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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cook Pacemaker Corporation

Serial No. 75/118,809

Richard J. Godlewski for applicant.

John D. Dalier, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Cook Pacemaker Corporation to register the term LEAD EXTRACTION for "medical kits comprised of various combinations of one or more of locking stylets, coils, sheaths, catheters, cannulae, tubes, locking wire guides, wire guides, hemostats, clamps, gauge pins, clippers, pin vises, coil expanders, stylet wires, dilators, dilator sheaths and baskets for the percutaneous or transvenous snaring,

removal, retrieval or withdrawal of surgical leads."[1] Applicant claims that the term sought to be registered has acquired distinctiveness as provided by Section 2(f) of the Trademark Act.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that LEAD EXTRACTION, when used in connection with applicant's medical kits, is not just merely descriptive, but is generic and, thus, incapable of functioning as a source identifying mark. The Examining Attorney further contends that, in view of the generic nature of the term LEAD EXTRACTION, the evidence of acquired distinctiveness submitted by applicant is insufficient to permit registration on the Principal Register.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. An oral hearing was not requested.

The Examining Attorney's position is that the term sought to be registered is generic. Further, the Examining Attorney maintains that if it is determined that the term is not generic, but rather merely descriptive, then the

[1] Application Serial No. 75/118,809, filed June 14, 1996, alleging dates of first use of April 11, 1991.

evidence of acquired distinctiveness is insufficient to support registration on the Principal Register. In the Examining Attorney's view, the term names the category of applicant's goods, namely medical instruments used in lead extraction. The Examining Attorney has relied upon dictionary definitions and excerpts retrieved from the NEXIS database.

Applicant contends that the term sought to be registered is inherently distinctive, but, at worst, is merely descriptive.[2] Applicant goes on to contend that in the event the term is determined to be merely descriptive, the applicant has submitted sufficient evidence of acquired distinctiveness and that, thus, the term LEAD EXTRACTION is registrable on the Principal Register. In maintaining its position, applicant more specifically argues that there are a variety of more accurate terms (e.g., "removal") to describe the function of applicant's goods, and that inasmuch as the term "extraction" in the medical field suggests a forcible tearing or pulling of an object from the body, the term is fanciful and incongruous when applied to applicant's goods. Applicant concludes that any doubts

[2] We also note, however, applicant's statement that it "recognizes that the question of genericness may well be a close one..." (reply brief, p. 1)

must be resolved in its favor, pointing out that those in the medical field will then have an opportunity to oppose registration of the term sought to be registered.

The issues on appeal are whether the term LEAD EXTRACTION is merely descriptive or generic for applicant's goods and, alternatively, if such designation is not regarded as generic but rather as merely descriptive, whether it has acquired distinctiveness.

We turn first to the issues of whether LEAD EXTRACTION is generic, and whether it is merely descriptive, as used in the context of a medical kit used to perform a lead extraction procedure. A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See: In re Abcor Development Corp., 588 USPQ 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). A mark is a generic name if it refers to the class or category of goods or services on or in connection with which it is used. 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. Section 14(3) of the Act; 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 Patent and Trademark Office has the burden of establishing that a mark is generic and thus unregistrable. 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. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The Patent and Trademark Office may, in appropriate cases, satisfy its evidentiary burden by means of dictionary definitions showing 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, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987).

Given the type of refusal at issue here, and the highly specialized and technical nature of applicant's

medical kit, it is important to understand the goods.

Applicant has provided the following background:

