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Mailed:
February 1, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nidek Co., Ltd.

Serial No. 76412719

Gary D. Krugman of Sughrue Mion, PLLC for Nidek Co., Ltd.

Alec Powers, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Nidek Co., Ltd. seeks registration on the Principal
Register of the stylized mark shown below:

OPD-Scan

for ophthalmic equipment identified in the application, as
amended, as a "refractive error and corneal aberration
analyzer" in International Class 10.¹

¹ Application Serial No. 76412719 was filed on May 22, 2002
based upon applicant's allegation of use in commerce with the
United States at least as early as October 22, 2000.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "OPD-Scan" immediately informs potential purchasers about the features and functions of applicant's goods.

Both applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing before the Board. We affirm the refusal to register.

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely descriptive is to consider the mark in relation to the goods or services for which registration is sought, the context in which the mark is used or is intended to be used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

While applicant has conceded that the term "OPD" may serve as an initialism for "optical path difference," applicant also argues that the term "OPD-Scan," when considered in its entirety, does not merely describe any feature, function, characteristic or attribute of applicant's goods. Applicant contends that although this initialism comprises a technical term in the field of optics, it cannot be said to directly or immediately convey any information about applicant's specific ophthalmological

instruments. Applicant applies the general case law for determining that dividing line between merely descriptive terms and suggestive terms, by arguing as follows:

While Applicant concedes that imagination and mature thought can be utilized to analyze the mark as it applies to Applicant's specific goods, it is submitted that such mature thought and imagination is necessary in order to determine the nature of Applicant's goods from the mark. This is, Applicant submits, a classic example of a suggestive mark. Applicant's mark OPD-SCAN, as applied to Applicant's specific product, suggests in a general way that the goods have something to do with an OPD map and that there is some scanning function of the retina that occurs but it is submitted that the mark OPD-SCAN does not immediately or directly describe any feature or characteristic of Applicant's goods.

Applicant's appeal brief, p. 6 [emphasis in original].

In further support of its position, applicant has submitted a number of third-party registrations for optical and medical products which marks included either the term OPD or the term SCAN as a component of the composite marks. Moreover, applicant argues that none of applicant's identified competitors even mentions or refers to "optical path difference" or "OPD" in any of the promotional materials of these companies. Applicant also points out that the involved mark was registered both in Japan and in the European Union, demonstrating that "at least two other intellectual property offices have determined that this

term is not merely descriptive of the goods for which registration is sought herein." Applicant's appeal brief, p. 7. Finally, applicant reminds the Board that, in the event that the descriptiveness determination is considered to be a close question, any doubt on this issue should be resolved in favor of the applicant with the mark being published for opposition so that any third party believed to be damaged by the registration of applicant's mark, can file an opposition. *In re The Rank Org., Ltd.* 222 U5PQ 324 (TTAB 1984). Applicant's appeal brief, p. 7.

By contrast, in support of his refusal of registration, the Trademark Examining Attorney submitted an excerpt from an "Acronym Finder" website showing twenty entries for the initialism, "OPD," one of which is "optical path difference." The Examining Attorney also submitted LEXIS/NEXIS and Internet excerpts where "OPD" is used as an abbreviated form of the term "optical path difference." With this evidence, the Trademark Examining Attorney contends that the term OPD is a commonly-used initialism for the "optical path difference" measurement technology relied upon in this equipment. Furthermore, based upon various dictionary definitions and applicant's webpages, the Trademark Examining Attorney contends that the term "scan" merely describes ophthalmic equipment that uses an

infrared light slit beam to scan the retina. The Trademark Examining Attorney argues further that when these two merely descriptive components ("OPD" and "Scan") are combined, the composite mark is still not registrable as it does not comprise a double entendre nor does it create a novel or incongruous term. See In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

We start our analysis of this case with the fact that OPD is shown in the acronym website to be an accepted abbreviation for "optical path difference." In its brief, applicant has conceded as much: "While the term OPD may serve as an acronym for optical path difference, it is a technical term in the optics field" Applicant's appeal brief, p. 6. Secondly, the Trademark Examining Attorney has shown from dictionary definitions that the term "scan" is an appropriate term to convey information about ophthalmic equipment that uses an infrared light slit beam to scan the retina as does applicant's refractive error analyzer. See further discussion *infra*.

