; a copy of the application and response to office action, dated January 10, 1997, in opposer's application Serial No. 75/123,223; and copies of the cases upon which applicant relies.

In response, applicant argues that the Board held that its composite marks which include the acronym TMR are not merely descriptive of applicant's identified goods. Applicant contends that opposer is estopped from arguing that a disclaimer is the relief it seeks because opposer did not argue that position in its initial motion for summary judgment. Applicant, while admitting that TMR is descriptive of the transmyocardial revascularization medical procedure, contends that opposer has provided no evidence that TMR is merely descriptive of a laser system, and thus disclaimers of the term are not required.

Preliminarily, the Board clarifies for the parties that, while it found in applicant's favor on the issue that "entry of a disclaimer of the letters TMR would be an appropriate remedy, in the event that TMR is found to be merely descriptive of applicant's goods, and that the marks would not be unregistrable as a whole," the Board expressly stated in its June 2, 1998 decision that, as for the pleaded grounds for the opposition, "the necessity for a disclaimer remains undecided." Thus, the Board did not determine that TMR was not descriptive of applicant's goods. Opposer is not estopped from returning to its

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original grounds for the notice of opposition, and applicant's arguments to that effect will be given no further consideration.

There is no genuine issue of material fact that TMR is a descriptive acronym meaning "transmyocardial revascularization," which identifies a surgical procedure. Thus, the Board must determine whether a genuine issue exists with respect to whether TMR is merely descriptive of: a "transmyocardial revascularization system, namely, a laser, control circuits, power supply, computer, monitor, and optical delivery system, namely, a laser handpiece and an articulating laser beam delivery arm connected to the handpiece," applicant's identified goods.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

In the present case, we find that opposer has adequately met its burden of establishing that TMR is descriptive of a function

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of applicant's goods and must be disclaimed if the marks as a whole are to be registered.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it describes a characteristic or feature of the goods, or if it conveys information as to the function, purpose or use of the goods. See *In re Pennzoil Products Co.*, 28 USPQ2d 1753 (TTAB 1991).

As stated previously, there is no genuine issue that TMR is a descriptive acronym for the surgical procedure known as "transmyocardial revascularization." Lasers are used to perform TMR.⁵ Applicant's laser system, as stated in its identification of goods, and further explained in applicant's annual reports, fact sheets, and other advertising, is used to perform the transmyocardial revascularization surgical procedure. Equipment and systems used in performing the surgery are referred to by the acronym TMR as well as the term "transmyocardial revascularization."⁶

⁵ See, for example, opposer's exhibit No. 5: "TMR uses a laser to create 1 mm channels within the heart muscle to supply the heart muscle with blood;" exhibit No. 22: "Presently, three different types of lasers - CO2 lasers, Holium lasers, and Excimer lasers - are under various stages of study by medical scientists to determine which is best suited for TMR;" and exhibit No. 49, a copy of applicant's 1993 annual report: "The Company has developed The Heart Laser and its sterile, single-use procedure kit for a revolutionary cardiosurgical procedure known as transmyocardial revascularization (TMR)."

⁶ See, for example, opposer's exhibit No. 4, one of opposer's information sheets, page No. 2, referring to "Eclipse's TMR holium laser system;" exhibit No. 22, page No. 3, referring to use of the "Acculase TMR System;" exhibit No. 23, referring to "TMR laser" at various points throughout the article; exhibit No. 32, referring to a third-party, "The Company's TMR systems are investigational devices;" and exhibit No. 49, applicant's 1993 annual report: "The company has

Thus, there is no genuine issue of material fact that the term TMR describes a feature of applicant's goods: a laser, and component parts comprising a system, used in the TMR surgical procedure. Moreover, the Board finds it disingenuous that applicant argues that TMR is not descriptive of its goods when it admits that TMR is the common acronym for "transmyocardial revascularization," and that the latter term is descriptive of applicant's goods by virtue of the disclaimers provided by applicant of "transmyocardial revascularization" in each of its applications herein.

Accordingly, opposer's motion for summary judgment is granted. Applicant is allowed until thirty days from the mailing date of this decision to submit appropriate disclaimers of TMR in each application,⁷ failing which the opposition will be sustained, and registration to applicant refused.

E. J Seeherman

E. W. Hanak

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

four issued and three pending U.S. patents relating to The Heart Laser and TMR disposables."

⁷ The standardized disclaimer format required by the Office is as follows: No claim is made to the exclusive right to use TMR apart from the mark as shown. See TMEP Section 1213.09(a)(i). The disclaimers of "transmyocardial revascularization" are to remain of record in each application.