

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: September 5, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elan Pharma International Ltd.

Serial No. 78517591

Kevin R. Casey of Stradley Ronon Stevens & Young, LLP for
Elan Pharma International Ltd.

Ellen Awrich, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Hohein, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application has been filed by Elan Pharma
International Ltd. to register on the Principal Register
the mark NANOCRYSTAL COLLOIDAL DISPERSION in standard
character form for the following goods: "pharmaceutical
preparations, namely, adjuvant preparations sold as a
component of a full line of pharmaceuticals, and
ingredients and components thereof, namely ultra-small

particle formulations.”¹ The application is based upon an allegation of December 19, 1996 as the date of first use of the mark anywhere and in commerce. During the course of examination of the application, applicant amended its application to seek registration of its mark under Section 2(f) of the Trademark Act, based upon a declaration of substantially exclusive and continuous use of the mark in commerce for over five years. Applicant further claimed ownership of Registration No. 2386089² for the mark NANOCRYSTAL in typed or standard character form for the same goods as those recited in the involved application, and Registration No. 2492925³ for the mark NANOCRYSTAL for the following services: “business marketing consulting services; business management consulting services” in Class 35; “manufacture of adjuvant preparations for use in pharmaceutical preparations to the order and specification of others” in Class 40; and “technical consultation and research in the field of pharmaceutical manufacturing; product development consultation; consumer product safety testing and consultation” in Class 42. In addition,

¹ Serial No. 78517591 was filed on November 16, 2004.

² Registration No. 2386089 issued on the Principal Register on September 12, 2000. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

³ Registration No. 2492925 issued on the Principal Register on September 25, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

applicant disclaimed the exclusive right to use "COLLOIDAL DISPERSION" apart from the mark as shown.

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its goods and that applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issues under appeal, and applicant has filed a reply brief.⁴

Evidentiary Matters

With its main brief on appeal, applicant submitted as exhibits copies from the United States Patent and Trademark Office's (USPTO) Trademark Application and Registration Retrieval (TARR) database of its previous, abandoned, application Serial No. 75425863 for the mark under consideration herein, and its prior registrations. Applicant further submitted a printout from its Internet website. With her brief on appeal, the examining attorney also submitted as exhibits printed copies of applicant's

⁴ The involved application was examined by several examining attorneys, and was most recently assigned to the attorney whose name is shown above to prepare the appeal brief.

prior registrations. Finally, with its reply brief, applicant submitted as exhibits printouts from several Internet websites, including its own, as well as copies of documents relating to applicant's marketing and business practices.

By not objecting to applicant's submission of the copies of its prior registrations to its main brief and, in addition, by attaching copies thereof to her own brief, the examining attorney is deemed to have waived any objection to our consideration thereof in our determination of the issues under appeal. As for the other exhibits submitted by applicant, the record in the application should be complete prior to the filing of an appeal. See Trademark Rule 2.142(d). The other exhibits attached to both applicant's main brief and reply brief were not made of record during examination. Accordingly, their submission at the briefing stage of this proceeding is untimely, and we have not further considered this evidence in reaching our decision.⁵ See *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1703 n.2 (TTAB 1998); and TBMP §1203.02(e) (2d ed. rev. 2004).

⁵ We hasten to add that even if these exhibits had been considered in our determination herein, the result would be the same.

Issue on Appeal

We note that both applicant and the examining attorney have presented arguments in their briefs directed toward the issues of whether applicant's NANOCRYSTAL COLLOIDAL DISPERSION mark is merely descriptive under Trademark Act Section 2(e)(1) as well as whether applicant has made a sufficient showing that such mark has acquired distinctiveness under Section 2(f).

However, applicant, in its November 17, 2006 communication, amended the instant application to seek registration under Section 2(f) based upon a claim of acquired distinctiveness. "Where ... an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact. Similarly, in cases where registration was initially sought on the basis of distinctiveness, subsequent reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive" (emphasis in original). *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). See also *General Foods Corp. v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984). Having amended its application to seek registration under Section 2(f), without reserving the

alternative contention that its mark is not merely descriptive, applicant has thereby conceded that its mark is merely descriptive and is registrable on the Principal Register only upon a showing of acquired distinctiveness. Thus, the sole issue on appeal is whether applicant has carried its burden of establishing, by a preponderance of the evidence, a prima facie case that its merely descriptive mark, NANOCRYSTAL COLLOIDAL DISPERSION, has acquired distinctiveness under Section 2(f). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, *supra*; and *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999). In consequence thereof, applicant's arguments directed toward the sufficiency of the examining attorney's refusal to register under Section 2(e)(1) are moot and will be given no further consideration.⁶

Acquired Distinctiveness

In support of its claim of acquired distinctiveness, applicant "points out its continuous and exclusive use of the composite mark since 1996 (now about 12 years) and its prior registrations, in 2000 and 2001 respectively, of the mark NANOCRYSTAL alone" (brief, p. 19). Applicant did not

⁶ We note in addition that an earlier refusal to register the involved mark on the ground of genericness was withdrawn prior to appeal. Accordingly, the issue of genericness is not before us and the examining attorney's arguments relating thereto will be given no consideration.

submit any additional evidence in support of its claim that NANOCRYSTAL COLLOIDAL DISPERSION has acquired distinctiveness under Section 2(f) of the Trademark Act.

