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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eli Lilly and Company

Serial No. 85183667

Marie-Anne Mastrovito of Abelman Frayne & Schwab for Eli Lilly and Company.

Brian Pino, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Cataldo, Masiello, and Hightower, Administrative Trademark Judges.

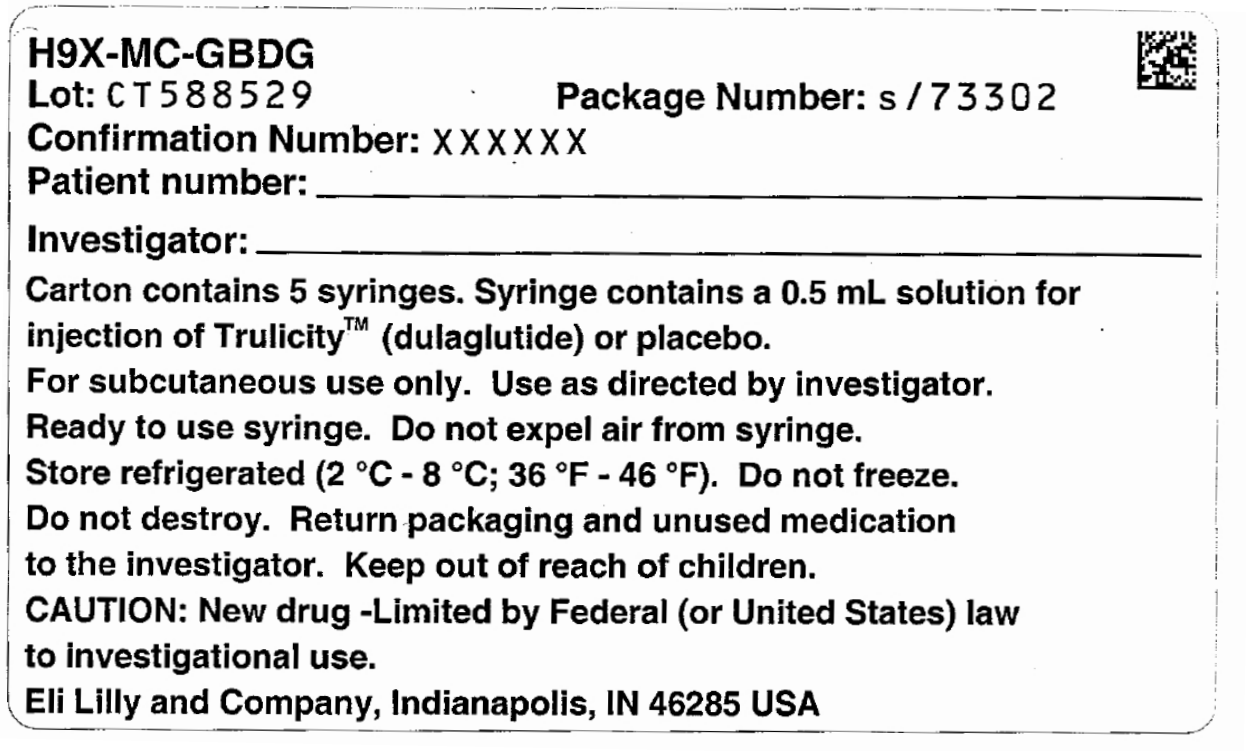
Opinion by Masiello, Administrative Trademark Judge:

Eli Lilly and Company ("Applicant") filed an application to register on the Principal Register the mark TRULICITY in standard characters for "pharmaceutical preparations, namely, pharmaceutical preparations for the treatment of diabetes."[1] After initial examination, the application was published for opposition and a notice of allowance issued. In due course, Applicant filed a statement of use as required by Trademark Act § 1(d), 15 U.S.C. § 1051(d).

[1] Application Serial No. 85183667 filed on November 23, 2010 under Trademark Act § 1(b), 15 U.S.C. § 1051(b).

