

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Trademarks, Box: TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513" on

Attorney Docket No. 2335-4001  
TRADEMARK

January 9, 2004  
9 Jan 2004  
Date  
Signature Joe Clark

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Application of Corium International, Inc.

For the CORIUM mark

Serial No.: 76/179,309

Law Office: 115

Filing Date: December 7, 2000

Examining Attorney: C.W. French

**APPEAL BRIEF**

Pursuant to 15 U.S.C. § 1070 and 37 C.F.R. § 2.141, applicant appeals the final rejection of this trademark application. The application was finally rejected in the Office Action of May 8, 2003. A Notice of Appeal was timely filed by facsimile transmission on November 6, 2003, and resubmitted by facsimile transmission on November 18, 2003. The TARR database shows that the Notice of Appeal was received by the Office on November 21, 2003. A copy of the originally filed Notice of Appeal, the resubmitted Notice of Appeal, and the TARR database print-out are all attached as an appendix to this brief. Because the Notice of Appeal was originally filed on November 6, 2003, a request for a thirty day extension of time for filing this brief was filed with the Office via Express Mail on December 30, 2003, to ensure its timely filing by the January 6, 2004, due date for filing this brief.

**I. ISSUES ON APPEAL:**

1. Whether the CORIUM mark is suggestive for its identified goods and services in International Classes 1, 5, and 10 ("IC 1," "IC 5," and "IC 10," respectively).
2. Whether the language of the identification of goods for the CORIUM mark in each of IC 1, IC 5, and IC 10 is definite.

## II. FACTS:

The CORIUM application was filed on December 7, 2000, as a use application with a date of first use of September 15, 2000, and a date of first use in commerce of September 15, 2000. The goods associated with the CORIUM mark were identified with the following language for IC 5.

Pharmaceutical products, namely drug delivery devices or other therapeutic devices for human use, in IC 5.

### A. THE FIRST OFFICE ACTION

The first Office Action for this matter was mailed from the Office on April 20, 2001. Substantively, the Examining Attorney rejected the CORIUM mark on three grounds: (i) the alleged descriptiveness of the mark; (ii) an inadequate identification of goods; and (iii) an unacceptable specimen to demonstrate use. Of these three grounds of rejection, the first and second are at issue on appeal. The remaining third ground of rejection is discussed only as part of the history of the prosecution of this trademark application.

In the descriptiveness rejection, the Examining Attorney acknowledged that no conflicting mark exists. Notwithstanding the foregoing, the Examining Attorney rejected the application as merely descriptive of the goods and services it identifies. Noting that the word "corium" means "dermis," the Examining Attorney took the position that the CORIUM mark "is merely descriptive of the applicant's goods, namely pharmaceutical products that may be used to treat the soft tissue in the human foot," which the Examining Attorney asserted is known as "corium" (Office Action of April 20, 2001, p.2, 3<sup>rd</sup> full para.). In support, the Examining Attorney provided several print-outs from the LEXIS/NEXIS research database showing use of the word "corium." As will be evident from the discussion that follows, the abstracts provided discuss laminitis in cows and hoof-bearing animals and cosmetics that are designed to penetrate the dermis, or corium.

The first abstract provided by the Examining Attorney describes laminitis as the inflammation of the "corium," i.e., "the delicate tissue found immediately below the sole of the foot [in a cow]" (*Farming Journal*, Dec. 15, 2000, p.37). Referencing "hoofs" in general, the second abstract describes laminitis as inflammation of "laminar corium," i.e., "an area of soft tissue in the foot containing lots of nerves and blood vessels" (*Belfast News Letter*, Sept. 30, 2000, pp.24-25). The third abstract is directed to the subject matter of parrots; there, the word "corium" is used not to describe "dermis," but rather to describe the keratin substance of "beaks," a substance which is described as similar to that which forms nails (*Edinburgh Evening News*, May 15, 1999, p. 16). The fourth abstract describes a cosmetic product that supplies collagen deep into the corium (*Cosmetics & Toiletries and Household Products Marketing News*

Attorney Docket No. 2335-4001  
Application Serial No. 76/179,309

in Japan, March 15, 1999). In the fifth abstract, also from *Cosmetics & Toiletries and Household Products Marketing News in Japan* (Feb. 15, 1998), the word "corium" is used only to describe the location of the skin where elastin is located. The sixth abstract is another reference that discusses cow hoofs; there, "corium" is described as the area on a cow's hoof "between the pedal bone and the sole" (*Farmers Weekly*, Sept. 19, 1997, p.24). The seventh abstract notes that collagen constitutes 70% of the skin's corium and thus is an effective moisturizer (*New Cosmetic and Household Products in Japan*, Sept. 15, 1997). Lastly, the eighth reference notes that while UV-B only penetrates the upper surface of the skin, UV-A rays penetrate deep into the skin, into the region known as the corium (*New Cosmetic and Household Products in Japan*, July 15, 1997).

After briefly referencing these eight abstracts cumulatively, the Examining Attorney concluded the descriptiveness analysis with the statement that the "mark immediately names a purpose of the goods and does nothing else."

In the identification of goods rejection, the Examining Attorney stated that the wording in the identification of goods in IC 5 was not acceptable as indefinite and suggested the following wording for IC 5, if accurate:

Pharmaceutical products, namely, drug delivery devices [specify type of delivery device, e.g., transdermal patch, hypodermic needle], and other therapeutic devices [specify type of device by common commercial name], all for human use, in IC 10.

In the specimen rejection, the Examining Attorney referenced the TMEP sections setting forth the procedures for submitting substitute specimens.

#### **B. THE RESPONSE TO THE FIRST OFFICE ACTION**

On October 22, 2001, applicant timely filed a response to the first Office Action.

In response to the identification of goods rejection, the identification of goods in IC 5 was amended to the following identification of goods in IC 10:

Pharmaceutical products, namely, transdermal and topical formulations, compositions and patches, for human use, in IC 10.

In response to the specimen rejection, the application was amended, without prejudice, from a use application to an intent-to-use application.

In response to the descriptiveness rejection, applicant set forth arguments, fully supported by case law, showing why the CORIUM mark is not descriptive for the goods it identifies. Citing several Court of Customs and Patent Appeals ("CCPA") and Trademark Trial and Appeal Board ("TTAB") decisions, applicant provided a concise statement of the law by stating that "[unless] a mark clearly informs potential customers 'only what the goods are, their function, their characteristics, or their use,' the mark is not merely descriptive" (quoting *In re Colonial Stores, Inc.*, 394 F.2d 549, 552 (CCPA 1968) (Response of Oct. 22, 2001, p.2, 3<sup>rd</sup> full para.). In particular, applicant argued that the CORIUM mark is not merely descriptive of the pharmaceutical products offered by applicant because "[t]he word 'corium' does not 'readily and immediately evoke an impression and understanding of applicant's products'" (quoting *In re Shuts*, 217 USPQ 363, 364 (TTAB 1983) (Response of Oct. 22, 2001, p.2, 3<sup>rd</sup> full para.). On this matter, applicant noted that "consumers would not immediately understand the nature, characteristics, properties, actions, functions and uses of the pharmaceutical products bearing the CORIUM mark merely by hearing or reading the word "corium" (Response of Oct. 22, 2001, p.2, 3<sup>rd</sup> full para.).

