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T013831US00 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77131316

MARK: FODOZAN



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APPLICANT: BioCryst Pharmaceuticals, Inc.

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The Applicant, BioCryst Pharmaceuticals, Inc., has appealed the Trademark Examining Attorney's final requirement that Applicant resolve the matching issue consisting of the mark on the specimen disagreeing with the mark on the drawing. 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); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1). Applicant has applied for the mark FODOZAN (standard character) for goods listed as "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" in International Class 05. The first specimen submitted in Applicant's Statement of Use filed on December 11, 2010, consists of a report from

December 11, 2006, which reports the results of clinical trial programs involving the listed goods, and which displays the modified mark FODOSINE. The second specimen was submitted in Applicant's response, dated July 26, 2011, and consists of a shipping label which displays the modified mark FORODESINE. As a result of the drawing not consisting of a substantially exact representation of the mark as used on either of the submitted specimens, the Examining Attorney refused registration because the specimens do not show the applied-for mark in use in commerce as a trademark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a).

Furthermore, Applicant, BioCryst Pharmaceuticals, Inc., has appealed the Trademark Examining Attorney's finding that the original specimen submitted with the Statement of Use, filed on December 13, 2010, is not acceptable to show trademark use of the applied-for mark in connection with the goods set forth in the Statement of Use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a).

FACTS

On March 14, 2007, BioCryst Pharmaceuticals, Inc. (hereinafter referred to as "Applicant") applied for registration on the Principal Register of the mark FODOZAN (standard character) for the goods listed as "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" in International

Class 05. The application was approved for publication on June 26, 2007 and a Notice of Allowance was issued on December 11, 2007.

On December 13, 2010, Applicant filed a Statement of Use with a specimen of use included therewith. The specimen of use was accurately described by Applicant as “an annual report describing clinical trial progress”.

On January 27, 2011, the Examining Attorney issued an Office action refusing registration because the specimen shows that Applicant has not used the mark in commerce in connection with the identified goods as of the filing date of the Statement of Use (Failure to Function – Premature Use Refusal). Trademark Act Sections 1, 3 and 45, 15 U.S.C. §§1051(a), 1053, 1127. In addition, the Examining Attorney refused Applicant’s specimen as unacceptable because it consists of advertising material for goods (Specimen Refused – Advertising Material Not Acceptable to Show Use With Goods). Trademark Act Section 45 requires use of the mark “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.” 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(1); TMEP §§904.03, 904.04(b), (c). Finally, the Examining Attorney required that Applicant resolve the matching issue consisting of the mark on the specimen, namely, FODOSINE disagreeing with the mark on the drawing, namely, FODOZAN (Mark Differs on Drawing and Specimen). 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); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1). The drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2), (b)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* Additionally, the Examining Attorney advised Applicant that amending the mark in the drawing to

conform to the mark on the specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the drawing.

On July 26, 2011, Applicant filed a response containing arguments against all of the refusals and requirements set forth in the previous Office action issued on January 27, 2011. In addition, Applicant submitted a substitute specimen consisting of a shipping label for the applied-for goods that displays the modified mark FORODESINE.

On August 31, 2011, the Examining Attorney issued a final Office action, wherein the Examining Attorney accepted Applicant's arguments against the Failure to Function - Premature Use refusal so as to obviate said refusal. In addition, the Examining Attorney accepted the physical form of the substitute specimen consisting of a shipping label, so as to obviate the refusal that the specimen is unacceptable because it consists of advertising material for goods. However, unconvinced by Applicant's arguments against the Examining Attorney's requirement that Applicant resolve the matching issue consisting of the mark on the specimen disagreeing with the mark on the drawing, the Examining Attorney issued a final requirement.

On February 24, 2012, Applicant filed a Notice of Appeal and on April 24, 2012, Applicant filed its Appeal Brief.

ISSUES

The issues on appeal are whether the original specimen is of an appropriate physical form to show trademark use on or in connection with the goods under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a); and whether the mark on the drawing, namely,

FODOZAN (standard character) is a substantially exact representation of the mark as used on the submitted specimens, namely, FODOSINE (original specimen) and FORODESINE (substitute specimen), respectively. 37 C.F.R. §2.51(b); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1).

ARGUMENTS

A. THE ORIGINAL SPECIMEN IS OF AN UNACCEPTABLE PHYSICAL FORM TO SHOW TRADEMARK USE AND THE MARK ON THE DRAWING, NAMELY, FODOZAN IS NOT A SUBSTANTIALLY EXACT REPRESENTATION OF THE MARK ON THE ORIGINAL SPECIMEN, NAMELY, FODOSINE

As a preliminary matter, the Examining Attorney reiterates that the substitute specimen submitted in Applicant's response, dated July 26, 2011, consisting of a shipping label for the applied-for goods, was accepted in order to obviate the requirement that applicant provide a substitute specimen of an appropriate physical form for the applied-for goods.¹ 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(1); TMEP §§904.03, 904.04(b), (c). However, because Applicant's Appeal Brief lists the Examining Attorney's refusal of Applicant's original specimen as a basis for appeal, the Examining Attorney herein addresses the unacceptable nature of the original specimen consisting of an annual report describing clinical trial progress.

