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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intuitive Surgical, Inc.

Serial No. 76654345

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Richter & Hampton LLP for Intuitive Surgical, Inc.

Bernice Middleton, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Zervas and Cataldo, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Intuitive Surgical, Inc. has appealed from the final
refusal of the examining attorney to register on the
Principal Register the term CARDIOVAC (in standard
character form) as a trademark for the following goods:
"medical devices, namely, suction apparatus for use during

urologic, gynecologic, pediatric, cardiac and general surgical procedures" in International Class 10.¹

The examining attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used on applicant's goods, the mark CARDIOVAC would be merely descriptive of such goods.

After the examining attorney issued a final action, applicant filed an appeal and a request for reconsideration. The examining attorney denied the request for reconsideration, and subsequently both applicant and the examining attorney filed briefs. We affirm the refusal to register.

The examining attorney maintains that applicant's mark is a combination of the terms "cardio" and "vac," and that both terms have significance in connection with applicant's goods. She has entered a definition of "cardio" from dictionary.cambridge.org into the record, which provides that "cardio" is a prefix meaning "of the heart," and she states that the term "will immediately convey to consumers that applicant's goods are to be used in cardiac or cardiovascular procedures." Brief at unnumbered p. 3.

¹ Application Serial No. 76654345 was filed on January 31, 2006, based on applicant's assertion of its bona fide intention to use

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"Vac" is identified as an abbreviation for "vacuum" in *Merriam-Webster's Online Dictionary* located at merriam-webster.com.² As an adjective, the record shows that "vacuum" is defined in part in bartleby.com as "operating by means of suction or by maintaining a partial vacuum."³ According to the examining attorney,

The mark is descriptive because it immediately conveys that the goods provide suctioning in procedures affecting the heart and/or blood vessels. Applicant's goods, a suction apparatus[,] would clearly utilize suction. Therefore applicant's use of the word 'vac' is descriptive for a suction apparatus and/or goods operating by suction.

Id. at unnumbered p. 3.

Applicant responds that its goods "have nothing whatsoever to do with the heart and blood vessels" and that they "are used in a wide variety of surgical procedures to remove or evacuate fluids that accumulate during those procedures ... and do not affect the heart or blood vessels themselves." Brief at pp. 5 - 6. It adds that even if it were to implicate the heart and blood vessels, "cardio"

the mark in commerce.

² We take judicial notice of this dictionary definition of "vac." The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *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).

³ As a noun, "vacuum" is defined in part as "a vacuum cleaner."

suggests "the importance of maintaining a clear surgical field while operating and that such maintenance is central or at the 'heart' of any successful surgical procedure."

Id. at p. 7.

With respect to the term "vac," applicant makes three arguments. First, applicant distinguishes a vacuum from the suction caused by applicant's goods. Referring to definitions of "vacuum" and "suction," applicant argues that suction "is the process of producing a pressure differential that attracts substances to a region of lower pressure"; that "[w]hile a vacuum is often created to achieve suction and often one is related to the other, a vacuum and suction are two different things"; and that "[t]he 'vac' portion of Applicant's mark is suggestive of the suction that is used by a vacuum cleaner or the suction created by a vacuum but is not descriptive of it." *Id.* at pp. 8 - 9.

Second, applicant maintains that applicant's apparatus "does not itself create the suction used to remove fluids, and instead simply transmits the suction effect through its tubing." Applicant quotes from a submission by applicant to the Food and Drug Administration, made of record by the examining attorney with her final Office action, and states that "the goods offered under CARDIOVAC transmit the

suction, they do not themselves create the vacuum from which the suction results." *Id.* at p. 9.

Third, applicant argues that "vac" has a suggestive connotation because "evacuate" is commonly used to refer to the removal of fluids from the body; that an "evacuator" is a medical device for removing fluid or small particles from a body cavity;⁴ and that "[s]urgeons and health care professionals, the consumers of Applicant's goods, commonly use the term evacuate and are highly likely to interpret the term 'vac' when used in connection with Applicant's goods ... to be suggestive of fluid removal or evacuation." Reply at p. 8.

As to the term CARDIOVAC as a whole, applicant argues that it is suggestive rather than merely descriptive of applicant's goods. According to applicant, neither "cardio" nor "vac" is merely descriptive of applicant's goods; the combination creates an incongruity because "the concept of using a vacuum in a medical procedure, whether involving the heart or not, seems strange and does not

⁴ The definition of record of "evacuate" from www2.merriam-webster.com is "2: to discharge (as urine or feces) from the body as waste)." The definition of record of "evacuator" from medical-dictionary.com is "a mechanical evacuant; an instrument for the removal of fluid or small particles from a body cavity ..." The definition of "evacuator" from medical-dictionary.thefreedictionary.com is "an instrument for removal of material from a body cavity."

comport with the common understanding of vacuuming." *Id.* at p. 10.

