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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Virtual Physical, Inc.*

Serial No. 76/243,246

Burton A. Amernick and *Michael L. Lovitz* of *Connolly Bove Lodge & Hutz, LLP* for *Virtual Physical, Inc.*

Ira Goodsaid, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

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

Opinion by *Hohein*, Administrative Trademark Judge:

Virtual Physical, Inc. has filed an application to register the mark "VIRTUAL PHYSICAL" and design, as shown below,



for "medical services rendered via CAT scan imaging centers."¹

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of

¹ Ser. No. 76/243,246, filed on April 19, 2001, which is based on an allegation of a date of first use anywhere of January 3, 2001 and a date of first use in commerce of January 15, 2001.

applicant's refusal to comply with a requirement for a disclaimer of the wording "VIRTUAL PHYSICAL," which the Examining Attorney maintains is merely descriptive of applicant's services 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, but an oral hearing was not requested. We affirm the disclaimer requirement.

Applicant, noting in its initial brief that the several excerpts which it made of record from various websites show that services like those which it provides "are typically described as total or full body scans, or CT scans," and that the record contains no evidence from the "NEXIS" database or other sources demonstrating any third-party use of the term "virtual physical," argues that in view thereof:

[A] "reasonably informed shopper" familiar with the relevant literature, news, and information concerning medical services rendered via CAT imaging centers would not readily associate the term "VIRTUAL PHYSICAL" with services of the type provided by applicant. Furthermore, the average prospective purchaser is one who is seeking a CT scan, or full body scan. As the term VIRTUAL PHYSICAL has not been used by other providers of similar services, such an average prospective consumer will not associate the term VIRTUAL PHYSICAL with medical services rendered via CAT scan imaging centers. This shows that the term "VIRTUAL PHSICAL" is not descriptive to an average prospective purchaser and should not be disclaimed from applicant's application.

Further noting in its initial brief that the record contains definitions of the words "virtual" and "physical" which the

Examining Attorney has referred to "as evidence that applicant's mark is descriptive," applicant contends in particular that the Examining Attorney erred by having "equated the word 'PHYSICAL' with a physical examination of the body." According to applicant:

In reality, however, CT scans, which are also referred to as computerized topography, are distinguished as a process separate and apart from a physical examination. As such, the word "PHYSICAL" is not descriptive of the type of services being offered by applicant.

In addition, applicant asserts in its initial brief that even if the terms "virtual" and "physical" are considered merely descriptive of its services, combining those words into the phrase "VIRTUAL PHYSICAL" results "in an incongruous juxtaposition that evokes a unique commercial impression overcoming any descriptiveness of the individual terms." In support of such assertion, applicant points out that:

The ... extract from webpedia.com attached to the [initial] Office Action ... shows that the literal meaning of the term "VIRTUAL" is "not real." The extract further states that the opposite of "VIRTUAL" is "PHYSICAL."

Moreover, applicant urges that "the terms are juxtaposed in such a position that prospective purchasers do not readily think of the type of services provided by the applicant upon hearing the phrase 'VIRTUAL PHYSICAL.'" According to applicant, the failure of the record to show that anyone else "has used the term 'VIRTUAL PHYSICAL' to describe the type of services provided by the applicant ... is evidence that the phrase is inventive and has a unique commercial impression."

Finally, correctly observing that unless a mark "gives some accurate or distinct knowledge as [to] the nature of a product [or service], it is [suggestive and] not descriptive," applicant insists in its initial brief that "the phrase 'VIRTUAL PHYSICAL' is vague, [in that it] indirectly suggests the type of services provided by applicant, and [thus] requires a leap of the imagination to be associated with applicant's services." In view thereof, applicant contends that such phrase is not merely descriptive of its services. Again, according to applicant, "[t]his is evidenced by the fact that the term 'VIRTUAL PHYSICAL' has not been used by others in conjunction with the type of services offered by applicant."

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). Instead, it is well established that the determination of mere descriptiveness must be decided on the basis of the identification of goods as set forth in the application. See, e.g., *In re Allen Electric & Equipment Co.*, 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972).

Applying the above to the facts of this appeal, we agree with the Examining Attorney that the requirement for a disclaimer of the term "VIRTUAL PHYSICAL" is proper because such term is merely descriptive of applicant's "medical services rendered via CAT scan imaging centers." Clearly, applicant's services are so broadly identified as to encompasses any form or type of "medical services" which may be "rendered via CAT scan imaging centers," including patient "physical examinations"² or physicals of any kind.

² We judicially notice in this regard that, for instance, Mosby's Medical, Nursing, & Allied Health Dictionary (5th ed. 1998) at 1261-62 defines "physical examination" as "an investigation of the body to determine its state of health, using any or all of the techniques of inspection, palpation, percussion, auscultation, and smell. The physical examination, history, and initial laboratory tests constitute the data base on which a diagnosis is made and on which a plan of treatment is developed." 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).

