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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Injex Pharma AG

Serial No. 79119172

Stewart J. Bellus and Sara M. Dorchak of Collard & Roe, P.C.,
for Injex Pharma AG.

Michael Eisnach Trademark Examining Attorney,[1] Law Office 104,
Chris Doninger, Managing Attorney.

Before Zervas, Cataldo, and Ritchie,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Injex Pharma AG ("Applicant") filed an application to register the mark INJEX, in standard character format, on the Principal Register, for the following goods in International Class 10:[2]

> needle-free injection system comprising needle-free injector sold empty for use in releasing medical drugs via disposable needle-free ampoules for medical drug storage and release, and accessories therefore, namely, dosing aids in the nature of a transporter into which medical drugs cartridges can be fixed, in order to allow a dose-accurate transfer of medical drugs to the empty ampoules, reset box, transporters,

[1] This Examining Attorney was substituted into the case after the appeal was filed.

[2] Application Serial No. 79119172, filed on July 25, 2012 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on International Registration No. 1132389, registered on July 25, 2012.

> adapters for different drug containers; medical apparatus and instruments for the needle-free hypodermic application of topical or parenteral medical drugs sold empty; needle-free medical drug delivery system, namely, needle-free injectors sold empty for medical drugs administered either subcutaneously, intramuscularly or intradermally, disposable needle-free ampoules sold empty, storage and carrying bags and boxes and carrying cases for needle-free injectors; medical fluid transfer couplers and accessories therefore, namely vial adapters, pen adapters, transporter adapters, and luer adapters.

The Examining Attorney refused registration of the mark (i) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of a feature of the identified goods; and (ii) under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the previously-registered mark INJEKT, registered on the Supplemental Register in standard character format, for "injection needles," in International Class 10,[3] that when used on or in connection with Applicant's mark, it is likely to cause confusion or mistake or to deceive.

Upon final refusal of registration, Applicant filed a timely appeal.[4] Both Applicant and the Examining Attorney filed briefs,[5] and Applicant filed a reply brief.

Section 2(e)(1)

We first consider the refusal under Section 2(e)(1). A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic

[3] Registration No. 3891618, issued December 14, 2010.

[4] The Final Office Action also included a third ground for refusal, regarding the definiteness of the identification of goods. However, this refusal was withdrawn after Applicant amended its identification of goods in its request for reconsideration.

[5] Applicant initially submitted a brief for an unrelated case. Applicant later filed the brief on this case, and the Board, in its order mailed on July 23, 2014, accepted the later-filed brief.

of the goods or services with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), *citing In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1538 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990)*;* and *In re American Greetings Corp.*, 226 USPQ 365, 365 (TTAB 1985).

The Examining Attorney argues that the applied-for mark INJEX identifies "a key function of applicant's needle-free injection devices." (Examining Attorney's brief at unnumbered p. 13 of 16). Applicant's applied-for mark INJEX is the phonetic equivalent of the term "injects." (See Appl's brief at unnumbered p. 4 of 8, referring to the the root term as "inject"). The Examining Attorney submitted the following dictionary definition with the November 27, 2012 Office Action:

> "Inject": *verb* To force (a fluid) into a passage, cavity, or tissue: *to inject a medicine into the veins. Dictionary.com* 11/26/2012.

The Examining Attorney further submitted evidence of third-party web sites that discuss or show use of the verb "inject/injects," used in a descriptive manner in connection with needle-free systems. Some examples include the following:

> Medtechinsider: Medtech Week Recap: Needle-free Device Injects Drugs to Various Depths: June 11, 2012; A new device developed by researchers at MIT can inject drugs without the use of a needle. While similar systems already exist, the new device is said to be the first to deliver drugs to variable depths in a highly controlled manner. Attached to September 30, 2013, Final Office Action, p. 43.
> *http://medtechinsider.com*.

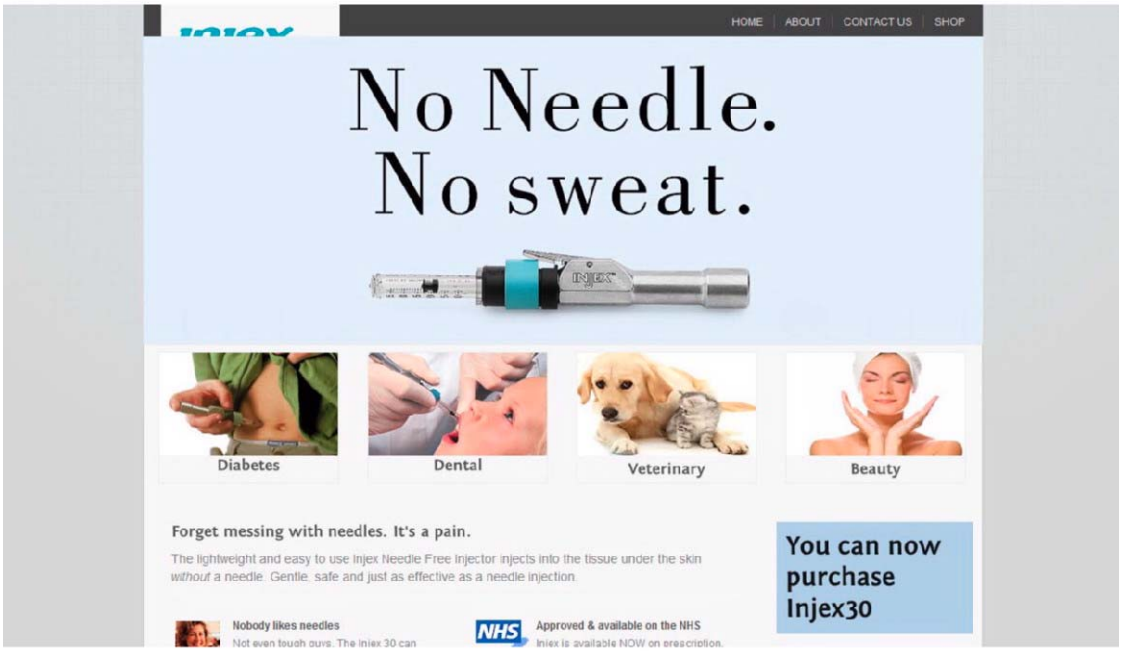
> MNT: Medical News Today: Jet Device Injects Drugs Without Needles: 25 May 2012; The prospect of less painful medicine shots without needles came a step closer this month, as US researchers revealed how they have developed a device that delivers a controlled, tiny, high-pressure jet into the skin without using a hypodermic needle. . . . Another advantage of a needle-less device is it may help improve compliance, for instance among diabetes patients who are reluctant to use hypodermic needles to inject themselves with insulin. . . . "If you are afraid of needles and have to frequently self-inject, compliance can be an issue." Attached to September 30, 2013, Final Office Action, p. 45.
> *medicalnewstoday.com*.

