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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Centocor

Serial No. 78448489

Mary Pat Weyback of Drinker Biddle & Reath LLP for
Centocor.

Evelyn Bradley, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Centocor, a Pennsylvania corporation, has filed an
application to register PROGRAMMED PROTEIN (in standard
character form) on the Principal Register for "medical
research services relating to DNA and gene synthesis" in
International Class 42.¹

The examining attorney has refused registration under
Section 2(e)(1) of the Trademark Act, 15 U.S.C.

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§1052(e)(1), on the ground that applicant's mark is merely descriptive of its services. After the examining attorney made the descriptiveness refusal final, applicant appealed and filed a request for reconsideration. Upon the examining attorney's denial of the request for reconsideration, the Board resumed the appeal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-

¹ Application Serial No. 78448489, filed July 9, 2004, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a

Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

In support of her position, the examining attorney submitted the following dictionary definition from the Merriam-Webster Online Dictionary for the word

"programmed":

Programmed: 3.(c)(1) to code in an organism's program (2) to provide with a biological program, <cells programmed to synthesize hemoglobin>; 4. to predetermine the thinking, behavior, or operations of as if by computer programming.

bona fide intention to use the mark in commerce.

In addition, she submitted printouts from various websites retrieved from the Internet and excerpted articles from various publications retrieved from the Lexis/Nexis database where the phrase "programmed protein" or the words "programmed" and "protein" are used by third parties in various medical contexts. The examining attorney highlighted the following excerpts from the Internet and Lexis/Nexis evidence:²

Our bodies are composed of many millions of individual cells and each cell inherits genetic material through ordered cell cycle events including DNA replication and chromosome segregation. Since most of these events are regulated by proteins, selective and **programmed protein** degradation can act as a rapid switch to control biological transitions. www.mcrl.ac.uk/research/cellcycle.asp;

This laboratory is used, for example, to develop novel protein chromatography tools, to improve the bio-efficacy of proteins undergoing sustained release drug delivery, to design unique surfactants that recognize and separate DNA in a sequence-specific manner, to develop novel

² Applicant's argument that the websites from foreign sources are not relevant is not persuasive in this case in view of the highly technical nature of the services and the sophistication of the prospective consumers of its services. See *In re Remacle*, 66 USPQ2d 1222 n. 5 (TTAB 2002) (Board found that professionals in certain fields, such as medicine, engineering, computers and telecommunications would be likely to monitor developments in their fields without regard to national boundaries, and that the Internet facilitates such distribution of knowledge). We further note applicant's suggestion that cached pages are not "competent evidence of the current use of the terms under consideration" because they are not the most recent version of the page. While it is true that the cached pages are not the current version of a web page, they do provide evidence of use of a term just as an excerpt from an earlier magazine publication or old newspaper article would.

responsive surfaces with thermally-**programmed protein** binding affinities, and to design bioMEMS devices for cell separations and highly sensitive, multiplexed biosensors.
www.cheme.cmu.edu/facilities/biointerfaces.htm;

Cystic fibrosis is a serious genetic disease (autosomal recessive) frequently seen in Caucasian people. It is caused by mutations in the CFTR gene (cystic fibrosis transmembrane conductance regulator gene). (1) The CFTR **protein programmed** by this gene mainly functions as a channel or pore that transports chloride ions across cell membranes. (2) CFTR is a cyclic AMP-regulated epithelial chloride channel that appears to control the activity of several other transport proteins. *Promising insights into cystic fibrosis; Phytotherapy Review & Commentary Townsend Letter for Doctors and Patients, The Townsend Letter Group Townsend Letter for Doctors and Patients (April 1, 2005)*;

This is so even though the peptides originate from regions both outside and within the putative DNA binding domain of jun protein. (ii) A small **protein programmed** in bacteria with the 3 coding region of c-jun protects the same sequence of SV40 DNA from nuclease digestion as does AP-1 and binds with the same efficiency as AP-1 to mutant binding sites for... *Oncogenes and transcriptional control, Science (December 4, 1987)*; and

These results again illustrate the power of merging the understanding of a reaction mechanism with the ability of the immune system to yield binding **proteins programmed** to interact in highly specific ways as the substrate traverses the reaction coordinate. The ability to dictate the reaction mechanism by design allows unprecedented control of the product outcome. But a particular feature of our study is the... *Antibody catalyzed cationic cyclization, Science (May 27, 1994)*.