As the Examining Attorney points out in his brief, the brochure submitted by applicant as its specimen of use "best show[s]" that the term "VIRTUAL PHYSICAL" "immediately describe[s] the medical services rendered at the applicant's [CAT] scan imaging centers." Such brochure, in relevant part, states as follows (bold italics in original):

While the annual physical is still important, the Virtual Physical's early detection capability can uncover asymptomatic and often life-threatening diseases generally not detectable by physical exam or standard screening tests.

....

Virtual Physical's comprehensive scan of your body is far more detailed and precise than an X-ray. It covers: the heart and arteries ...; the lungs ...; the spine ...; internal organs ...; aneurysms ...; thyroid and parathyroid disease; joint disease; uterine, ovarian and prostate disease.

....

Once your Virtual Physical is completed, a Board Certified Radiologist will review it with you, noting any problems that may require further evaluation. You'll leave with the Radiologist's written analysis, a CD-ROM of your entire Virtual Physical and selected color photographs of your scan. At your request, the Virtual Physical data can be forwarded to your personal physician or a specialist for additional evaluation and treatment.

The non-invasive Virtual Colonoscopy.

The Virtual Colonoscopy is a new method of imaging the entire colon that is simpler, faster, and less invasive than conventional colonoscopy. It requires no sedation and can simply be incorporated in the overall Virtual Physical that already includes virtual bronchoscopy and virtual gastroscopy. The technology provides higher resolution with faster scanning.

About Virtual Physical

Virtual Physical was established by concerned health care professionals who saw this test as a powerful new weapon against heart disease, cancer and other deadly illnesses. With wide-spread use, the Virtual Physical will help people lead healthier, longer lives.

....

The Virtual Physical is a revolutionary approach to preventive medicine that gives you a remarkably precise 3-D visualization of your total body.

The Examining Attorney, in view thereof, persuasively observes in his brief that:

The opening line of the above-quoted brochure contrasts an annual physical with a virtual physical. The specimen touts a virtual physical as better to detect problems, and less invasive than a conventional physical. The references to "virtual colonoscopy," "virtual bronchoscopy" and "virtual gastroscopy" emphasize that the applicant's [CAT] scan imaging is the virtual equivalent of a physical and the other named procedures.

In addition, as further support for his position, the Examining indicates that The American Heritage Dictionary of the English Language (3rd ed. 1992) defines "virtual" as an adjective meaning "[e]xisting or resulting in essence or effect though not in actual fact, form or name: *the virtual extinction of the buffalo*" and lists "physical" as a noun signifying "[a] physical examination."³ Moreover, while noting that the prior Examining Attorney assigned to this case made of record, from the online

³ Although the former definition, unlike the latter, was not mentioned for the first time until reference thereto in the Examining Attorney's

encyclopedia webopedia, the following "lengthy, encyclopedic explanation of the meaning of 'virtual'," the Examining Attorney points out that applicant's positing therefrom (in its main brief) that "the opposite of 'VIRTUAL' is 'PHYSICAL'" is "inapt," given the entirety of the last sentence of the definition of the word "virtual" as set forth below (italics and underlining in original):

Not real. The term *virtual* is popular among computer scientists and is used in a wide variety of situations. In general, it distinguishes something that is merely conceptual from something that has physical reality. For example, virtual memory refers to an imaginary set of locations, or addresses, where you can store data. It is imaginary in the sense that the memory area is not the same as the real physical memory composed of transistors.

The opposite of virtual is *real*, *absolute*, or *physical*.

Based on the above, and citing for the first time in his brief the definition, which we judicially notice, of the term "physical examination," which is set forth in the MEDLINEplus Online Medical Dictionary (2003) as meaning "an examination of the bodily functions and condition of an individual," the Examining Attorney maintains that:

The applicant's CAT scan imaging centers provide examinations of individuals that presumptively exceed the diagnostic abilities of a standard physical. The definitions and common understanding of "virtual physical," viewed in the context of the applicant's [medical] scanning services, immediately describe[s] an examination of the condition of an individual. The 3-D visualization of

brief, we have considered such since, as previously pointed out, the Board may properly take judicial notice of dictionary definitions.

the body touted by the applicant's [brochure] ... is literally a virtual physical, as opposed to a typical physical involving corporeal inspection.

....

A physical typically involves a hands-on examination which checks heart rate, blood pressure, pulse and other metabolic functions. Consumers would understand a virtual physical to entail an examination that is not hands-on. As the applicant's [brochure] ... clearly indicates, the applicant's CAT scans provide a virtual physical--the electronic inspection and imaging of the body to provide an essentially touch-free physical: a virtual physical.

