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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Stereotaxis, Inc.**

Serial No. 78108674

Brian K. Wheelock of Harness, Dickey & Pierce, P.L.C. for
Stereotaxis, Inc.

Michael E. Bodson, Trademark Examining Attorney, Law Office 110
(Chris AF Pedersen, Managing Attorney).

Before **Hanak, Hohein** and **Chapman**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Stereotaxis, Inc. has filed an application to register
on the Principal Register the mark "STEREOTAXIS" and design, as
shown below,



for "magnetic navigation systems comprised of magnetic devices
and controls for controlling the position and/or orientation of
magnetic substances and devices in the body; a line of magnetic

medical devices that can be magnetically navigated in the body for diagnostic and therapeutic purposes; catheters; endoscopes; magnets and electromagnets for medical applications; atherectomy devices; medical guidewires; medical imaging apparatus; apparatus for locating medical devices in the body; intercranial bolts; tissue samplers for extracting tissue samples from the body; [and] medical electrodes and electrode catheters."¹

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the term "STEREOTAXIS," which the Examining Attorney maintains is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed apart from the mark as shown.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not requested. We affirm the disclaimer requirement.

¹ Ser. No. 78108674, filed on February 13, 2002, which is based on an allegation of a bona fide intention to use the mark in commerce.

² Applicant, while asserting in its brief that "[t]here are several companies who have registered marks for stereotactic equipment," has attached to such brief as "Exhibit 4" a list of various third-party registrations and applications. The Examining Attorney, citing Trademark Rule 2.142(d), states in his brief that he "objects to the additional evidence submitted by applicant at Exhibit 4 as untimely and improper as it was not previously provided to the trademark examining attorney." Such objection is well taken. As noted by the Examining Attorney, the evidence is untimely inasmuch as Trademark Rule 2.142(d) provides in relevant part that the Board "will ordinarily not consider additional evidence filed ... by the appellant ... after the appeal is filed." Moreover, because the Board does not take judicial notice of third-party registrations and applications, a mere list of such does not suffice to make them properly of record; instead, copies thereof or printouts of the registrations and applications from the electronic search records of the United States Patent and Trademark Office must be timely furnished. See, e.g., In

It is well settled that a 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 an immediate idea of any 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 term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a 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 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). Furthermore, it is well established

re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). While no further consideration will therefore be given to the evidence attached to applicant's brief as Exhibit 4, it nonetheless is pointed out that, even if such evidence were to be considered, it would make no difference in the disposition of the issue of the propriety of the requirement for a disclaimer since a mere listing of third-party marks, without any accompanying indication of the goods and/or services associated therewith, is essentially lacking in any probative value.

that registration must be denied if a term is merely descriptive of any of the goods or services for which registration is sought. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980).

Applicant, by way of background information, states in its brief that:

Applicant ... is [in] the business of making and selling magnetic surgery equipment, including magnet systems that create a navigating magnetic field in the body, and medical devices that respond to such navigating magnetic fields. Applicant has become well known in the medical field for its breakthroughs in the magnetic navigation of medical devices. Applicant is widely known and has received substantial publicity for its magnetic surgery systems.

While acknowledging, in its brief, that "the term 'stereotaxis' has a variety of medical meanings," applicant maintains that "it does not convey an immediate impression of Applicant's magnetic surgery systems and related medical goods listed in the application."

In particular, applicant notes that the initial Office Action served to make of record the following definitions of the term "stereotaxis" (also known as "stereotaxy") from The American Heritage Dictionary of the English Language (3d ed. 1992): "1. A method in neurosurgery and neurological research for locating points within the brain using an external, three dimensional frame of reference usually based on the Cartesian coordinate system. 2. Movement of an organism in response to contact with a

solid body. In this sense, also called *thigmotaxis*." Applicant also points out in its brief that:

In its response of August 5, 2003, Applicant made several other definitions of [such term] record: 1. The definition from <http://www.biology-online.org/dictionary.-asp>: "A response to the stimuli of a solid surface, typically common in microorganisms that exist in small cracks and crevasses and have adapted to this environment in the form of an adaptation that responds to contact with a hard surface. The actual response itself is coined as a stereotaxi." 2. The definition from <http://www.medterms.-com/script/main/art.asp?ArticleKey=5555>: "Use of a computer and scanning devices to create three-dimensional pictures. This method can be used to direct a biopsy, external radiation, or the insertion of radiation implants." 3. The definition from <http://www.phoenix5.org/glossary/stereotaxis.html>: "Use of a computer and scan device to create 3-dimensional pictures. Can be used to direct a biopsy, external beam radiation, or the insertion of radiation implants (brachytherapy)."

