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Paper No. 10
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Polygenyx, Inc.

Serial No. 75/765,120

Christine M. Baker of Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C. for Polygenyx, Inc.

Darlene D. Bullock, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Seeherman, Wendel and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Polygenyx, Inc. has appealed from the final refusal of
the Trademark Examining Attorney to register POLYGENYX as a
mark for the following goods and services:

Analytical products for genotyping and
DNA sequencing, namely, test kits for
diagnostic, prognostic and
pharmacogenomic applications; for life
science research; for DNA-
fingerprinting; and for identification
and marker-assisted selection of
individuals, for use with humans,

plants, animals, fish, and
microorganisms (Class 10);

Analytical services for genotyping and
DNA sequencing for diagnostic,
prognostic, and pharmacogenomic
applications; for life science
research; for DNA-fingerprinting; and
for identification and marker-assisted
selection of individuals, for use with
humans, plants, animals, fish and
microorganisms (Class 42).¹

Registration has been refused pursuant to Section
2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the
ground that applicant's mark is merely descriptive of its
goods and services. Specifically, the Examining Attorney
contends that applicant's mark is the phonetic equivalent
or purposeful misspelling of "polygenics," which is the
plural of the word "polygenic," and "polygenic" describes a
feature of applicant's goods and services, namely, that
they involve the use or study of polygenic material.

Both applicant and the Examining Attorney have filed
briefs; an oral hearing was not requested.

In support of her position that the mark is merely
descriptive, the Examining Attorney has submitted excerpts
from articles taken from the NEXIS database which contain
the word "polygenic," such as the following:²

¹ Application Serial No. 75/765,120, filed August 24, 1999,
asserting a bona fide intention to use the mark in commerce.

² We have considered only those articles which were published in
U.S. periodicals, as there is no indication as to whether the

In genetic studies there are two terms worth knowing: polygenic inheritance and pleiotropy.

The first means it sometimes takes more than one gene to control a single trait.

"The Washington Times," December 29, 1999

"... All of the things that you might test for are polygenic (traits influenced by more than one gene). We don't even know what these genes are."

"New Scientist," December 11, 1999

Genetic diseases are arranged into three classes: chromosomal disorders, monogenic or class Mendelian, and polygenic (ie, involving more than one gene).

"AORN Journal," August 1, 1999

...type 2 diabetes is now considered to be a polygenic disease, with different genes likely to confer susceptibility in different populations.

"Bulletin of the World Health Organization," August 1, 1999

The study of gene-nutrient interactions includes both single-gene defects and complex polygenic diseases. Single-gene defects, such as phenylketonuria (PKU) and maple syrup urine disease (MSUD), are known as inborn errors of metabolism.

Polygenic diseases include common diseases such as cancer, diabetes, and obesity.

"Nutrition Today," January 1, 2000

articles appearing in foreign publications, or in newswire reports, were ever circulated in the United States. The determination of mere descriptiveness must be based on the perception of the relevant consuming public.

In addition to the NEXIS excerpts, the Examining Attorney has requested that we take judicial notice of the following dictionary definitions, a request which we hereby grant:³

polygenic (adjective): of, relating to, or determined by polygenes: *polygenic inheritance*.

polygene (noun): Any of a group of nonallelic genes, each having a small quantitative effect, that together produce a wide range of phenotypic variation. Also called *multiple factor, quantitative gene*.⁴

The Examining Attorney explains that it is her position "that the word polygenic clearly describes a feature of goods and services that are a test kit to be used in connection with polygene and services that consist of performing research in connection with a polygene or test." Brief, p. 5. She goes on to say that the use of the word "genotyping" in applicant's identification of goods and services clearly "demonstrates that the applicant's goods and services are related to genes." Brief, pp. 5-6. She further asserts that the fact that applicant's "test kits are used for a complex disease that

³ The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

is polygenic in nature clearly indicates the word being merely descriptive of applicant's goods and services."

Brief, p. 6.

