

4/30/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Zervas

Opposition No. 115,805

G. D. Searle & Co.

v.

Victorio Rodriguez

Before Cissel, Quinn and Bucher, Administrative Trademark Judges.

By the Board:

Victorio Rodriguez (proceeding pro se)¹ has filed an application to register the proposed mark CEREBRIL (in typed form) for "pharmaceutical preparations for the treatment of brain edema."²

G. D. Searle & Co. has opposed the registration of applicant's proposed mark, alleging that opposer

¹ Applicant was represented by an attorney during the prosecution of this case, but has since discharged his attorney. On November 15, 2000, prior to the date when applicant filed his motion for summary judgment, the Board granted opposer's attorney's request for withdrawal. Since then, applicant has been proceeding pro se.

² Application Serial No. 75/409,172 for CEREBRIL was filed on December 22, 1997 and is based on the assertion of an intent to use the mark in commerce.

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manufactures and sells pharmaceuticals, and has a need to use anatomical and medical terms such as "cerebral"; that

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CEREBRIL is merely a variation of the spelling of "cerebral," which is defined as "of or relating to the brain or cerebrum"; and that applicant's proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act.

Applicant has denied the salient allegations of the notice of opposition.

This case now comes up on (a) opposer's "Request for Clarification and Modification of Orders" (filed August 15, 2001); (b) applicant's motion for summary judgment (filed via a certificate of mailing on August 29, 2001); (c) opposer's cross motion for summary judgment (filed via a certificate of mailing on October 3, 2001);³ (d) applicant's motion for sanctions (filed October 29, 2001); and (e) opposer's motion (filed November 5, 2001) to strike applicant's brief entitled "Applicant's Response to Opposer's Support of Cross-Motion for Summary Judgement & Applicant's Support for its Motion for

³ Applicant, in his response to opposer's cross motion, contends that opposer's cross motion was untimely because "opposer's time to respond [to his summary judgment motion] has run out. The date of service to the Opposer was on August 29, 2001 and Opposer's response is October 3 which is 35 days."

Applicant is incorrect. The Trademark Rules permit opposer thirty-five days to file and serve a response to applicant's motion. Specifically, under Trademark Rules 2.127(e)(1) and 2.119(c), respectively, opposer is permitted thirty days from the date of service of applicant's motion for summary judgment,

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Summary Judgement," which applicant filed via a certificate of mailing on October 26, 2001.

We first turn to opposer's motion to strike, which we hereby grant. If applicant's brief is viewed as a *surreply* filed in connection with applicant's summary judgment motion, the brief is impermissible under Trademark Rule 2.127(e)(1).⁴ If the brief is viewed as a *reply* filed in connection with opposer's cross motion for summary judgment, the brief is late since applicant filed the brief beyond the period allowed by Trademark Rule 2.127(e) (fifteen days) plus the period allowed under Trademark Rule 2.119(c) for service by first-class mail (five days).⁵ Thus, we have given no consideration to "Applicant's Response to Opposer's Support of Cross-Motion for Summary Judgement & Applicant's Support for its Motion for Summary Judgement" and its exhibits.⁶

plus an additional five days (because applicant's motion was served via first class mail), in which to file its response.

⁴ Trademark Rule 2.127(e)(1) states that "The Board may, in its discretion, consider a reply brief. * * * No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board."

⁵ Opposer filed and served its response to applicant's summary judgment motion on October 3, 2001. Any reply by applicant should have been filed by October 23, 2001.

⁶ Even if we were to consider "Applicant's Response to Opposer's Support of Cross-Motion for Summary Judgement & Applicant's Support for its Motion for Summary Judgement," it would not change the result herein.

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We next turn to the motions for summary judgment, beginning with applicant's summary judgment motion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a

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matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Old Tyme Food, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In applicant's one and a half page summary judgment motion, applicant merely states that "**CEREBRIL** is at most a **SUGGESTIVE MARK.**" (Emphasis in the original.) However, applicant has not explained why it believes that its proposed mark is suggestive. Applicant also submitted several exhibits with his motion.⁷ However,

⁷ Applicant's exhibits include (a) information regarding a product named CEREBRIL taken from the web site of a corporation named Neurochem, Inc. which, according to applicant, is connected to opposer and is a "start -up" company in Canada; (b)

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many of the exhibits cannot be allowed into the evidentiary record because they are not supported by an affidavit or declaration authenticating them. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998) and Fed. R. Civ. P. 56(e). The remaining exhibits, which appear to be official records such as Canadian Intellectual Property Office records or Neurochem, Inc.'s United States trademark application for CEREBRIL, have little or no probative value on the questions of descriptiveness and suggestiveness. Thus, we find that applicant has failed to carry his initial burden, as the moving party, of making a prima facie showing of the absence of any genuine issues of material fact, and that he is entitled to judgment as a matter of law on the questions of suggestiveness and descriptiveness. Applicant's motion for summary judgment therefore is denied.

