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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Idiag

Serial No. 75/592,564

Peter C. Michalos and John Zaccaria of Notaro & Michalos P.C. for Idiag.

David T. Taylor, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hohein, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Idiag, a Swiss joint stock company, seeks registration of the term SPINALMOUSE for "data processors and computers; computer operating programs; computer programs and software for operating and measuring the input from spinal measuring devices and for collecting, processing and presentation of data in the field of orthopedic and sports medicine, neurology, physical rehabilitation and therapy; [and] computerized noninvasive scanning devices used to measure the shape and mobility of the spine and other parts of the body," in International Class 9, and for "medical apparatus and instruments, namely, physical

exercise apparatus for medical purposes," in International Class 10.[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant' goods, the term SPINALMOUSE is merely descriptive of them. Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

There is no dispute that applicant's goods include, but are not limited to, an electronic-measuring device and software for assessing back shape, mobility and flexibility. The sole issue before us, then, is whether the combined term SPINALMOUSE is merely descriptive of applicant's goods listed above in International Class 9.[2]

Based upon the record as a whole, the Trademark Examining Attorney argues that clearly the word "spinal" is descriptive of applicant goods. Considering the identification of goods, a

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[1] Application serial number 75/592,564, filed on November 20, 1998. This application is based upon an allegation of a *bona fide* intention to use the mark in commerce.

[2] Applicant's brochure and manual seem to give meaning to the collection of items enumerated in International Class 9. Further, we note that the Trademark Examining Attorney has submitted extensive evidence directed toward the "spinal measuring device" in International Class 9. Hence, we consider that the Section 2(e)(1) refusal was directed toward the goods in this class. It is not clear to us exactly what is included in the "physical exercise apparatus" of International Class 10, but to the extent this identifies something different from the spinal measuring device, we do not find anything in the record directed to a Section 2(e)(1) refusal of the goods in that class.

dictionary definition,[3] the contents of applicant's responses to the Office actions, and the detailed text of applicant's manual and brochure accompanying applicant's response to the first Office action, we agree that the word "spinal," considered alone, is descriptive of the location of the body on which applicant's tracking device is used and the bodily structure that provides it with a purpose.

Furthermore, the Trademark Examining Attorney argues that the word "mouse" is also descriptive of the hand-held tracking device used to measure the shape and mobility of the spine. However, applicant argues that this small hand-held device, whose operation is admittedly dependent upon a computer, is not a computer mouse.[4] It does not perform any of the defined moving and pointing functions of a computer mouse. Applicant notes

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[3] **Spinal** Of, relating to, or situated near the spine or spinal cord; vertebral; spinal injury. [The American Heritage Dictionary of the English Language, Electronic Version (Third Edition 1992)].

[4] Applicant's counsel states that " … it is not stated anywhere in applicant's manual or brochure that applicant's goods are a 'mouse.'" Actually, several places on page 7 of the manual, for example, the hand-held device is indeed referred to as a "mouse." Additionally, throughout the text in the manual, applicant's trademark itself is misused as the name of the product and on page 23 is incorrectly pluralized (e.g., " … the SpinalMouse …," " … two SpinalMice in the same room… "). However, we hasten to add that this is still an intent-to-use application, and that these materials were requested by the Trademark Examining Attorney under Trademark Rule 2.61(b). Upon submission, applicant's counsel expressly qualified these written materials as being "in draft" and "not yet … distributed to the public." Presumably applicant's U.S. trademark counsel will ensure that when translated from the German language original into the English language editions, the literature as distributed will avoid such imprudent misuses of the trademark and ensure the adoption and consistent usage of a correct generic designation for this device.

that it is not structured like a computer mouse and its operation is distinctly different. Applicant's tracking device is guided in one direction only, down the patient's back over the skin along the spinal column.

The Trademark Examining Attorney, having concluded that each word individually ("Spinal" and "Mouse") is descriptive, then finds that the composite term (SPINALMOUSE) is merely descriptive. By contrast, applicant points out that arguably SPINALMOUSE is an arbitrary, coined term, or at worst, that the combined term is suggestive of the goods.