Lastly, the Examining Attorney asserts that, contrary to applicant's contention, "[t]here is no 'incongruous juxtaposition' of the words 'virtual' and 'physical' in the mark." Citing, again for the first time in his brief, the definition, which we judicially notice, of "CAT scan" from the MEDLINEplus On-line Medical Dictionary (2003) as meaning "a sectional view of the body constructed by computed tomography-- called also CT scan," the Examining Attorney consequently insists that there is no incongruous juxtaposition or unique or inventive commercial impression which is created by the combination of the words "virtual" and "physical." Instead, according to the Examining Attorney, the term "VIRTUAL PHYSICAL" merely describes applicant's services, and hence must be disclaimed, because such services plainly "constitute a virtual physical, as those words are defined and commonly understood," in that the services "are essentially a computer scan of the body to detect possible problems." Furthermore, as the Examining Attorney, citing *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020

(TTAB 1983), properly points out, even if the term "VIRTUAL PHYSICAL" has not been used by any other providers of the same or similar scanning services, the fact that applicant may thus be the first and only user of such term does not justify registration where, as here, the term is merely descriptive of applicant's services. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 n. 8 (CCPA 1980).

As indicated above, we concur with the Examining Attorney's analysis and disagree with applicant's contentions. Plainly, when considered in the context of applicant's "medical services rendered via CAT scan imaging centers," applicant's brochure makes clear that the imaging scans provided by such services are a kind of "physical," i.e., a patient physical examination, and that customers of applicant's services, namely, ordinary consumers of medical services, would so understand that its imaging scans function as a type of physical. While such scans are not a standard physical examination, in the sense of a traditional "hands-on" physical conducted in person by a physician to assess the state of a patient's health, they are nonetheless a "virtual" physical in that the noninvasive CAT scan images of the patient's body in essence or effect likewise provide information (often in much greater detail) concerning the state of a patient's health.

Consequently, as contended by the Examining Attorney, the term "VIRTUAL PHYSICAL" immediately describes, without the need for speculation or conjecture, the nature, function or use of the medical services rendered by applicant by way of its CAT

scan imaging centers. Applicant's advertising literature and the definitions of the words "virtual" and "physical," as relied upon by the Examining Attorney, are sufficient evidence to establish that the term "VIRTUAL PHYSICAL," when used in connection with applicant's services, is merely descriptive thereof. Nothing in such term, for instance, is ambiguous, vague or incongruous when considered in the context of applicant's services, nor would customers or prospective consumers of the services need to gather further information in order to understand the meaning of the term "VIRTUAL PHYSICAL." See In re Styleclick.com Inc., 58 USPQ2d 1523, 1527 (TTAB 2001) [term "VIRTUAL FASHION" held merely descriptive of, inter alia, electronic retailing services rendered via a global computer network and featuring apparel, fashion, accessories, personal care items, jewelry and cosmetics, given that "the meaning of the term 'virtual' is commonly recognized and understood by most people as meaning something that is merely conceptual rather than something that has physical reality, especially in connection with things encountered via computers and the Internet," and that "[a]s the Internet continues to grow, merely descriptive 'virtual' terms for Internet-related goods and/or services must be kept available for competitive use by others"].

Moreover, the fact that applicant introduced evidence showing that some of its competitors describe their services, which are the same as or similar to applicant's medical services rendered via CAT scan imaging centers, by such other terms as "total or full body scans, or CT scans," does not mean that the

term "VIRTUAL PHYSICAL" is not merely descriptive of applicant's services. See, e.g., Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc., 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962). Furthermore, it is pointed out that, contrary to applicant's repeated assertions as to the absence thereof, neither applicant nor the Examining Attorney introduced any evidence as to the extent, if any, of any third-party use of the term "VIRTUAL PHYSICAL." Plainly, the absence of evidence with respect thereto is not evidence of absence of any use of "VIRTUAL PHYSICAL" by applicant's competitors.

Finally, no new, nondescriptive meaning is created by the combination or juxtaposition of the descriptive words "virtual" and "physical." Combining such words into the term "VIRTUAL PHYSICAL" does not result in a composite which is so inventive, unusual or otherwise different in meaning from its descriptive constituent words as to possess no definitive connotation or significance other than that of an indication of source for applicant's services. Instead, there is simply nothing in such combined term which, when used in connection with applicant's rendering of medical services via CAT scan imaging centers, requires the exercise of imagination, cogitation or mental processing in order for the merely descriptive significance thereof to be immediately apparent. A disclaimer of the merely descriptive term "VIRTUAL PHYSICAL" is thus proper.

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

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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 "VIRTUAL PHYSICAL."⁴

⁴ See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.08(a) and (b) (3d ed. 2d rev. May 2003).