We now turn to opposer's cross motion for summary judgment, where opposer contends that "consumers will

information regarding trademark applications in the name of Neurochem, Inc. taken from the web sites of the Canadian Intellectual Property Office and the United States Patent and Trademark Office; (c) the first page of two of applicant's patents; (d) copies of correspondence between applicant and opposer's attorneys; (e) a copy of an email sent by a third party regarding CEREBRIL; (f) information from the Internet regarding the treatment of brain edema with acetazolamide; and

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perceive the term 'cerebril' as the descriptive word 'cerebral,' or as a slight misspelling of that term." Opposer maintains in its motion that there are no genuine issues of material fact in this case, and applicant has not identified any such issues in his response. Upon consideration of the record before us, we find that there are no genuine issues of material fact and that this case is ripe for decision on summary judgment.⁸ Consequently, we must determine whether applicant's proposed mark is merely descriptive as a matter of law. After considering the evidence of record and the arguments presented, we find that summary judgment is warranted in opposer's favor.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it

(g) opposer's responses to applicant's first set of interrogatories and first request for production of documents.
⁸ This includes any question regarding opposer's standing in this case. To show standing, it is necessary for opposer to prove that it is engaged in the sale of goods of which the applied-for mark is allegedly descriptive. *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). Here, opposer has filed the declaration of Cynthia Summerfield, opposer's Associate General Counsel, with opposer's cross motion, which establishes that opposer tests, manufactures and distributes drugs that treat or relate to disorders and conditions of the brain; and that opposer commonly uses the term "cerebral" "to describe the therapeutic indications of the pharmaceuticals they test, manufacture and sell that treat brain or cerebral

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immediately describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). If so, the term may not be registered on the Principal Register, absent a showing of acquired distinctiveness.⁹ Trademark Act §§ 2(e)(1), 2(f); 15 U.S.C. §§1052(e)(1), 1052(f). It is not necessary that a term describe all the characteristics or features of the goods in order for it to be considered merely descriptive. It is sufficient if the term describes one significant attribute of the goods. *In re Pennzoil Products Co.*, 20 USPQ2d 1735 (TTAB 1991).

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

disorders and conditions." Opposer therefore has established, as a matter of law, its standing to oppose applicant's mark.

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term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

We now consider whether the term "cerebral" is merely descriptive in connection with applicant's goods in view of the evidence of record. The evidence of record includes the pleadings; the file of the involved application; the official records filed by applicant with his summary judgment motion; opposer's response to applicant's first set of interrogatories and first request for production of documents;¹⁰ the declaration of Cynthia Summerfield, opposer's Associate General Counsel; the first declaration of Edward Whalen, a trademark paralegal with opposer's law firm of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo P.C., filed in support of opposer's cross motion; applicant's declaration filed in support of his response to opposer's cross motion; and Mr. Whalen's second declaration filed with opposer's

⁹ A showing of acquired distinctiveness is ordinarily unavailable in an intent to use application, such as the application involved in this proceeding.

¹⁰ Opposer's response to applicant's first set of interrogatories and first request for production of documents merely recites objections to applicant's interrogatories and document requests, a statement that opposer "is in the process of searching for information" and that it reserves "the right to supplement its responses ...". Applicant need not have filed a copy of opposer's response because it does not contain any substantive evidence relating to this case.

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reply to its cross motion. See Fed. R. Civ. P. 56(e); and Trademark Rules 2.112(b), 2.112(e) and 2.127(e)(2).

Opposer has enclosed several dictionary definitions of "cerebral" with Mr. Whalen's first declaration. For example, in *Merriam-Webster's Collegiate Dictionary* (10th Ed. 1995), "cerebral" is defined as "of or relating to the brain"; and in *The American Heritage Dictionary* (1985), "cerebral" is defined as "of or pertaining to the brain or cerebrum." First Whalen declaration at Paragraph 2, Exhibits 1 and 2. Because applicant's pharmaceutical preparations are used for treatment of a *brain* condition, and "cerebral" is defined as "of or relating to the brain,"

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we conclude that applicant's pharmaceutical preparations can be described as used for a *cerebral* condition.

"Cerebral" hence describes a feature or use of applicant's pharmaceutical preparations.

