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

Proceeding	77131316
Applicant	BioCryst Pharmaceuticals, Inc.
Applied for Mark	FODOZAN
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: **FODOZAN**

Serial No.: **77-131,316**

Applicant: **BioCryst Pharmaceuticals, Inc. (a Delaware corporation)**

Filing Date: **March 14, 2007**

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Examining Attorney: **Brian P. Callaghan (Law Office 101; 571.272.4906)**

APPLICANT'S APPEAL BRIEF

The Applicant appeals the Examining Attorney's final refusal, issued on August 31, 2011, of its application for registration of the mark FODOZAN ("Applicant's mark") for "pharmaceutical products, namely, preparations and substances for the treatment of cancers and immunological diseases and disorders, namely, cancers of the immune system such as T-cell and B-cell leukemias and lymphomas and immunological disorders such as transplant rejection" on the grounds that the original specimen provided with the statement of use fails to show use in commerce, and that the mark in the drawing disagrees with the marks on the specimens. For the reasons which follow, Applicant respectfully requests the Board to reverse the refusal to register.

1. Specimen Refusal

The Examining Attorney has rejected the specimens submitted by Applicant in the Statement of Use of December 13, 2010 ("the Report" – Appendix A), on the basis that the specimens consist of advertising material and that Section 45 of the Trademark Act requires use

"on the goods or the displays associated therewith or on tags or labels affixed thereto." Applicant respectfully contends that the specimens submitted are acceptable, and requests that the rejection be reversed.

While the Examining Attorney referenced a portion of the Trademark Act regarding suitable specimens, the Applicant would like to note the additional provisions of the Lanham Act, 15 U.S.C. § 1127, which provide that a mark is deemed to be in use in commerce on goods when:

> (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
>
> (B) the goods are sold or transported in commerce.

(emphasis added). Applicant contends that the language of the Trademark Act lends itself to being broadly construed by virtue of the "in any manner" language. In this case, the goods covered by the application have been sold or transported in commerce in connection with clinical trials, satisfying part B of the relevant statutory provision.

Further, as discussed below, the specimens of record meet the requirements of part (A) of the relevant statutory provision, quoted above.

The Report constitutes a public display, showing the mark in modified form (FODOSINE) placed prominently on the third and fifth pages of the Report.

The Report shows a picture of the packaging for the goods, and this picture is in close proximity to the mark FODOSINE shown with a "TM" designation. In addition, a description of the goods is provided, along with a statement (circa 2006) that "Fodosine™ is currently being tested in a pivotal trial, for patients with T-ALL, under a special protocol assessment negotiated

with the FDA." A purpose of the Report (which is publicly available) is to inform the shareholders of Applicant as well as the public regarding Applicant's business, including its product. It is not merely advertising material.

Applicant contends that because its goods are subject to FDA guidelines and restrictions, the nature of the goods makes traditional trademark usage on the goods currently impracticable for the Applicant, and accordingly, a document associated with the goods, such as the annual report, is an acceptable specimen evidencing use of the mark in commerce as defined by the Lanham Act.

The Report is associated with the goods, as the Report clearly references and describes the goods provided under the mark.

The Examining Attorney relies on *In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006), to support the position that there is no impracticability in applying the mark to Applicant's goods. However, Settec in inapposite to the instant case. *Settec* involved a mark used in association with hardware and software for the encryption of digital media. Such goods are not strictly regulated, as are Applicant's pharmaceutical products. Unlike hardware and software for the encryption of digital media, pharmaceutical products are subject to strict approval requirements by the U.S. Food and Drug Administration ("FDA"). The FDA must approve all trade names, production, distribution, dosages, and advertised uses of any given pharmaceutical product. Consequently the use in commerce of such products is strictly limited, especially during the early stages of the approval process. For this reason it is often impracticable to apply a mark directly to a pharmaceutical product.

The Applicant urges the Board to interpret the requirements regarding the specimen with flexibility, consistent with the guidance of the Senate Judiciary Committee's report regarding the

Trademark Act. It is in keeping with the intent of the revisers of the Lanham Act to accept less traditional trademark uses as acceptable uses when there is genuine trademark use, even when a traditionally accepted specimen may not be available due to the nature of the goods.