Traversing the Examining Attorney's position that because the word "corium" means "dermis," it must consequently describe pharmaceutical products comprising transdermal and topical formulations, compositions, and patches, applicant noted that the references submitted by the Examining Attorney only reinforce the definition of the word "corium" as referring to *tissue, not pharmaceutical products*. On this matter, applicant argued that had the identification of goods for the CORIUM mark recited "tissue grafts" or "substitute skin," the Examining Attorney's position may have been tenable; however, as it stands, the CORIUM mark is not merely descriptive because the average consumer would not immediately associate the CORIUM mark with "pharmaceutical products, namely, transdermal and topical formulations, compositions, and patches, for human use."

In one final substantive matter, applicant reminded the Examining Attorney that "[w]here several steps of thought, imagination, and perception are required for a mark to describe a product, the term is suggestive, not descriptive." Referencing the Examining Attorney's definition of descriptive goods as set forth on the first page of the Office Action of April 20, 2001, applicant noted that the mark "CORIUM does not by itself inform potential customers how applicant's products are used, what the goods do, how they work, or what is required to make use of them" (Response of Oct. 22, 2001, p. 3, last para.). Further noting that the purpose of the goods is the treatment of humans through pharmaceutical products, applicant added that a customer would not know whether a product would meet their needs by virtue of the word "corium." Rather, consumers would have to ask numerous questions to determine the functions and uses of such products. Providing two examples, applicant argued that the average consumer would have

difficulty arriving at the nicotine patches and motion sickness patches covered under the CORIUM mark merely through an understanding the definition of the word "corium."

Lastly, referencing the policy of the TTAB, applicant provided the Examining Attorney with the following quote: "When doubts exist as to whether a is descriptive as applied to the goods or services for which registration is sought, it is the practice of the Board to resolve doubts in favor of applicant and pass the mark to publication..." (Response of Oct. 22, 2001, p.4, citing *In re Stroh Brewery Co.*, 34 UPSQ2d 1796, 1797 (TTAB 1994)).

#### C. THE SECOND OFFICE ACTION

On March 28, 2002, the second Office Action for this matter was mailed from the Office. In this Office Action, the Examining Attorney maintained the rejections set forth in the first Office Action and requested applicant's compliance with three additional matters. First, the Examining Attorney requested additional information about the goods to determine whether all or part of the mark is merely descriptive as applied to the goods; specifically, the Examining Attorney inquired if applicant's goods are used on or in relation with the corium. Second, the Examining Attorney noted a defect with the amendment of the application from a use to an intent-to-use application and requested correction. Third, the Examining Attorney stated that the wording in the amended identification of goods in IC 10 was not acceptable as indefinite and suggested the following wording for IC 5, if accurate:

Pharmaceutical preparations, namely, transdermal and topical formulations, compositions, and patches, for use in the treatment of [specify ailment, condition, or illness], in IC 5.

#### D. THE RESPONSE TO THE SECOND OFFICE ACTION

On September 24, 2002, applicant timely filed a response to the second Office Action.

In response to the identification of goods rejection, applicant amended the application to include the following three identifications:

Pharmaceutical products, namely, drug delivery devices or other therapeutic devices that are applied by adhesion to a human body surface in IC 10.

Adhesive compositions for human use that are applied to a moist surface, in IC 5.

Polymers for use in the manufacture of pharmaceutical products and adhesive compositions that are applied to a human body surface, in IC 1.

In response to the rejection of the intent-to-use amendment, applicant submitted a Declaration under 37 C.F.R. §§ 2.20 and 2.33, which set forth applicant's statement of intent-to-use pursuant to 15 U.S.C. § 1051(b) and 37 C.F.R. § 2.34(a)(2)(i).

In response to the descriptiveness rejection, applicant provided the following two arguments in support of the identification of goods for the CORIUM mark:

First, applicant noted that the terminology "human body surface" in the identification of goods for the CORIUM mark implies epidermis and not dermis. In support of this fact, applicant provided medical dictionary definitions showing that the dermis is a layer of skin that resides below the epidermis with the latter being the skin that comprises the human body surface.

Second, applicant set forth a list of marks courts have found to be merely descriptive and compared those marks against a list of judicially determined suggestive marks. Against this legal backdrop, applicant argued that the Examining Attorney's rejection would have merit were the CORIUM mark to be used to identify any of the following: dermis skin grafts or natural or synthetic dermis skin produced in a laboratory (Response of Sept. 24, 2002, p.4, 2<sup>nd</sup> full para.). By contrast, because the CORIUM mark is to be attached to pharmaceutical products and adhesive patches that are adhered to the *surface* of a human body and the *polymers* used to manufacture the pharmaceutical products and adhesive patches, the average consumer must make an intellectual leap from the CORIUM mark to the identified goods and services.

#### **E. THE FINAL OFFICE ACTION**

On May 8, 2003, the final Office Action for this matter was mailed from the Office. In this Office Action, the Examining Attorney finally rejected the CORIUM mark. In support of the rejection, the Examining Attorney stated that the term "corium": "bears a logical relationship to the goods provided by the applicant." In so doing, the Examining Attorney maintained the position that "[t]he CORIUM mark is merely descriptive of the applicant's goods, namely, pharmaceutical products and adhesive compositions used on the human dermis or CORIUM." The Examining Attorney added that the "mark immediately names the exact purpose of the goods, describes the intended user and does nothing else" (Office Action of May 8, 2003, p.2, 5<sup>th</sup> full para.).

In response to applicant's arguments that the CORIUM mark is suggestive, the Examining Attorney took the position that as worded, the identification of goods for the CORIUM mark does not "specify use on the surface of the skin" (Office Action of May 8, 2003, p.3, 2<sup>nd</sup> full para.) and thus, as stated by the Examining Attorney: "As worded, the goods may include such CORIUM related goods as surgical adhesives." The Examining Attorney concluded the descriptiveness rejection by stating that no

leap of logic is required to jump from the word "corium" to the pharmaceutical products, adhesives, and polymers that identify the CORIUM mark.

Addressing the identification of goods for the CORIUM mark, the Examining Attorney once again held the language to be indefinite and suggested amending the language for the identification of goods to the following:

Bioabsorbable polymers for use in the manufacture of pharmaceutical products and adhesive compositions that are applied to a human body surface, namely, transdermal drug delivery patches and adhesives for use on transdermal drug delivery patches, in IC 1.

Adhesive compositions for human use that are applied to a moist surface, namely adhesives used to affix transdermal drug delivery patches to the epidermis, in IC 5.

Pharmaceutical drug delivery devices that are applied by adhesion to a human body surface, namely, transdermal drug delivery patches sold without medication, in IC 10.