Applicant has also introduced into the record several third-party registrations for marks with either the term CARDIO or the term VAC that have registered without disclaimers. In particular, we note the following registered marks containing VAC; SAF-T-VAC for suction devices for removing by-products of electrocautery medical procedures; MEDI-VAC for medical suction collection containers; and PLAK-VAC for "aspirating oral hygiene instrument for use in conjunction with a separate suction system." Applicant points out that the lack of a disclaimer of "vac" indicates the term is suggestive. Further, applicant has introduced into the record the registration for the mark CARDIOVAD for "blood pumps," arguing that a "vad" is a common abbreviation for "ventricular assist device" or a heart pump. In view of these registrations without any disclaimers, applicant maintains that its mark is suggestive.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *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 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Both the examining attorney and applicant have considered the mark as having two components, CARDIO and VAC, and so do we. We consider each component and then consider the mark as a whole.

The examining attorney has established that "cardio" is a prefix meaning "of the heart." Because applicant's identification of goods specifies that applicant's goods are to be used, inter alia, in cardiac or cardiovascular procedures, we find that the term CARDIO in applicant's mark immediately informs the purchaser of a use of applicant's goods. We are not persuaded by applicant's argument that the goods "have nothing whatsoever to do with the heart and blood vessels." Brief at p. 5. Applicant's identification of goods provides that applicant's suction apparatus is for cardiac procedures. Further, even if

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applicant's goods can be used in other non-cardiac surgical procedures, the term may be deemed merely descriptive. As mentioned above, a term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *Id.* We also find little merit in applicant's argument that "cardio" "suggests the importance of maintaining a clear surgical field while operating and that such maintenance is central to or at the 'heart' of any successful surgical procedure." Brief at p. 7. The connotation suggested by applicant is not one that purchasers are likely to give to the term "cardio" in applicant's mark in the context of cardiac procedures in which applicant's goods may be used.

Turning then to the term VAC, the examining attorney has established that "vac" is an abbreviation for "vacuum," defined as "operating by means of suction or by maintaining a partial vacuum," and that applicant's "suction apparatus" operates through the use of a vacuum. The term "vac" in applicant's mark hence informs the purchaser that applicant's goods operate in conjunction with a vacuum and hence too informs the purchaser of a feature of applicant's goods.

Applicant's argument that the goods "transmit the suction, they do not themselves create the vacuum from which the suction results," and its reliance on statements made in its submission to the Food and Drug Administration, are not persuasive. Applicant has chosen to describe its goods as "suction apparatus" and not the "sterilized tubing assemblies" described in the Food & Drug Administration submission. The Board considers the issue of mere descriptiveness based on the identification of goods; other goods on which applicant may use its mark are not relevant to our analysis.⁵ Further, applicant's "suction apparatus" is sufficiently general to be construed as including an element that provides the suction, or a vacuum. And, even if "suction apparatus" is the equivalent of "sterilized tubing assemblies," "vac" indicates that the tubing assemblies are specifically suited for use in a vacuum environment. See material regarding "Medi-Vac Suction Tubing" submitted by applicant with its request for reconsideration, emphasizing that "[t]hick tubing walls offer safety and collapse resistance at high vacuum pressures."

Applicant has also argued that the word "evacuate" and "evacuator" are commonly used by health care professionals

⁵ Also, the present application is an intent-to-use application.

in connection with the removal of fluids from the body, citing to dictionary definitions of "evacuate" and "evacuator," and concludes that "consumers of Applicant's goods are highly likely to interpret and understand Applicant's mark as having this suggestive connotation." Brief at p. 10. The dictionary definitions do not persuade us that consumers of applicant's goods would consider "vac" as a reference to "evacuate" or "evacuator" rather than as a reference to "vacuum." We consider it more likely that health care professionals would give "vac" its dictionary definition rather than the "suggestive" meaning applicant advocates.

We are also not persuaded by the evidence of third-party registrations of marks containing CARDIO or VAC. These registrations may not contain disclaimers of the terms CARDIO and VAC because the examining attorneys may have considered the marks as unitary and hence not requiring a disclaimer. Further, as the examining attorney pointed out, third-party registrations are not conclusive as to the question of descriptiveness and each case must be analyzed based on the facts pertinent to that case. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

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Thus, we find that CARDIO is merely descriptive of a use of applicant's goods, i.e., that they are used in connection with cardiac procedures. VAC also is merely descriptive of the vacuum component of applicant's goods. Combining the two terms into CARDIOVAC does not negate the mere descriptiveness of these terms; the composite is as merely descriptive of the goods as the two terms are when considered separately - a separate non-descriptive meaning is not created by combining the two terms. Applicant is not entitled to appropriate for itself (via Federal registration) the exclusive right to use the term CARDIOVAC in connection with suction apparatus for use during urologic, gynecologic, pediatric, cardiac and general surgical procedures.

Decision: The refusal to register is affirmed.