

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Zimmer Technology, Inc.

v.

MIS Implant Technologies Ltd.

Opposition No. 91164293
to application Serial No. 78177980
filed on October 24, 2002

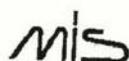
Gerard T. Gallagher and Meg A. Anderson of Baker & Daniels
LLP for Zimmer Technology, Inc.

Victor N. King and Ann W. Speckman of Speckman Law Group
PLLC for MIS Implant Technologies Ltd.

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Zimmer Technology, Inc. has opposed the application of
MIS Implant Technologies Ltd. to register the mark MIS in
stylized form, as shown below,



for the following goods:

surgical, medical, dental and orthodontic apparatus and instruments, namely, surgical screw drivers, torque wrenches, drills, ratchets and hammers, tissue punches, dental burs, scalpels, scissors for surgery, saws for surgical purposes, trephines, orthodontic appliances, prosthetic holders, abutment holders, suction tubes, kidney trays, gloves for medical purposes, masks for use by medical personnel, surgeon's caps, surgical sterile sheets, surgical thread, cases fitted for medical instruments; implants for surgery and medicine, namely, dental implants, surgical implants comprising artificial material; superstructures for prosthetic reconstruction, namely, for prosthetic reconstruction of teeth; crowns, bridges and prostheses, which are mountable upon implants, for dental medicine; artificial teeth, dentures, artificial jaws; pins for artificial teeth; brackets, wires and screws for orthodontics.¹

As grounds for opposition, opposer has alleged that it is a manufacturer of various orthopedic and dental implants, surgical tools and equipment; that the term MIS is a commonly and widely used acronym and abbreviation for "minimally invasive surgery," a term that describes a commonly and widely used surgical technique in various fields of medical treatment, including the dental field; and that applicant's mark is merely descriptive of the identified goods and therefore prohibited from registration by Section 2(e)(1) of the Trademark Act.

¹ Application Serial No. 78177980, filed October 24, 2002, based on Section 1(b) of the Trademark Act (intent-to-use).

Applicant has denied the salient allegations of the notice of opposition, and has also asserted what it characterizes as affirmative defenses, but which are primarily amplifications of its denial that its mark is merely descriptive. In any event, applicant has not filed a trial brief, and therefore has not argued that it is entitled to judgment on any of its actual affirmative defenses. Accordingly, we deem such claims to have been waived.

The record includes the pleadings and the file of the opposed application. Opposer has made of record, under a notice of reliance, 48 exhibits that constitute printed publications under Trademark Rule 2.122(e). Applicant has also submitted evidence under a notice of reliance, and of the 60 exhibits, opposer initially moved to strike all but Exhibit 57. Although applicant did not file a paper in opposition to the motion, we do not treat it as conceded. In its brief opposer reiterated its motion to strike, although it did not maintain its objections to Exhibits 58-60. Thus, we consider only the objections to Exhibits 1 through 56, although we note that, in any event, opposer's objections to Exhibits 58-60 are not well taken. Specifically, Exhibits 58-60 are copies of opposer's registrations, taken from the USPTO TESS database. Opposer

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had initially objected to these exhibits because they were not status and title copies prepared by the Office. However, Trademark Rule 2.122(d)(2) requires that a status and title copy of a registration be submitted by a party who wishes to make its own registration of record. Because applicant is not attempting to make its own registrations of record by submitting the TESS records, but has submitted copies of registrations owned by opposer, these exhibits constitute official records of the USPTO, and may be submitted under a notice of reliance pursuant to Trademark Rule 2.122(e).

The first group of exhibits to which opposer has objected are webpages. Exhibits 1-9, according to applicant's notice of reliance, were obtained from applicant's own website. Such documents do not qualify as printed publications under Trademark 2.122(e). See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). The next set of webpages, Exhibits 30-56, shows the results of searches for "mis" with other words. To the extent that applicant is attempting to rely on results stating that no items were found the exhibits cannot be considered, as they do not constitute printed publications. However, some of these exhibits are for articles that have been retrieved from printed publications, e.g., Exhibit 33 is an article published in the "Journal of the Canadian Dental

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Association," April 2005, Vol. 71, No. 4. We treat these exhibits in the manner of articles retrieved from the NEXIS database, i.e., as the electronic equivalent of printed articles. The next grouping of exhibits are materials published by applicant, such as newsletters and catalogs and brochures. These do not qualify as printed publications.

In summary, opposer's motion to strike is granted as to Exhibits Nos. 1-30, 36-39, and 41-56. Exhibits Nos. 31-35, 40 and 57-60 of applicant's notice of reliance are of record.

On February 10, 2006, the last day of its testimony period, and at the same time it filed its notice of reliance, applicant also filed a motion to amend its identification of goods to limit its goods to those with a dental application. The proposed identification, which shows the goods which applicant seeks to delete, is as follows. Deleted items are shown by strikethroughs, added terms are shown in bold type.