Turning first to applicant's prior registrations, Trademark Rule 2.41(b) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as prima facie evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. *See In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of the rule, is the analysis used in tacking cases, i.e., whether the marks are legal equivalents. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. *See Van Dyne-Crotty*,

Inc. v. Wear-Guard Corp., supra; and *In re Dial-A-Mattress Operating Corp., supra*. Therefore, a minor difference in the marks, such as an inconsequential modification or modernization of the later mark, would not be a basis for rejecting application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) *aff'd*, 769 F.2d 764 (Fed. Cir. 1985); and *In re Flex-O-Glass, Inc., supra*.

Aside from the legal equivalency of the marks in the registration and the application, applicant is also required to establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods and/or services in the prior registrations and the goods identified in the application to warrant the conclusion that the distinctiveness of the mark associated with the goods and services in the registrations will "transfer" to the goods listed in the application. See *In re Rogers, supra*.

It is applicant's contention that "[b]ecause the shared term NANOCRYSTAL in the claimed registrations is the only distinctive term in the instant mark, and it is the dominant portion of the instant mark, it is the legal equivalent of the prior NANOCRYSTAL registrations and creates the same continuing commercial impression such that the consumer would consider them the same mark" (brief, p.

20).

In this regard, we note that applicant's prior registrations for the mark NANOCRYSTAL, both registered on the Principal Register without a showing of acquired distinctiveness, are each over five years old and thus at present are no longer subject to attack by way of a cancellation proceeding based upon mere descriptiveness and instead can only be cancelled if shown to be generic. See 15 U.S.C. §1065. See also *In re American Sail Training Association*, 230 USPQ 879, 880 (TTAB 1986). We further note that subsequent to amending the involved application to seek registration under Section 2(f), applicant, in response to a requirement from the examining attorney, disclaimed the exclusive right to use "COLLOIDAL DISPERSION" apart from the mark as shown. Further, in view of the evidence made of record by the examining attorney, the wording "COLLOIDAL DISPERSION" appears, at best, to be highly descriptive of the recited goods. As a result, we agree with applicant that the word NANOCRYSTAL in the involved mark, NANOCRYSTAL COLLOIDAL DISPERSION, is the dominant and distinguishing portion thereof.

Thus, the involved mark for which applicant seeks to make a prima facie showing of acquired distinctiveness consists of the word NANOCRYSTAL, previously found to be

inherently distinctive, and the highly descriptive wording "COLLOIDAL DISPERSION." In light of the foregoing, we find that on the record of this case the mark NANOCRYSTAL COLLOIDAL DISPERSION creates the same, continuing commercial impression as the previously registered NANOCRYSTAL marks such that it is the legal equivalent thereof. Therefore, the marks are "the same" for purposes of Trademark Rule 2.41(b).

We further find that the goods identified in applicant's prior Registration No. 2386089 are identical to the goods identified in the application. Accordingly, there is no question that the distinctiveness of the NANOCRYSTAL mark associated with the goods in Registration No. 2386089 will "transfer" to the identical goods listed in the involved application.⁷ See *In re Rogers*, *supra*.

In view of the above evidence, coupled with the further evidence, as set forth in applicant's declaration, that the involved mark has been in substantially exclusive and continuous use in commerce since 1996, we find that the combination of such evidence is sufficient to show that applicant's mark has acquired distinctiveness.

⁷ As a result, we need not and do not reach the question of whether the services recited in applicant's Registration No. 2492925 are sufficiently related to the goods in the involved application such that the distinctiveness of the NANOCRYSTAL mark therein would transfer to such goods.

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Accordingly, we find that, based upon its ownership of prior Registration No. 3386089 for the mark NANOCRYSTAL, and the evidence set forth in its Section 2(f) declaration, applicant has made a prima facie showing that its mark NANOCRYSTAL COLLOIDAL DISPERSION has acquired distinctiveness as applied to the recited goods sufficient to permit registration thereof under Section 2(f).

Decision: The refusal to register is reversed.