The Trademark Examining Attorney has placed into the record a number of scholarly papers drawn from commercial and university sites (from the Internet and from the Medline database of Lexis/Nexis electronic files) that serve as a veritable primer on applied physics and the

refractive principles of light. Some articles are written in the context of optical microscopy, and explain how the refraction of light occurs when it passes through an object.² One of the Lexis/Nexis articles refers to "Optical Path Difference (OPD)" in the context of an experiment on the corneas of rabbits' eyes.³ The Olympus site lays out the mathematical equations for calculating the OPD from the microscopic measurements of the object and the refractive index.⁴ Several additional websites use the term in the context of telescopes, hence involving an Optical Path Difference, or OPD, of much larger orders of magnitude (e.g., involved with astronomy and astrophysics) than is the case with optical microscopy.⁵ We find in all of these

² TITLE: *Digital Hilbert transformation for separation measurement of thicknesses and refractive indices of layered objects by use of a wavelength-scanning heterodyne interference confocal microscope*, AUTHORS: Yuuki Watanabe & Ichirou Yanaguchi, *Applied Optics*, vol. 41, iss. no. 22, pp. 4497-4502.

TITLE: A scanning microminterferometer with correction of errors caused by overlapping 'ghost' images. AUTHORS: De Josselin De Jong JE, Loeve J, Richter H, De Sterke H, Ploem JS, *J Microsc.* 1979 Apr; vol. 115, iss. no. 3, pp. 257-69.

³ TITLE: *Analysis of birefringence during wound healing and remodeling following alkali burns in rabbit cornea*. AUTHORS: Huang Y.; Meek K.M.; Ho M.W.; and Paterson C.A., *Exp Eye Res.* 2001 Oct; vol. 73, iss. no. 4, pp. 521-32.

⁴ <http://www.olympusmicro.com/primer/java/contrast/phaserefract/>

⁵ TITLE: *Optical Path Difference Fluctuations at the CHARA Interferometric Array*, AUTHORS: A. Merand (NOAO & DESPA), T.A. ten Brummelaar, H.A. McAlister (CHARA), S.T. Ridgway (NOAO & CHARA), J. Sturmann, L. Sturmann, N.H. Turner, W.G. Bagnuolo, M. Hrynevych, M.A. Shure (CHARA), <http://www.aas.org/publications/baas/v33n2/aas198/667.htm>;

articles, the initialism "OPD" is used substantially synonymously with the term "Optical Path Difference."

We find that the evidence of record demonstrates the fact that OPD, while admittedly a technical term, would be readily understood by the relevant consumers, including ophthalmologists, optometrists, opticians, and other optical professionals. The term OPD, within the larger designation, "OPD-Scan," would immediately convey to them the nature of the technology at the heart of this product, as applicant's goods obviously use OPD technology.

As further corroboration of our conclusion that the mark is merely descriptive, we turn to applicant's own webpages and sales brochure. The webpages explain what applicant's refractive error analyzer measures and how it works. In general, its refractive error analyzer measures the distance light travels in different paths going through the eye. Applicant's webpages say, "The retina is scanned ... " by the refractive error analyzer using an

TITLE: *Real-time optical path difference compensation at the Plateau de Calern I2T interferometer*, AUTHORS: B. Sorrente, F. Cassaing, G. Rousset, S. RobbeDubois and Y. Rabbia, <http://www.edpsciences.org/articles/aa/abs/2001/02/aads1678/aads1678.html> (Received 6 January 1999/Accepted 14 August 2000);

TITLE: Physics@Sydney, The Optical path length compensation (OPLC) system, http://www.physics.usyd.edu.au/astron/susi/susi_path.html

infrared light slit beam. Applicant's use of the word "scan," either as a verb or as a noun, is consistent with the dictionary entry placed into the record by the Trademark Examining Attorney.⁶

According to applicant's webpages, the analyzer captures the reflected light with an array of rotating light detectors to create a refractive map (or "an OPD map"). Light that has farther to travel will have more of a phase difference. The map is produced by comparing the phase differences off of the same incoming beam through different paths in the eye.

Specifically, applicant's website, in describing the principles of operation, says, "The OPD-Scan utilizes the principle of skiascopic phase difference for refractive map measurement." Elsewhere, the record discusses how the involved refractive error analyzer uses "dynamic skiascopy." The word "skiascopy," like the word "retinoscopy," refers to "the medical examination and

⁶ Dictionary definitions of "**Scan**" including: "(verb) (1.) to examine closely; (2.) To look over quickly and systematically; ... (7.) *Medicine*: To examine (a body or body part) with a CAT scanner or similar scanning apparatus. (noun) ... (3.a.) Examination of a body or bodily part by a CAT scanner or similar scanning apparatus; (3.b.) A picture or an image produced by this means..."

analysis of the refractive properties of the eye.”⁷ This “refractive power analyzer” ... “[c]reates an OPD map”