~~surgical, medical, d~~Dental and
orthodontic apparatus and instruments,
namely, surgical screw drivers, torque
wrenches, drills, ratchets and hammers,
tissue punches, dental burs, scalpels,
scissors for surgery, saws for surgical
purposes, trephines, orthodontic
appliances, prosthetic holders, abutment
holders, ~~suction tubes, kidney trays,~~
~~gloves for medical purposes, masks for~~
~~use by medical personnel, surgeon's~~
~~caps, surgical sterile sheets, surgical~~
~~thread, cases fitted for medical~~
instruments; implants for **oral** surgery

and medicine, namely, dental implants, surgical implants comprising artificial material; superstructures for prosthetic reconstruction, namely, for prosthetic reconstruction of teeth; crowns, bridges and prostheses, which are mountable upon implants, for dental medicine; artificial teeth, dentures, artificial jaws; pins for artificial teeth; brackets, wires and screws for orthodontics.

The reason given in applicant's motion is to conform the identification of goods with the goods upon which applicant's mark is actually used.

Opposer has opposed this motion on the basis that it is untimely, in that it was filed after the completion of opposer's testimony period, and therefore opposer prepared its case based on the original identification.

Opposer has cited, in particular, the following language in Personnel Data Systems Inc. v. Parameter Driven Software Inc., 20 USPQ2d 1863, 1864-65 (TTAB 1991):

Section 18 of the Trademark Act, as amended effective November 16, 1989, provides the Trademark Trial and Appeal Board with the authority to limit, or otherwise modify, the goods or services in a registration or an application. However, in this case, we decline to exercise our authority under the statute and rules for the reason that this proceeding was tried without respondent's ever having raised the issue of possible restriction of its recitation of goods. As a consequence, petitioner had not been put on notice before it presented its case that respondent intended to seek to have its identification of goods amended. That is to say, the Board will exercise its

discretion under Trademark Rule 2.133(b) only where the petitioner or opposer has been put on notice during the trial period that the Board will be considering the issue of confusion with respect to a recitation of goods or services narrower in scope than that which was shown in the registration or application at the commencement of the proceeding.

In reply, applicant attempts to distinguish the Personnel Data case on the basis that in Personnel Data the request to amend the identification of goods was made in the party's brief, while applicant has made its motion during trial. However, the testimony period for opposer had closed before applicant ever made its motion, so the effect of the timing of the motion is the same as that in Personnel Data, namely, opposer had not been put on notice before it presented its case that applicant intended to seek to have its identification of goods amended. Applicant also points to the fact that opposer's rebuttal testimony period had not yet opened at the point applicant filed its motion. However, rebuttal testimony is limited to testimony that rebuts the evidence that the applicant submits during its testimony period; a plaintiff may not use it to submit evidence that should have been made of record during its case-in-chief, and evidence to prove the descriptiveness of the goods in applicant's proposed identification would have been part of opposer's case-in-chief. Moreover, we must recognize that opposer expended time and effort to prepare

its case-in-chief based on the identification of goods in applicant's application as published for opposition.

Applicant has not provided a compelling reason why it waited until after the close of opposer's testimony period (and, indeed, until the last day of its own testimony period) to file its motion to amend. Certainly if applicant wished only to conform the goods in its identification to those on which its mark is in use, it could have done so prior to the commencement of trial. Here, the prejudice to opposer if we were to grant applicant's motion would be substantial. Even if we were to reopen opposer's testimony period for its case-in-chief, that would not remove the prejudice to opposer, since it would then essentially have to mount a new trial. Applicant has simply not provided a sufficient reason for us to require this.

Applicant's motion to amend its identification of goods is denied.

We turn now to the substantive issues in this opposition, namely, whether opposer has shown its standing and whether it has shown that applicant's mark is merely descriptive of its identified goods.

With respect to standing, we note that opposer has not submitted any evidence on this point. Although opposer stated in its notice of opposition, and again in the "Facts" section of its brief, that "opposer is a leading

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manufacturer of various orthopedic and dental implants, surgical tools and equipment," brief, p. 7, opposer submitted no evidence to support such an allegation. An allegation in a notice of opposition is just that--an allegation--and it must be supported by evidence for it to be treated as fact. In the present case, however, applicant has submitted under a notice of reliance copies of three registrations owned by opposer for MIS marks, stating in the notice that these are registrations of opposer's. See exhibits 58-60 of applicant's notice of reliance. Registration No. 3007589 is for printed materials in the field of minimally invasive surgical techniques; Registration No. 2967452 is for educational services in the field of minimally invasive surgical techniques; and Registration No. 2967451 is for public relations campaigns. These registrations are sufficient for us to find that opposer has a real interest in this proceeding and a reasonable claim of damage.²

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the

² The irony is not lost on us that opposer had initially moved to strike the very exhibits which we have found to establish its standing.