> Applicant's particular goods are useful in performing a minimally invasive and minimally traumatic procedure for the percutaneous or transvenous snaring, removing, retrieving or withdrawing from a patient a previously implanted cardiac lead, such as a pacemaker lead. The removal of a cardiac lead is very problematic because the lead, and in particular the tip of the lead, can become highly enmeshed and encapsulated in the tissues and vessels in which the lead is positioned. Prior procedures have often entailed forcibly tearing a lead and lead tip from any encapsulating material, resulting in substantial trauma to the patient, and possibly even leading to stroke or cardiac arrest during the removal procedure. Such forcible tearing can sometimes fracture the lead or separate the lead tip from the balance of the lead. Applicant's goods permit implanted cardiac leads to be removed while avoiding these drawbacks of prior procedures.
>
> This appeal involves the trademark designating the only medical devices presently approved by the FDA for distribution in interstate commerce for percutaneously or transvenously snaring, removing, retrieving or withdrawing implanted cardiac leads. Applicant's devices were developed in response to a problem encountered with the use of Telectronics Accufix atrial pacemaker leads, such as models 330-801 and 329-701, which were voluntarily withdrawn from the market. The specific problem was the fracture or extrusion of a J-shaped retention wire on the Accufix leads. Such extrusion

> can result in laceration of the atrium or the surrounding vascular structures.
>
> It became clear to medical practitioners and regulators that it would be highly desirable to develop a technique or a device for removing from a patient the entirety of such leads (including their potentially problematic retention wires) with relative safety and efficiency. Applicant and its associated companies have pioneered percutaneous and transvenous procedures and devices for snaring, removing, retrieving or withdrawing whole leads. Applicant's devices are the sole devices presently approved by the FDA for distribution in interstate commerce for this purpose, and are in fact used for the performance of a significant number of procedures annually.
>
> While prior procedures for the removal of cardiac leads may have entailed the forcible tearing of a lead and lead tip from any encapsulating tissue, applicant's goods do not involve the forcible pulling or removal of anything from a patient. Instead, the goods are used to first separate the lead from any encapsulating material with minimal trauma to the patient, while the lead is generally maintained in its original position. Only after such separation are the goods then employed to remove the lead from the patient, while simultaneously also protecting the lead and preventing its fracture during removal.

In support of the refusal to register, the Examining Attorney submitted dictionary definitions of the words "lead" and "extraction." Although the term "lead" is defined in terms of an electrocardiograph, there is a

listing for the term "pacemaker lead" which is more pertinent to applicant's goods and the issue before us. That term is defined as "the connection between the heart and the power source of an artificial cardiac pacemaker, comprising an electrode to contact the heart, a conductor coil, and a terminal pin to connect to the generator." The term "extraction" is defined as "the process or act of pulling or drawing out." *Dorland's Illustrated Medical Dictionary* (28th ed. 1994). In addition, we take judicial notice, as requested by the Examining Attorney in his brief, of the listing showing that the term "extraction" is synonymous with the term "removal." *The Original Roget's Thesaurus of English Words and Phrases* (Americanized Version 1994).

The Examining Attorney also has introduced numerous excerpts retrieved from the NEXIS database wherein the term "lead extraction" is used in a generic fashion.[3] The following examples are representative of the generic uses made of record by the Examining Attorney:

> Thus, the risk of leaving the lead in place must be balanced against the risk of lead extraction for each individual patient. Removal of a pacemaker lead is a specialized procedure. Only some of the doctors who implant pacemakers

[3] Applicant takes issue with certain aspects of the NEXIS evidence. Suffice it to say that applicant's views are not well taken, and we have accorded appropriate probative value to this evidence.

can perform lead extractions.
Harvard Heart Letter, September 1995

...including a pacing/defibrillation lead extraction system...
Health Industry Today, November 1992

Standard lead extraction techniques include...
PACE—Pacing and Clinical Electrophysiology, October 1996

Chronic pacemaker lead extraction...
Primary Cardiology, August 1995

This unique procedure can be used to avoid the morbidity associated with percutaneous lead extraction or thoracotomy and to prevent potential dislodgment and embolization of the retention wire during lead extraction.
Mayo Clinic Proceedings, April 1995

Indications for lead extraction were...
Journal of Thorasic and Cardiovascular Surgery, June 1991

...serious consideration should be given to transcatheter or surgical lead extraction after a period of anticoagulation.
American Journal of Cardiology, July 1995

Further evidence of genericness is shown by the five letters solicited by applicant from physicians who use applicant's goods in their practices. As pointed out by applicant, these are not form letters, but rather letters written in the physicians' own words. The letters essentially indicate that each of these five physicians associate the term sought to be registered as identifying goods originating with applicant. The letters also

include, however, the following statements showing the writers' usage of "lead extraction" in a generic manner:

