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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masimo Corporation

Serial No. 78558331

Stacey R. Halpern of Knobbe, Martens, Olsen & Bear LLP for
Masimo Corporation.

Doritt Carroll, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney)

Before Rogers, Drost, and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Masimo Corporation filed an intent-to-use trademark
application for the mark PULSE CO-OXIMETER, in standard
character format, for goods ultimately described as
"medical devices, namely, patient monitors and patient
sensors for monitoring and measuring blood properties such
as pulse, blood pressure, hemoglobin content,

concentrations of dissolved substances and blood gases," in Class 10.¹

The Trademark Examining Attorney refused registration on the ground that the mark PULSE CO-OXIMETER when used in connection with the described medical devices is merely descriptive. Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1). The Examining Attorney contends that the mark is merely descriptive because it is the combination of two descriptive terms (pulse oximeter and co-oximeter) that forms a composite, equally descriptive term. In essence, the Examining Attorney argues that PULSE CO-OXIMETER directly conveys to the relevant purchasing public that applicant's identification of goods includes a product that is a pulse oximeter that measures carbon monoxide in the blood. On the other hand, applicant argues that the mark PULSE CO-OXIMETER is suggestive because it does not convey any information about applicant's product. "Due to the nature of Applicant's goods, consumers and potential consumers will realize that the mark PULSE CO-OXIMETER results in a humorous play on the terms 'CO,'

¹ Application Serial No. 78558331, filed February 1, 2005. While the description of goods describes a monitor with many applications, applicant's product, as described in its website, is a handheld monitor for measuring carbon monoxide poisoning in the blood. (Applicant's website attached to the August 30, 2005 Trademark Office Action).

PULSE and OXIMETER and therefore results in a suggestive mark."² "Moreover, due [to] the existence of CO-, which emphasizes the mark's blended roots and the fact that Applicant's devices combine the convenience and non-invasiveness of a pulse oximeter with the accuracy of a co-oximeter, Applicant's mark also includes a double entendre."³

The issue on appeal has been fully briefed. For the reasons set forth below, we affirm the refusal.

In its February 27, 2006 response to the August 30, 2005 Trademark Office Action, applicant provided the following description of the technology involved in its product:⁴

Pulse oximetry is a non-invasive diagnostic test used for detecting the percentage of hemoglobin that is saturated with oxygen.⁵ This oxygen saturation is a measure of how much oxygen the blood is carrying as a

² Applicant's Brief, p. 11.

³ Applicant's Brief, p. 13.

⁴ Applicant is commended for providing an explanation of the technology involved with its product that a layperson can understand.

⁵ "Hemoglobin" is "the oxygen-carrying pigment of red blood cells that gives them their red color and serves to convey oxygen to the tissues: occurs in reduced form (deoxyhemoglobin) in venous blood and in combination with oxygen (oxyhemoglobin) in arterial blood." *Dictionary.com Unabridged* (v 1.1) based on The Random House Unabridged Dictionary (2006). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

percentage of the maximum it could carry.

A pulse oximeter is the device used for performing the test. A probe is attached to the patient's finger or ear lobe and connected to a computerized unit. The unit displays the percentage of hemoglobin saturated with oxygen. In some pulse oximeter models, the heart rate and blood flow can also be monitored. The oximeter can detect hypoxia (inadequate supply of oxygen in the blood) before a patient becomes cyanotic (the skin, lips and nails become bluish or purplish in color due an insufficient amount of oxygen in the blood).

While a pulse oximeter measure (sic) oxygenation, it cannot distinguish carbon monoxide from oxygen. Thus, a pulse oximeter will report erroneous high oxygen levels, even when patients are severely poisoned with carbon monoxide. In order to obtain an accurate measurement of carbon monoxide in the body, medical professionals (sic) were required to undergo invasive procedures.

As such, measuring carbon monoxide concentration in the bloodstream was done by a Co-Oximetry test, which required a painful blood draw and potentially significant delay in diagnosis. Specifically, a Co-Oximeter is a device which requires a sample of blood obtained from a patient to analyze, with its attendant inconvenience, pain, expense and delay.

The record includes the following evidence:

1. An excerpt from applicant's website describing applicant's product.⁶ The product is introduced in the following manner:

introducing

RAD-57™

Pulse CO-Oximeter

Noninvasive measurement of carbon monoxide in the blood - in seconds!

The first sentence of the introductory text reads as follows:

Masimo is proud to introduce the next breakthrough in noninvasive product monitoring; Masimo Rainbow™ SET Pulse CO-Oximetry™.⁷

Finally, applicant ends this section of its website by exclaiming that its product is "The world's first Pulse CO-Oximeter™."

2. A definition of the word "oximeter" as "a device for measuring the oxygen saturation of arterial blood."

The American Heritage Dictionary of the English Language
(3rd ed. 1992).⁸

⁶ August 30, 2005 Trademark Office Action.