#### F. THE RESPONSE TO THE FINAL OFFICE ACTION

On November 6, 2003, applicant filed a Notice of Appeal from the final Office Action via facsimile transmission. The details surrounding the filing of the Notice of Appeal are set forth on the first page of this brief.

### III. ARGUMENT:

#### A. THE CORIUM MARK IS SUGGESTIVE, NOT MERELY DESCRIPTIVE

A mark is refused registration on the Principal Register if it is descriptive of the goods or services to which it relates. 15 U.S.C. § 1052(c)(1). A mark is descriptive if it immediately conveys to one seeing or hearing it the thought of the goods or services with which it is used. *In re Bed & Breakfast Registry*, 229, USPQ 818, 819 (Fed. Cir. 1986). In 1984, the Trademark Trial and Appeal Board ("TTAB") enumerated that a mark may be considered descriptive if it describes an "ingredient, quality, characteristic, function, feature, purpose, use, etc. of the goods or services to which it is applied." *In re MetPath*, 223 USPQ 88, 89 (TTAB 1984). Whether a mark is descriptive is a question of fact, determined from the viewpoint of the relevant purchasing public. *Id.* The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re MetPath, Inc.*, 223 USPQ 88, 89 (TTAB 1984). Accordingly, whether a mark is descriptive requires consideration of the context in which the mark is used or intended to be used in

connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See, *In re Omaha National Corp.*, 819 F.2d 1117 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 200 USPQ 215, 217-18 (CCPA 1978); *In re Venture Lending Associates*, 226 U.S.P.Q. 285 (TTAB 1985).

Examples of marks found merely descriptive include the following:

- APPLE PIE for potpourri in *In re Gyulay*, 3 USPQ2d 1009, 1010. The mark APPLE PIE was refused registration because the mark immediately conveys a key characteristic of the potpourri, namely, its apple pie scent.
- BED & BREAKFAST REGISTRY for lodging reservations services in *In re Bed & Breakfast Registry*, 229 USPQ 818, 820 (Fed. Cir. 1986). The mark BED & BREAKFAST REGISTRY was refused registration because the average consumer would understand that the mark describes a register of bed and breakfast lodgings.
- BREWSKI for bar services in *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ 2d 1281, 1287 (TTAB 1998); the mark BREWSKI was refused registration because it is "highly descriptive" of the bar services covered by the mark, i.e., namely the service of beer (colloquially referred to as "brewski").
- COASTER-CARDS for a coaster suitable for direct mailing in *In re Bright-Crest, Ltd.*, 204 USPQ 591, 592-593 (TTAB 1979). The mark COASTER-CARDS was refused registration because it "aptly and succinctly" advises the public of the nature of the goods described by the mark, that is, a "combination coaster and postcard."
- MALE-PAP TEST for clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer in *In re MetPath, Inc.*, *supra*. The mark MALE-PAP TEST was refused registration because, in view of the common significance of the term "Pap test" as a test for detecting cancer of the female reproductive tract, the general consuming public would immediately perceive the designation as an indication that applicant's services involve tests for the detection of cancer of the male reproductive tract. *Id.* at 89. Further, the court also found that those knowledgeable in the field of medicine and those laypersons reading the consumer advertisements for the MALE-PAP TEST would recognize that the letters PAP in the designation as an acronym for "prostatic acid phosphatase"; thus, the TTAB concluded that the designation as a whole serves to indicate that the MALE-PAP TEST involves the testing of prostatic acid phosphatase levels in males. *Id.* at 90.

Attorney Docket No. 2335-4001  
Application Serial No. 76/179,309

As mentioned above, marks that are descriptive are denied registration on the Principal Register. By contrast, suggestive marks may be registered on the Principal Register. The most popular test with the courts to test the suggestiveness of a mark is the imagination test or the *Stix* test. The *Stix* test derives its name from Judge Weinfeld's enunciation of this test in the case *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479 (S.D.N.Y. 1968), as follows:

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.

The *Stix* test was endorsed by the CCPA, the predecessor court to the United States Court of Appeals for the Federal Circuit ("the Federal Circuit"), in *In re Abcor Dev. Corp., supra*. Under the *Stix* test, the question is how immediate and direct the thought process is from the mark to the particular characteristic of the product. See, *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). Thus, looking back to the list of descriptive marks, it is evident that virtually no thought process is required for a consumer to identify the goods and services that are to be associated with the marks set forth in that list. By contrast, the following list of suggestive marks demonstrates the extent to which logic must be leaped in order for the average consumer to connect a mark with its products.

Examples of marks found suggestive include the following:

- CHEW 'N CLEAN for dentifrice in *In re Colgate-Palmolive Co.*, 160 USPQ 733 (CCPA 1969). The CCPA found that the mark *suggests* a possible manner of use of the dentifrice, i.e., by chewing it, but is not merely descriptive of the dentifrice *per se*.
- FLORIDA TAN for suntan lotion in *Plough, Inc. v. Florida Tan Products, Co.*, 174 USPQ 46, 47-48 (TTAB 1972). The TTAB found that the mark is *suggestive* rather than descriptive of a Florida tan because "you cannot pour a Florida tan out of a container"; rather, to get a Florida tan, "one would have to bask and bake in the Florida sun."
- MINITMIX for biscuit mix in *Ex parte Pillsbury Flour Mills Co.*, 23 USPQ 168 (Com'r Pat. 1934). Stating that a "descriptive term is any one that would normally and naturally be employed by a manufacturer in describing the particular goods upon which the mark is used," the Commissioner of Patents held that the mark MINITMIX is *suggestive* and not merely descriptive of the biscuit mix it identifies. *Id.* at 168-169. Noting that the term "minute" is often used to denote haste or speed, the Commissioner held that the notation MINIT is

therefore suggestive of the product but not descriptive because it would not occur to the ordinary biscuit manufacturer to describe biscuit flour by the use of the term MINIT. On this matter, the Commissioner added that all of the "natural language that would normally and logically be availed of in describing biscuit flour is still freely available to the public." *Id.* at 169.<sup>1</sup>

- SKINVISIBLE for transparent medical adhesive tape in *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 172 USPQ 491, 492 (CCPA 1972). The CCPA held the mark to be highly suggestive, but not descriptive, of the quality of invisibility in the applied tape and found that mark to be a "a short, snappy way of suggesting advantageous characteristics of the goods." *Id.* at 492. On the nondescriptiveness of the mark, the CCPA noted that the "employees in charge of marketing for the competing transparent tape admitted that they have been able to describe that product and advertise it without the use of the term coined by their competitor." *Id.* Accordingly, the CCPA concluded that registration would not deprive the appellee of any right to use the language in the normal way." *Id.*
- UNBURN for skin preparation in *Norwich Pharmacal Co. v. Chas. Pfizer & Co.*, 165 USPQ 644 (TTAB 1970). Acknowledging that the word "unburn" has a rare and archaic definition (i.e., to restore from the effects of burning), the TTAB noted that as literally translated, "unburn" denotes the opposite of a burn but as it is obvious that once something has been burned it cannot be unburned, the mark is suggestive and not descriptive of the desired result it intends to achieve. *Id.* at 646.