> I have had experience now with over 200 lead extractions. As you know, I have been able to speak worldwide about my experience with lead extractions and have been involved with all of the latest developments.
> *Raymond H.M. Schaerf, M.D.*
>
> When my father required removal of his permanent pacemaker leads, there was no tool set nor was the concept of lead extraction developed.
> *Bruce L. Wilkoff, M.D.*
>
> As those of us involved in pacing and pacemaker lead extraction are well aware, the only company to market lead extraction devices with approved technology is that of [applicant].
> *Charles J. Love, M.D.*
>
> When I think of lead extraction or a lead extraction system, I think of [applicant] and its lead extraction kit.
> *Carey S. Fredman, M.D.*
>
> As you know, I've used the Cook lead extraction system for quite some time and have found it to be exceptional in its capabilities for removing some leads under very difficult situations. This system employed unequivocally is involved with lead extraction and should be considered a lead extraction system...
> *Mark H. Schoenfeld, M.D.*

After reviewing the entirety of the record, we conclude that the term LEAD EXTRACTION is a generic name

for the type or category of applicant's goods, namely lead extraction medical kits (or medical kits used in lead extraction). The words comprising applicant's applied-for mark have readily understood meanings as shown by the medical dictionary definitions. There is absolutely nothing left for speculation or conjecture in the alleged trademark. In the present case, "the terms remain as generic in the compound as individually, and the compound thus created is itself generic." In re Gould Paper Corp., supra at 1111-12. Indeed, the compound itself, as shown by the other evidence of record, would appear to have a commonly used and readily recognized meaning. Simply put, LEAD EXTRACTION is a name for a type or category of medical kits, that is, lead extraction medical kits, rather than a mark identifying the source of the goods.

We recognize that the term "lead extraction" may not be the only generic term for the category of goods involved here. As shown by the brochure of applicant's German competitor, it uses "lead removal." Applicant has suggested the following alternative designations: lead snaring, lead removal, lead withdrawal and lead retrieval.[4]

[4] We note in this connection that the Examining Attorney conducted a search of the NEXIS database for all of these alternative terms suggested by applicant. The search yielded

Indeed, a product may have more than one generic name. In re Recorded Books Inc., 42 USPQ2d 1275, 1281-82 (TTAB 1997), citing In re Sun Oil Company, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970) (J. Rich, concurring). Nevertheless, as Judge Rich instructed in his concurring opinion, "[*a*]*ll* generic names for a product belong in the public domain." Id. (emphasis in original). See: J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:10 (4th ed. 1999). And, we point to the evidence showing that the terms "extraction" and "removal" are synonymous.

Applicant's specimen, which appears to be a label for application directly to the goods, is reproduced below.

We particularly note that applicant's videotape is titled "Intravascular Extraction of Chronic Pacemaker Leads."

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only one story, but this excerpt discussed "withdrawal" in the context of the metal lead, not surgical leads.

This title certainly undermines applicant's argument that the term "extraction" is not one which would be used in connection with or associated with the procedure undertaken with applicant's goods. Rather, as applicant's own use would seem to indicate, the term is used in connection with the removal, i.e., extraction of leads.

In finding that the designation LEAD EXTRACTION is incapable of being a source identifier for applicant's medical kits used to perform lead extraction procedures, we have considered, of course, all of the evidence touching on the public perception of this designation, including the evidence of acquired distinctiveness. In re Paint Products Co., 8 USPQ2d 1863 (TTAB 1988). As to acquired distinctiveness, applicant has the burden of proof to establish a prima facie case of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Applicant submitted the declarations of Louis Goode, applicant's president, wherein he asserts that the term sought to be registered has become distinctive as a result of substantially exclusive and continuous use since April 11, 1991 in connection with applicant's goods. Mr. Goode also indicated that applicant's goods are the only such goods presently approved by the Food and Drug

