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Mailed: September 14, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re L.VAD Technology, Inc.

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Serial No. 76291030

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Andrew R. Basile of Young and Basile, P.C. for L.VAD Technologies, Inc.

Yong Oh (Richard) Kim<sup>1</sup>, Trademark Examining Attorney,  
Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Walters, Walsh and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

L.VAD Technology, Inc. filed an application to register on the Principal Register the mark PERMANENT BALLOON PUMP in standard character form for, as amended, the following goods<sup>2</sup>:

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<sup>1</sup> This examining attorney took over responsibility for the application after issuance of the first Office action.

<sup>2</sup> Serial No. 76291030 was filed on July 27, 2001, based on an allegation of a bona fide intention to use the mark in commerce on the goods. On April 5, 2002, applicant filed an amendment to allege use, alleging first use and use in commerce as of March 21, 2002. The amendment to allege use was approved on August 9, 2002.

medical and surgical procedure products, namely, permanent implantable, left ventricular assist devices and permanent intra-aortic balloon pumps and parts therefor, namely a blood pump, skin connector and drive unit,

in International Class 10.

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). After filing its amendment to allege use, applicant amended its application to the Supplemental Register. The examining attorney refused registration, under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is incapable of identifying applicant's goods and distinguishing them from those of others. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, but an oral hearing was not requested.

Applicant contends its proposed mark is not generic for its goods and is appropriate for registration on the Supplemental Register. More specifically, applicant argues that the class of goods at issue in its application is "medical and surgical procedure products and even more narrow, heart assist devices, namely intra-aortic balloon pumps" (brief p. 4); that the examining attorney has not shown any use of PERMANENT BALLOON PUMP other than in

connection with applicant's goods; that, rather, the evidence of record identifies the class of goods as "intra-aortic balloon pump," "IABP," or "balloon pump" (*Id.*) Applicant further argues that PERMANENT BALLOON PUMP, while descriptive of applicant's goods, remains an indicator of source; that to the relevant purchasing public, i.e. the medical community, PERMANENT BALLOON PUMP points to applicant as the source of the identified goods, rather than a class of goods; and that the evidence of record is not sufficient to show that PERMANENT BALLOON PUMP is used in a generic manner. Applicant argues in addition that "the addition of the term 'permanent' further makes Applicant's mark an indicator of source of Applicant's goods" (brief p. 5); and that numerous marks that include the term "permanent" are registered on the Principal Register with other material disclaimed.

The examining attorney maintains that applicant's proposed mark is a generic designation for its goods. In particular, the examining attorney argues that "it is clear from the identification that the goods constitute permanently implantable balloon pumps" (brief, unnumbered p. 3); that "the relevant portion of the purchasing public refers to this class of heart assist devices as 'permanent balloon pumps'" (brief, unnumbered p. 4)' and that the term

PERMANENT is a class-defining generic term that fails to indicate source when added to the generic designation BALLOON PUMP. In support of the refusal, the examining attorney has made of record articles and advertisements retrieved from Internet web pages. Excerpts from these web pages follow (emphasis added):

Dr. Adrian Kantrowitz introduced the intra-aortic **balloon pump** (IABP) in the late 1960s as a simple yet effective device to increase coronary perfusion...Although the IABP was first used for surgical patients, the pump can now be used along with interventional cardiology procedures and medical therapy medications...The IABP is driven by the **balloon pump** console. The operating controls are located on a touch pad below the display monitor and can be programmed to produce rates as high as 140 beats per minute.

*(Texas Heart Institute Homepage, Copyright 1996-2004)*

The CardioVad™ System was developed by Adrian Kantrowitz, M.D., of LVAD Technology, based in Detroit. The first U.S. surgeon to perform a heart transplant, Dr. Kantrowitz has been working on this project for more than 30 years. One of his early spin-offs was a temporary assist device, the intra-aortic **balloon pump**, which is now used 100,000 times a year worldwide to support patients in acute heart failure.

Creating a **permanent balloon pump** has been much more challenging, however. It required developing complex computer technology that allows the pump to match the heart's natural rhythms, speeding up or slowing down as needed. *(The University of Chicago Hospitals - New Patient Device Gives Heart Failure Patients More Freedom by John Easton October 30, 2000)*

The CardioVAD (LVAD Technologies, Detroit, Mich.) is unlike all other assist devices in that it uses the aorta to indirectly support the circulation...It can be best considered a **permanent**, larger, and more efficient version of the commonly used inta-aortic **balloon pump**.  
(*University of Chicago Medical Center Clinical*, Winter 2001)

For patients with chronic heart failure that does not respond to medication alone, current surgical treatment options are broadly categorized as procedures that preserve native heart function and those that replace native heart function...