In the instant case, Applicant is attaching the CORIUM mark to pharmaceutical products and adhesives that are applied to the surface of a human body and the polymers used to manufacture the pharmaceutical products and adhesives. It is the Examining Attorney's position that the CORIUM mark is descriptive of these goods because the term "corium": "immediately names the exact purpose of the goods, describes the intended user, and does nothing else" (Office Action of May 8, 2003, p.2). In support of this statement, the Examining Attorney quotes the applicant's website, which provides that applicant is a specialist in "dermal, transdermal, mucosal, and transmucosal drug delivery platforms and manufacturing systems" and from this quote argues that because applicant produces products that pass through multiple

---

<sup>1</sup> On a separate matter, the Commissioner of trademarks also explained that the word "merely" in the term "merely descriptive" applies only to composite marks where one word in the composite is descriptive but the others are not. With those marks only comprised of one word, the mark is either descriptive or it is not. *Ex parte Pillsbury*, 23 USPQ at 170. Accordingly, as the subject of this appeal is a one word mark, throughout this brief, applicant uses the word "descriptive" rather than "merely descriptive."

layers of the skin including the dermis (also known as the "corium"), the CORIUM mark is descriptive of the "transdermal pharmaceutical" set forth in the identification of goods for the CORIUM mark. The Examining Attorney concludes his descriptiveness analysis by stating that no imagination is required for "purchases of the applicant's goods to readily perceive the merely descriptive significance of the mark as it relates to drug delivery devices, adhesive compositions for human use, and polymers for use in the manufacture of pharmaceutical products, which all may be used on the human skin, including the layer known as the corium" (Office Action of May 8, 2003, p.3). As will be evident from the discussion that follows, the Examining Attorney's position is incorrect both factually and legally.

With respect to the Examining Attorney's position that the term "corium" describes the purpose of the identified pharmaceutical products, adhesives, and polymers identified by the CORIUM mark, applicant respectfully traverses the Examining Attorney's position. As is known from the dictionary definition of the word "corium," the word refers to the dermis of the skin. Accordingly, were this word to describe a purpose, the purpose would have to be to replace or repair the dermis of the skin. Even assuming *arguendo* that the word "corium" may refer to more than just the dermis but in fact all skin, the purpose of the identified goods would be at the most, products that would replace or repair the skin, such as skin grafts or natural or synthetic skin produced in a laboratory. As it stands, the identified goods are *not* goods that are intended to replace or repair the dermis or skin in general; rather, they are products that must be *adhered* to the surface of intact skin, be it a dry surface or a moist surface. On this matter, applicant notes that the surface of a moist mucous membrane is comprised of the same layers of epidermis and dermis as is the surface of the dry cutaneous human skin that is exposed to air.

With respect to the Examining Attorney's assertion that the CORIUM mark describes the intended user, applicant acknowledges that the mark does in fact identify the intended user of the goods associated with the CORIUM mark to be humans; however, applicant respectfully notes that no case law has been uncovered that prohibits registration of a trademark on the Principal Register merely because the mark identifies the intended user of the goods associated with the mark. Accordingly, applicant asserts that because the Examining Attorney's position is not supported by law, this Honorable Board should not give any weight to the Examining Attorney's position on this matter.

With respect to the Examining Attorney's statement that the CORIUM mark "does nothing else" but name the purpose of the goods and the intended user, applicant vehemently disagrees. The CORIUM mark does a great deal; it requires the consuming public to seek information on the goods that may be covered by the mark, and in so doing suggests to the average consumer that the mark may have some relation to that layer of skin known as the corium. In so doing, the average consumer must exercise a considerable degree of thought and perception to arrive from the CORIUM mark to its associated products.

Turning first to the pharmaceutical products covered by the CORIUM mark, for the average consumer to arrive at these products, the consumer would first have to identify the word "corium" as meaning dermis. Next, contrary to the Examining Attorney's assertion, the average consumer would *not* immediately jump from the word "corium" to a transdermal pharmaceutical product such as a drug delivery patch; rather, the average consumer, identifying the dermis as the lower layer of skin, would probably consider products associated with maintaining the appearance of healthy skin, such as lotions or cosmetics. After considered the incorporation of active agents, such as pharmaceuticals, into the lotions, the average consumer may be led to the concept of administering pharmaceuticals that pass through the layers of the skin into the bloodstream. Once the average consumer has reached this stage, the concept of using drug delivery patches to administer the pharmaceuticals may be within reach. To this end, in relation to the pharmaceutical products covered by the CORIUM mark, the word "corium" provides no direct information on the nature of the pharmaceutical products in question; it neither describes an ingredient, quality, characteristic, function, feature, purpose, or use of the identified pharmaceutical products. What the word "corium" does suggest with respect to the pharmaceutical products covered by the CORIUM mark is that the route of administration of the pharmaceutical products may be through the dermis.

Turning next to the identified adhesives, applicant submits that the CORIUM mark is even further removed from these products than it is from the pharmaceutical products discussed above. As a preliminary matter, applicant notes that the identified adhesives may include any adhesives that may be applied to a moist surface, such as for example, adhesives for use on drug delivery patches or surgical adhesives. Thus, with respect to the drug delivery patches, the average consumer would first have to go through the exercise set forth above for the pharmaceutical products and then take his or her imagination one step further to imagine the adhesives that would be used to apply the patch to a moist epidermal layer. For the surgical adhesives, beginning with the CORIUM mark, the average consumer would again have to identify corium with dermis; dermis with skin; skin with wound healing; wound healing with surgery; and surgery with surgical adhesives. Unarguably, the thought process required to arrive at the identified adhesives far exceeds the immediate and direct thought processes required of descriptive marks.

For the polymers, the imaginative process becomes even further removed than that of the adhesives. To arrive at the polymers, the average consumer would have to arrive at the pharmaceutical products and the surgical adhesives as described above and then take the imaginative process one step further to consider that polymers that may be used to manufacture the pharmaceutical products and the adhesives. Such an exercise would require quite a stretch of imagination even for the most sophisticated of consumers.

As the foregoing demonstrates, the steps required to arrive at the identified goods from the CORIUM mark are well in line with those steps set forth by the Federal Circuit, the CCPA, the former Commissioner of Patents, and the TTAB as necessary to satisfy the suggestiveness required for registration on the Principal Register (see, the foregoing list of suggestive marks set forth on pages 9-10 of this brief). Because the foregoing analysis clearly shows that the CORIUM mark is suggestive and not descriptive of its identified goods, applicant respectfully requests that this Honorable Board reverse the Examining Attorney's rejection of the CORIUM mark as descriptive.

**B. THE IDENTIFICATION OF GOODS FOR THE CORIUM MARK IS DEFINITE AND THEREFORE ACCEPTABLE FOR PUBLICATION**

The goods associated with the CORIUM mark are identified as follows:

Pharmaceutical products, namely, drug delivery devices or other therapeutic devices that are applied by adhesion to a human body surface, in International Class 010.