Administration (FDA) for the percutaneous or transvenous removal of cardiac leads. Mr. Goode states that the market for applicant's goods is highly specialized and that the relevant purchasers are highly sophisticated, namely physicians who remove previously implanted cardiac leads from patients. These physicians number approximately 495 in the United States, all of whom must use applicant's goods as regulated by FDA. Mr. Goode states his belief that a majority of these physicians recognize applicant as the sole source of goods identified by LEAD EXTRACTION. Mr. Goode also indicates that a German entity is applicant's only competitor outside the United States, and that this competitor's product brochure, a copy of which accompanies Mr. Goode's declaration, uses the term "removal" but not "extraction."

Also of record, as noted above, are the five letters from physicians who essentially state that they associate the term sought to be registered as indicating source in applicant.

Applicant's evidence of acquired distinctiveness suggests that at least some relevant purchasers (5 out of an alleged pool of 495 physicians) view LEAD EXTRACTION as a trademark. Nonetheless, if the evidence as a whole establishes--as it does to our satisfaction--that the term

is used and would be primarily perceived as a generic term, the recognition of the term as a trademark by some of applicant's customers must be deemed no more than a de facto secondary meaning that, in legal effect, can neither confer nor maintain trademark rights in the designation sought to be registered. See, e.g., Kellogg Co. v. National Biscuit Co., 385 U.S. 111, 39 USPQ 296, 299 (1938); J. Kohnstam, Ltd. v. Louis Marx & Co., Inc., 280 F.2d 437, 126 USPQ 362, 364 (CCPA 1960); and Schulmerich Electronics, Inc. v. J. C. Deagan, Inc., 202 F.2d 772, 97 USPQ 141, 145-46 (CCPA 1953). See also: *McCarthy on Trademarks and Unfair Competition*, § 12:47 (4th ed. 1999).

We recognize that applicant's use dates back to 1991, and that at least five "customers" assert that they perceive the term LEAD EXTRACTION as a source identifier for applicant's goods. In our view, this evidence clearly is outweighed by the other evidence of record. For us, the dictionary definitions, the NEXIS excerpts, and each of these physicians' own generic use of the term "lead extraction"[5] persuade us of the unambiguously generic meaning of the words that make up applicant's alleged mark.

[5] Indeed, in the words of applicant: "And yes, applicant may wish that the letters had been ghost-written by counsel rather than by the doctors themselves." (reply brief, p. 8)

Accordingly, even if the term LEAD EXTRACTION were found to be not generic, but merely descriptive, given the highly descriptive nature of the term LEAD EXTRACTION, we would need to see a great deal more evidence than applicant has made of record in order to find that the term has become distinctive of applicant's medical kit used in lead extraction procedures. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. Yamaha Int'l. Corp. v. Hoshino Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra. See also: *Restatement (Third) of Unfair Competition* (1993), Section 13, comment e:

> The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness.

Lastly, we acknowledge applicant's emphasis on the fact that it is the sole source of goods approved by the FDA to be used in lead extraction procedures in this country. In the unique circumstances of the present case, however, the fact that applicant may be the first or the

only one using LEAD EXTRACTION in the field is not dispositive. In re Central Sprinkler Co., 49 USPQ2d 1194, 1199 (TTAB 1998); and In re E S Robbins Corp., 30 USPQ2d 1540, 1542-43 (TTAB 1992). Although it appears that applicant is the only one in the field using the term LEAD EXTRACTION in connection with medical kits, this is undoubtedly due to the fact that applicant is the only entity which manufactures and sells the particular medical kits approved by the FDA. Thus, we are entirely unpersuaded by applicant's claim that there is no competitive need to use the term LEAD EXTRACTION. The absence, therefore, of any third-party uses of the term LEAD EXTRACTION does not mean that prospective competitors of applicant would not need to use such term to name their medical goods used in lead extraction procedures. Competition certainly would be hindered at the point when others in the field gain FDA approval for their goods to be used in lead extraction procedures. In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994).

Decision: The refusal to register is affirmed.

E. J. Seeherman

T. J. Quinn

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board