> MIT news: Device may inject a variety of drugs without using needles: Jet-injected drugs could improve patient compliance, reduce accidental needle sticks; May 24, 2012; Getting a shot at the doctor's office may become less painful in the not-too-distant future. Attached to September 30, 2013, Final Office Action, p. 53.
> *http://web.mit.edu*.

> Bespak: Needle-free Jet Injectors: Bespak Injectables' reusable needle-free injectors utilize spring power to inject drugs without a needle. . . . These injectors are suitable for use with drugs packaged in a range of vials and cartidges. Attached to April 15, 2014 Denial of Request for Reconsideration, p. 8.
> *Bespak.com*.

The Examining Attorney notes that Applicant's own website uses the term "injects" to describe the function of its needle-free system:

http://www.injexuk.com/ 09/28/2013 11:21:07 AM



Furthermore, in its identification of goods, Applicant utilizes the terms "injection" and "injector."

Applicant, although admitting "[o]bviously, the term has 'something to do' with an injection system," states that "but the precise characteristic to which that word refers will not be grasped without 'some measure of imagination and mental pause," citing *In re Shutts,* 217 USPQ 363 (TTAB 1983) (SNO-RAKE not descriptive of a snow removal tool, even though the mark's significance would become clear upon contemplation); *In re George Weston, Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI-BAKE only vaguely suggests desirable quality of frozen dough that can be baked quickly); *In re Geo. A. Hormel & Co.*, 218 USPQ 286 (TTAB 1984) (FAST 'N EASY requires analysis by purchasers to understand the significance of pre-cooked meats

that are quickly and easily prepared). (See Appl's August 27, 2013 Petition to Revive). We find this case to be distinguishable from those cited, however. There is no "mental pause," imagination, or analysis needed to decipher the meaning of "injects," in order to understand the significance in relation to the goods identified. Rather, based on the dictionary definition, the third-party uses, and Applicant's own website and identification of goods, we have no doubt that a consumer would understand INJEX, used in connection with Applicant's goods, as directly conveying information about them, namely, that they provide an injection system for the administration of medicine. Thus, the applied-for mark immediately describes a key function, characteristic or an aspect of the identified goods. Applicant argues that there is no "competitive need" for use of the term INJEX with regard to the identified goods. In this regard, our precedent dictates that the primary purposes for refusing registration of a merely descriptive mark are "(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products." *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). We find that the mark is merely descriptive of the identified goods, and we affirm this refusal to register.

Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Each of these factors may, from case to case, play a dominant role. *du Pont*, 177 USPQ at 567.

In this case, the strength of the cited registration, or rather the lack of strength, plays a significant role in our analysis. The cited registration, as noted above, is on the Supplemental Register. Marks that are not registrable on the Principal Register, such as those that are merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, may be registrable on the Supplemental Register. The registration of INJEKT on the Supplemental Register, rather than on the Principal Register, indicates that it is a merely descriptive term, and therefore is entitled to a limited scope of protection. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (an application for registration on the Supplemental Register of a particular term is an admission of descriptiveness).

The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). That is, the descriptiveness of a mark may result in a more narrow

scope of protection. As the predecessor to our primary reviewing court stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958), in which no likelihood of confusion was found between SURE-FIT and RITE-FIT for ready-made slip covers:

> It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

When marks are registered on the Supplemental Register because they are descriptive, the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods or services are substantially similar. *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

With the foregoing in mind, we consider the similarity or dissimilarity of the marks. Both are merely descriptive terms, and there are differences in the terminal lettering of each mark. Further, both marks constitute unusual misspellings of "inject" or "injects." The marks hence are not sufficiently similar to make confusion likely for such weak terms.

With regard to the goods, they are by no means similar, and in fact differ considerably in that one concerns injection needles and the other concerns injection systems that do not use needles. Despite the evidence submitted by the Examining Attorney of a commercial relationship between Applicant's and the registrant's

identified goods, the good are quite different. Thus, in view of the differences in the marks and the goods, and the limited scope of protection to which the cited Supplemental Registration is entitled, we find that confusion is not likely between Applicant's mark and the cited registrant's mark.

Decision: The refusal to register under Section 2(d) is reversed. However, the Section 2(e)(1) refusal is affirmed.