Adhesive compositions for human use that are applied to a moist surface, in International Class 05.

Polymers for use in the manufacture of pharmaceutical products and adhesive compositions that are applied to a human body surface, in International Class 01.

These foregoing three identifications limit the original identification, which was:

Pharmaceutical products, namely drug delivery devices or other therapeutic devices for human use, in International Class 5.

The Examining Attorney contends that the amended identifications for the CORIUM mark are indefinite. In the Office Action of May 8, 2003, rather than providing applicant with a reason for the indefiniteness of the identifications, the Examining Attorney proposes three alternative definitions, all of which serve to overly narrow the goods identified with the mark. Specifically, the Examining Attorney's proposed amendments to the identifications of goods for the CORIUM mark attempt to limit the goods associated with the CORIUM mark exclusively to: (i) pharmaceutical patches that are sold without medication; (ii) adhesives that are only used with transdermal drug delivery patches; and (iii) exclusively bioabsorbable polymers that are used to manufacture transdermal drug delivery patches and the adhesives used on the patches. Such narrowing language excludes a wide range of products that are to be covered under the CORIUM mark. Indeed, the Examining Attorney himself in referencing applicant's website

acknowledged that applicant is a specialist in "dermal, transdermal, mucosal, and transmucosal drug delivery platforms and manufacturing systems" (see, page 10 of this brief). Notwithstanding the foregoing, with the proposed amendments, the Examining Attorney appears to be choosing one drug delivery platform, namely, the transdermal type, from among those enumerated in applicant's website for the proposed identification of goods for the CORIUM mark. In light of the Examining Attorney's position that the CORIUM mark is descriptive, the Examining Attorney's chosen language almost appears to be crafted to expressly support the contention that the mark is descriptive of its identified goods.

Applicant respectfully submits the Examining Attorney's proposed amendments to the identification of goods for the CORIUM mark are both inappropriate and not in line with the examination guidelines set forth in the TMEP. As explained in TMEP § 1402.01:

The language used to describe goods or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field. An identification may include terms of art in a particular field or industry, but, if these terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology.

The TMEP further explains that where an examining attorney requires amendment of the identification of goods and services to ensure that the identification is clear and accurate and conforms to the requirements of the statute and rules, the examining attorney should explain "clearly but concisely the reason for requiring an amendment." TMEP § 1402.01(d). In the instant case, the Examining Attorney did not provide any reason for the rejection of the identification of goods for the CORIUM mark, other than to say that the definition remains indefinite and that "applicant has failed to respond to the specificity requirement as to the type of goods/services for which it is applying" (Office Action of May 8, 2003, p.4). The Examining Attorney does recite *verbatim* the entire first paragraph of TMEP § 1402.01; however, applicant cannot accept this recitation as an explanation of the rejection.

As set forth above in the recounting of the facts of the prosecution of this trademark application, applicant has thrice attempted to comply with the Examining Attorney's specificity rejection, each time amending the application to the extent acceptable, to include as much of the Examining Attorney's language for the identification of goods for the CORIUM mark as possible. Indeed, applicant complied with the Examining Attorney's request to change the classification of the goods from IC 5 to IC 10 and back to IC 5, finally settling on a definition in each of IC 1, IC 5, and IC 10 in order to specify the exact nature of the goods to be associated with the mark. Yet despite applicant's efforts, the Examining Attorney continues to reject the identification of goods as indefinite and lacking specificity.

With respect to the Examining Attorney's request for specificity, applicant notes that in the first Office Action of April 20, 2001, the Examining Attorney rejected the original identification of goods as indefinite, and without providing a reason for the rejection, suggested that the language may be amended to include the following information: (i) the type of delivery device, e.g., transdermal patch or hypodermic needle; and (ii) the type of therapeutic device by commercial name. With this suggestion, the Examining Attorney indicated that the identification should be in IC 10 rather than IC 5. In response, applicant amended the identification to name the following pharmaceutical products: "transdermal and topical formulations, compositions and patches, for human use" and changed the classification pursuant to the Examining Attorney's recommendation. Finding this definition also unacceptable as indefinite, and again providing no reason for the rejection, the Examining Attorney suggested that the language may be amended to specify: (iii) the ailments, conditions, or illnesses for which the transdermal and topical formulations, compositions, and patches would be used. With this suggestion, the Examining Attorney indicated that the identification should be put back in IC 5 rather than IC 10. In response, applicant introduced the three identifications that are presently on appeal.

Applicant submits that the Examining Attorney has never provided applicant with sufficient guidance to be able to understand why the identification of goods lacks specificity. With each rejection, the Examining Attorney suggests the specification of different aspects of the goods and then rejects applicant's attempts to further define the goods as failing to respond to the specificity requirements. To this end, applicant can no longer strive to amend the identification of goods for the CORIUM mark so that it comports with the Examining Attorney's suggestions.

Regarding the language of the identification of goods for the CORIUM mark as it presently stands, applicant submits that the average consumer would be able to understand the content of the identification of goods without adding the undue limitations suggested by the Examining Attorney. The following discussion will explain why this is the case.

For the pharmaceutical products, the identification of goods recites that the pharmaceutical products include drug delivery devices and therapeutic products that are applied by adhesion to the human body surface. The average consumer of the pharmaceutical products covered by the CORIUM mark would understand that such pharmaceutical products include transdermal drug delivery patches as well as other devices that are adhered to the surface of the human body. Adding the Examining Attorney's limitations, would not provide elucidation as to the goods covered under the identification, rather, it would only serve to exclude those other drug delivery devices and therapeutic products that applicant would choose to market under the CORIUM mark, such as, for example, the dermal, mucosal, and transmucosal drug delivery platforms that are enumerated on applicant's website.

For the adhesives, the Examining Attorney suggests limiting the identification of the CORIUM mark only to those adhesives used to manufacture the transdermal drug delivery patches. The Examining Attorney's request completely disregards that these adhesives, which are unique in that they adhere to moist human surfaces, may have broad utility and thus should be identified broadly. Further, the Examining Attorney's limitation to the applicant's language does not further define the adhesives, it merely provides one example of the use of the adhesives on patches that may be attached to a moist human body surface such as a mucous membrane. On this matter, by choosing transdermal patches over transmucosal patches, the Examining Attorney's proposed identification of goods actually does a disservice to the ultimate adhesive product line that will be covered under the CORIUM mark.

In a similar way, applicant's polymers, while certainly useful for the manufacture of transdermal drug delivery patches, have a wide-ranging applicability and thus should also be entitled to a broader definition than suggested by the Examining Attorney. On this matter, the Examining Attorney suggests amending the language of the identification to be exclusive to "bioabsorbable polymers." While applicant admits that the recited polymers may include bioabsorbable polymers, they are not exclusive to such. Because one of the uses of the polymers will be in the manufacture of drug delivery patches that are applied to the dry human body surface, the polymers that will be used for this purpose should preferably *not* be bioabsorbable. On this matter, applicant notes that bioabsorbable polymers include such polymers as catgut suture and polyglycolic acid (also known as "PGA"), both of which are used to suture internal wounds, and both of which are absorbed into the body after a predetermined period of time.