During the prosecution of this application, the focus of much of the evidence placed into the record by the Trademark Examining Attorney was on the definition of a computer "mouse."[5]

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[5] **Mouse** A common pointing device, popularized by its inclusion as standard equipment with the Apple MacIntosh. With the rise in popularity of graphical user interfaces in MS-DOS, UNIX, and OS-2, use of mice is growing throughout the personal computer and workstation worlds. The basic features of a mouse are a casing with a flat bottom, designed to be gripped by one hand; one or more buttons on the top; a multidirectional detection device (usually a ball) on the bottom; and a cable connecting the mouse to the computer. By moving the mouse on a surface (such as a desk), the user typically controls an on-screen cursor. A mouse is a relative pointing device because there are no defined limits to the mouse's movement and because its placement on a surface does not map directly to a specific location. To select items or choose commands on the screen, the user presses one of the mouse's buttons, producing a "mouse click."

[Computer Dictionary, Microsoft Press (Second Edition, 1994) p. 262].

Mouse An input device, equipped with one or more control buttons, that is housed in a palm-sized case and designed so that you can roll it about on the table, next to your keyboard. As the mouse moves, its circuits relay signals

Accordingly, we are faced with the question of exactly what minimal features are necessary for a computer mouse to still qualify as a mouse?

There are certainly some superficial similarities between these two devices. Both devices have a "palm sized case" that is "gripped in one hand." This tracking device communicates with its base station via a radio link, not a cable. However, while most computer mice still have a "cable" attaching them to the computer terminal (see first definition *supra*), a state-of-the-art cordless mouse is in every way still a mouse. Like a computer mouse, this device has several "buttons" on top (viz. on applicant's device, merely "Stop" and "Start") that would be pressed with one's forefinger.

As to the dissimilarities, applicant correctly notes the significant difference in function between a computer mouse and its hand-held device. All the definitions cited in this record

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> that correspondingly move a pointer on screen. A mouse is distinguished by the internal mechanism it uses to generate its signal and by its means of connection with the computer.

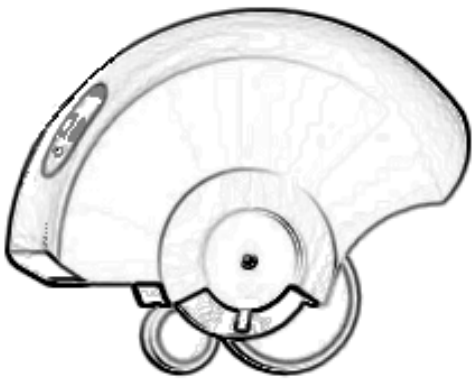
[Webster's New World Dictionary of Computer Terms (Seventh Edition 1999) p. 346].

> **Mouse** An input device designed to assist in the use of a computer system. For example, in a graphical user interface environment like Macintosh or Windows, an icon is displayed on the screen. The user selects the icon by moving the cursor to point to the icon with a mouse, automatically activating a set of commands without the user having to enter complex instructions…

[Prentice Hall's Illustrated Dictionary of Computing (Third Edition 1998) p.442].

emphasize that a computer mouse is a pointing device designed to assist the computer user in interacting with the computer. By contrast, applicant's hand-held device is not a pointing device and is not designed to make a computer easier to use. While the sole mission of a computer mouse is to assist one in operating a computer, applicant has designed a high-tech, medical tracking device that relies upon computerized technology to accomplish its mission. As to form and operation, because a mouse is a *relative* pointing device, it is necessarily multi-directional. In its design and operation, applicant's device is strictly uni-directional. The computer mouse has a flat bottom. The bottom of applicant's tracking device is arcuate and offset at various points with tracking wheels. The tracking device cannot rest on a flat surface but rather, when not in use, sits in a cradle in the base station. While a computer mouse is moved on a flat surface, applicant's device is designed to move down the highly irregular surface of a patient's back along the spine.[6]

[6] This is a rough outline view of the hand-held device at the center of this debate.



On balance, we find this device falls outside the scope of a computer mouse.[7] Certainly, this device could never replicate the critical functionalities of a computer mouse. This device could not be used with a computer that does not have the base station/receiver and applicant's software.[8] Applicant's entire set of goods listed in International Class 9 are useful only to trained medical professionals in the fields of chiropractic medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine.