Applicant himself uses "cerebral" to refer to the brain, and more particularly uses "cerebral edema" interchangeably with "brain edema" in the context of a pharmaceutical treatment for brain edema. See, the abstracts of applicant's U.S. Patent No. 5,755,237 entitled "Therapeutic use of Acetazolamide for the Treatment of **Brain** Edema" and applicant's U.S. Patent No. 5,944,021 entitled "Therapeutic Use of a Carbonic Anhydrase Enzyme Inhibitor for the Treatment of **Brain** Edema," which state: "A method for treating victims of **cerebral** edema" (Emphasis added.) See also the introduction and prior art sections of both of these patents, which state:

This invention relates to the medical treatment of victims of **cerebral** edema, and especially to the relief of **brain** swelling as a result of ischemic strokes especially [sic], but also swelling due to tumors, surgeries, or **cerebral** trauma, which swelling usually results in severe disability and often death of the patient.

* * *

U.S. Patent No. 5,389,630 was issued Feb. 14, 1995 to Sato, et al., claiming an array of certain diamine compounds and their use for

treating disorders of **cerebral** function or preventing the progress of such disorders, including **cerebral** hemorrhage, **cerebral** infarction, subarachnoid hemorrhage, transient ischemic attack, cerebrovascular disorders, and the like.

* * *

Accordingly, **cerebral** protective drugs that promise excellent clinical effect and are readily available and useful for oral or intravenous administration are to be desired.

(Emphasis added.) First Whalen declaration at Paragraph 5, Exhibits 52 and 53.

Others also use "brain" and "cerebral" interchangeably in the context of edema. Opposer has submitted with Mr. Whalen's first declaration numerous "commonly available trade publications, newspapers, and magazines [which reveal] that the term 'cerebral' is used interchangeably with the term 'brain' to describe a brain swelling condition known as 'cerebral edema' or 'brain edema.'" The following are representative excerpts from such trade publications, newspapers and magazines:

A decline in ICP can be achieved by dehydration of the brain, thus decreasing **brain edema**. **Cerebral edema** results from an increase in brain volume and usually peaks 48-72 hours post injury. Types of **cerebral edema** include ...
Mary Dee Fisher, *Pediatric Traumatic Brain Injury; Critical Care Pediatrics*, Critical Care Nursing Quarterly, May 1997. (Emphasis Added.)

(First Whalen declaration, Paragraph 4, Exhibit 39.)

Cerebral edema is a swelling of the **brain** caused by accumulation of water, and is fatal in as many as 90% of children who develop it. It is the leading cause of diabetes-related deaths in children. Thomas H. Maugh, *Say AAAH; Capsules; Hair Dye, Cancer May be Linked After All*, Los Angeles Times, January 29, 2001. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 21).

Such **brain** swelling, called **cerebral edema**, is responsible for up to 60 percent of diabetes-related deaths in children. *A Diabetic Treatment is Linked to Deaths*, The New York Times, January 26, 2001. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 22).

Disturbed ratios of the three amino acids occur as leucine rises, causing the onset of varied and subtle signs of focal **cerebral edema**, which ultimately can be fatal for any child. Early signs of localized **brain edema** include ataxia, anorexia, slurred speech, high pitched cry, hallucinations, increased gag reflex, dilated pupils, vomiting, lethargy, and/or hyperactivity. Donna Robinson and Leigh-Anne Drumm, *Maple Syrup Disease: A Standard of Nursing Care*, Pediatric Nursing, May 1, 2001. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 37).

Changes such as increased permeability of the blood-brain barrier, cytotoxic and **vasogenic cerebral edema** and intracranial hypertension can lead to a reduction in **cerebral** blood flow. Because of their anti-inflammatory effects and efficacy in reducing **vasogenic brain edema**, corticosteroids may be useful adjuncts to antimicrobial therapy. *Dexamethasone Therapy for Bacterial Meningitis*, American Family Physician, March 1989. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 38).

"The management of **cerebral edema** is one of the unsolved problems in neurology and neurosurgery," Dr. Huxtable notes, "but ginkgo extract has proven effective in animal experiments to reduce chemically-induced **brain edema**." Rob McCaleb, *Ginkgo: Circulation Herb*, Better Nutrition for Today's Living, February 1993. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 40).

Cortex Pharmaceuticals Inc., a small biotech firm, and Alkermes Inc. of Cambridge, Mass., said Friday that they have settled a lawsuit over development of a drug to treat **cerebral** blood vessels Cortex's research on uses of the drug for **cerebral vasospasm** violated Alkermes' exclusive right Cortex, *Massachusetts Firm Settle Rights Dispute*, Los Angeles Times, October 8, 1995. (Emphasis Added.) (First Whalen declaration, Paragraph 3, Exhibit 7).

A frequent cause of death in severe cases of liver failure is **cerebral edema**, the swelling of the **brain**. Josephine Marcotty, *The Genesis of an Artificial Liver*, Star Tribune (Minneapolis, MN), March 15, 2000. (Emphasis Added.) (First Whalen declaration, Paragraph 4, Exhibit 32).

