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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Biovector Therapeutics, S.A.**

Serial No. 75/339,348

Thomas D. Drescher of **Wilson Sonsini Goodrich & Rosati** for
Biovector Therapeutics, S.A.

Fred Mandir, Trademark Examining Attorney, Law Office 105
(**Thomas Vlcek**, Managing Attorney).

Before **Hanak, Quinn** and **Wendel**, Administrative Trademark
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

Biovector Therapeutics, S.A. (applicant) seeks to
register BIOVECTOR in typed drawing form for the goods and
services listed below. The intent-to-use application was
filed on August 12, 1997.

Class 5

Pharmaceutical preparations, namely, drug delivery systems,
drug carriers, pharmaceutical excipients, drug adjuvants,
drug activators and drug penetration enhancers; and
pharmaceutical preparations used for: neurology, pain,
cancer, immunotherapy, vaccines, namely, DNA vaccines,
autoimmune disease, hormonotherapy, endocrinology, anti-

infectious, cardiology, deficiency disease, rheumatology, allergy, otorhino-laryngology, pneumology, ophthalmology, gene therapy and diagnostics;

Class 42

Pharmaceutical research and development services for others.

The Examining Attorney refused registration on multiple grounds. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

There were two Office actions in this proceeding. In both actions the Examining Attorney alleged that the mark BIOVECTOR was both merely descriptive and generic for applicant's goods and services. Indeed, in the first office action, the Examining Attorney informed applicant that because applicant's mark was generic, the Examining Attorney could not "recommend an amendment to proceed under Trademark Act Section 2(f)." In essence, the Examining Attorney advised applicant that it would be pointless for applicant to present evidence in an effort to demonstrate that its mark had acquired distinctiveness in the sense that the mark now served to indicate goods and services coming solely from applicant.

In addition, in both Office actions the Examining Attorney asked applicant to "submit any informative

literature regarding all the goods and services for which applicant has asserted a bona fide intent to use the mark." In both Office actions, the Examining Attorney made reference to Trademark Rule 2.61(b).

However, in his appeal brief, the Examining Attorney never contended that applicant's mark was generic for applicant's goods or services. Rather, the Examining Attorney contended simply that said mark was merely descriptive of applicant's goods and services. In addition, in his appeal brief, the Examining Attorney made clear for the first time that applicant's failure to provide informative literature regarding its goods and services was a separate ground for refusal.

In view of the foregoing, we find that in his appeal brief, the Examining Attorney has now abandoned his contention that applicant's mark is generic as applied to applicant's goods and services. Moreover, we note that, in any event, the Examining Attorney has not established that applicant's mark BIOVECTOR is generic for applicant's goods and services. It is beyond dispute that "the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining

Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

As the Examining Attorney concedes, the term BIOVECTOR is not listed in any dictionary. The only evidence the Examining Attorney has made of record in support of his claim of genericness are 32 excerpts of stories appearing in printed publications and wire service releases. In virtually all of these stories, the term BIOVECTOR is used to refer to applicant's products and company. In only two or three of the stories is the term BIOVECTOR used to refer to products not associated with applicant. In sum, the Examining Attorney's evidence simply does not constitute the required strong, substantial showing that applicant's mark BIOVECTOR is indeed generic as applied to applicant's goods and services.

However, the aforementioned evidence may be sufficient to establish that applicant's mark BIOVECTOR is merely descriptive of applicant's good and /or services. However, as previously noted, in Office action number one the Examining Attorney strongly discouraged applicant from attempting to establish that even if its mark was merely descriptive, that nevertheless it had acquired distinctiveness pursuant to Section 2(f). According, because the Examining Attorney has now abandoned his claim that the mark is generic and because in any event the evidence does not establish that the mark is generic, we find it prudent to remand this file to the Examining Attorney to afford applicant, after it files its amendment to allege use, the opportunity, if it so desires, to argue in the alternative and submit Section 2(f) evidence in a effort to establish that its mark has acquired distinctiveness, assuming for the sake of argument that the mark is indeed merely descriptive.

Finally, as for the refusal on the basis that applicant has not furnished literature describing its good or services, we reverse. In neither of the two Office actions did the Examining Attorney make it clear that the failure to comply with this request would constitute a separate basis for a refusal to register. It was only in

his brief that the Examining Attorney clearly articulated the fact that applicant's failure to provide descriptive literature was in and of itself a separate ground for refusal. There is no dispute that the failure to comply with such a request can constitute a separate ground of refusal. In re Babies Beat Inc., 13 USPQ2d 1729, 1731 (TTAB 1990). However, this separate ground of refusal should be made clear during the examination process and should not be made clear for the first time in the Examining Attorney's brief. In any event, applicant has now attached to its reply brief a substantial body of literature describing its BIOVECTOR goods and services.

Decision: The refusal to register on the basis that applicant failed to provide descriptive literature for its BIOVECTOR goods and services is reversed. The refusal to register on the basis that applicant's mark is generic for applicant's goods and services is considered withdrawn, and in the alternative, is reversed for failure make the required strong, substantial showing that applicant's mark is indeed generic. As for the mere descriptiveness refusal, this file is returned to Examining Attorney with the instruction that he issue a third Office action affording applicant the opportunity to file an amendment to allege use and any evidence that applicant wishes to submit

in an effort to prove that pursuant to Section 2(f) of the Trademark Act, applicant's mark, if considered to be merely descriptive, has acquired distinctiveness indicating goods and services coming solely from applicant. If applicant submits Section 2(f) evidence and this persuades the Examining Attorney that the mark has acquired distinctiveness, then the mark will be passed to publication. If applicant responds but declines to submit Section 2(f) evidence or if the Examining Attorney deems such evidence to be insufficient, then the Examining Attorney will issue a final Office action refusing registration and the file will, in due course, be returned to this board.

E. W. Hanak

T. J. Quinn

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

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