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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BioArray Solutions Ltd.

Serial No. 78908764

George B. Snyder, of Kramer Levin Naftalis & Frankel LLP for
BioArray Solutions Ltd.

Barney L. Charlton, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Quinn, Hairston and Ritchie de Larena, Administrative
Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark Judge:

Applicant, BioArray Solutions Ltd., filed an application to
register its proposed mark "BEADCHIP" in standard character
format on the Supplemental Register for goods ultimately
identified as: "single or multiple randomly assembled microbead
arrays for use in medical research and scientific applications;
kits for arrays and assemblies comprising nucleotide probes or
proteins attached to microbeads for use in medical research and
scientific applications" in International Class 1, and "single
or multiple randomly assembled microbead arrays for use in

diagnostic applications; kits for arrays and assemblies comprising nucleotide probes attached to microbeads for use in diagnostic applications” in International Class 5.¹

The trademark examining attorney refused registration under Trademark Act Section 23(c), 15 U.S.C. §1091(c), on the ground that the mark is generic and incapable of registration. Applicant has appealed from the refusal. Both applicant and the examining attorney have submitted briefs. After careful consideration of all of the arguments and evidence of record, we affirm the refusal to register.

Genericness

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Office has the burden of proving genericness by "clear evidence" of the public's understanding thereof. *In re Merrill*

¹ Application Serial No. 78908764; filed June 15, 2006; alleging a date of first use and first use in commerce for both International Classes on December 15, 2003.

Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

1. *The genus of applicant's goods and the relevant public for the goods.*

The genus of goods is the wording used in the recitation, "single or multiple randomly assembled microbead arrays for use in medical research and scientific applications; kits for arrays and assemblies comprising nucleotide probes or proteins attached to microbeads for use in medical research and scientific applications"; and "single or multiple randomly assembled microbead arrays for use in diagnostic applications; kits for arrays and assemblies comprising nucleotide probes attached to microbeads for use in diagnostic applications." More broadly, the genus of applicant's goods may be identified as a particular type of "microarray technology."

2. *The meaning of "beadchip" to the relevant public.*

Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). The examining attorney has submitted three types of evidence to demonstrate use of the term "beadchip" as a generic term for a particular type of "microarray technology" as identified in the

application. First, the examining attorney submitted patents and patent applications by various parties showing generic use of the term "beadchip" to identify applicant's goods. Second, the examining attorney submitted online research database results for various parties also showing generic use of the term "beadchip" to identify applicant's goods. Finally, the examining attorney submitted a glossary definition showing that the term "beadchip" is used to generically identify applicant's goods.

To counter the examining attorney's assertion of genericness, applicant submitted arguments to refute the examining attorney's evidence. Applicant further submitted its own evidence to show both its own use of the term "BEADCHIP" as a purported mark, and recognition by third parties of applicant's purported rights in "BEADCHIP" as a mark. We have considered all the arguments and evidence of record bearing on consumer perception of "beadchip."

- a) *Patents and patent applications showing generic use of the term "beadchip" to identify applicant's goods.*

The examining attorney submitted evidence of patents and patent applications showing generic use of the term "beadchip" in connection with applicant's identified goods. Several of the references are from third parties apparently unrelated to applicant. Excerpts from the third-party patent and patent

application cites containing generic use of the term "beadchip"

to identify applicant's goods are as follows:

U.S. Patent Registration No. 7164533, assigned to CyVera Corporation, entitled "Hybrid random bead/chip based microarray," and making several additional generic references to this genus of microarray technology.

Patent Application No. 20060008821, which relates to the analysis of peptides, proteins, DNA and RNA, including the following references in the preamble: "Within an inside of a bead chip forming a reactor flow pass therein, rinsing liquid flow passes are also provided in one body" and "The bead chip is made of a PDMS (Polydimethylsiloxane: (C₂H₆SiO)_n);" and including the following reference in paragraph [0008] of the Background of the Invention: "However, for applying such the bead-chip array apparatus into the inspection apparatus, there is a demand of further increasing the efficiency of reaction, so as to shorten a measuring time."

