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Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Advanced Neuromodulation Systems, Inc.

Serial No. 76588517

Michele P. Schwartz of Andrews Kurth LLP for Advanced Neuromodulation Systems, Inc.

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Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Advanced Neuromodulation Systems, Inc. seeks registration on the Principal Register of the mark **ULTRACATH** *(in standard character format)* for goods identified in the application as "catheters" in International Class 10.[1]

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the

[1] Application Serial No. 76588517 was filed on April 23, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "Ultracath" immediately informs potential purchasers about a characteristic of applicant's goods.

Applicant and the Trademark Examining Attorney have each filed a brief on the issues involved in this appeal, but applicant did not request an oral hearing before the Board. We reverse 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. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services"]. The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality

or characteristic of the product or service"]. Hence, the ultimate question before us is whether the term **ULTRACATH** conveys information about a significant characteristic of applicant's goods with the immediacy and particularity required by the Trademark Act.

On the other hand, 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) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys … knowledge of the ingredients, qualities, or characteristics of the goods … with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's

mark alone. *In re Abcor*, *supra* at 218 ["Appellant's abstract test is deficient – not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of "real estate advertisement services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is 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 Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [the term "first tier" describes a class of banks]; *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996) [the term

VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

The Trademark Examining Attorney herein argues:

> … that the designation ULTRACATH, when used in connection with "catheters" immediately, and without conjecture or speculation, describes a significant feature or characteristic of applicant's goods, namely, a catheter that is beyond the ordinary or normal. This mark is both descriptive and laudatory.

Trademark Examining Attorney's appeal brief, unnumbered pp. 5 – 6. As support for this position, the Trademark Examining Attorney argues from a dictionary entry for the word "ultra," selecting "beyond the normal" as the most relevant definition.

By contrast, applicant argues that this inventive combination of the terms "ultra" and "cath" forms a unitary mark that is either fanciful or, at worst, suggestive.

Applicant also cites to *In re WSI Corp.*, 1 USPQ2d 1570 (TTAB 1986) [SUPERSAT not merely descriptive for service of collecting, formatting, analysis, and distribution of meteorological information inasmuch as the Office had failed to show purchaser recognition of the abbreviated suffix "-SAT" for "satellite" given the nebulous connotation for satellite in connection with the recited services.] However, we find that applicant's "-CATH" suffix herein is different from the "-SAT" abbreviation. Hence, *WSI Corp.* is distinguishable in that the root term "-CATH" would be understood immediately as a common, shortened form of the word "catheter" when used in connection with applicant's goods. In addition to dictionary evidence, the third-party registrations that applicant has placed into the record, discussed *infra*, also make this point most clearly.

On the other hand, applicant argues that the position of the Trademark Examining Attorney in finding **ULTRACATH** to be merely descriptive is inconsistent with what the United States Patent and Trademark Office has done in the past with thirty-seven recited registrations having marks where a variety of prefixes are combined with "-CATH."

Applicant summarizes its arguments, based on these third-party registrations, as follows:

> The Examining Attorney has argued that [in the third-party registrations,] "-CATH" is paired with non-descriptive wording. To the contrary, these marks have [the term "-CATH"] paired with descriptive terms. For example, among the 25 marks registered between 1990 and the present are the marks LUBRICATH for catheters (Registration No. 1613687), CARDIOCATH for thermodilution catheters for measuring cardiac output (Registration No. 2463879), SPEEDICATH for catheters for incontinence (Registration No. 2608545), and SLIM-CATH for catheters (Registration No. 2518448). In the case of these recently registered marks, the ending "-CATH" clearly has been paired with readily or immediately descriptive wording that describes characteristics of the goods, whether the mark directly describes the goods ("CARDIO" for a catheter used for cardiac output) or indirectly describes an attribute (SLIM-CATH for a catheter that must be slim or narrow though not described as such in the registration). Moreover, the older registered marks contain terms that were as descriptive in the 1960's and 1970's as they are today; e.g. ANGIOCATH registered in 1968, MINICATH registered in 1968, QUIK-CATH registered in 1973, SELF-CATH registered in 1978. Terms such as "ANGIO," "MINI," "QUIK" and "SELF" would not have been deemed arbitrary or suggestive when they were registered. In comparison to these registered "-CATH" marks, the mark ULTRACATH is not merely descriptive or laudatory.

Applicant's reply brief, pp. 1 – 2.

We have to agree with applicant that some of these prefixes are at least as descriptive as the word "ultra" is

in the instant case (e.g., prefixes such as LUBRI-, MICRO-, UNI-, CARDIO-, FAST-, STERI-, CLEAN- and MINI- were evidently not considered to be either laudatory or descriptive, in their respective contexts). While each case must be decided on the facts contained within that record, it seems clear that this field is replete with dozens of terms ending in "-CATH" that must be characterized, at best, as being *highly suggestive*.

As applied to any type of goods, where the word "ultra" falls on the continuum of distinctiveness is a function of its context. For example, it should come as no surprise that an expression like ULTRA PURE was held *generic* when applied to biological interferons for medical use. *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986).

