

Hearing:  
October 8, 1997

Paper No. 14  
Hohein/MD

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB 7/28/98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Genemedicine, Inc.

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Serial No. 74/598,265

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William C. Steffin of Lyon & Lyon LLP and Charles A. Wendel, Esq.  
for Genemedicine, Inc.

Carolyn C. Gray, Trademark Examining Attorney, Law Office 101  
(R. Ellsworth Williams, Managing Attorney).

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Before Cissel, Hohein and Hairston, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Genemedicine, Inc. has filed an application to register  
the mark "GENEMEDICINE, INC." and design, as reproduced below,

for "formulated nucleic acid pharmaceutical preparations for the  
treatment of disease."<sup>1</sup>

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<sup>1</sup> Ser. No. 74/598,265, filed on November 14, 1994, which alleges a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the mark "GENEMEDICINE, INC." and design is merely descriptive of them.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register.

Preliminarily, however, we note that there is an issue as to whether applicant has conceded the mere descriptiveness of the term "GENEMEDICINE" by voluntarily offering to disclaim such term. Specifically, in the first Office action, the Examining Attorney--notably without any explanation or supporting evidence--refused registration of applicant's mark on the ground that it is merely descriptive of applicant's goods. Applicant, in response, traversed the refusal, stating that:

The Examiner has not shown that "GENEMEDICINE" is descriptive of the goods identified in the application or of any particular goods. No evidence has been cited by the Examiner supporting her position. In order to facilitate the prosecution to a Notice of Allowance, Applicant hereby disclaims the exclusive right to use the word mark "GENEMEDICINE" on or in association with formulated nucleic acid pharmaceutical preparations for the treatment of disease, apart from the mark as shown. Applicant believes that the design format in which "GENEMEDICINE" is presented in this application is sufficiently distinctive that the design is allowable upon a disclaimer of the word mark.

In support of its position, applicant cited *In re Clutter Control Inc.*, 231 USPQ 588, 589 (TTAB 1986), in which the Board stated that: "When words which are merely descriptive, and hence unregistrable, are presented in distinctive design, the

design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6 of the Trademark Act." Applicant, noting that the Board in such case determined that the mark "CONSTRUCT-A-CLOSET" and design, as illustrated below,

would be registrable on the Principal Register upon the filing of a disclaimer of the term "CONSTRUCT-A-CLOSET" because, as the Board stated, "the tube-like rendition of the letter 'C' in the words 'construct' and 'closet' make a striking commercial impression, separate and apart from the word portion of applicant's mark," 231 USPQ at 589-90, likewise contended that:

Here, Applicant's design is entitled to registration on the Principal Register now that the word mark "GENEMEDICINE" has been disclaimed. The design has a distinctly modern and uncluttered look making a striking commercial impression, which was achieved by forming the characters using straight lines and simple geometric shapes. Also contributing to the design's striking appearance is the complete encapsulation of the characters in a solid rectangle.

The Examining Attorney, in her responsive Office action, stated, however, that "[t]he disclaimer proposed by the applicant has not been accepted." Continuing the refusal to register applicant's mark on the ground of mere descriptiveness, the Examining Attorney noted that she "has determined that the design element of the mark is merely a carrier" and that "[a]s such it is not sufficiently distinct[ive] to warrant registration" with a disclaimer of the term "GENEMEDICINE".

Applicant, in reply, reiterated its contention that its mark, in light of the assertedly distinctive design elements, is registrable with a disclaimer of the term "GENEMEDICINE". Applicant concluded its remarks by stating that, "[f]or the foregoing reasons, Applicant continues its proposal for a disclaimer of the word portion of this mark, and respectfully submits that the [application for the] proposed mark is now in condition for allowance."

The Examining Attorney, after considering applicant's arguments, was not persuaded and made the mere descriptiveness refusal final. However, other than adding that "the proposed mark appears to be generic as applied to the goods" and stating that "applicant's design element lends nothing to the commercial impression of the word mark element," the Examining Attorney offered no explanation for her determination of mere descriptiveness (including the assertion of the ultimate form thereof, namely, genericness) and made no mention of applicant's continued proffer of a disclaimer.

Applicant appealed the final refusal and indicated in its initial brief that, among other things, it has disclaimed the "GENEMEDICINE" term "of its design mark in order to facilitate allowance of the application" in view of its theory that the design elements of the mark are sufficiently distinctive to permit registration if the proffered disclaimer is included. The Examining Attorney, in her brief, contends--for the first time--that applicant "has conceded that the mark is descriptive by applicant's consent ... to disclaim the word portion of the

mark." Applicant, in its reply brief, insists, however, that it has not conceded that its mark is merely descriptive. In particular, applicant maintains that its "disclaimer of the word portion of its mark was not an admission that the mark is descriptive but was simply done to 'facilitate the prosecution to a Notice of Allowance'," as it previously stated.