Hence, while the word "spinal" alone is merely descriptive of these goods, we find that the word "mouse" is not merely descriptive of this tracking device. Beyond the fact that this device is not technically a mouse, we agree with applicant that the combined expression, SPINALMOUSE, is somewhat incongruous, and that no purpose or characteristic is readily described by this combined term, either generally or with particularity. *See* *In re Shutts*, 217 USPQ 363 (TTAB 1983) [SNO-RAKE not merely descriptive for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid

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[7] The conclusion that "applicant's device is an atypical mouse" appears quite early in the dissenting opinion, *infra*. Of course, whether applicant's hand-held device is enough like a computer mouse to be deemed a "mouse" is really what the debate herein is all about. The dissenting judge has handed us a *non-sequitur* hardly capable of removing the doubt of the majority members.

[8] It would be misleading to equate the sophisticated computer-*applications* software supporting applicant's measuring device with "the associated *driver* software" (see dissent, pp. 20 – 21) routinely required for any computer device, including all pointing devices.

uninterrupted construction without prongs."]; *In re Shop Vac Corp.*, 219 USPQ 470 (TTAB 1983) [WET/DRY BROOM is not merely descriptive of a vacuum cleaner or an electric cleaning appliance of similar appearance]; *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975) [BIASTEEL is suggestive of the character of tires]; and *In re Werner Electric Brake & Clutch Co.*, 154 USPQ 328 (TTAB 1967) [ELECTRO-MODULE not descriptive of goods even though each term, considered separately, was found to describe applicant's goods].

Finally, to the extent that there may be any doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. *See In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

Hohein, Administrative Trademark Judge, dissenting:

I would affirm the refusal to register. 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 information concerning any significant 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 considered 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). In addition, registration must be refused if the mark 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) and In re American Society of Clinical Pathologists, Inc., 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1971).

Applying the above principles to the present case, there is simply no question that the evidence and admissions of record establish that the word "spinal" is merely descriptive of, in particular, applicant's "computer programs and software for operating and measuring the input from spinal measuring devices" and its "computerized noninvasive scanning devices used to measure the shape and mobility of the spine." While applicant, in light of the specious arguments to the contrary presented in its reply brief,[1] seems to lack the backbone to admit it, the majority properly concedes that the Examining Attorney is correct that the term "spinal" merely describes applicant's goods, stating that it "agree[s] that the word 'spinal,' considered alone, is descriptive of the location of the body on which applicant's tracking device is used and the bodily structure that provides it with a purpose."

[1] Such arguments also effectively undermine whatever credibility might otherwise be given to applicant's arguments in its main brief.

In this case, however, I also agree with the Examining Attorney, and respectfully disagree with the majority, that applicant's computerized noninvasive spinal scanning device, along with the computer programs and software for operating and measuring the input from such a device, in essence constitute a highly specialized type of computer mouse. Moreover, when the words "spinal" and "mouse" are combined to form the designation "SPINALMOUSE," the result is a term which merely describes a significant purpose, use or function of such goods within the meaning of the statute.

As the majority notes, the record contains a number of definitions of a what generally constitutes a computer "mouse," and judicial notice may usefully be taken of several additional definitions.[2] Unlike the majority, however, which views the

[2] For example, The Dictionary of Computer Words (rev. ed. 1995) at 180-81 defines "**mouse** Plural **mice** or **mouses**" in relevant part as (*italics in original*):

> A hand-held, button-activated *input device* that when rolled along a flat surface controls the movement of a *cursor* or *pointer* on a display screen. A mouse largely frees the user from the keyboard. With *menu-driven* applications the user simply points to a command choice and clicks a button on the mouse. With *draw* or *paint programs* the mouse can be used like a pen or brush. Mice are distinguished by the way they work internally and by how they connection to the computer.
>
> A mechanical mouse has a rubber-coated ball on its underside that rotates as you move the mouse. Optical sensors detect the motion and move the screen pointer correspondingly. You can roll the mouse over almost any surface, but using a *mousepad* gives the best results.

inquiry in this case as being whether applicant's computerized noninvasive spinal scanning device possesses the minimum

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Similarly, the Random House Personal Computer Dictionary (2d ed. 1996) at 324 sets forth "**mouse**" as meaning, in pertinent part:

> A device that controls the movement of the cursor or pointer on a display screen. A mouse is a small object you can roll along a hard, flat surface .... Its name is derived from its shape, which looks a bit like a mouse, its connecting wire that one can imagine to be the mouse's tail, and the fact that one must make it scurry along a surface. As you move the mouse, the pointer on the display screen moves in the same direction. Mice contain at least one button and sometimes as many as three, which have different functions depending on what program is running.
>
> Invented ... in 1963, and pioneered ... in the 1970s, the mouse is one of the great breakthroughs in computer ergonomics because it frees the user to a large extent from using the keyboard. In particular, the mouse is important for graphical user interfaces because you can simply point to options and objects and click a mouse button. .... The mouse is also useful for graphics programs that allow you to draw pictures by using the mouse like a pen, pencil, or paintbrush.