⁷ The website explains that the sensors employ eight wavelengths of light to collect and analyze physiological data that measures carbon monoxide and other parameters.

⁸ August 30, 2005 Trademark Office Action.

3. A definition of the word "carbon" as "a colorless, odorless, highly poisonous gas, CO." The American Heritage Dictionary of the English Language (3rd ed. 1992).⁹

4. A definition of the word "carboxyhemoglobin" as "the compound that is formed when inhaled carbon monoxide combines with hemoglobin in the blood." The American Heritage Dictionary of the English Language (3rd ed. 1992).¹⁰

5. An article entitled *Pulse Oximetry in the Emergency Department* featured in the Clinical Window website, a web journal for medical professionals (www.clinicalwindow.net).¹¹ This article asserts that pulse oximetry, the measurement of oxyhemoglobin saturation, has become the fifth vital sign in the clinical arena, joining temperature, pulse, blood pressure and respiratory rate. The article explains that a co-oximeter is necessary to measure dyshemoglobins, such as carboxyhemoglobin. However, to use a co-oximeter, a sample of blood must be obtained from the patient.

6. An excerpt from what appears to be an article entitled *Practical Applications of Pulse Oximetry* published

⁹ August 30, 2005 Trademark Office Action.

¹⁰ April 12, 2006 Trademark Office Action.

¹¹ August 30, 2005 Trademark Office Action.

in a website.¹² The relevance of this excerpt is that it explains that a pulse oximeter is a noninvasive monitor of arterial hemoglobin oxygenation in the patient's blood.

7. A copy of U.S. Trademark Registration No. 1559686 for the mark OXI-PULSE for "medical devices, namely, a pulse oximeter."¹³ The Examining Attorney contends that the use of pulse oximeter in the description of goods is evidence that the term is generic.

8. The search results for "CO" from the AF Acronym Finder website.¹⁴ The term "CO" has seventy-five (75) meanings, including carbon monoxide and cobalt.¹⁵

9. The hit list for the first thirty (30) entries from a search for "pulse co-oximeter" on the Google search

¹² www.nda.ox.ac.uk/wfsa/html/u11/u1104_.02.htm+pluse+co-oximetr&hl=en. August 30, 2005 Trademark Office Action.

¹³ August 30, 2005 Trademark Office Action.

¹⁴ Applicant's February 27, 2006 Response, Exhibit A. The URL for the AF Acronym Finder was not provided.

¹⁵ Applicant contends that "CO" also means together, joint, jointly, and mutually. (Applicant's February 27, 2006 Response, p. 5; Applicant's Brief, p. 10, Exhibit A). In support of this definition, applicant submitted a definition of "con" from Dorland's Illustrated Medical Dictionary, p. 364 (1994), and requests that we take judicial notice of the definition. "Con" is "a prefix meaning with or together. It appears as co- before a vowel or h." (Emphasis in the original). Applicant argues that the commercial impression engendered by applicant's mark creates a double entendre because the term "CO" could stand for the monitor's ability to jointly perform the functions of both a pulse oximeter and a co-oximeter. (Applicant's February 27, 2006 Response, p. 5; Applicant's Brief, p. 10). As indicated in footnote 4, we may take judicial notice of dictionary definitions, and we do so in this case.

engine evidencing that the only use of that term refers to applicant's product.¹⁶

10. An article from the online weekly *Wireless Healthcare Newsletter* entitled FDA Clears Masimo's Pulse CO-Oximeter.¹⁷ The "Pulse CO-Oximeter" is described as an "8-wavelength finger sensor to accurately measure arterial oxygenation saturation, carbon monoxide, methemoglobin and pulse rate."

11. An excerpt from the GRx Medical website (<http://grxmedical.com>) advertising an SPO PulseOx 5500 Finger Pulse Oximeter that measures oxygen level and pulse rate.¹⁸

12. An excerpt from the Teko Technicians, Inc. website (ww.tekotechnicians.com) advertising a finger tip pulse oximeter, the Pulse-OX-5500.¹⁹ The text describes the product as follows: "The finger unit accurately measures blood oxygen saturation levels (SpO2) and heart rate pulse on an easy-to-read liquid crystal display."

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods in connection

¹⁶ Applicant's February 27, 2006 Response, Exhibit B.

¹⁷ April 12, 2006 Trademark Office Action.

¹⁸ April 12, 2006 Trademark Office Action.

¹⁹ April 12, 2006 Trademark Office Action.

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with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods are will understand the mark to convey information about the goods. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 UPSQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

Finally, in determining whether a mark is merely descriptive, we must consider the mark in its entirety. As argued by applicant, common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark. *See Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989).