Patent Application No. 20060275891 including the following reference in the preamble: "When detecting fluorescence of a bead chip array, reflected light from a bead is detected at the same time, so as to recognize the bead position."

However, most troubling to applicant's argument of nongenericness is use by applicant itself of the term "beadchip" as a generic term in its own patent application:²

Patent Application No. 20040002073, which relates to methods and processes for the identification of polymorphic gene expression,

² Two of the listed inventors have been identified by applicant as key employees working on beadchip technology.

includes the following reference at [0256]:
"The composition of bead chip containing 26 CF mutations is provided below."

In response to this evidence by the examining attorney, applicant stated that applicant was not aware "as far as applicant can see" of having used the term 'beadchip' in this patent application." (Appl's Brief at 6) Notably, applicant does use the term "beadchip" in this application, but not in a trademark fashion. Rather, applicant includes "beadchip" as a generic identification of a particular type of "microarray technology."

- b) *Research databases and publications showing generic use of the term "beadchip" to identify applicant's goods.*

The examining attorney submitted evidence of research databases and publications showing generic use of the term "beadchip" to identify applicant's goods. Excerpts are as follows:

The University of Washington's L2L Microarray Analysis Tool is a library of microarrays used in genetic experiments. It refers to various microarray technologies from different companies, including "Whole genome bead chips for analyzing 6 samples simultaneously" and "Bead chips that permit analysis of 8 samples for characterized RefSeq transcripts," from Illumina Inc.

The Life Sciences Conference-Expo webpage includes an abstract regarding testing begun in 2005 by The Center for Inherited Disease Research of a database management system for an Illumina Inc. platform, in which "all stages of processing, from DNA plate through association

to a beadchip, while recording reagent lot numbers," are tracked, and in which "[r]igorous data validation ensures that reagents scanned are valid for each phase and that each plate or beadchip scanned is ready for processing in the phase being recorded."

The January 2004 article from *Drug Discovery & Development* reports on the introduction by Illumina Inc. of "two new Sentrix *BeadChips* for whole-genome expression profiling of multiple samples on a single chip" and that "[t]he first BeadChip holds six whole-genome human samples on one chip" while "[t]he second BeadChip product analyzes eight samples."

The Gene Expression Omnibus of the National Center for Biotechnology Information (NCBI), a division of the National Library of Medicine at the National Institutes of Health, provides a list of microarray studies, including several involving a "16-sample beadchip."

- c) *Glossary definition showing that the term "beadchip" is used to generically identify applicant's goods.*

The examining attorney submitted evidence of a glossary definition showing that the term "beadchip" is used to generically identify applicant's goods, as follows:

The glossary of genomic terms provided by Cambridge Healthtech Institute includes under the sub-heading "Microarrays glossary" . . . generic use of the terms "bead arrays, bead chips and bead microarrays."

Applicant argues that these three categories of evidence presented by the examining attorney to show genericness are not compelling because either 1) the term "beadchip" is used as an adjective rather than a noun for which applicant seeks

registration; 2) several instances of the use of the term "beadchip" as cited by the examining attorney either show "bead chip" with a space, or "bead/chip" with a forward slash; 3) the term "beadchip" is used by a rival company, Illumina, and therefore is being used in a subversive manner to undermine applicant's purported trademark rights; 4) the term "beadchip" is used by third parties merely parroting rival company, Illumina, and therefore only adds to Illumina's subversive tactics; 5) the term "beadchip" is used without context (in the glossary definition); or 6) the submissions by the examining attorney are duplicative. To further its argument, applicant presented its own evidence as follows:

