

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John C. Somberg

Serial No. 75/105,514

Patricia A. Cigelnik of Dvorak & Orum for applicant.

Mark Sparacino, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Quinn, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

John C. Somberg has filed a trademark application to register the mark THERAPEUTIC WINDOW for "computer software for medical diagnosis and treatment."¹

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act,

¹ Serial No. 75/105,514, in International Class 9, filed May 17, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Both the Examining Attorney and applicant agree that the term "therapeutic window" has a specific recognized meaning in the medical field. The Examining Attorney accepts applicant's description of "therapeutic window" as "the range of medication which is the recommended dosage for treatment of a specific medical condition[;] [t]he lower number of that range is the minimum dosage which is necessary for the medication to be effective; the higher number of that range is the maximum dosage which should be administered before the medication could have an adverse effect or could become toxic." [Applicant's brief, p. 2.] Additionally, applicant submitted the following excerpt from *Cecil Textbook of Medicine*, 17th ed., W. B. Saunders Company (1985), describing "therapeutic window":

Therapeutic Window. For plasma levels to be a useful guide to therapy, the range of drug concentrations required for optimal therapeutic effects with minimal toxicity must be established. This range is called the "therapeutic window" and is determined experimentally for each drug in a group of patients who are carefully observed for desired and toxic drug effects.

The Examining Attorney also accepts applicant's statement that the "'therapeutic window' of a drug is developed and derived by the manufacturing pharmaceutical company, for use by a medical practitioner in prescribing the proper doses for patients." [Applicant's brief, p. 2-3.]

The Examining Attorney submitted excerpts of articles from the NEXIS/LEXIS database that use the term "therapeutic window," and several examples follow:

"... First they help maintain the concentration of the drug in the blood within what is called the drug's 'therapeutic window,' in which the drug has its most beneficial effect." *Standard & Poor's Emerging and Special Situation*, October 15, 1996.

"Neuprex appears to have a nice therapeutic window, with efficacy seen in the 4 mg/kg/day range and toxicity in the preclinicals showing up at doses ..." *Bioventure View*, September 1, 1996.

"... drug has a narrow therapeutic index, however, and has the potential to cause significant toxicity. The misuse of digoxin in the elderly is of special concern because the therapeutic window narrows in this population ..." *Drug Topics*, July 8, 1996.

"Maximum values, however, are 'generally only important for those nutrients of known potential toxicity, especially for those with a narrow therapeutic window (e.g., vitamins A and D),' IFC said." *Food Chemical News*, June 24, 1996.

Considering this evidence and applicant's explanation and evidence, the Examining Attorney argues the following:

One attribute of applicant's software is that it provides a recommendation for the optimal dose of a drug to be prescribed for a given condition. In order to provide that recommendation, the software uses the therapeutic window of the drug to be prescribed. The dosage of the drug prescribed by the software must be within the therapeutic window of the drug. The term therapeutic window, therefore, describes a feature of the medical software and is merely descriptive.

[Examining Attorney's brief, p. 4.]

Applicant contends, on the other hand, that the Examining Attorney misunderstands both the actual meaning and application of the term "therapeutic window" and the nature of applicant's software and its intended uses. Applicant explains that the meaning and use of the term "therapeutic window" is limited; that it "is generally used when discussing the research and development of specific drugs"; and that "applicant's software is *not* used to help a health care provider determine or track a drug's therapeutic window; such a determination is made by the pharmaceutical companies." [Applicant's brief, p. 3.] Applicant submitted printouts showing several of its software screens, including an index of topics, several diagnostic screens, and one screen entitled "Suggested Therapeutic Options" that recommended medications and indicated doses and warnings. Additionally, applicant submitted a description of its software as "a series of CD-

ROM based computer programs, covering a wide spectrum of topics in medicine ... it is designed to aid the physician both in making a diagnosis for a patient presenting with a complex of symptoms, and in selecting an optimal treatment plan for that patient based on current state-of-the-art standards of medical practice, cost considerations, and the patient's medical history." Applicant contends that its software has nothing to do with determining or tracking a drug's therapeutic window; and that its proposed mark "is suggestive that its software is for use in the healthcare industry." In its brief, applicant indicated its willingness to enter a disclaimer of "therapeutic."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the

determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

In the present case, we find that the Examining Attorney has not established that, when applied to applicant's goods, the mark THERAPEUTIC WINDOW immediately describes, without conjecture or speculation, a significant feature or function of such goods. We believe that some cogitation or mental processing would be required for prospective customers of applicant's goods to readily perceive the mark THERAPEUTIC WINDOW as merely descriptive as it pertains to applicant's software for medical diagnosis and treatment. We find applicant's explanation of the significance of the term "therapeutic window" in the medical field to be credible and uncontroverted by the Examining Attorney. While drug dosage levels are within the "therapeutic windows" established by pharmaceutical manufacturers, the term "therapeutic window" does not appear to be synonymous with terms used by medical practitioners, such as "recommended dosage" and the like. Thus, we find the mark THERAPEUTIC WINDOW herein to be

somewhat incongruous such that the significance of the term in the context of applicant's software is not immediately apparent.²

There is a fine line between what is a suggestive mark and what is unregistrable merely descriptive matter. It is our view that the record before us is not sufficient³ to establish that the term THERAPEUTIC WINDOW, when applied to applicant's goods, is merely descriptive thereof. We believe that this is a close case and we emphasize that our determination on this issue is not free from doubt. However, where there is doubt on the question of mere descriptiveness, that doubt is to be resolved in applicant's behalf and the mark should be published for opposition. See, *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

² We find it unnecessary to address applicant's offer, not addressed by the Examining Attorney, to consider a disclaimer of the word THERAPEUTIC in its mark.

³ We do not intend by this statement to criticize the Examining Attorney's presentation of his case. First, we note that this application is based on a bona fide intention to use the mark in commerce and, thus, no specimens are of record. Further, we recognize that there are practical limitations to the nature of evidence accessible to an Examining Attorney in defending a refusal in an *ex parte* matter. That is to say, our conclusion in this *ex parte* appeal would not, of course, preclude the Board from reaching a different result in a subsequent *inter partes* proceeding brought against this same application by a competitor of applicant, if the competitor was able to present evidence that the term "therapeutic window" is merely descriptive when used in connection with goods of the type identified herein.

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Decision: The refusal under Section 2(e)(1) of the Act is reversed.

T. J. Quinn

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board