The second of the above definitions, we observe, is identical to that which was also made of record by the Examining Attorney in his subsequent Office Action, which cited the "MedTerms.com Medical Dictionary" as the on-line source thereof. Applicant insists that, "[g]iven the various meanings of the term 'stereotaxis' based upon the definitions in the Office Action, and these definitions, 'stereotaxis' is not an apt description of Applicant's products." Applicant also argues that, even if such term "would indicate the 'field' of Applicant's medical devices," as asserted in the initial Office Action, it is still the case that "merely conveying the 'field' of a product does not make a term 'merely descriptive'."

Accordingly, while acknowledging that "the term 'stereotaxis' has several meanings in the medical field," applicant urges that "this does not make it merely descriptive" of its goods for the reasons that, as set forth in its brief (*italics in original*):

Applicant's products relate generally to the magnetic navigation of medical devices in the body through the application of magnetic fields. They *could* be used in neurological procedures, but they have much wider application, particularly in cardiac procedures. Further, while Applicant's goods *could* be used in conjunction with stereotactic apparatus from third parties that locates points within the brain using an external, three dimensional frame of reference usually based on the Cartesian coordinate system, Applicants' [sic] products do not themselves perform this function, nor are they specially adapted for use with stereotactic equipment from third parties. The goods listed in Applicant's application provide for moving medical devices anywhere in the body and not "locating points within the brain using an external, three dimensional frame of reference. The term "stereotaxis" does not convey an immediate impression with respect to Applicant's goods, and therefore the word "stereotaxis" is not merely descriptive of the Applicant's goods.

Applicant concludes, therefore, that registration of its mark, without the required disclaimer of the term "stereotaxis," for its "magnetic navigation equipment and other medical devices listed in the application, will not unduly impair the ability of other manufacturers of magnetic navigation systems from describing and marketing their products, and of course will not prevent those companies that are actually selling stereotactic equipment ... from use [of] the word in a non-trademark sense to describe stereotactic equipment (as opposed to Applicant's

magnetic navigation and other medical devices)." Any doubt in such regard, applicant adds, should be resolved in its favor.

The Examining Attorney, on the other hand, states in his brief that a further definition, which we have judicially noticed,³ from the on-line "MSN Encarta-Dictionaries" defines the term "stereotaxis" in relevant part as "**2. MEDICINE technique in brain surgery:** neurological surgery involving the insertion of delicate instruments that are guided to a specific area by the use of three-dimensional scanning techniques."⁴ The Examining Attorney, we also observe, has made of record a news article concerning applicant from the website of Advent International Corporation (at <http://www.adventinternational.com/News/Article-.aspx?PageID=7.1&NewsID=44>) which states, *inter alia*, that:

Advent International, the global private equity firm, today announced that it has co-led a \$25.5 million investment in Stereotaxis Inc., an innovator in the field of surgical automation.

³ It is settled that the Board may properly take judicial notice of dictionary definitions. *See, e.g.,* Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

⁴ Other useful medical definitions, we judicially notice, may be found in Melloni's Illustrated Medical Dictionary (4th ed. 2002) at 610, which defines "stereotaxis" in pertinent part as "**1.** The localization of the three-dimensional arrangement of body structures by means of coordinate landmarks" and lists a synonym thereof, "stereotaxy," as meaning "[a] method of inserting an electrode into a specific area of the brain by means of three-dimensional coordinates; used to destroy deep-seated nuclear masses and fiber tracts in the brain." In a similar vein, Stedman's Medical Dictionary (27th ed. 2000) respectively sets forth such terms in relevant part as "**1.** Three-dimensional arrangement. **3. syn** stereotaxy" and "[a] precise method of identifying nonvisualized anatomic structures by use of three-dimensional coordinates; more frequently used for brain and spinal surgery. SYN stereotactic surgery, stereotaxic surgery, stereotaxis (3)."

Stereotaxis will use the new capital to expand the clinical development of its proprietary Magnetic Navigation System (MNS). The system is designed to integrate magnetics, computers and three-dimensional medical imaging to help clinicians navigate and control catheters and other surgical instruments throughout the body.

....

The system could make it possible to perform minimally invasive procedures that may improve treatment for a variety of challenging medical conditions. Potential areas of application include electrophysiology, interventional cardiology, neurosurgery and interventional neurosurgery.