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goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (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 to be merely descriptive; rather, it is sufficient 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); In re MBAssociates, 180 USPQ 338 (TTAB 1973). 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 the 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; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to sustain the opposition with respect to the entire class. See In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

It is opposer's position that MIS is an initialism that is readily understood as meaning "minimally invasive surgery," and that this initialism, as well as the phrase which it represents, is merely descriptive of applicant's identified goods because it describes a feature, use, function or purpose of the goods, which are surgical, medical, dental and orthodontic apparatus and instruments. In support of this position opposer has made of record a listing from the Dictionary of Medical Acronyms & Abbreviations, 5th ed. © 2005, stating that "MIS" means, inter alia, "minimally invasive surgery." Opposer has also submitted some 47 publications in which MIS is used as an alternative term for "minimally invasive surgery." In some of these publications MIS appears in parentheses after the phrase "minimally invasive surgery," while in others it is used directly as the term. Some examples follow:

Minimally invasive surgery describes an area of surgery that crosses all traditional disciplines, from general surgery to neurosurgery. ...Minimally invasive surgery is a means of performing major operations through small incisions, often using miniaturized, high-tech imaging systems, to minimize the trauma of surgical exposure. ...John Wickham's term minimally-invasive surgery (MIS) is widely used because it describes the paradox of postmodern high-tech surgery—small holes, big operations—and the "minimalness" of the access and invasiveness of the procedures, captured in three words.

Chapter 13, Minimally Invasive Surgery,
Schwartz's Principles of Surgery, 8th
ed. © 2005.

Exhibit 2 to opposer's notice of
reliance

With the potential for fewer
complications, less complex procedures
and reduced average lengths of hospital
stay, minimally invasive surgeries (MIS)
will hold particular appeal to cost
conscious healthcare authorities.
Therefore, the long-term cost
efficiencies may encourage uptake of MIS
devices despite their higher capital
costs, boosting the prospects of
European MIS device manufacturers.
"Medicine & Law Weekly," September 30,
2005

Exhibit 3 to opposer's notice of
reliance

Surgeons also commended the system for
its inherent versatility with both open
and minimally invasive surgery (MIS)
procedures.

"Managed Care Business Week," August 2,
2005

Exhibit 5 to opposer's notice of
reliance

Sales of minimally invasive surgery, or
MIS, products increased 6% to \$4.3
million....

...Sales of MIS products increased 22% to
\$1.2 million in the fourth quarter....

"Medical Devices & Surgical Technology
Week," March 14, 2004

Exhibit 11 to opposer's notice of
reliance

Study claims the MIS approach results in
positive short-term outcomes [headline]
According to the latest research on the
minimally-invasive surgery (MIS)
approach for hip, knee and shoulder
surgery,....

"Espicom Business Intelligence,"
February 5, 2003

Exhibit 22 to opposer's notice of reliance

Further research is needed before MIS is expanded to all areas [headline] Minimally-invasive surgery (MIS) will result in less pain, shorter hospital stays and quicker recovery times for more patients undergoing joint replacement surgery and other types of joint reconstruction....

"Espicom Business Intelligence,"
January 30, 2003

Exhibit 23 to opposer's notice of reliance

SPINAL IMPLANTS: Spinal Concepts announces first implantations of PathFinder MIS device [headline] Spinal Concepts, Inc., a leading innovator of spinal implant technology, announced in December that its PathFinder Minimally Invasive Surgery (MIS) pedicle screws were implanted for the first time.

"Medical Devices & Surgical Technology Week," January 26, 2003

Exhibit 25 to opposer's notice of reliance

In addition to the exhibits submitted by opposer, we also note that in opposer's three registrations for MIS marks, opposer has disclaimed exclusive rights to use MIS, thereby giving further support to opposer's position that it regards this term as merely descriptive.

The evidence of record shows that MIS is a recognized initialism for minimally invasive surgery. Further, when MIS is used in connection with such items as scalpels, suction tubes, surgical thread and the like, it immediately

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conveys to the relevant group of consumers and purchasers that such goods are used for minimally invasive surgery.

As noted previously, applicant has not submitted a trial brief, so we do not know why it takes the position that its mark is not merely descriptive. It has properly made of record some articles in which "MIS" is used to mean something other than "minimally invasive surgery." For example, one article has the title "(Mis) Interpretations of Leukoplakia." Exhibit 33 to applicant's notice of reliance. The fact that "mis" may have other meanings in other contexts, however, does not affect the fact that, as used in connection with at least some of the goods identified in applicant's application, MIS would be understood as the equivalent of "minimally invasive surgery," and immediately conveys to the relevant class of consumers information about the character or purpose of the goods.

Decision: The opposition is sustained.