Applicant, on the other hand, has failed to present persuasive evidence to support his claim that his proposed mark is not merely descriptive when used in connection with the goods identified in his application. Applicant's personal declaration with its 14 exhibits, filed with applicant's response to the cross motion, does not raise a genuine issue of material fact in connection with the cross motion. The search results on the "OneLook [Internet] Dictionaries" for CEREBRIL only

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establish that the term is not in that dictionary. See Exhibit 1 of applicant's declaration. However, opposer's contention was never that CEREBRIL is a descriptive word; its contention is that CEREBRIL is a misspelling of "cerebral," which is merely descriptive of applicant's identified goods. Thus, that CEREBRIL does not appear in a dictionary is not dispositive of the issues at hand. Further, the Internet search results of Exhibits 2-7 for CEREBRIL are of no probative value because many of the summaries do not even include the term CEREBRIL, applicant has not included the full text of the websites identified in the summaries, and many of the summaries are in foreign languages and applicant has not provided an English translation of the foreign language summaries. If the contents of the websites helped to establish that "cerebral" or CEREBRIL is not merely descriptive, applicant should have introduced printouts of the websites themselves, showing the context in which "cerebral" or CEREBRIL appears in the websites. The remaining evidence submitted by applicant (e.g., the excerpts from the Canadian Intellectual Property Office) is of no probative value regarding the issues in this case.

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Applicant also appears to incorporate by reference in his response to opposer's cross motion arguments applicant made during the ex parte prosecution of this case, such as his claim that he coined the proposed mark from "'cereb' from cerebrum and 'ril' from a generic diuretic drug Hydrodiuril," and the arguments made in his answer to the Notice of Opposition. Inasmuch as they do not address the significant evidence introduced by opposer in support of its contention that the proposed mark is merely descriptive, applicant's arguments are of limited weight in resolving the cross motion.

In view of the foregoing, we conclude that the arguments and the evidence introduced by opposer, which have not been persuasively countered by the arguments and evidence introduced by applicant, establish that "cerebral" is merely descriptive of a function and a use of applicant's goods.

Having found the term "cerebral" merely descriptive in this context, we turn next to the question of whether, as argued by opposer, applicant's alleged trademark, CEREBRIL would be perceived by relevant consumers as the term "cerebral."

Whether a novel spelling of a descriptive term is also merely descriptive depends upon whether purchasers

would perceive the different spelling as largely the equivalent of the descriptive term. As Professor McCarthy notes, a "slight misspelling of a word will not generally turn a descriptive word into a non-descriptive mark." 2 T.J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11.31 (4th Ed. 1998).

The spelling of CEREBRIL differs from "cerebral" only by one letter at the terminal portion thereof. Thus, the terms are visually highly similar. Additionally, they are highly similar in sound; "il" at the end of CEREBRIL is virtually indistinguishable in sound from "al" at the end of "cerebral," when CEREBRIL and "cerebral" are spoken. Thus, we agree with opposer that CERERBRIL is a slight misspelling of "cerebral" and that the consuming public would perceive CEREBRIL as "cerebral" or as a slight misspelling of "cerebral."¹¹

¹¹ The parties have made much of opposer's evidence in support of its contention that CEREBRIL is a common misspelling of "cerebral." Opposer, pursuant to the Mr. Whalen's first declaration, filed a printout of a computer spell-check program showing that CEREBRIL was not in the program's dictionary and offering "cerebral" as a correction; and filed excerpts of searches on the Internet search engines www.msn.com, www.altavista.com and www.google.com. According to opposer, "the search engine automatically inquired whether the user meant to search the term 'cerebral.'" See first Whalen declaration, paragraph 6. Applicant maintains that he conducted the searches Mr. Whalen conducted, notes that his results were different from those of Mr. Whalen, and filed a copy of his search results for CEREBRIL as Exhibits 9-14 to his personal declaration. He concludes that Mr. Whalen "MALICIOUSLY ERASED THE SEARCHED

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Thus, we find that applicant's proposed mark is merely descriptive of the goods recited in applicant's application, grant opposer's cross motion for summary judgment and deny applicant's motion for summary judgment. Judgment is therefore entered against applicant and registration of applicant's proposed mark is refused. Also, opposer's "Request for Clarification and Modification of Orders" is denied as moot, and applicant's motion for sanctions is given no consideration because the Board had ordered applicant not to file the motion in its order mailed on October 15, 2001.

REPORTS ON THE TERM 'CEREBRIL' WITH THE INTENT TO DECEIVE THE BOARD AND THE APPLICANT IN THIS OPPOSITION." (Capitalization in the original.)

The spell check software inquiry, Mr. Whalen's Internet inquiries for CEREBRIL, and applicant's duplication of Mr. Whalen's Internet searches are of little probative value on the issues involved in this case. We have given them scant consideration.