We are constrained to agree with applicant that it has not, by voluntarily offering to disclaim the term "GENEMEDICINE," conceded the mere descriptiveness of such term as used in connection with its goods. Instead, when viewed in the totality of applicant's argument as to the registrability of its mark, it is clear that applicant has proffered only a conditional disclaimer. That is, in order to facilitate the registration of its mark, applicant has offered to disclaim the term "GENEMEDICINE" *provided that* the Examining Attorney accepts applicant's contention that the design elements of the mark are distinctive enough to allow registration of applicant's mark with the inclusion of such a disclaimer. However, inasmuch as the Examining Attorney has not only stated that the disclaimer proffered by applicant has not been accepted, but has indicated that the design elements of applicant's mark do not preclude the mark as a whole from being merely descriptive within the meaning of Section 2(e)(1), it is plain that applicant's offer to disclaim the term "GENEMEDICINE" simply cannot be taken as an admission of the mere descriptiveness of that term for purposes of this appeal.

Turning, therefore, to the merits of the final refusal, applicant asserts that the mark "GENEMEDICINE, INC." and design is not merely descriptive of its formulated nucleic acid pharmaceutical preparations for the treatment of disease. Specifically, as noted previously, applicant maintains that its mark is registrable, with a disclaimer of "GENEMEDICINE," in light of the mark's assertedly distinctive design elements, which include "the uncluttered, modern typeface of the words, the light tone of the words, and the dark shaded box surrounding, contrasting, and encapsulating them." According to applicant:

The combination of the distinctive typeface with a surrounding, contrasting box renders a striking commercial impression. .... The surrounding box heightens the effect of the typeface to create a distinctive presentation.

The design of Applicant's mark, [with] the words "GENEMEDICINE, INC." encapsulated in a solid surrounding box, cleverly suggest the method of delivering Applicant's products into a patient. Applicant's products encapsulate nucleic acid therapeutic drugs inside a liquid or solid matrix, just as Applicant's mark encapsulates "GENEMEDICINE, INC." inside a box. ....

Applicant, in any event, additionally points out that "[a]t no time during the prosecution of the present application has the Examining Attorney presented any evidence that applicant's design mark, as a whole, would be merely descriptive or generic."

The Examining Attorney, correctly noting that the Board may properly take judicial notice of dictionary definitions,<sup>2</sup>

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<sup>2</sup> See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du*

argues on the other hand that, as set forth for the first time in her brief, applicant's mark is merely descriptive of its goods because (footnote omitted):

A gene is defined by Webster's II New Riverside University Dictionary as a functional hereditary unit that occupies a fixed location on a chromosome, has a specific influence on phenotype, and is capable of undergoing mutation to various allelic forms. Medicine is defined ... as the science of diagnosing, treating, or preventing disease or damage to the body or mind. Id. Inc. or incorporated represents an entity designation and has no trademark significance[.] Id. Applicant's design is merely a border or carrier which has no trademark significance. .... The design does not create a distinctive commercial impression. ....

In view thereof, the Examining Attorney insists that "[t]he sole issue is whether the display of the mark creates a distinctive commercial impression separate from the literal component[s]."

The Examining Attorney particularly contends that, unlike the distinctive "double C configuration" in the "CONSTRUCT-A-CLOSET" and design mark at issue in *In re Clutter Control Inc.*, supra, the rectangular design in applicant's "GENEMEDICINE, INC." and design mark functions simply as a carrier for the literal terms therein and "is not sufficiently unique or distinctive as to warrant registrability" of applicant's mark. Common basic shapes, such as a rectangle, are considered to be inherently nondistinctive, the Examining Attorney correctly observes, "when such common basic shapes are used as a vehicle or background for

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*Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the display of word marks," citing *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804, 1805 (TTAB 1990). In view thereof, and since, as in *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986), the Examining Attorney finds that the typeface in which the wording in the mark appears "is insufficiently stylized to create an inherently distinctive, registrable display," the Examining Attorney concludes that applicant's mark is merely descriptive of its goods.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, 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 those 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. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what

the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

On the other hand, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). 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, e.g., In re Atavio, 25 USPQ2d 1361, 1362 (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). Any doubt as to whether a mark is merely descriptive or suggestive is resolved, in accordance with the Board's policy, in favor of the applicant by allowing publication of the mark for opposition. See, e.g., In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981) and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

While, in the present case, we concur with the Examining Attorney that, contrary to applicant's contentions, the

solid rectangular design in applicant's mark is a common, basic shape which serves simply as a carrier or vehicle for the display of the words "GENEMEDICINE, INC." and that such words are displayed in an ordinary, nondistinctive typeface, we agree with applicant that the Examining Attorney has offered no evidence on this record which prima facie shows that the terminology "GENEMEDICINE, INC." is merely descriptive of applicant's goods. Although, to be sure, the term INC. merely describes the fact that applicant's products are produced and/or sold by an incorporated entity and thus is lacking in trademark significance,<sup>3</sup> the dictionary definitions cited by the Examining Attorney fail to establish that, to the doctors and medical researchers who, as applicant admits, would constitute its primary customers, the designation "GENEMEDICINE" has a merely descriptive significance. Such designation simply does not immediately or directly describe any significant attribute, function, feature, purpose, use or other aspect of applicant's formulated nucleic acid pharmaceutical preparations for the treatment of disease. Purchasers, users and/or prospective customers for such goods would, instead, have to pause and