....

About Stereotaxis

Stereotaxis is a leader in the field of surgical automation. The company is developing as its core technology a proprietary surgical workstation. The workstation is expected to be uniquely capable of remotely directing catheter-based therapeutic or diagnostic devices along complex trajectories within the body.

According to the Examining Attorney, the term "STEREOTAXIS" merely describes "a significant feature or characteristic of applicant's goods in that the term ... describes a method of planning neurosurgery." More particularly, the Examining Attorney contends that such a method or "technique uses ... magnetic navigation resonance imaging to track the devices using magnetic forces to show where the devices are." Noting that, as pointed out by applicant, part of its goods consist of a line of medical devices that can be magnetically navigated or guided in the body for diagnostic and therapeutic purposes as well as imaging apparatus and apparatus for locating

medical devices in the body, the Examining Attorney maintains that "[i]t is apparent that the goods of the applicant involve an imaging technique to help surgeons more accurately locate and remove a tumor, for example, during surgery."

In view thereof, the Examining Attorney concludes that "[t]he dictionary evidence ... establishes that the term STEREOTAXIS does in fact describe a significant feature of the applicant's goods," which include magnetic navigation systems comprised of magnetic devices and controls for controlling the position and/or orientation of magnetic substances and devices in the body as well as a line of magnetic medical devices that can be magnetically navigated in the body for diagnostic and therapeutic purposes. The fact that, as argued by applicant, such term has several meanings in the medical field and other contexts is not controlling on the issue of mere descriptiveness inasmuch as a term may properly be considered to be merely descriptive, as the Examining Attorney correctly points out, so long as any one of its meanings is descriptive. See, e.g., In re Chopper Industries, 222 USPQ 258, 259 (TTAB 1984); In re Bright-Crest, Ltd., supra; and In re Champion International Corp., 183 USPQ 318, 320 (TTAB 1974).

Upon careful consideration of the evidence and arguments, we find that, when used in connection with applicant's goods, the term "STEREOTAXIS" immediately describes, without conjecture or speculation, significant information concerning the nature, purpose or function of at least some, if not most, of applicant's goods, namely, that they are stereotaxis medical or

surgical devices. Clearly, as used in the medical and surgical fields, the term "STEREOTAXIS" broadly designates a computerized scanning method or technique for creating three-dimensional pictures of, or otherwise locating points in, the brain or elsewhere in the body using a three-dimensional frame of reference, usually based on a Cartesian coordinate system, and navigating medical or surgical devices with respect thereto in order to perform neurosurgical procedures, direct biopsies or external radiation, insert radiation implants, or perform other kinds of operations. The concept of stereotaxis thus involves the use of magnetic or other means to position medical or surgical instruments, such as probes, electrodes, biopsy cannulas or other tissue samplers, catheters, guidewires, etc., in a patient. Plainly, for example, whether products used in stereotaxis surgery or other medical procedures (i) serve to control the position and/or orientation of magnetic substances and devices, such as applicant's "magnetic navigation systems comprised of magnetic devices and controls" and its "medical imaging apparatus" and "apparatus for locating medical devices in the body," or (ii) constitute apparatus that can be magnetically navigated in the body for diagnostic and therapeutic purposes, such as applicant's "line of magnetic medical devices" for those uses and its various "catheters," "medical guidewires," "tissue samplers" and "medical electrodes," it is still the case that the aforementioned items fall within the class of goods which is merely described as stereotaxis products.

Accordingly, when viewed in the context of applicant's goods, there is nothing in the term "STEREOTAXIS" which, to neurosurgeons, cardiovascular surgeons, radiologists and other medical practitioners and clinicians who would utilize and/or recommend the purchase of such goods, would be ambiguous, incongruous or otherwise require the need for the exercise of any imagination, cogitation or mental processing or necessitate the gathering of further information in order for them to readily perceive the merely descriptive significance of the term. Applicant's magnetic surgical equipment, in short, is aptly and merely described as stereotaxis equipment inasmuch as the term "STEREOTAXIS" forthwith conveys the nature, purpose or function of such goods. In consequence thereof, the term "STEREOTAXIS" may not be exclusively appropriated by applicant, even if applicant may be the first and/or only producer to use that term. See, e.g., In re Quik-Print Copy Shop, Inc., supra at 507 n.8; and In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Decision: The requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the merely descriptive term "STEREOTAXIS."⁵

⁵ See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993); and TMEP §§1213.08(a) and (b) (3d ed. 2d rev. May 2003).