

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 21, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Medinol Ltd.

Serial No. 75/313,058

Joseph F. Nicholson and Karen Feisthamel of Kenyon & Kenyon
for Medinol Ltd.

Howard B. Levine, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney)

Before Cissel, Bottorff and Rogers, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Medinol, Ltd. has filed an application to register
"TRANSFORMABLE GEOMETRY" as a mark for goods identified as
"medical devices, namely, stents."¹ Registration has been
refused under Section 2(e)(1) of the Trademark Act, 15
U.S.C. §1052(e)(1), on the basis that, when used on or in

¹ Serial No. 75/313,058, filed June 23, 1997, based upon an
allegation of a bona fide intention to use such term in commerce.

connection with applicant's goods, the mark will be merely descriptive of them.

When the Examining Attorney made the refusal final, applicant appealed. Briefs were filed, but an oral hearing was not requested. We affirm the refusal of registration.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In support of the refusal of registration, the Examining Attorney has made of record a dictionary definition for the word "transform" showing that one meaning is "to change the nature, function, or condition of" and that "transformable" is the adjectival form of the word²; dictionary definitions of the word "geometry" showing that non-mathematical definitions include "configuration" and "a surface shape"; a medical dictionary definition of the word "stent"; and numerous excerpts retrieved from the NEXIS computerized database of periodicals, each of which includes the word "geometry," or a form thereof, and the word "stent," or a form thereof.

² In this regard, we also take judicial notice of the following definition: **trans•form•able** *adj* : capable of being transformed. 2427 Webster's Third New International Dictionary (1993).

The Examining Attorney contends that the NEXIS article excerpts "show that the shape or configuration of a medical stent is often called its GEOMETRY." He also contends that "the shape or configuration of applicant's stents is changeable or TRANSFORMABLE. Thus, the stents can be said to have a TRANSFORMABLE GEOMETRY."

The Examining Attorney also made of record two NEXIS excerpts which, he alleged, demonstrate descriptive use of "transformable geometry" by what appears from the excerpt to be a competitor of applicant's. With its appeal brief applicant made of record a full version of one of the articles.³ The article explains that the apparent competitor holds an exclusive worldwide license from applicant to market and distribute a particular stent manufactured by applicant, which "is based on a proprietary transformable geometry design that creates flexibility when it is inserted[,] but rigidity after it is implanted."

It is well settled that a term is considered merely descriptive of goods, within the meaning of Section 2(e)(1)

³ The Examining Attorney referenced and discussed the article in his appeal brief, which we therefore accept as if it had been properly made of record. The second excerpt introduced by the Examining Attorney was from a newswire service, and applicant discounted its value on this basis. In any event, the second excerpt includes a "TM" designation after the words "transformable geometry" and does not, therefore, support the Examining Attorney's argument.

of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

It is not necessary that a term describe all of the properties or functions of the goods 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 for which registration is sought, the context in which it is being used on or in connection with those goods and the possible significance that the term would have to the average purchaser because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[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).

First, we consider the nature of applicant's goods. Applicant offers a dictionary definition that describes a

"stent" as "a compound or a mold made of the compound for holding a surgical graft in place." In contrast, the medical dictionary definition offered by the Examining Attorney includes not only the definition offered by applicant, but also the following: "a slender rod- or thread-like device used to provide support for tubular structures that are being anastomosed or to induce or maintain patency within these tubular structures."⁴

Moreover, the article offered by applicant quotes applicant's CEO, Dr. Judith Richter, as stating: "We believe the Nir [i.e., applicant's 'proprietary transformable geometry design' stent] is the premier coronary stent platform in the world."

While the record reveals that the term "stent" may refer to various medical devices, it is clear that applicant manufactures, and we must consider its identification of goods to encompass, a "slender rod- or thread-like device used to provide support for tubular structures that are being anastomosed or to induce or maintain patency within these tubular structures."

⁴ "Anastomosis" is defined as "**1.** *Anat., Biol.* connection between parts of any branching system, as of blood vessels. **2.** *Surg., Pathol.* communication between two organs or spaces not normally connected." 49 The Random House College Dictionary (1982). "Patency," in this context, is defined as "**2.** *Med.* the condition of not being blocked or obstructed." *Id.* at 973.

It is well settled that a term need not be descriptive of all possible goods encompassed within an identification for the term to be properly refused as descriptive. See In re Analog Devices, Inc., 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd* 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). Since applicant's identification of goods must be read to include all types of stents, if the term "transformable geometry" is descriptive of any type of stent, refusal of registration under Section 2(e)(1) of the Trademark Act is appropriate.

The Examining Attorney's NEXIS evidence has been criticized by applicant, but the criticism goes too far. There are duplicate articles among those made of record, but this does not mean, as applicant asserts, that we must disregard all of the articles, both originals and duplicates, or both "full" and "kwic" versions, where there is overlap. Rather, we simply disregard the second copy or version of the article.⁵ In addition, there are some articles that we find inapposite. Nonetheless, we find the relevant NEXIS evidence more than sufficient to establish that "geometry" means "shape" or "configuration" when used

⁵ The duplication appears to have resulted from the Examining Attorney's search of two different libraries or fields within the NEXIS database, with some articles retrieved in both searches.

in conjunction with stents that are used in various types of surgical procedures in which tubular bodily structures are provided with support to maintain patency or are anastomosed.

In regard to the term "transformable", we agree with the Examining Attorney's conclusion that this term is readily understood to mean "changeable." We find the combination of "transformable" and "geometry", when considered in conjunction with stents, to be readily understood as meaning that the stents have a transformable or changeable shape or configuration.

We are not persuaded otherwise by applicant's argument that each of the separate terms has multiple meanings and that the combination of these two terms results in an ambiguous, non-descriptive phrase which would require the exercise of "mental gymnastics" or a multi-stage reasoning process to discern its meaning. Compare In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) (combination of SCREEN FAX PHONE held merely descriptive and without incongruity resulting from combination); and In re Lowrance Electronics, 14 USPQ2d 1251 (TTAB 1989) (generic terms COMPUTER and SONAR held just as generic and not incongruous when used in combination).

Finally, applicant argues that the Examining Attorney has not produced any evidence showing descriptive use of "transformable geometry." Clearly, in so arguing, applicant is discounting the *Medical Industry Today* article that it attached to its appeal brief. The article does explain that the "transformable geometry" stent is applicant's product; nonetheless, it provides some support for the Examining Attorney's refusal, in that the article uses the terms in a descriptive manner. It is noteworthy that this descriptive use is in an article in what appears to be a trade publication and which otherwise capitalizes apparent trademarks (Compare the following phrases: "the FDA approved [applicant's licensee's] Radius self-expanding stent," and "three weeks later, its low-profile sheathless stent, the Nir, gained the nod" and "the Nir is based on a proprietary transformable geometry design"). Thus, it appears that at least one trade publication writer familiar with applicant's goods, its role in the marketplace, and its trademarks, viewed "transformable geometry" as descriptive.

In any event, even if the referenced article is discounted, the fact that applicant may be the first or only user of the term is not determinative when the term sought to be registered has a merely descriptive

connotation. In re Eden Foods Inc., 24 USPQ2d 1757, 1761 (TTAB 1992).

In sum, it is our view that, when used on or in connection with stents, the term "transformable geometry" immediately describes, without the need for conjecture or speculation, a significant feature of applicant's goods, namely that the stents have a changeable or transformable shape or configuration.

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

R. F. Cissel

C. M. Bottorff

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board