The required specimen of use filed with the application papers on May 22, 2002 was a black-and-white photocopy of the front cover of a brochure put out by applicant. In the center of the specimen is a photograph of the ARK-10000 model of ophthalmic equipment sold under the designation “OPD-Scan.” On the top of the specimen, right above the term OPD-Scan, is printed the phrase, “Optical Path Difference Scanning System”:



The designation “Optical Path Difference Scanning System” appears to be a highly-descriptive term for the involved product. Combined with the Lexis/Nexis and Internet evidence reviewed above, we find that the initialism OPD is an accepted abbreviation used

⁷ **skiascopy** (See retinoscopy). The American Heritage® Dictionary of the English Language, (4th ed. 2000).

retinoscopy: (*noun*) Medical examination and analysis of the refractive properties of the eye. Also called skiascopy. The American Heritage® Dictionary of the English Language, (4th ed. 2000). The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)

synonymously with the term "Optical Path Difference."
Modern Optics v. Univis, 234 F.2d 504, 110 USPQ 293 (CCPA 1956). The remaining portion of the larger phrase on applicant's brochure is "Scanning System" - wording applicant has placed directly above the word "Scan." On applicant's webpages and brochure, we see that both "OPD" and "scan" are used separately in a highly-descriptive manner in connection with discussions of its ARK-10000 OPD-Scan equipment. We further find that when these two components are combined into the composite term, OPD-Scan, the individual words do not lose their descriptive significance, and that the mark OPD-SCAN is also merely descriptive. Relevant consumers viewing the mark in connection with the goods would immediately understand that the goods use *optical path difference* technology in an analyzer designed to *scan* the retina. It takes no imagination to know that the combined term, "OPD-Scan" is a shorthand term for applicant's "Optical Path Difference Scanning System."

In other arguments, applicant contends that in the past the United States Patent and Trademark Office has determined that these individual terms are not merely descriptive for goods in the optical or medical equipment fields:

In addition to the foregoing, Applicant has submitted third party registrations of marks which include OPD and SCAN for optical or medical products. While it is recognized that these third party registrations are not binding on any descriptiveness determination in this case, they are probative to show that [the] United States Patent and Trademark Office, on at least several past occasions, has had an occasion to determine the descriptive nature of these terms in the optical/medical field and has determined that they are not descriptive.

Applicant's appeal brief, p. 7. Of course, the fact that third parties registered marks containing the element SCAN for other unrelated products in the medical field, or registered marks containing the term OPD for medical equipment clearly not involving the technology of optical path difference (e.g., lancets), or even optical equipment apparently not involving such technology (e.g., display units for projectors), is not persuasive of a different result herein.⁸

Suffice it to say that these registrations are of little help in determining the registrability of the

⁸ Reg. No. 2637255, **SCAN-X** for "computer software for analyzing data generated by laser scanners on video metrology systems"; Reg. No. 2634591, **I-SCAN** for "computer hardware and software for pressure distribution measurement in the fields of medical, dental, industrial and consumer products"; Reg. No. 2569787, **BIOSCAN** for "automatic ion chromatography apparatus, namely, carbohydrate analyzer, electrochemical multifunctional detector, column oven"; Reg. No. 2328141, **OPD** for "Display units for optical projection of three-dimensional images"; and Reg. No. 1494991, **OPD** for "lancets for medical use."

mark at issue in this case. As has often been noted by the Board, each case must be decided on its own set of facts. None of these marks involved this particular combination of terms, and thus the facts in those records (to which we are not privy) would obviously be different. Moreover, the Board is not bound by actions taken by Trademark Examining Attorneys. In re National Novice Hockey League, Inc. 222 USPQ 638, 641 (TTAB 1984) and In re Scholastic Testing Service, Inc., 196 USPQ 517, 519 (TTAB 1977). While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's asserted mark is registrable.

Applicant points out (applicant's appeal brief, p. 7) that this mark has been registered in Japan as well as in the European Union:

Applicant has also submitted evidence to demonstrate that Applicant's mark herein has been accepted for registration both in Japan and in the European Union. Again, while it is recognized the successful obtaining of registrations of the mark in Japan and in the European Union is not binding on the United States Patent and Trademark Office, they were brought to the Examining Attorney's attention to demonstrate that at least two other intellectual property offices have determined that this term is

not merely descriptive of the goods for which registration is sought herein.

While applicant acknowledges that registration by two other intellectual property offices is not binding on the United States Patent and Trademark Office, this fact is actually of no consequence in the determination of mere descriptiveness under the Trademark Act in this country.

Accordingly, we conclude that the term *OPD-Scan* immediately describes applicant's goods, and therefore registration on the Principal Register is barred by Section 2(e)(1) of the Trademark Act.

Decision: The refusal to register this mark on the Principal Register based upon Section 2(e)(1) of the Lanham Act is hereby affirmed.