d) *Use by applicant of "BEADCHIP" as a purported mark.*

Applicant argues that it uses the term "beadchip" as a mark, and that therefore the term should not be considered generic. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). Applicant submitted several examples of its purported use of "BEADCHIP" as a mark, including two trade journal articles that discuss applicant's use of the "beadchip" technology. In support of its argument that the trade journal publications evidence its nongeneric use as a mark, applicant cites the case of *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). However, *Plyboo* presented quite a different factual scenario. In *Plyboo*, the

applicant submitted its trade journal publications as evidence of its use of the proposed mark. The applicant in *Plyboo* capitalized its proposed mark and placed it in quotations. The Board found however that the *Plyboo* applicant's capitalization or putting into quotations of the purported mark was neutral, and "arguably as consistent with descriptive or generic use as it is with trademark use." *Id.* at 1638. The weight that the Board accorded the trade-journal evidence in *Plyboo* was due instead to the definition that applicant provided with each use of the proposed mark in its articles. In particular, the *Plyboo* applicant followed use of the proposed mark with a description of the identified goods. *Id.*

Applicant here capitalized "beadchip" in its articles, but tellingly did not anywhere define the term. Instead, applicant used the term "beadchip" throughout its articles in a generic fashion, showing that applicant expected its readers to already be aware of the common definition of "beadchip" as a technological term rather than a proprietary mark. Furthermore, applicant's intent in capitalizing the mark in its trade journal articles is ambiguous and not overtly consistent with use as a mark, since rather than capitalizing all of the letters, or even just the first letter, applicant capitalized both the "B" and the "C," as follows: "BeadChip." Accordingly, this case must be distinguished from the scenario presented in *Plyboo*.

- e) *Recognition by third parties of applicant's purported rights in "BEADCHIP" as a mark.*

To demonstrate its argument that third parties have recognized its rights in its proposed "BEADCHIP" mark, applicant submitted correspondence from a competitor, Illumina, and from the publisher of a trade journal, Transfusion, as well as an erratum published by Transfusion. As brief background, applicant published two articles with Transfusion, one in 2005 and one in 2007. In the 2005 article, Transfusion apparently misattributed the source of applicant's use of the beadchip technology to applicant's rival, Illumina, by showing the following in the articles: "BeadChip (Illumina)". Both applicant and Illumina took issue with this mischaracterization.

Illumina was concerned that it would lead readers to believe that Illumina had undertaken the beadchip technology cited in the article. Accordingly, counsel for Illumina sent a letter to applicant citing the mistake. Apparently believing that the error was intentional on the part of applicant, Illumina's counsel stated: "we insist that you refrain from associating your company with our client." Although applicant argues that Illumina's letter indicates a belief of applicant's rights in the proposed "BEADCHIP" mark, we read it as simply asking applicant not to misattribute the source of the beadchip work discussed in the article. Our interpretation is supported by two particular pieces of evidence. First, other use of

parentheticals in the articles show that they refer to the source of where work was done, and not to the source of a purported mark. An example is evidenced on page 737 of the 2007 article, with the following quote: "The bar code on each blood tube (=donor ID) was scanned with a sample entry module provided as part of the control software for the array imaging system (BioArray Solutions)." Clearly this parenthetical does not intend to show applicant's purported rights in a mark for the term "control software for the array imaging system." Rather, it shows that applicant undertook the scanning cited in that sentence. Second, the letter from counsel for Illumina goes on to assert in connection with applicant's pending trademark application: "our client maintains that the word "beadchip" in any form should be free for all in the industry to use in connection with bead-based arrays and assemblies, and that no one party should monopolize such term by obtaining federal, state or international trademark rights." Accordingly, we do not view this letter as in any way supporting applicant's argument of third-party recognition of its purported trademark rights.