In the Office action, dated January 27, 2011, the Examining Attorney refused Applicant's specimen submitted with the Statement of Use and described by Applicant as "a report from December 11, 2006 which reports the results of clinical trial programs involving the listed goods, and which also uses the mark FODOSINE to refer

¹Although the substitute specimen submitted in Applicant's response, dated July 26, 2011, is of an acceptable physical form to show trademark use in connection with the applied-for goods, it is not acceptable because the mark on the drawing is not a substantially exact representation of the mark used on the substitute specimen. 37 C.F.R. §2.51(b); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1).

to the goods” as unacceptable because it consists of advertising material for goods. Trademark Act Section 45 requires use of the mark “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.” 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(1); TMEP §§904.03, 904.04(b), (c).

In both its response, dated July 26, 2011, and its Appeal Brief, dated April 24, 2012, Applicant argues that the original specimen is of an acceptable physical form to show trademark use in connection with the goods. Applicant notes 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.

First, Applicant states that 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, quoted above. *See Applicant’s Appeal Brief at page 2.* Next, 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. *Id. at page 2.* Furthermore, Applicant argues that the annual report constitutes a public display, showing the mark in the modified form FODOSINE placed prominently on the third and fifth pages of the report that includes a

description of the goods and is also used to inform Applicant's shareholders as well as the public regarding Applicant's business, including its product. As such, Applicant states that said specimen is not merely advertising material. *Id. at pages 2-3.*

The Examining Attorney is not persuaded. The Examining Attorney agrees with Applicant's assertion that 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, quoted above. However, the Examining Attorney points out that Applicant's original specimen is unacceptable to show trademark use of the applied-for mark because it consists of an annual report describing clinical trial progress to shareholders, and therefore, is not considered a public display associated with the goods at their point of sale. Displays must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. In order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation. *See* TMEP §904.03(g). In the instant case, Applicant has failed to produce evidence of point-of-sale presentation in relation to the specimen consisting of an annual report to shareholders. Additionally, Applicant has failed to make a prima facie showing of impracticability in order for the annual report specimen to qualify as "documents associated with the goods", pursuant to TMEP §904.03(k). A mere assertion of impracticability does not suffice to establish that traditional trademark use is impracticable. Rather, the record must indicate that the goods are, in fact, of such a nature. *In In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006). As evidenced by Applicant's substitute specimen consisting of a shipping label for the applied-for goods, it is clearly not impracticable to place the mark on the goods, packaging, or displays

associated with the goods. 15 U.S.C. §1127 (definition of “use in commerce”); 37 C.F.R. §2.56(b)(1).

However, even assuming *arguendo*, that the original specimen is of an acceptable physical form, the Examining Attorney points out that the mark on the drawing, namely, FODOZAN is not a substantially exact representation of the mark as used on the original specimen, namely, FODOSINE. For applications under §1 of the Trademark Act, the drawing must always be compared to the specimen of record to determine whether they match. 37 C.F.R. §§2.51(a) and (b). The first step is to analyze whether the mark in the drawing is a substantially exact representation of the mark shown on the specimen. If the mark in the drawing is not a substantially exact representation of the mark shown in the specimen, the second step is to determine whether an amendment to the drawing to agree with the mark shown on the specimen would be a material alteration of the mark in the original drawing. If the answer is “no,” the applicant must submit either an amended drawing or a substitute specimen. If the answer is “yes,” the applicant must submit a substitute specimen and no amendment to the drawing is allowed. 37 C.F.R. §§2.72(a) and (b); *see* TMEP §§807.14 *et seq.* for more information about material alteration.

In this case, the mark as used on the original specimen, namely, FODOSINE is significantly different in appearance and pronunciation from the applied-for mark FODOZAN. More specifically, the marks are spelled differently and the lettering patterns “SINE” and “ZAN” are not phonetic equivalents, nor is safe to assume that the pronunciation thereof by the consuming public is only slightly different. There is no correct pronunciation of a mark because it is impossible to predict how the public will

pronounce a particular mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). Consequently, the mark on the drawing is not a substantially exact representation of the mark on the original specimen.

In its Appeal Brief, Applicant submits that the mark on the specimens provided creates essentially the same impression as the applied-for mark. *See Applicant's Appeal Brief at page 4*. First, Applicant submits that the letters “Z” and “S” are often substituted for one another in English words ending in “AN.” In support of this contention, Applicant has provided examples of words in which there are two interchangeable spellings, one ending in “ZAN” and the other ending in “SAN.” *Id. at page 5*. Applicant states that 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 commercial impression. Moreover, Applicant states that the suffix “SINE” is phonetically similar and similar in overall commercial impression to “SAN” and “ZAN”. *Id.*