Applicant has explained that its kits

are for use in determining the genetic makeup of humans, plants, animals, fish and micro-organisms and identifying the naturally occurring differences between them, and analyzing DNA sequences and complex disease and agricultural traits for drug discovery and pharmacogenomic applications. In other words, the Applicant's test kits locate DNA that is involved in the development of complex diseases such as diabetes, asthma and coronary artery disease or in complex agricultural traits such as growth rate, yield or disease resistance and enable the development of therapeutic agents.

Similarly, its services analyze

the genetic composition of humans, plants, animals, fish and micro-organisms and nucleic acids, which may or may not carry genetic information, for the purpose of developing drugs and pharmacogenomic applications that will treat complex diseases and agricultural traits. Brief, p. 8.

Applicant, although acknowledging that POLYGENYX is the phonetic equivalent of "polygenics," disputes that it is the phonetic equivalent of "polygenic." Applicant further points out that there is no evidence that "polygenics" is even a word, and asserts that "polygenics" would not be recognized as a word because it is

grammatically incorrect, that one would not add "s" to the end of the adjective "polygenic." Applicant also asserts that the odd usage of the letters "YX" at the end of its mark results in a delayed recognition of what this word would be. As a result, consumers viewing the mark in connection with applicant's goods or services would have to engage in mental gymnastics to leap from POLYGENYX to "polygenics" to "polygenic" to something to do with many genes to an understanding that applicant's goods and services have something to do with many genes.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). On the other hand, a mark is suggestive, and therefore registrable without evidence of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. Id. It has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible

descriptiveness. **In re Recovery, Inc.**, 196 USPQ 830 (TTAB 1977).

Here, we find that the Office has not met its burden in proving that POLYGENYX is merely descriptive of applicant's identified goods and services. Although "polygenic" is clearly a recognized term to indicate a group of genes, and can be used to describe diseases with multiple-gene involvement, there is no evidence whatsoever that "polygenics" is a word.⁵ We agree with applicant that several mental steps are involved to get from POLYGENYX to a recognition that it is the phonetic equivalent of "polygenics" to realizing that it is similar to "polygenic" to the fact that there are "polygenic" diseases to understanding that applicant's goods and services can be used to locate DNA and/or genes that are involved in the development of polygenic diseases like diabetes.

We acknowledge that this is a close case. However, in reaching our decision we must follow the well established principle that, to the extent that any doubt exists as to

⁵ The dissent comments that "those immersed in this nascent field presumably already use the word 'polygenics' to name this scientific specialty" and implies that "the word 'polygenics' names the field of applicant's endeavor." However, there is no evidence in the record to show this. We cannot presume that "polygenics" is being used to name a scientific specialty without evidence to this effect. Not one of the submissions made of record by the Examining Attorney employs the term "polygenics."

whether a mark is merely descriptive, it must be resolved in favor of applicant.

Decision: The refusal of registration is reversed.

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Bucher, Administrative Trademark Judge, dissenting:

With all respect due my colleagues, I would affirm the Trademark Examining Attorney's refusal to register.

The record shows that "polygenic" expressions are traits or diseases influenced by multiple-genes. Applicant's goods and services involve the analysis of these highly complex patterns of inheritance. Accordingly, without a lot of cogitation, I find that the word "polygenic" immediately conveys knowledge of the characteristics of applicant's goods and services. From that conclusion, one must then ask whether the plural form of that word represents the incongruous grammatical concept portrayed by applicant. I think not.

Several other English-language analogies spring to mind. In discussing its goods and services, *supra*, applicant refers to "pharmacogenomic applications." While "pharmacogenomic" is an adjective, the specialty is correctly known as "pharmacogenomics" - the pluralized form

of the word - which functions as a noun. Or another example - a word having similar etymological roots to "polygenic": ancient "eugenic" (adj.) theories long predated the terrible 20th century history of "eugenics" (noun).

Similarly, those immersed in this nascent field presumably already use the word "polygenics" to name this scientific specialty. And if the word "polygenics" names the field of applicant's endeavor, how can "polygenyx" (the exact phonetic equivalent) be anything other than descriptive of applicant's goods and services?⁶

⁶ Unregistrable under Section 2(e)(1) of the Lanham Act, I would propose, absent the possibility that applicant might be permitted a registration on the Principal Register under Section 2(f) of the Act upon the submission of sufficient evidence of acquired distinctiveness for its unique spelling.