Meanwhile, applicant was also upset by the publisher's error attributing its beadchip work to applicant's rival and requested an erratum by the publisher, which was duly granted. After the publication of its 2007 article in Transfusion,

applicant again took issue with an alleged mistake by the publisher over the characterization of the term "beadchip" in the article, this time since the publisher had omitted the TM symbol that applicant wanted the publisher to include alongside the term. Therefore, applicant asked the publisher to issue a correction. The publisher did so, but not for the reason applicant claims. In particular, the publisher specifically took issue with applicant's claim of ownership rights in the purported "BEADCHIP" mark, citing in an email message to applicant, "the numerous other users" of the term beadchip to identify this genus of goods.

Ultimately, under threat from applicant, the publisher did issue a corrected version of the 2007 article including the following statement: "BioArray Solutions Ltd., Warren, New Jersey, uses 'BeadChip' as its trademark." Given the circumstances of this erratum by the publisher and in light of the publisher's concurrent comments to applicant, we do not view it as an acknowledgement of the publisher's belief of applicant's rights in the proposed "BEADCHIP" mark. Indeed, even if this were viewed as an acknowledgement of trademark rights by the publisher, one isolated instance is outweighed by the remainder of the evidence showing generic use.

In sum, we find applicant's arguments and evidence regarding the nongenericness of the proposed "BEADCHIP" mark to

be unconvincing. We also find applicant's protests against the probative value of the examining attorney's submitted evidence to be equally unconvincing. The term "beadchip" has a particular, generic meaning for microarray technology. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Dial-A-Mattress*, 57 USPQ2d at 1810. This is evident from the particular technical meaning attested to both by applicant (in its recitation of goods) and by the examining attorney (via evidence of the relevant public's understanding of the word). That some have used the word as an adjective or with a space or forward slash is irrelevant since they have used it to mean the same thing. Applicant actually presents the best evidence of this, since applicant itself has repeatedly used the term "beadchip" as an adjective in its trade journal articles ("'BeadChip' array; "BeadChip analyses"; "BeadChip panel"; "BeadChip format"), belying applicant's argument that such use is different or that it is "demonstrative of the author's presumed lack of familiarity with 'beadchip' as a common noun." (Appl's Brief at 8).

The Board has held that adjectives, not just nouns, can be deemed to be generic. Adjectives are generic if they name a key characteristic or feature of the goods or services. *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (Applicant's proposed mark "ATTIC" did not fall within the

classic case of a generic noun, but rather was a generic adjective; nonetheless the Board held that because the term "attic" "directly names the most important or central aspect or purpose of applicant's goods, that the sprinklers are used in attics, this term is generic and should be freely available for use by competitors"). See also *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) ("BUNDT" for coffee cake held generic); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) ("CUSTOMBLENDED" for gasoline held generic); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTUERIZED for face cream held generic); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991) ("MULTI-VIS" for multiple viscosity motor oil held generic). Thus, it is irrelevant that the term "beadchip" is sometimes used as an adjective, since it is still being used in a generic manner to refer to this genus of microarray technology.

Meanwhile, applicant's attempt to discount the evidence of use of the "beadchip" term by its rival Illumina is not convincing. Clearly, Illumina has shown in its letter to applicant that it believes the term "beadchip" to be generic. That Illumina also uses it that way merely follows its own assertion. That third parties also use the term "beadchip" generically shows Illumina to be correct.

Applicant's protest as to the probative value of the glossary definition taken out of context is duly noted. However, the glossary definition simply adds to the record and to the use by applicant itself, both in its own patent application, and in its trade journal articles, of the term "beadchip" as a generic identification of the goods in this genus.

Upon full consideration of all of the evidence in the record, we simply cannot conclude that this is a "mixed record" as alleged by applicant. Rather, we are convinced by the "clear evidence" of the public's understanding of the term "beadchip" as generic for the genus of goods for which applicant seeks to register the proposed mark. *Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 4 USPQ2d at 1143. We find that the proposed mark "beadchip" is incapable of distinguishing applicant's services, and that it therefore is not registrable on the Supplemental Register.

Decision: The refusal to register is affirmed.