The Examining Attorney is not persuaded. While the suffixes “ZAN” and “SAN” are phonetically similar, if not virtually identical in pronunciation, the Examining Attorney respectfully disagrees with Applicant’s statement that the suffix “SINE” is phonetically similar to the suffixes “SAN” and “ZAN”. The pronunciation of the suffix “SINE” is significantly different from that of “SAN” and “ZAN”, primarily due to differences in pronunciation between the vowel patterns of “SINE” versus “SAN” and “ZAN”, as well as a hard versus soft pronunciation of the consonants “S” and “Z”. Furthermore, the Examining Attorney points out that Applicant’s arguments that the mark

on the specimens provided creates essentially the same impression as the applied-for mark and that various FDA-approved drugs feature names ending in “ZAN”, “SINE” or “SAN” are irrelevant in the instant case, where the applied-for mark FODOZAN is not a substantially exact representation of the modified mark on the original specimen, namely, FODOSINE and where applicant has not attempted to amend the drawing of record.² Applicant’s arguments would be probative, for example, if Applicant was seeking to amend the drawing of record to FODOSAN and the modified mark on the submitted specimen was FODOSAN, a phonetic equivalent of the applied-for mark FODOZAN. Moreover, for the reasons discussed *supra*, the Examining Attorney advised Applicant that amending the mark in the drawing to conform to the mark on the original specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the drawing.

B. THE MARK ON THE DRAWING, NAMELY, FODOZAN IS NOT A SUBSTANTIALLY EXACT REPRESENTATION OF THE MARK ON THE SUBSTITUTE SPECIMEN, NAMELY, FORODESINE

In the final Office action, dated August 31, 2011, the Examining Attorney explained that the mark on the substitute specimen consisting of a shipping label for the goods disagrees with the mark on the drawing. In this case, the substitute specimen

² The “substantially exact” standard is more stringent than the “material alteration” standard; in other words, in some situations, a drawing that is not a substantially exact representation of the mark as used may nonetheless be amended to agree with such use, so long as the amendment does not materially alter the mark in the drawing. *See generally* Trademark Manual of Examining Procedure (TMEP), §§807.12-807.13 (5th ed. 2007). For example, if a drawing contains punctuation, the elements of punctuation are presumed to be part of the mark. Thus, as noted in TMEP §807.12(a), if there is punctuation in the mark on the drawing, the punctuation must also appear on the specimen or the drawing is not considered to be a “substantially exact” representation of the mark as used in commerce. If deletion of the punctuation from the drawing does not alter the commercial impression, the drawing may be amended to match the specimen. If deletion of the punctuation changes the commercial impression, the applicant must submit a substitute specimen to match the original drawing.

displays the mark as FORODESINE, while the drawing shows the mark as FODOZAN. In addition, the Examining Attorney advised Applicant that amending the mark in the drawing to conform to the mark on the original specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the drawing. In support of this advisory, the Examining Attorney explained that an amendment of the applied-for mark to the modified mark appearing on the substitute specimen consisting of a shipping label, namely, FORODESINE, would require a further search of the register based on its difference in structure from that of the applied-for mark FODOZAN. More specifically, the inclusion of the lettering “RO” in the modified mark would require a further search of the register. As a general rule, the addition of any element that would require a further search will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). In addition, the modified mark FORODESINE is significantly different in appearance and pronunciation from the applied-for mark FODOZAN. Consequently, the modified mark does not contain what is the essence of the original mark, so as to convey the impression of being essentially the same mark.

In its Appeal Brief, Applicant states that the Examining Attorney refused registration in part on the basis that the mark on the substitute specimen, namely, FORODESINE is a material alteration of the applied-for mark FODOZAN. *See Applicant’s Appeal Brief at page 4.* Applicant submits that the differences between FORODESINE and FODOZAN consist phonetically of only addition of a single syllable and the substitution of “ZAN” for “SINE”. Consequently, 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. *Id.* at pages 4-5.

The Examining Attorney notes that Applicant has mischaracterized, in part, the basis for the final requirement that Applicant resolve the matching issue consisting of the mark on the substitute specimen, namely, FORODESINE disagreeing with the mark on the drawing FODOZAN. The final requirement was not predicated upon a finding of material alteration. Rather, for the reasons discussed above, the Examining Attorney merely advised Applicant that an amendment of the drawing to agree with the mark shown on the substitute specimen would be a material alteration of the mark in the original drawing, and therefore, would not be permitted. However, the material alteration standard is not the issue in the instant case because Applicant has not attempted to amend its drawing. Rather, the final requirement was predicated upon the fact that the applied-for mark FODOZAN is not a substantially exact representation of the mark on the substitute specimen, namely, FORODESINE.

CONCLUSION

For the reasons noted above, the Examining Attorney respectfully submits that the original specimen is of an unacceptable physical form to show trademark use on or in connection with the goods under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a); and that the mark on the drawing, namely, FODOZAN (standard character) is not a substantially exact representation of the mark as used on the submitted specimens, namely, FODOSINE (original specimen) and FORODESINE (substitute specimen), respectively.

37 C.F.R. §2.51(b); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(1). Accordingly, the Examining Attorney respectfully requests that the Board affirm the requirement for a substitute specimen showing use in commerce of the mark on the drawing.

Respectfully submitted,

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