Because the identification of goods for the CORIUM mark as amended by applicant is definite, and the Examining Attorney's suggested language for the identification of goods for the CORIUM mark is both overly narrow and inaccurate, applicant respectfully requests that this Honorable Board reverse the Examining Attorney's rejection of the identification of goods as indefinite.

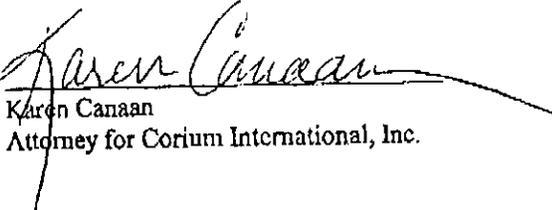
**IV. CONCLUSION:**

1. **The Issue of the Suggestiveness of the CORIUM Mark:** Because the CORIUM mark suggests the pharmaceutical products, adhesives, and polymers identified by the mark, applicant respectfully requests that this Honorable Board reverse the Examining Attorneys rejection of the CORIUM mark as descriptive of its identified goods and services.

2. **The Issue of the Definiteness of the Identification of Goods for the CORIUM Mark:** Because the identification of goods for the CORIUM mark is definite and readily understood by the average consumer, applicant respectfully requests that this Honorable Board reverse the Examining Attorney's rejection of the CORIUM mark as having an indefinite identification of goods.

With the reversal of the Examining Attorney's rejections, this application will be condition for allowance. Accordingly, upon reversal of the Examining Attorney's rejections applicants respectfully request that this Honorable Board accept this application for publication on the Principal Register.

Respectfully submitted,

By:   
Karen Canaan  
Attorney for Corium International, Inc.

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

F:\Document\23354001\appealbrief.doc

# APPENDIX

Serial No. 76/179,309

# Originally Filed Notice of Appeal

**REED & EBERLE LLP**

INTELLECTUAL PROPERTY LAW  
800 MENLO AVENUE, SUITE 210  
MENLO PARK, CALIFORNIA 94025  
(650) 330-0900 TELEPHONE  
(650) 330-0980 FACSIMILE  
WWW.REEDPATENT.COM

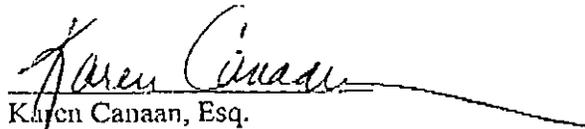
**FACSIMILE TRANSMITTAL SHEET**

TO: Trademark Trial and Appeal Board	FACSIMILE NO.: (703) 308-9333 TELEPHONE NO.:
FROM: Karen Canaan	FACSIMILE NO.: (650) 330-0980 TELEPHONE NO.: (650) 330-0900
DATE: November 6, 2003	PAGE 1 OF 3
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Following please find a Notice of Appeal; and Associate Power of Attorney for submission in connection with the above-identified trademark application.

Please charge the \$100.00 fee for filing an Ex Parte Appeal to Deposit Account No. 18-0580 (\$100.00 per class as required by 37 C.F.R. § 2.6(a)(18)). The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 2.6 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-0580.

Respectfully submitted,

  
 Karen Canaan, Esq.  
 Attorney for Applicant

**FAXED**  
 (6 Nov 2003)  
 J

11/6/03 (2)  
 re DOCKETED  
 appeal Brief 11/10/4  
 11/6/03 (2)  
 DOCKETED

**WARNING:** This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review, or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

PLEASE CALL (650) 330-0900 IF YOU HAVE ANY PROBLEMS RECEIVING THIS TRANSMISSION OR HAVE RECEIVED THIS TRANSMISSION IN ERROR.

I hereby certify that this correspondence is being transmitted via facsimile to the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, at facsimile number 703-308-9333, on November 6, 2003.

6 Nov 2003  
Date

Joe Clark

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Corium International, Inc.  
(Name of applicant)

76/179,309  
(Serial Number of application)

December 7, 2000  
(Filing date of application)

CORUIM  
(Mark)

**NOTICE OF APPEAL**

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

By Karen Canaan

Karen Canaan  
(Signature)

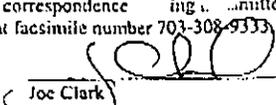
November 6, 2003.  
(Dated)

Attorney for Applicant  
(Identification of person signing)

F:\Document\23354001\Notice of Ex Parte Appeal.doc

I hereby certify that this correspondence was transmitted via facsimile to the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, at facsimile number 703-308-9333, on November 6, 2003.

6 Nov 2003  
Date

  
Joe Clark

Atty Dkt No. 2335-4001  
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:  
Corium International, Inc.

Serial No.: 76/179,309

Law Office: 115

Filing Date: December 7, 2000

Examining Attorney: C.W. French

Mark: CORIUM

**ASSOCIATE POWER OF ATTORNEY**

Commissioner For Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Madam:

Please recognize as associate attorneys in this case:

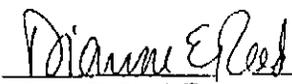
Shelley P. Eberle, Esq.  
Karen Canaan, Esq.

both affiliated with Reed & Eberle LLP, previously Reed & Associates, to prosecute the above-identified application to register, to transact all business in the United States Patent and Trademark Office in connection therewith, and to receive the certificate of registration. If the affiliation of any of these representatives is severed from their respective organization, such representative's appointment and all powers derived from this appointment shall terminate on the date of the severance.

Please address all future communications to:

Karen Canaan  
REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

Respectfully submitted,

By:   
Dianne E. Reed, Esq.  
Attorney for Applicant

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

F:\Decisions\23354001\Power of Attorney - Associate.DOC

TRANSACTION REPORT

NOV-06-2003 THU 12:16 PM

DATE	START	RECEIVER	TX TIME	PAGES	TYPE	NOTE	M#	DP
NOV-06	12:15 PM	17033089333	33"	3	SEND	OK	048	

TOTAL : 33S PAGES: 3

REED & EBERLE LLP

INTELLECTUAL PROPERTY LAW  
 800 MENLO AVENUE, SUITE 210  
 MENLO PARK, CALIFORNIA 94025  
 (650) 330-0900 TELEPHONE  
 (650) 330-0980 FACSIMILE  
 WWW.REEDPATENT.COM

FACSIMILE TRANSMITTAL SHEET

TO: Trademark Trial and Appeal Board	FACSIMILE No.: (703) 308-9333 TELEPHONE No.:
FROM: Karen Canaan	FACSIMILE No.: (650) 330-0980 TELEPHONE No.: (650) 330-0900
DATE: November 6, 2003	PAGE 1 OF: 3
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No

Following please find a Notice of Appeal; and Associate Power of Attorney for submission in connection with the above-identified trademark application.

Please charge the \$100.00 fee for filing an Ex Parte Appeal to Deposit Account No. 18-0580 (\$100.00 per class as required by 37 C.F.R. § 2.6(a)(18)). The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 2.6 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-0580.