2. Refusal Due to Differences Between Drawing and Specimen

The Examining Attorney based the refusal in part on alleged differences between the marks in the specimens provided (FODOSINE and FORODESINE) and the drawing provided with this application (FODOZAN).

The mark on the drawing must be a substantially exact representation of the mark as used on the specimen. 37 C.F.R. § 2.51(b); see 37 C.F.R. § 2.72(b)(1). This is the same standard that is used to determine when a registered mark may be amended. An amendment of a registered mark is acceptable if the modified mark contains the essence of the original mark (i.e., the mark as originally registered), and the mark as amended creates essentially the same impression as the original mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996).

In this case, the mark on the specimens provided creates essentially the same impression as the original mark.

The specimen submitted on July 29, 2011, consisted of a shipping label for Applicant's goods showing the mark in modified form on the labeling. This specimen shows the mark as FORODESINE. The Examining Attorney refused registration in part on the basis that FORODESINE and FODOZAN constitute a material alteration.

The differences between FORODESINE and FODOZAN consist phonetically of only the addition of a single syllable and the substitution of "zan" for "sine." Applicant contends that the marks FORODESINE and FODOZAN carry the same overall commercial impression and that

the differences do not constitute a material alteration of the mark as applied for and, accordingly, Applicant requests that the specimen submitted should be accepted.

The modified form of the mark in the Report specimen (FODOSINE) carries the same overall impression and the differences do not constitute a material alteration of the mark as applied for. The Examining Attorney concluded that "The lettering patterns 'SINE' and 'ZAN' are not phonetic equivalents, nor is it safe to assume that the pronunciation thereof by the consuming public is only slightly different." However, a comparison of the marks compels the opposite conclusion.

The letters Z and S are often substituted for one another in English words ending in "AN." The following are examples of English words, found in WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY, UNABRIDGED. Merriam-Webster, 2012. (*available at* http://unabridged.merriam-webster.com) (last visited 14 Jul. 2011), in which there are two interchangeable spellings, one ending in "ZAN" and the other ending in "SAN."

Gozzan/Gossan

Partizan/Partisan

Courtezan/Courtesan

Nonpartizan/Nonpartisan

Because the suffixes ZAN and SAN are fully interchangeable in several common English words, it must be concluded that they are identical phonetically and in overall impression. The suffix SINE is phonetically similar and similar in overall impression to SAN and ZAN.

All three suffixes are commonly used to name drug products, and all convey the same commercial impression: that of a pharmaceutical product. The following are examples of FDA-approved drugs with named ending in ZAN, SINE, or SAN:

Quarzan	Trimo-San	Inapsine	Insulin Glulisine
Hetrazan	Calphosan	Metyrosine	Inversine
Mectizan	Calsan	Flucytosine	Adenosine
Azasan	Otisan	Didanosine	Benzylpenicilloyl
Pentosan	Gensan	Visine	Polylysine
Chitosan	Diosan	Myochrysine	

Consequently FODOSINE and FORODESINE convey the same impression and do not materially differ from FODOZAN.

CONCLUDING COMMENTS:

Because the Examining Attorney has failed to establish that the specimens fail to show use in commerce, the Examining Attorney's refusal of the registration of Applicant's mark must be reversed. Both specimens show use in commerce, despite minor discrepancies between the marks, particularly when the limitations on using pharmaceutical products in commerce during the early regulatory stages are taken into account.

Respectfully submitted on this 24th day of April, 2012.

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Index of Citations

15 U.S.C.A. § 1127 (West 2012)

In re Settec, Inc., 80 U.S.P.Q.2d 1185, 2006 WL 1706430 (TTAB, Jun 5, 2006)

37 C.F.R. § 2.51

37 C.F.R. § 2.72

In re Umax Data System Inc., 40 U.S.P.Q.2d 1539, 1996 WL 657223 (Com'r Pat. & Trademarks, 1996)