Procedures that assist or replace heart function  
Insertion of partial assist devices  
    Intra-aortic **balloon pump**  
    **Permanent** implantable **balloon pump**  
(*Postgraduate Medicine Online* March 2001)

From its initial clinical use, over 37 years ago, to its current extensive use of over 100,000 times annually in the US alone, the **balloon pump**, developed and pioneered by Dr Adrian Kantrowitz, remains the first choice intervention for mechanical circulatory assistance. A **permanent balloon pump** (the experimental patch booster) was commercialized as the CardioVad System and successfully implanted in a number of patients...  
(*ASAIO Gold The 25 Landmark 'Milestone' Papers* Published by ASAIO 1955-2003)

...Don't be concerned when the **balloon pump** stops, because your heart is continuously beating for itself. At pre-programmed intervals, the **balloon pump** will stop pumping for a brief period of time. Your heart will continue pumping. And remember too, that a nurse or health care professional trained in the operation of the **balloon pump** will be monitoring the machine throughout your period of therapy.  
([www.datascope.com/ca/caballoompumptherapy.html](http://www.datascope.com/ca/caballoompumptherapy.html))

...On a nationwide basis, the use of the intra-aortic **balloon pump** in combination with clot-busting drugs at these hospitals has the potential to save thousands of lives each year...Of the 21,178 patients studies, 6993 received the **balloon pump** treatment.  
([www.ucsf.edu/pressrel/1998/03/0331aort.html](http://www.ucsf.edu/pressrel/1998/03/0331aort.html))

In addition, applicant submitted, as an exhibit to its response to the examining attorney's second Office action, printed copies of patents related to the goods identified in the involved application.<sup>3</sup> Excerpts from this exhibit are reproduced below (emphasis added):

MECHANICAL AUXILLIARY VENTRICLE  
BLOOD PUMP WITH REDUCED WAIST  
PORTION

FIELD OF THE INVENTION

The present invention relates to a dynamic aortic patch for assisting cardiac function during a cardiac cycle of a patient when positioned with respect to an aorta of the patient, and in particular, to a dynamic aortic patch or blood pump with a reduced waist portion to reduce the probability of occluding a port to the inflatable chamber of the pump.

BACKGROUND OF THE INVENTION

A dynamic aortic patch is permanently surgically implanted in the wall of the aorta to augment the pumping action of the heart. It is sometimes referred to as a mechanical auxiliary ventricle (MAV) or described as a **permanent balloon pump**.

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<sup>3</sup> Applicant submitted this material in response to the examining attorney's request for information regarding the nature and purpose of the goods recited in its application.

(US Patent No. 6,471,633 B1)

Before turning to the substantive ground for refusal, we will address an evidentiary issue herein. Applicant, as an exhibit to its September 14, 2005 request for reconsideration of the examining attorney's final Office action, submitted a list of third-party registrations that contain the term PERMANENT. In his brief, the examining attorney objects to these registrations on the ground that they have not properly been made of record. The examining attorney's objection is well taken. To make third-party registrations of record, applicant must submit a copy thereof or a printout from the USPTO's electronic database prior to the briefing stage of the case. *See In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record."). Inasmuch as applicant in this case did not submit copies or printouts of the referenced third-party registrations, but merely provided a listing thereof, the registrations have not properly been made of record. Accordingly, those registrations will be given no further consideration.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. *See In re Dial-A-*

*Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In the case of *In re American Fertility Society*, *supra*, our primary reviewing court stated that if the PTO can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the

public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

In the case of *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home retail services in the field of mattresses," the court further clarified the test as follows (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a

word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole." In concluding that there was not substantial evidence that the term is generic, the court added that the term is not literally a genus or class name nor does it "immediately and unequivocally" describe the service at issue.

We find that, in this case, PERMANENT BALLOON PUMP is more analogous to the phrase considered by the court in *American Fertility* than it is to the compound word considered in *Gould*. Thus, dictionary definitions alone cannot support a refusal to register the proposed mark.<sup>4</sup> The evidence establishes that the constituent term "balloon pump" is the name of a class of goods, and that "permanent balloon pump" is a subset or new entry in that class of goods. Articles made of record by the examining attorney clearly establish that a "permanent balloon pump" is an improvement over the long standing and widely used temporary "balloon pump" as a treatment for patients with

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<sup>4</sup> We note that neither the examining attorney nor applicant submitted dictionary definitions of the terms comprising the proposed mark PERMANENT BALLOON PUMP. Inasmuch as definitions of these terms would add little to our determination of the issue in this case, we decline to take judicial notice thereof.

acute heart failure. As noted above, one of applicant's own patents for the applied-for goods indicates that they are "described as a permanent balloon pump." Finally, applicant's identification of goods includes "permanent intra-aortic balloon pumps," and that fact that the mark does not include the term "intra-aortic" is of little significance in view of the other evidence of record. Nor do we find that the term "permanent" serves a source identifying function merely because it describes a subset of the "balloon pump" class of goods. See *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991). Thus, the record is sufficient to establish that the relevant public would find PERMANENT BALLOON PUMP a generic term indicating a balloon pump permanently implanted to assist the heart in pumping blood. The fact that applicant may be the first or only entity to successfully produce and use a "permanent balloon pump" does not confer trademark status on an otherwise generic term. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

Therefore, we conclude that the examining attorney has met the substantial burden of establishing that PERMANENT BALLOON PUMP is incapable of identifying and distinguishing the source of the identified goods.

**Ser No. 76291030**

*Decision:* The refusal under Section 23 of the Act is affirmed.