

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
September 14, 2005

Mailed: 12/1/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bayer Aktiengesellschaft

Serial No. 78212751

Michael L. Lovitz and Stanley C. Macel of Connolly Bove
Lodge & Hutz for applicant.

Anne Madden, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Bayer Aktiengesellschaft
to register the mark ASPIRINA for "analgesics."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground
that applicant's mark, if used in connection with
applicant's goods, would be merely descriptive thereof.

¹ Application Serial No. 78212751, filed February 10, 2003, based
on an allegation of a bona fide intention to use the mark in
commerce.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was held at which applicant's counsel and the examining attorney appeared.²

The examining attorney contends that the term "aspirina" is the Spanish word for "aspirin" and that, therefore, the term is, at the very least, merely descriptive for analgesics. In support of the refusal, the examining attorney submitted definitions from four online dictionaries retrieved from the Internet; a search report showing the first ten hits for "aspirina" obtained by the GOOGLE search engine; a copy of a page from the English translation of applicant's Spanish web site; a copy of applicant's previously filed and now-abandoned application to register the same mark for the same goods; and articles retrieved from the NEXIS database. In connection with applicant's earlier application, the examining attorney points to applicant's acknowledgement, in response to the Office's inquiry, that the Spanish term "aspirina" is

² Applicant's counsel raised for the first time at the oral hearing his client's desire to seek remand for consideration of a prospective amendment to the Supplemental Register (in conjunction with an amendment to allege use). The Board explained that, given the late stage of the appeal process, an amendment to the Supplemental Register would not be entertained. Thus, the issue herein is not genericness, but rather mere descriptiveness; that is, whether applicant's mark is inherently distinctive as to allow registration on the Principal Register.

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translated in English as "aspirin," and the subsequent express abandonment of the application. In sum, the examining attorney asserts that "the term comprising the applicant's mark is the foreign equivalent of ordinary English wording, which is in common usage in the pharmaceutical industry as evidenced by the dictionary definitions/translations of record, LEXIS/NEXIS evidence of record, and website evidence of record." (Appeal Brief, unnumbered p. 5).

Applicant states that it owns registrations (copies and/or renewals have been submitted) in several Spanish-speaking countries, including Bolivia, Chile, Columbine, Dominican Republic, Ecuador, Guatemala, Honduras, Mexico, Nicaragua, Peru, El Salvador, Spain and Uruguay. Applicant also owns International Registrations, giving it protection in no less than twenty countries. Applicant contends that "ASPIRINA" is a coined term having no specific definition or meaning in Spanish or in any other language. Rather, applicant maintains, its only use is as a trademark identifying applicant as the source of its analgesics. Although applicant acknowledges that U.S. consumers "not familiar with the international fame" of applicant's mark may believe that the mark is suggestive of the term "aspirin" when applied to applicant's analgesics, applicant

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argues that consumers will recognize that applicant's mark differs from the English word "aspirin" in spelling, pronunciation and meaning, and, thus, they would not view the mark as merely descriptive. With respect to its earlier application, applicant claims that the translation of "aspirina" to "aspirin" was submitted in error.

Applicant also contends that the majority of NEXIS excerpts relied upon by the examining attorney refer to applicant's mark as a source indicator for applicant's analgesics. In support of its position, applicant submitted the Spanish version of a portion of its web site, copies of listings from Spanish/English dictionaries, and copies of its foreign registrations. Applicant also submitted a letter from its counsel to the legal department of Google, Inc. pointing out what applicant alleges is Google, Inc.'s improper translation of "aspirina" to "aspirin." Google Inc.'s letter in response is also of record wherein applicant is informed that the translation is "produced automatically," and that "we will remove the 'Translate this page' link that appears next to the www.aspirina.com site in our search results."

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an

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ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

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 or is intended to be 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 or intended use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum,

what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

There are several dictionary listings of record, and the definitions relied upon by applicant and the examining attorney are conflicting. The examining attorney's evidence shows online Spanish/English translations of the term "aspirina" as "aspirin." (www.yourdictionary.com; www.ultralingua.net; and www.altavista.com). To counter this evidence, applicant submitted a dictionary listing from Diccionario de la Lengua Española (2d ed. 2001) that is maintained, according to applicant, by the Real Academia Española; applicant describes this publication as "the official Spanish language resource (in the same manner as the Oxford English Dictionary is the official English language resource)." (Appeal Brief, p. 5). The listing is as follows:

Aspirina. (From the German *Aspirin*, Registered Trademark). *F.Med.* White, crystalline solid, constructed by acetyl salicyclic acid, which is used as an analgesic and antipyretic. 2. Caplet manufactured with this substance.