Such dictionary at 235 also points out that, of the three ways mice connect to a computer, "**[c]ordless mice** aren't physically connected at all. Instead they rely on infrared or radio waves to communicate with the computer." In the IBM Dictionary of Computing (10th ed. 1994) at 441, "**mouse**" is listed as connoting:

> (1) In computer graphics, a hand-held locator operated by moving it on a flat surface. A mouse generally contains a control ball or a pair of wheels. .... (2) In SAA usage, a device that a user moves on a flat surface to position a pointer on the screen. It allows a user to select a choice or function to be performed or to perform operations on the screen ....

In a similar vein, The Dictionary of Computing & Digital Media (1999) at 202 lists "**mouse**" as signifying:

> An input device for a computer. A mouse rolls on a smooth surface and determines the location of the cursor on the screen. A mouse has one or more buttons, which are used to "click" on icons or hot spots on the screen. The computer interprets these mouse clicks as instructions. ....

features necessary to still qualify as an ordinary computer mouse, I find that such a device has enough significant features in common with a generalized computer mouse that, to the sophisticated purchasers and users of applicant's goods, its computerized noninvasive spinal scanning device would be readily understood and regarded as a specialized version of a computer mouse.

In particular, while the Examining Attorney focuses on perhaps the broadest of the definitions of what basically constitutes a computer mouse in arguing that, as set forth in Prentice Hall’s Illustrated Dictionary of Computing (3rd ed. 1998) at 442, "the relevant definition of a 'MOUSE' is 'an input device designed to assist in the use of a computer system'," it is still the case that, as persuasively pointed out in his brief (**bold in original**):

> [A]pplicant's goods include ... a computer input device (*i.e.*, a **mouse**) used to measure and characterize different sections of a person's spine (*i.e.*, to take **spinal** measurements and make **spinal** characterizations). According to the brochures, pictures, and user's manual submitted by the applicant, the device is placed on a surface--in this case, on the ... back--and run ... down a person's spine from a start point to a finish point. The person using the "SPINALMOUSE" takes the mouse from its base station and then presses a button to select a measurement mode for the patient's particular standing or seated position. Once that is selected, the mouse is then placed on the spine in the proper starting position and the user presses the

> start button found on top of the mouse. The user then runs the mouse along the spinal column until the measurement is finished, at which point the user presses the start button to terminate the measurement. The pair of wheels at the base of the mouse enables the movement of the mouse along the spinal column. The brochure, pictures, and user's manual make readily apparent that a chief device for which the mark "SPINALMOUSE" is used happens to be a specialized medical computer peripheral input device (*i.e.*, a **mouse**) that can be used with a standard personal computer--whether desktop, laptop or otherwise--to take **spinal** measurements. Idiag, *Spinal Mouse Manual* 15-19 (1999) (emphasis added).

Applicant's contention, however, that in terms of cursor movement, its device apparently does not perform any of the defined moving and pointing functions of a typical computer mouse is not dispositive of the issue of mere descriptiveness because applicant's device is an atypical mouse in that it measures and inputs data concerning spinal shape and mobility directly into a computer. This is clearly seen from applicant's advertising literature, which under the heading "FUNCTION AND DESCRIPTION," states in relevant part that (**bold in original**):

> The computer-assisted SpinalMouse is a newly developed device of medical and therapeutic use **to measure the spine's shape and mobility in the sagittal plane**. The movement is simple, fast, accurate and harmless to the patient.
>
> The handy device is manually guided over the skin of the back along the spinal column; the measuring head follows automatically the sagittal shape. Clinically relevant parameters such **as**

> **length, inclination** relative to a vertical line, **sagittal curvature, segmental angles** of the thoracic and lumbar spine and pelvic tilt are registered and shown in an easily understandable drawing.
>
> In comparison to existing methods the SpinalMouse offers many advantages in terms of **accuracy, objectivity**, data presentation, **non-invasiveness, absence of radiation, ease of use** and excellent cost-benefit ratio.