In support of its position, applicant submitted a business plan which "describe[s] applicant's anticipated PROGRAMMED PROTEIN services," a "hit list" and excerpted articles from the GOOGLE search engine, search results from the Lexis Allnews database, search results from the Lexis "Full-Text Medical Journals" and "Current Healthcare News" databases, search results from the websites of the "Top 10 Pharmaceutical companies," and search results from the "On-Line Medical Dictionary." Br. p. 3. In addition, applicant submitted the following dictionary definition from the Merriam-Webster Online Dictionary for the word "protein":

Protein 1. any of numerous naturally occurring extremely complex substances that consist of amino acid residues joined by peptide bonds, contain the elements carbon, hydrogen, nitrogen, oxygen, usually sulfur, and occasionally other elements (as phosphorus or iron), and include many essential biological compounds (as enzymes, hormones, or immunoglobulins).

As noted above, we determine the descriptiveness of a term in the context of the goods or services at issue, not in the abstract. In re Chopper Industries, 222 USPQ 258 (TTAB 1984); In re Bright-Crest, Ltd., supra. In its business plan applicant describes its services as follows:

Because Egea employs a directed, not a random process, Egea's protein libraries can be uniquely targeted to modify and improve specific protein properties including efficacy, dosage, immune

response and tissue penetration. In addition, proteins developed using Egea's technology are customized for manufacturing in bacteria or any other host, avoiding the significant production challenges and expense found with most current protein drugs produced in mammalian cells... Egea's technology platform has been proven in extensive proof of concept studies. For instance, Egea has: Produced libraries of more than 1,000,000 Programmed Proteins.TM Produced over 200 synthetic genes and proteins. Produced the largest gene ever chemically synthesized of over 16,000 bases. Engineered proteins for novel functions. Improved protein expression through codon optimization. Developed custom genes for protein manufacturing in specific host cells... Egea's objective is to be the leader in the design, development and commercialization of novel protein pharmaceuticals...

Egea's proprietary GeneWriterTM and Protein ProgrammingTM technologies are the first and only means of producing such large protein libraries with directed changes, changes targeted to the functional portions of a protein drug...

GeneWriterTM is a proprietary system developed by Egea that rapidly produces large scale highly accurate synthetic genes. Proteins are then produced by programming the sequence into the synthetic DNA and expressing it in host cells... Since GeneWriterTM can program and synthesize DNA to produce any protein, it provides a powerful tool for generating protein libraries for protein drug optimization. Inherent in the revolutionary power of GeneWriterTM is the ability to create targeted diversity in protein sequences and create variations of proteins that do not exist in nature. Instead of a single synthetic protein, variation is introduced at specifically targeted sites in the gene, leading to specific amino acid changes in the resulting protein, and producing Programmed ProteinTM libraries. These proteins can have any of the 20 amino acids at any single amino acid position in the protein. Since the proteins are produced by synthetic genes that are assembled from oligonucleotide components, the resulting protein library

represents a mixture of all possible combinations of the different changes, yielding a family of closely related proteins with all the changes directed to critical parts of the sequence... This incredibly powerful technique allows Egea to produce Millions of variant proteins with directed changes based upon a single parent structure and in a single synthetic step.

As stated by applicant, its services will involve the design and development of protein pharmaceuticals and the proteins are produced "by programming the sequence into the synthetic DNA and expressing it in host cells." "Protein" is descriptive of applicant's services inasmuch as it is the resulting product of the services. "Programmed" is similarly descriptive inasmuch as it is the means by which the services create the product. Applicant states that its mark "refers to the use of a computer for the design of the proteins, and hence the use of the term PROGRAMMED."

Response to Office Action (August 17, 2005). However, as shown by the dictionary definition, the term "programmed" has a meaning in the genetic field that directly describes what applicant does: to code in an organism's program; to provide with a biological program. Clearly, these terms separately have a descriptive significance in relation to applicant's services. The question remains whether combined they present a unique or incongruous combination. We find that when combined these terms do not lose their

descriptive significance and, in fact, make clear that applicant intends to produce programmed protein. Thus, we are persuaded by the evidence of record that the words PROGRAMMED and PROTEIN are merely descriptive of applicant's recited services and that when combined do not present a unique or incongruous meaning. In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002).

Applicant argues that "the simple term PROGRAMMED PROTEIN does not aptly describe these complicated and sophisticated medical research services." Br. p. 7. Further, applicant contends that the evidence submitted by the examining attorney does not support a finding that applicant's "PROGRAMMED PROTEIN mark is merely descriptive of medical research services relating to DNA and gene synthesis." Br. p. 8. More specifically, applicant notes that "the few additional uses of the words 'programmed protein' together were surrounded by significant modifying material, for example, 'RNA programmed protein synthesis in cell-free systems,' which refers to the programming, through the use of RNA, of a protein's synthesis. Or 'developmentally-programmed protein aggregation,' which again discusses not the 'programming' of 'proteins' but rather the programming of their aggregation." Br. p. 9. By contrast, applicant argues, its own research, consisting

of searches of the Google search engine and Lexis/Nexis databases and a review of competitors' websites, "showed no use of the term PROGRAMMED PROTEIN," which supports "the proposition that PROGRAMMED PROTEIN is unique to Applicant." Br. p. 9. These arguments are unavailing. Merely because applicant may be the first and only user of the specific combination PROGRAMMED PROTEIN does not support registration if the only significance conveyed by the phrase is merely descriptive. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