The NEXIS excerpts relied upon by the examining attorney likewise are conflicting. The examining attorney submitted articles retrieved from the NEXIS database showing uses of "aspirina" as the Spanish equivalent of the English term "aspirin." Some of these uses are reproduced below:

After a few minutes of language instruction--Where is the aspirin/Onde ha aspirina?--the pupils seemed only to care about learning the phrase, "When is the Portuguese lesson over?"
(*Chicago Tribune*, December 11, 2003)

"Quiero aspirinas--I want aspirin."
(*Los Angeles Times*, July 1, 1994)

There's a Mexican ad for a product called Aspirina (Spanish for aspirin).
(*Campaign*, July 5, 2002)

Do you sell aspirin and how much does it cost? Venden Vds. Aspirina? Cuanto cuesta?
(*Daily Star*, June 21, 2001)

As pointed out by applicant, however, other excerpts submitted by the examining attorney refer to "aspirina" or "Aspirina" as a product of applicant's (e.g., "Bayer's Aspirina" or "a product called Aspirina").³

We have considered the evidence of record against the

³ A common mistake of examining attorneys is submission of NEXIS excerpts originating in foreign countries. The present record includes such evidence, and these excerpts are not probative on the issue before us.

backdrop of the genericness of the term "aspirin." Judge Learned Hand long ago determined that "aspirin" is generic for an analgesic. *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921). In this connection, we take judicial notice of the dictionary definition of "aspirin": "a white crystalline compound...of salicyclic acid used esp. in tablet form as an antipyretic and analgesic." Webster's Third New International Dictionary (unabridged ed. 1993). Thus, starting from the premise that "aspirin" is generic for analgesics in this country, the question is whether a slight variation, ASPIRINA, is merely descriptive for analgesics.

We find that the mark ASPIRINA is not inherently distinctive, but, rather, is merely descriptive and, thus, is not registrable on the Principal Register. In view of the closeness in sound, appearance and meaning between the generic term "aspirin" and applicant's applied-for mark ASPIRINA, we see no reason to engage in the type of foreign equivalent analysis urged by the examining attorney. Irrespective of any Spanish/English translation,⁴ or the purported renown of the mark in foreign countries,

⁴ Although applicant contends that the translations provided by the examining attorney (either in the dictionary or in the NEXIS articles) are in error, consumers in this country nevertheless have been exposed to them.

prospective consumers in this country, aware of the generic term "aspirin," will view ASPIRINA as a slight variation (or even a misspelling) of the generic term and, thus, the term is merely descriptive of analgesics. The term immediately conveys the impression that applicant's analgesics are aspirin-based products. See *In re Coney Island Bredzel*, 199 USPQ 45 (TTAB 1978).

We are not persuaded that a different result is mandated by applicant's ownership of foreign registrations for the mark sought to be registered in the United States. The fact that a term is registered in a foreign country, pursuant to foreign trademark laws, is immaterial to the issue of inherent distinctiveness and the registrability of the same term in the United States. See *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967).

Applicant, in arguing that its mark is only suggestive, also cites to two third-party registrations of "ASPER-" formative marks. Firstly, the registrations were not properly made of record. Secondly, even if considered, the registrations do not compel a different result herein. *In re Nutt Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application,

the PTO's allowance of such prior registrations does not bind the Board or this court."].

In reaching our decision, we likewise have not accorded any probative value to applicant's translation submitted in its earlier application. The examining attorney essentially urges us to consider applicant's earlier translation of "aspirina" to "aspirin" as tantamount to an admission against interest. Applicant explains its previous statement as follows:

In responding to an Office action during prosecution of Applicant's prior application, counsel for applicant entered an English translation for "ASPIRINA" into the file, when in fact no such English translation exists. Once advised of the error, and the available options, applicant determined it would be best to proceed with a new application for its mark, so as to ensure the application file was accurate and correct. Applicant then requested that the first application be expressly abandoned so as to avoid any confusion between the files, and to allow the new application to proceed apace. Applicant specifically denies the Examiner's contention that the express abandonment "is evidence that applicant recognized that the mark was merely descriptive." To the contrary, had applicant truly had such a belief, applicant would have known that a new application would not be successful, absent some change in circumstance (such as establishing evidence of acquired distinctiveness). That applicant refiled its application demonstrate's [sic] applicant's *bona*

fide believe [sic] that its mark is **not** merely descriptive, as explained herein. (Appeal Brief, p. 15)(bold in original)

Cf. *Interstate Brands Corp. v. Celestial Seasonings Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978)[party's prior statement, in unrelated proceedings, of opinion on legal issue which is contrary to position taken in present proceeding is not an estoppel, but is relevant to the extent that it may be "illuminative of shade and tone in the total picture confronting the decision maker"; and "[u]nder no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record."]. So as to be clear, we have made our decision based on the evidence of record.

The intent of Section 2(e)(1) is to protect the competitive needs of others, that is, "descriptive words must be left free for public use." In *re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (CCPA 1968). The mere addition of the letter "A" at the end of the generic term "aspirin" is simply insufficient to transform ASPIRINA into an inherently distinctive mark for analgesics.

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We conclude that the applied-for mark ASPIRINA, if used in connection with analgesics, would be merely descriptive thereof.

Decision: The refusal to register is affirmed.