A pulse oximeter is a noninvasive device for measuring the oxygen level in a patient's blood. A co-oximeter is a device for measuring the level of carbon monoxide in a patient's blood. There is a need in the medical field for an easy-to-use, noninvasive device for measuring the level of carbon monoxide in a patient's bloodstream. In other words, there is a need for a pulse oximeter that measures carbon monoxide. The term "pulse co-oximeter" directly conveys to relevant consumers that applicant's product is, in fact, a noninvasive device for measuring carbon monoxide in a patient's blood. The combination or blending of the terms "pulse oximeter" and "co-oximeter" to form "pulse co-oximeter" does not create an incongruous word combination requiring some measure of imagination or thought to comprehend its meaning.

The natural or expected way a manufacturer would describe a pulse oximeter that measures carbon monoxide is

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to call it a "pulse co-oximeter." The blending of the terms "pulse oximeter" and "co-oximeter" under these circumstances is not unusual, nor does it evoke a unique commercial impression. In the case *sub judice*, the terms "pulse oximeter" and "co-oximeter" do not lose their descriptive significance in the combined term.

We are not persuaded by applicant's argument that there is no evidence showing the use of PULSE CO-OXIMETER in a descriptive manner. First, on its website, applicant uses the term "pulse co-oximeter" to identify the product, not its source. As indicated *supra*, applicant introduces the product as follows:

introducing

RAD-57™

Pulse CO-Oximeter

**Noninvasive measurement of carbon monoxide in the
blood - in seconds!**

In other words, a RAD-57 brand pulse co-oximeter.

At the end of the website excerpt, applicant touts its product as "The world's first Pulse CO-Oximeter™." In that sentence, "Pulse CO-Oximeter" is used to identify the product, not the source.

Second, the use of the superscript "tm" in connection with "Pulse CO-Oximeter" is not persuasive (e.g., "The

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world's first Pulse CO-Oximeter™"). See *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) ("Use of the letters "TM" on a product does not make unregistrable matter into a trademark"); *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("the use of the "TM" does not, ipso facto, make a trademark or service mark out of the term or expression in connection with which it is used"). Whether a term performs the function of a trademark depends upon its use and probable impact of that use on consumers. *In re Morganroth, supra*; *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989). Despite the use of the superscript "tm," the term "pulse co-oximeter" describes the product, not the source.

Finally, the fact that all of the references to a "pulse co-oximeter" reference applicant is not surprising since applicant is the only manufacturer of a pulse oximeter that has the capability of measuring carbon monoxide.²⁰ See *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) ("the fact that applicant may be the first and/or only entity using the phrase AGENTBEANS is not

²⁰ Applicant's February 27, 2006 Response to the August 30, 2005 Trademark Office Action, p. 5; Applicant's website ("The world's first Pulse CO-Oximeter™!").

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dispositive"); *In re Mortgage Bankers Association of America*, 226 USPQ 954, 956 (TTAB 1985); *In re National Shooting Sports Foundation*, 219 USPQ 1018, 1020 (TTAB 1983).

We are also not persuaded by applicant's argument that the term "co" in "pulse co-oximeter" is capable of multiple meanings. First, as stated previously, descriptiveness is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp., supra*; *In re Remacle, supra*. When the term "pulse co-oximeter" is used in connection with a medical device for measuring the blood gases, medical practitioners will immediately know that the device measures carbon monoxide. The fact that "co" may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984) ("so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive"); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318, 320 (TTAB 1974).

Second, because applicant's mark is in standard character format, it may be displayed in any font, size, or

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color, including "CO." Trademark Rule 2.52(a), 37 CFR §2.52(a). In fact, in its website, applicant displays the mark as **Pulse CO-Oximeter**. "CO" is an abbreviation for carbon monoxide. The record shows that medical practitioners need the capability of measuring carbon monoxide in a patient's bloodstream. Thus, medical practitioners would understand the term "CO" in PULSE CO-OXIMETER (or any format in which it is displayed) as the chemical symbol for carbon monoxide.²¹

Finally, even though the identification of goods in the application at issue could encompass other products besides the one featured in applicant's website and discussed herein, registration will be denied so long as the term sought to be registered readily describes one of the products identified in the identification of goods. In other words, the issue is whether the mark PULSE CO-OXIMETER is merely descriptive of any of applicant's products. *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); *In re Dun & Bradstreet, Inc.*, 185 USPQ 173, 174 (TTAB 1974) ("while it may be true that the term in question does not describe all of

²¹ There is nothing in the record to suggest that medical practitioners would interpret the CO in PULSE CO-OXIMETER as "cobalt" when PULSE CO-OXIMETER is used in connection with a medical device for measuring blood gases.

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applicant's activities, it is unnecessary to a holding of descriptiveness that the term describe each of such activities").

It is therefore concluded that PULSE CO-OXIMETER is merely descriptive when used in connection with "medical devices, namely, patient monitors and patient sensors for monitoring and measuring blood properties such as pulse, blood pressure, hemoglobin content, concentrations of dissolved substances and blood gases."

Decision: The refusal to register is affirmed.