Notwithstanding that, like an ordinary computer mouse, applicant's device is *manually guided* over a surface, applicant further asserts that the operation of its device is distinctly different in that the device, which is guided down a patient's spinal column, is moved in only one direction. However, while it is plain that, in order to take its measurements and input the data gathered into a computer, applicant's device does indeed, generally speaking, travel down a person's spine, in actuality such a device, like a typical computer mouse, is multi-directional rather than merely uni-directional as claimed by applicant and the majority. Just as an ordinary mouse can move in a variety of directions (up or down, left or right, or a combination thereof) within the planar surface of a mousepad, applicant's device in effect uses the skin covering a person's spinal column as a three-dimensional (down, left or right, in or out, or a combination thereof)[3] mousepad surface as it measures

[3] While applicant's device can also travel in an upward direction, it is designed to provide useful data only when moved downwards. As stated in the user manual at 19:

sagittal shape and such relevant spinal parameters as length, inclination to vertical, curvature, segmental angles and pelvic tilt. The measurements so gathered by applicant's device are automatically entered, through the use of applicant's programs and operating software, into a computer. Applicant's user manual at 17 states, for example, that "[a]s you run down the patients [sic] back, the back curve will be generated real-time on the computer screen." Clearly, like an ordinary computer mouse, such ease of operation assists the user in the use of the computer to provide various data presentations for evaluation.

Accordingly, I simply cannot agree with the stated view of the majority, set forth below, that applicant is correct as to there being a "significant difference in function between a computer mouse and its hand-held device," based principally upon the lack of both cursor-pointing capability and user ease of computer interaction:

> All the definitions cited in this record emphasize that a computer mouse is a pointing device designed to assist the computer user in interacting with the computer. By contrast, applicant's hand-held device is not a pointing device and is

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> Always begin measurement at the upper marker and roll down the back .... The SpinalMouse is not bi-directional. If you try measurements in the opposite direction the data will be meaningless.

Thus, it is fair to say that applicant's device is uni-directional only in the vertical plane; in terms of horizontal and depth measurements, it is clearly multi-directional.

> not designed to make a computer easier to use. While the sole mission of a computer mouse is to assist one in operating a computer, applicant has designed a high-tech, medical tracking device that relies upon computerized technology to accomplish its mission. As to form and operation, because a mouse is a *relative* pointing device, it is necessarily multi-directional. In its design and operation, applicant's device is strictly uni-directional. .... While a computer mouse is moved on a flat surface, applicant's device is designed to move down the highly irregular surface of a patient's back along the spine.

As noted earlier, applicant's device is specifically engineered so as to not require a corresponding cursor movement in order for the user to interact with a computer; instead, all the user need do, after selecting a measurement mode, is to start at the top of a patient's spine and move the device down the spinal column, with the measurements so registered being automatically entered into a computer.

The majority, moreover, glosses over the several additional similarities shared by applicant's device and an ordinary computer mouse, while seizing upon inconsequential dissimilarities. As to those similarities which the majority deems "superficial," I find it significant that in terms of ease of use and interaction with a computer, applicant's device, like a general purpose computer mouse, features a palm-sized case which is gripped in one hand and has two buttons on top which are "clicked" with a forefinger. With respect to the

dissimilarities, the majority to its credit does not regard the absence of a cable or "tail" on applicant's device as a notable difference, accurately noting that:

> This tracking device communicates with its base station via a radio link, not a cable. However, while most computer mice still have a "cable" attaching them to the computer terminal ..., a state-of-the-art cordless mouse is in every way still a mouse.

The majority, nonetheless, finds that applicant's device "is not technically a mouse," observing among other things that:

> The computer mouse has a flat bottom. The bottom of applicant’s tracking device is arcuate and offset at various points with tracking wheels. The tracking device cannot rest on a flat surface but rather, when not in use, sits in a cradle in the base station.

To me, however, such distinctions are without a meaningful difference. While an ordinary mouse, which is designed to roll along a flat surface, would typically have a flat bottom, it must be kept in mind that applicant's specialized device has an arcuate bottom, and rests in a cradle when not use, precisely because it is designed to roll along the curves of a patient's spinal column. Moreover, the fact that applicant's device uses wheels instead of a ball does not, according to most of the pertinent definitions, make it something other than a mouse.