Respectfully submitted,

# Resubmitted Notice of Appeal

**REED & EBERLE LLP**

INTELLECTUAL PROPERTY LAW  
 800 MENLO AVENUE, SUITE 210  
 MENLO PARK, CALIFORNIA 94025  
 (650) 330-0900 TELEPHONE  
 (650) 330-0980 FACSIMILE  
 WWW.REEDPATENT.COM

**FACSIMILE TRANSMITTAL SHEET**

<b>TO:</b> Amy King Trademark Trial and Appeal Board	<b>FACSIMILE NO.:</b> (703) 308-9333 <b>TELEPHONE NO.:</b>
<b>FROM:</b> Joe Clark Patent and Trademark Administrator	<b>FACSIMILE NO.:</b> (650) 330-0980 <b>TELEPHONE NO.:</b> (650) 330-0900
<b>DATE:</b> November 18, 2003	<b>PAGE 1 OF:</b> 5
<b>SUBJECT:</b> Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	<b>CONFIRMATION COPY TO FOLLOW:</b> <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

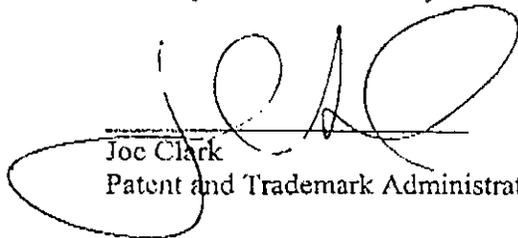
Further to our conversation today, November 18, 2003, following please find copies of the following documents that were filed via facsimile on November 6, 2003.

Facsimile Transmittal Sheet and Transaction Report;  
 Notice of Appeal; and  
 Associate Power of Attorney.

**FAXED**  
 18 Nov 03

Please feel free to contact me if you have any questions or need additional information.

Thank you in advance for your attention to this matter.

  
 Joe Clark  
 Patent and Trademark Administrator

11/18/03  
 DOCKING

**WARNING:** This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review, or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

**PLEASE CALL (650) 330-0900 IF YOU HAVE ANY PROBLEMS RECEIVING THIS TRANSMISSION OR HAVE RECEIVED THIS TRANSMISSION IN ERROR.**

TRANSACTION REPORT

NOV-18-2003 TUE 12:46 PM

DATE	START	RECEIVER	TX TIME	PAGES	TYPE	NOTE	M#	DP
NOV-18	12:44 PM	17033089333	1' 15"	5	SEND	OK	107	
			TOTAL :	1M 15S	PAGES:	5		

REED & EBERLE LLP

INTELLECTUAL PROPERTY LAW  
 800 MENLO AVENUE, SUITE 210  
 MENLO PARK, CALIFORNIA 94025  
 (650) 330-0900 TELEPHONE  
 (650) 330-0980 FACSIMILE  
 WWW.REEDPATENT.COM

FACSIMILE TRANSMITTAL SHEET

TO: Amy King Trademark Trial and Appeal Board	FACSIMILE No.: (703) 308-9333 TELEPHONE No.:
FROM: Joe Clark Patent and Trademark Administrator	FACSIMILE No.: (650) 330-0980 TELEPHONE No.: (650) 330-0900
DATE: November 18, 2003	PAGE 1 OF: 5
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Further to our conversation today, November 18, 2003, following please find copies of the following documents that were filed via facsimile on November 6, 2003.

Facsimile Transmittal Sheet and Transaction Report;  
 Notice of Appeal; and  
 Associate Power of Attorney.

Please feel free to contact me if you have any questions or need additional information.

**KEED & EBERLE LLP**

INTELLECTUAL PROPERTY LAW  
800 MENLO AVENUE, SUITE 210  
MENLO PARK, CALIFORNIA 94025  
(650) 330-0900 TELEPHONE  
(650) 330-0980 FACSIMILE  
WWW.REEDPATENT.COM

FACSIMILE TRANSMITTAL SHEET

TO: Trademark Trial and Appeal Board	FACSIMILE NO.: (703) 308-9333 TELEPHONE NO.:
FROM: Karen Canaan	FACSIMILE NO.: (650) 330-0980 TELEPHONE NO.: (650) 330-0900
DATE: November 6, 2003	PAGE 1 OF 3
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Following please find a Notice of Appeal; and Associate Power of Attorney for submission in connection with the above-identified trademark application.

Please charge the \$100.00 fee for filing an Ex Parte Appeal to Deposit Account No. 18-0580 (\$100.00 per class as required by 37 C.F.R. § 2.6(a)(18)). The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 2.6 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-0580.

Respectfully submitted,

*Karen Canaan*  
\_\_\_\_\_  
Karen Canaan, Esq.  
Attorney for Applicant

**FAXED**  
6 Nov 2003  
J

11/6/03 (2)  
KE DOCKETED  
appeal Brief 11/10/04  
11/6/03 (6)  
DOCKETED

**WARNING:** This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review, or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

PLEASE CALL (650) 330-0900 IF YOU HAVE ANY PROBLEMS RECEIVING THIS TRANSMISSION OR HAVE RECEIVED THIS TRANSMISSION IN ERROR.

TRANSACTION REPORT

NOV-06-2003 THU 12:16 PM

DATE	START	RECEIVER	TX TIME	PAGES	TYPE	NOTE	M#	DP
NOV-06	12:15 PM	17033089333	33"	3	SEND	OK	048	
TOTAL :						33S PAGES:	3	

**REED & EBERLE LLP**

INTELLECTUAL PROPERTY LAW  
 800 MENLO AVENUE, SUITE 210  
 MENLO PARK, CALIFORNIA 94025  
 (650) 330-0900 TELEPHONE  
 (650) 330-0980 FACSIMILE  
 WWW.REEDPATENT.COM

**FACSIMILE TRANSMITTAL SHEET**

TO: Trademark Trial and Appeal Board	FACSIMILE NO.: (703) 308-9333 TELEPHONE NO.:
FROM: Karen Canaan	FACSIMILE NO.: (650) 330-0980 TELEPHONE NO.: (650) 330-0900
DATE: November 6, 2003	PAGE 1 OF: 3
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Following please find a Notice of Appeal; and Associate Power of Attorney for submission in connection with the above-identified trademark application.

Please charge the \$100.00 fee for filing an Ex Parte Appeal to Deposit Account No. 18-0580 (\$100.00 per class as required by 37 C.F.R. § 2.6(a)(18)). The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 2.6 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-0580.

Respectfully submitted

I hereby certify that this correspondence is being transmitted via facsimile to the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, facsimile number 703-308-9333, on November 6, 2003.

6 Nov 2003  
Date

Joe Clark  
Joe Clark

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Corium International, Inc.  
(Name of applicant)

76/179,309  
(Serial Number of application)

December 7, 2000  
(Filing date of application)

CORUIM  
(Mark)

**NOTICE OF APPEAL**

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

By Karen Canaan

Karen Canaan  
(Signature)

November 6, 2003.  
(Dated)

Attorney for Applicant  
(Identification of person signing)

F:\Document\2335\4001\Notice of Ex Parte Appeal.doc

I hereby certify that this correspondence was transmitted via facsimile to the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, at facsimile number (308) 9333 on November 6, 2003.