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<sup>3</sup> See, e.g., In re E. I. Kane, Inc., 221 USPQ 1203, 1206 (TTAB 1984) ("addition of the term 'INC.' [to the designation 'OFFICE MOVERS, INC.' for the services of moving office facilities] does not add any trademark significance to the matter sought to be registered") and In re Packaging Specialists, Inc., 221 USPQ 917, 919 (TTAB 1984) (in designation "PACKING SPECIALIST, INC." for distributorship services for packaging material and equipment, "the element 'INC.' ... [is] recognized, in trademark evaluation, to have no source indication or distinguishing capacity"). Counsel for applicant, in fact, conceded at the oral hearing the lack of trademark significance of the term "INC." in applicant's mark. Since, in view thereof, such term must be disclaimed, the application is hereby deemed to be amended to set

reflect on the significance of the term "GENEMEDICINE" in order to understand that applicant's goods, presumably, act as a medication by providing the substances which normal genes, unlike defective or missing ones, customarily produce or supply.

Consequently, customers for, and others interested in, applicant's products would be left to speculate as to what particular function(s) or other aspect(s) the term "GENEMEDICINE" refers when used in connection with applicant's goods, which are not themselves genes but are instead formulated nucleic acid preparations for the treatment of disease.<sup>4</sup> Literally,

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forth the following disclaimer: No claim is made to the exclusive right to use "INC." apart from the mark as shown.

<sup>4</sup> We judicially notice, in this regard, the dictionary definitions of the following terms:

(a) "gene," which Webster's New World College Dictionary (3d ed. 1997) at 561 defines as "[g]enetics any of the units occurring at specific points on the chromosomes, by which hereditary characters are transmitted and determined: each is regarded as a particular state of organization of the chromatin in the chromosome, consisting primarily of DNA and protein" and which The Random House Dictionary of the English Language (2d ed. 1987) at 795 lists as meaning "the basic physical unit of heredity; a linear sequence of the nucleotides along a segment of DNA that provides the coded instructions for synthesis of RNA, which, when translated into protein, leads to the expression of heredity character";

(b) "medicine," which Webster's New World College Dictionary (3d ed. 1997) at 842 sets forth as signifying, inter alia, "1 the science and art of diagnosing, treating, curing, and preventing disease, relieving pain, and improving and preserving health 2 the branch of this science and art that makes use of drugs, diet, etc., as distinguished esp. from surgery and obstetrics 3 a) any drug or other substance used in treating disease, healing, or relieving pain" and which The Random House Dictionary of the English Language (2d ed. 1987) at 1194 similarly defines, among other things, as "1. any substance or substances used in treating disease or illness; medicament; remedy. 2. the art or science of restoring or preserving health or due physical condition, as by means of drugs, surgical operations or appliances, or manipulations: often divided into medicine proper, surgery, and obstetrics. 3.

applicant's goods do not appear, on this record, to be medicines for genes. Accordingly, while nucleic acids form parts of genes, it would be only after reflection, or through the exercise of a multistage reasoning process, that purchasers and other users of applicant's goods possibly could conclude that such goods may serve to treat genetic diseases by, for example, supplying the substances which the nucleic acid component(s) of a normal gene, unlike a defective one, would provide. The mark "GENEMEDICINE, INC." and design, therefore, is suggestive rather than merely descriptive of applicant's goods.

**Decision:** The refusal under Section 2(e)(1) is reversed.

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the art or science of treating disease with drugs or curative substances, as distinguished from surgery and obstetrics";

(c) "nucleic acid," which Webster's New World College Dictionary (3d ed. 1997) at 930 lists as signifying "any of a group of essential complex organic acids found in all living cells: the two types are DNA and RNA and consist of long chains of nucleotide units with each unit composed of phosphoric acid, a carbohydrate, and a base derived from purine or pyrimidine" and which The Random House Dictionary of the English Language (2d ed. 1987) at 1329 sets forth as meaning "[*biochem.*] any of a group of long, linear macromolecules, either DNA or various types of RNA, that carry genetic information directing all cellular functions: composed of linked nucleotides"; and

(d) "nucleotide," which Webster's New World College Dictionary (3d ed. 1997) at 930 defines as "1 any of several phosphate esters of nucleosides: the basic unit of nucleic acids 2 any of several compounds not found in nucleic acids, which function as coenzymes" and which The Random House Dictionary of the English Language (2d ed. 1987) at 1329 lists as signifying "[*biochem.*] any of a group of molecules that, when linked together, form the building blocks of DNA or RNA: composed of a phosphate group, the bases adenine, cytosine, guanosine, and thymine, and a pentose sugar, in RNA the thymine base being replaced by uracil."

R. F. Cissel

G. D. Hohein

P. T. Hairston  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board