Applicant also argues that the combined words PROGRAMMED PROTEIN do not provide the "viewer with an immediate understanding of the sophisticated medical services offered under the mark." Br. p. 10. Applicant argues that the broad definitions of the separate terms "programmed" and "protein" "make clear that there would be no single, immediately understood meaning for PROGRAMMED PROTEIN, and posits other possible meanings, for example, that it could "signify medical research services related to diet and nutrition" or "represent a 'program' for introducing 'proteins' into any number of medical settings" or "bring to mind the concept of 'working out' a sequence of 'proteins' that could be used in a wide variety of scientific or medical settings." Br. p. 12. Further,

applicant argues that "no image of a service immediately comes to mind upon hearing the words. It would take multi-step reasoning to get from the words 'programmed protein' to 'medical research services concerning DNA and gene synthesis.'" Br. p. 14. The problem with applicant's argument is that we must look at the term as used in connection with applicant's identified services, namely "medical research services relating to DNA and gene synthesis." The fact that a term may have meanings other than the one relevant to the services in issue here is not controlling; it is enough that a purpose or feature of applicant's services is included within the meaning of the term. See *In re Bright-Crest, Ltd*, supra at 593.

Applicant relies on *In re Hutchison Technology*, 852 F.2d 552, 7 USPQ2d 1490, 1493 (Fed. Cir. 1988) and *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674, 1675 (TTAB 1987) in support of its position that PROGRAMMED PROTEIN is a broad term that could include many categories of goods and thus cannot be viewed as merely descriptive. These cases are easily distinguished. *Hutchison Technology* involved a surname refusal under Section 2(e)(3) of the Trademark Act and the issue concerning the term TECHNOLOGY was whether its inclusion altered the primary significance of the mark as a surname. The Federal Circuit noted that

the Board, in making its determination that the word TECHNOLOGY did not remove the surname significance, only relied on the applicant's concession that the word TECHNOLOGY is frequently used on many goods similar to those listed in the application and the Board "offered no other evidence to support its findings on the effect of the inclusion of 'technology' in Hutchinson's mark as a whole." Hutchinson Technology, supra, 7 USPQ2d at 1493. Here, we have dictionary definitions, applicant's business plan and uses by third parties in the genetics field.

Intelligent Medical involved a descriptiveness refusal under Section 2(e)(1) for the mark INTELLIGENT MEDICAL SYSTEMS for electronic thermometers for measuring human body temperature. The Board noted that the word intelligent "could suggest that selecting said thermometer represents an intelligent choice." *Intelligent Medical*, 5 USPQ2d at 1675. Further, the Board stated:

While the word 'intelligent' when applied to computers may immediately impart information about computers to average prospective purchasers of computers, the word 'intelligent' when applied to electronic thermometers does not, insofar as the record herein shows, immediately impart with any 'degree of particularity' information about electronic thermometers to average prospective purchasers of electronic thermometers. In short, it cannot be said that INTELLIGENT MEDICAL SYSTEMS as applied to an electronic thermometer only serves to inform prospective purchasers of an ingredient within the electronic thermometer,

namely a computer or microprocessor [and] given "the absence of any evidence even suggesting that INTELLIGENT MEDICAL SYSTEMS or simply 'intelligent' has any meaning when applied to electronic thermometers or indeed any medical devices - we cannot say that the mark in question is 'merely descriptive' of applicant's goods."

Id. at 1675-1676.

Again, in *Intelligent Medical* the record lacked evidence of descriptiveness and, in addition, the Board found that the word in issue, "intelligent," could have another meaning when used in connection with the identified goods. In the case before us, "programmed" and "protein" have no other meanings in connection with applicant's services.

Looking at the average or ordinary prospective customers of applicant's services, as we must, In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987), the average consumer of applicant's medical research services relating to DNA and gene synthesis would certainly know and be familiar with the terms programmed and protein as used in the field of DNA and gene synthesis. Nor would it take any speculation or mental leap to understand that PROGRAMMED PROTEIN refers to a service that would provide them with programmed proteins.

Viewing PROGRAMMED PROTEIN as a whole, we find the evidence of record sets forth a prima facie case that it is

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descriptive. Thus, we are persuaded that when applied to applicant's services, PROGRAMMED PROTEIN immediately describes, without need for conjecture or speculation, a significant feature or function of applicant's services, namely the provision of programmed proteins. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective consumers of applicant's services to perceive readily the merely descriptive significance of PROGRAMMED PROTEIN as it pertains to applicant's services.

Decision: The refusal to register is affirmed under Section 2(e)(1).