6 Nov 2003  
Date

  
Joe Clark

Atty Dkt No. 2335-4001  
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:  
Corium International, Inc.

Serial No.: 76/179,309

Filing Date: December 7, 2000

Mark: CORIUM

Law Office: 115

Examining Attorney: C.W. French

**ASSOCIATE POWER OF ATTORNEY**

Commissioner For Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Madam:

Please recognize as associate attorneys in this case:

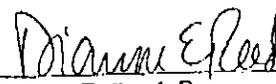
Shelley P. Eberle, Esq.  
Karen Canaan, Esq.

both affiliated with Reed & Eberle LLP, previously Reed & Associates, to prosecute the above-identified application to register, to transact all business in the United States Patent and Trademark Office in connection therewith, and to receive the certificate of registration. If the affiliation of any of these representatives is severed from their respective organization, such representative's appointment and all powers derived from this appointment shall terminate on the date of the severance.

Please address all future communications to:

Karen Canaan  
REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

Respectfully submitted,

By:   
Dianne E. Reed, Esq.  
Attorney for Applicant

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

F:\Document\23354001\Power of Attorney - Associate.DOC

# TARR Database Print-Out

Latest Status Info

Thank you for your request. Here are the latest results from the TARR website.

This page was generated by the TARR system on 2003-12-29 19:06:56 ET

Serial Number: 76179309

Registration Number: (NOT AVAILABLE)

Mark (words only): CORIUM

Standard Character claim: No

Current Status: Appeal Received at TTAB

Date of Status: 2003-11-21

Filing Date: 2000-12-07

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

Attorney Assigned:  
FRENCH CURTIS W Employee Location

Current Location: 845 -TTAB

Date In Location: 2003-12-01

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

1. Corium International, Inc.

**Address:**

Corium International, Inc.  
2686 Middlefield Road, Suite G  
Redwood City, CA 94063  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Michigan

**GOODS AND/OR SERVICES**

polymers for use in the manufacture of pharmaceutical products and adhesive compositions that are applied to a human body surface

**International Class:** 001

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76%2F179%2C309&action=Request+Status>

12/29/2003

**Basis: 1(b)**

Adhesive compositions for human use that are applied to a moist surface

**International Class:** 005

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**Basis: 1(b)**

Pharmaceutical products, namely drug delivery devices or other therapeutic devices that are applied by adhesion to a human body surface

**International Class:** 010

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**Basis: 1(b)**

**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

**MADRID PROTOCOL INFORMATION**

(NOT AVAILABLE)

**PROSECUTION HISTORY**

2003-11-21 - EXPARTI APPEAL RECEIVED AT TTAB

2003-07-24 - TEAS Change of Correspondence Received

2003-05-08 - Final refusal mailed

2002-09-30 - Communication received from applicant

2002-09-30 - PAPER RECEIVED

2002-03-28 - Non-final action mailed

2001-10-22 - Communication received from applicant

2002-01-11 - ITU claim added

2002-01-11 - Section 1(a) claim - Deleted

2001-10-25 - Communication received from applicant

2001-04-20 - Non-final action mailed

2001-04-06 - Case file assigned to examining attorney

**CONTACT INFORMATION**

**Correspondent (Owner)**

Mark A Wilson (Attorney of record)

KAREN CANAAN  
REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park CA 94025

**Phone Number:** (650) 330-0900

**Fax Number:** (650) 330-0980

Attorney Docket No.: 2335-4001 Mailing Date: 9 January 2004

Applicant: Corium International, Inc.

Mark: CORIUM

Documents: \_\_\_\_\_



- Application Transmittal
- Application ( Trademark /  Service-Mark)
- Drawing of Mark
- Power of Attorney
- Filing Fee Check \$
- Certificate of Express Mail (Express Mail No.: \_\_\_\_\_)

01-12-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #76

**XX Transmittal; Appeal Brief (w/appendix); Return Post Card.**

KC/jc  
RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Trademarks, Box: TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513" on

Attorney Docket No. 2335-4001  
TRADEMARK

January 9, 2004  
9 Jan 04  
Date  
Signature Joe Clark

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Application of Corium International, Inc.

For the CORIUM mark

Serial No.: 76/179,309

Law Office: 115

Filing Date: December 7, 2000

Examining Attorney: C.W. French

**TRANSMITTAL**

BOX TTAB  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Madam:

Further to the Notice of Appeal filed November 6, 2003, transmitted herewith for filing in the above-identified trademark application is an Appeal Brief. Pursuant to TMEP §1203.01, one copy of the appeal brief is submitted.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. § 2.6, which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-0580.

Respectfully submitted,

By: Karen Cavanaugh  
Karen Cavanaugh  
Attorney for Corium International, Inc.

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

E:\document\2335\4001\appealbrief.transmittal.doc

## REED &amp; EBERLE LLP

INTELLECTUAL PROPERTY LAW  
 800 MENLO AVENUE, SUITE 210  
 MENLO PARK, CALIFORNIA 94025  
 (650) 330-0900 TELEPHONE  
 (650) 330-0980 FACSIMILE  
 WWW.REEDPATENT.COM

## FACSIMILE TRANSMITTAL SHEET

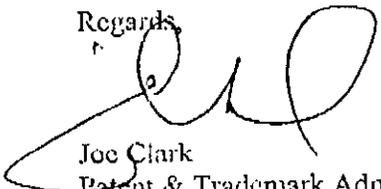
TO: Eric McWilliams Trademark Trial and Appeal Board	FACSIMILE No.: (703) 746-7085 TELEPHONE No.: (703) 308-9300x234
FROM: Joe Clark Patent and Trademark Administrator	FACSIMILE No.: (650) 330-0980 TELEPHONE No.: (650) 330-0900
DATE: March 2, 2004	PAGE 1 OF: 37
SUBJECT: Serial No.: 76/179,309 Filing Date: December 7, 2000 Mark: CORIUM	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Dear Mr. McWilliams,

Pursuant to our telephone conversation today, following are:  
 a copy of the return receipt post card with the "date in" label and  
 a complete copy of the Appeal Brief as filed with the Trademark Trial and Appeal Board  
 on January 9, 2004, in connection with the above-identified trademark application.

Please feel free to contact us if you should require any additional information.

Regards,

  
 Joe Clark  
 Patent & Trademark Administrator  
 Reed & Eberle LLP  
 800 Menlo Avenue, Suite 210  
 Menlo Park, California 94025  
 Tel: (650) 330-0900  
 Fax: (650) 330-0980  
 Direct: (650) 330-4915  
[clark@reedpatent.com](mailto:clark@reedpatent.com)

**WARNING:** This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review, or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

PLEASE CALL (650) 330-0900 IF YOU HAVE ANY PROBLEMS RECEIVING THIS TRANSMISSION  
 OR HAVE RECEIVED THIS TRANSMISSION IN ERROR.