The Trademark Examining Attorney, in arguing that the word "ULTRA has been consistently held as laudatory on the Trademark Register," placed into the record a variety of composite marks in which the mark begins with an "ultra" prefix, where this term is laudatorily descriptive inasmuch as each of the composite marks is registered on the Supplemental Register:

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| ULTRA SHIELD | for "ophthalmic lenses" in International Class 9;[2] |
| ULTRA ROASTER/BAKER | for "aluminum pans" in International Class 21;[3] |
| ULTRASPONGE | for a "dry dusting/cleaning sponge" in International Class 21;[4] |
| ULTRA BIBLE | for "pre-recorded magnetic media in the nature of CD ROMS featuring multiple Bible versions, a collection of Biblical research and reference works, computer games programs, pre-record clip art, maps and other information in the field of religion, and containing interactive searching, annotation and notepad software" in International Class 9;[5] |
| ULTRA WIRELESS | for "computer hardware and computer software for wireless connectivity between computers, peripherals and storage networking devices; and instruction manuals packaged therewith" in International Class 9;[6] |
| ULTRA QUIET | for "massagers, namely, a foot bath massager" in International Class 10;[7] |

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[2] Registration No. 2092339 issued on the Supplemental Register on August 26, 1997 claiming first use anywhere and first use in commerce at least as early as January 15, 1997; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

[3] Registration No. 2560729 issued on the Supplemental Register on April 9, 2002, claiming first use anywhere and first use in commerce at least as early as January 2000.

[4] Registration No. 2584005 issued on the Supplemental Register on June 18, 2002 claiming first use anywhere and first use in commerce at least as early as May 2000.

[5] Registration No. 2633714 issued on the Supplemental Register on October 8, 2002, claiming first use anywhere and first use in commerce at least as early as November 4, 2001.

[6] Registration No. 2751505 issued on the Supplemental Register on August 12, 2003, claiming first use anywhere and first use in commerce at least as early as October 30, 2002.

[7] Registration No. 2828705 issued on the Supplemental Register on March 30, 2004, claiming first use anywhere and first use in commerce at least as early as December 2001.

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| ULTRA WEAVE | for "cleaning rags; cloths for wiping, cleaning or dusting; and polishing cloths" in International Class 21; and for "utility articles for cleaning purposes, namely, dish cloths, kitchen towels, cleaning towels, dusting towels, and scrubbing towels" in International Class 24;[8] |
| ULTRA SPORT | for "tires" in International Class 12;[9] |
| ULTRAHEAT | for "heat guns" in International Class 11;[10] |
| ULTRASLIM | for "electrical air filter and purifier for domestic use" in International Class 11.[11] |

On the other hand, in finding that ULTRA for "gasoline, motor oil, automotive grease, general purpose grease, machine grease and gear oil" would be likely to be confused with ULTRA LUBE for "lubricating oils and greases," and

for "chemicals-namely, engine oil additives, fuel additives, radiator products and automatic transmission fluid," the Board volunteered in a footnote that "[w]e also recognize that 'ultra' is a laudatorily *suggestive* word found in the

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[8] Registration No. 2885357 issued on the Supplemental Register on September 14, 2004, claiming first use anywhere and first use in commerce in International Class 21 at least as early as May 15, 2002, and claiming first use anywhere in International Class 24 at least as early as January 20, 2003 and first use in commerce at least as early as March 2003.

[9] Registration No. 2911843 issued on the Supplemental Register on December 14, 2004, claiming first use anywhere and first use in commerce at least as early as February 1, 2003.

[10] Registration No. 2926056 issued on the Supplemental Register on February 8, 2005, claiming first use anywhere and first use in commerce at least as early as August 14, 2003.

[11] Registration No. 2953853 issued on the Supplemental Register on May 17, 2005, claiming first use anywhere and first use in commerce at least as early as September 11, 2003.

dictionary …." *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 n.6 (TTAB 1994) [*emphasis* supplied].

As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. *See In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. *See In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

After carefully considering the record before us in this appeal in the context of the arguments presented by both applicant and the Trademark Examining Attorney, we find that the Trademark Examining Attorney has not established that **ULTRACATH** would immediately and forthwith convey significant information about applicant's goods with any specificity to prospective purchasers of catheters.

Other than asking us to extrapolate from a dictionary entry, there is no evidence in the record demonstrating that this term has descriptive significance in connection

with catheters. Admittedly, this "inventive" (applicant's characterization) composite projects a vague but unmistakable feeling of puffery. However, after the exercise of considerable effort to relate the general dictionary connotation to the involved goods, we find that this composite mark belongs on the suggestive side of the ledger. Even if a prospective purchaser should conclude from the proposed mark that the involved catheter might be "beyond the normal," what information is being conveyed? While the qualitative information conveyed by the word "ultra" in the contest of ULTRA PURE for biological interferons for medical use is precise and immediate, which characteristic of the **ULTRACATH** catheter might be "beyond the normal" is simply not clear.

The Trademark Examining Attorney has the burden of proof on this issue, and any doubts we have must be resolved in favor of the applicant. Inasmuch as the mere definition of the word "ultra" submitted by the Trademark Examining Attorney leaves us unsure that this term describes a feature, function, characteristic or purpose of the goods with which applicant intends to use it, we cannot affirm the refusal to register under Section 2(e)(1) of the Trademark Act.

Of course, in the event that applicant's competitors need to use this term to describe their own products in this field, they will be free to oppose registration to applicant. If they could create a record that establishes that this term has descriptive significance in connection with these goods, such an opposition would be sustained.

*Decision*: The refusal to register under Section 2(e)(1) of the Lanham Act is hereby reversed.