Applicant, in fact, not only finds it necessary in its user manual to distinguish between its "SpinalMouse" device and

an ordinary computer mouse, variously referring to the latter (at 14, 15, 21 and 25, respectively) as a "PC-mouse," "computer mouse," "PC Mouse" and "PC mouse," but even refers to its own device as a "mouse". In particular, under the heading "Problems and Solutions," applicant indicates in its user manual at 7 that the possible cause of the program-error message "Leave energy-saving mode - press Marker button twice" is (*emphasis added*): "The SpinalMouse was not used for at least 30 seconds. The *mouse* is now in energy-saving mode." Likewise, with respect to the program-error message "Movement too fast. Repeat the measurement," applicant on the same page of such manual states that the possible cause thereof is (*emphasis added*): "You exceeded the maximum speed which the *mouse* can handle." These instances not only show that it would be natural for applicant's "SPINALMOUSE" device to be called a mouse, but more significantly that the medically knowledgeable and highly sophisticated purchasers and users of applicant's device would readily understand that such a device, while quite specialized, in essence is nevertheless a type of computer mouse.[4]

[4] Although the majority rightfully chastises applicant for counsel's demonstrably false representation that "it is not stated anywhere in applicant's manual or brochure that applicant's goods are a 'mouse'," and properly takes applicant to task for the misuse of its mark, counsel's characterization (if such can be believed) of applicant's written materials as being "in draft" and "not yet ... distributed to the public" does not alter the fact the applicant's literature plainly evidences that applicant's computerized noninvasive spinal scanning device is a kind of computer mouse and would be so regarded by customers therefor and users thereof.

In consequence of the above, I am unable to subscribe to the majority's strained conclusion that:

> On balance, we find this device falls outside the scope of a computer mouse. Certainly, this device could never replicate the critical functionalities of a computer mouse. This device could not be used with a computer that does not have the base station/receiver and applicant's software. Applicant's entire set of goods listed in International Class 9 are useful only to trained medical professionals in the fields of chiropractic medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine.

The finding by the majority that applicant's goods could not duplicate the usual workings of an ordinary computer mouse fails in my view to give sufficient consideration to the fact that, as previously explained, applicant's device is a specialized kind of mouse designed solely for measuring and recording spinal parameters. That such device, as well as applicant's other goods, are therefore of use only to trained professionals in the fields of chiropractic medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine does not alter the fact that applicant's device in essence is still a kind of mouse. Furthermore, that such a device could not be used with a computer that does not have the requisite base station/receiver and operating software dismisses the very fact, recognized by the majority, that a state-of-the-art cordless mouse--including applicant's device--is still in every

way a mouse and that no mouse, whether cordless or linked to a computer by a cable, will function absent the associated driver software required for its operation.

Accordingly, since for all of the above reasons, applicant's computerized noninvasive spinal scanning device, together with the computer programs and software for operating and measuring the input from such a device, basically constitute a highly specialized type of computer mouse, I would find that combining the descriptive terms "spinal" and "mouse" into the designation "SPINALMOUSE" creates a term which immediately describes, without conjecture or speculation, a significant purpose, use or function of such goods. Contrary to the majority's holding, there is nothing in the term "SPINALMOUSE" which, to the highly trained and medically knowledgeable customers for and users of applicant's goods, is in the least bit incongruous,[5] nor is there anything which is ambiguous or even suggestive of another plausible meaning. No imagination, cogitation or mental gymnastics is required in order for purchasers and users alike to readily understand the merely descriptive significance of such term. Instead, the designation

[5] What the majority perceives as an incongruity in the mark may more likely be the apparent novelty of the applicant's device itself. However, the fact that spinal shape and mobility have not previously been measured using a computer-assisted noninvasive scanning device in the form of a mouse does not make the designation "SPINALMOUSE" even "somewhat incongruous" as contended by the majority.

"SPINALMOUSE," especially in light of the manner in which it is chiefly used (*i.e.*, "SpinalMouse"), is merely descriptive of applicant's goods because it conveys forthwith that the purpose, use or function of applicant's computerized noninvasive scanning device and associated software is that of a mouse for measuring the spinal column or, in short, that such goods are a spinal mouse. See, e.g., In re Abcor Development Corp., supra at 219 (Rich, J., concurring) [term "GASBADGE" held merely descriptive of a device to determine and monitor pollution due to fact that, since "users of language have a universal habit of shortening full names," it is "*inevitable* that a gas monitoring badge will be called a gas badge as the name of the goods to the same extent as gas monitoring badge is the [full] name" of such goods].