Upon examination of the statement of use, the Examining Attorney refused registration under §§ 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that the specimen of use "does not show the applied-for mark in the drawing in use in commerce."[2] When the refusal was made final, Applicant filed a request for reconsideration, which the Examining Attorney denied. Applicant then brought this appeal. Applicant and the Examining Attorney have filed their briefs on appeal, and Applicant has filed a reply brief.

The specimen of use submitted with the statement of use is reproduced below. Applicant describes the specimen as a label applied to the goods when distributed to clinical trial sites.



[2] Office Action of June 18, 2014 at 2.

The Examining Attorney argues that the mark set forth in the application "is not a substantially exact representation of the mark on the specimen,"[3] and that therefore "[A]pplicant has failed to provide the required evidence of use of the applied-for mark … on or in connection with [A]pplicant's goods …." The Examining Attorney continues:

> The sole specimen of record shows the proposed mark as part of [a] logically connected and continuous sentence …
>
> [T]he proposed mark TRULICITY is in the same size and stylized font as the surrounding wording. Additionally, the term TRULICITY is part of a sentence … Furthermore, TRULICITY is not set out from the surrounding text; the term TRULICITY is not so prominent that consumers will recognize it as a trademark. Finally, viewers of the specimen in the instant case will have to search through the same size and stylized text even to find the purported mark TRULICITY. … [T]he proposed mark shown on the specimen is not being used as a trademark on the specimen because of its presentation as part of a logically connected and contiguous sentence.[4]

The Examining Attorney cites *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007), as a factually similar case and has modelled his argument on the discussion set forth in that decision.

Applicant points out that TRULICITY is the only coined term on the specimen; that it appears directly before the generic name of the goods;[5] that it carries an

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[3] *See* 37 C.F.R. § 2.51(b) ("… once … a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.")

[4] Examining Attorney's brief, 9 TTABVUE 4, 7.

[5] *See* Wikipedia entry for "Dulaglutide," filed with Applicant's request for reconsideration of October 16, 2014 at 24-27 ("Dulaglutide is a glucagon-like peptide receptor agonist (GLP-1

initial capital letter T, even though it is not the first word in its sentence; and that it carries the TM designation. Applicant argues that "proximity to other wording does not preclude TRULICITY from creating a separate and distinct commercial impression";[6] and that "it is commercial impression that determines registrability of a mark, and not a mechanical test of whether the mark in the specimen appears in a sentence or appears on the specimens separated from other wording."[7]

The essence of the Examining Attorney's refusal is that the manner in which the term TRULICITY appears on the specimen is such that the term does not function as a trademark. On this point, the Board has said:

> The salient question is whether the designation in question, as used, will be recognized in itself as an indication of origin for the particular product or service. That is, does this designation create a commercial impression separate and apart from the other material appearing on the label or advertisement. This necessitates a determination as to whether it is used and provided in such a manner so as both to make it known to purchasers and to have such individuals associate it with the goods as an identification symbol.

In re Morganroth, 208 USPQ 284, 287-88 (TTAB 1980) (citations omitted). The Board has also stated:

> While a trademark or service mark need not be displayed in any particular size or degree of prominence, the important question is whether, when it is noticed, it will be understood as indicating origin of the goods or services.

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agonist) for the treatment of type 2 diabetes. … The FDA approved dulaglutide for use in the United States in September 2014.")

[6] Applicant's brief at 4, 7 TTABVUE 5.

[7] *Id*. at 6, 7 TTABVUE 7.

In re Royal Viking Line A/S, 216 USPQ 795, 797 (TTAB 1982) (*citing In re Singer Mfg. Co.*, 118 USPQ 310, 312 (CCPA 1958)).

The crucial wording on the label is the following:

> Carton contains 5 syringes. Syringe contains a 0.5mL solution for injection of Trulicity™ (dulaglutide) or placebo.

Bearing in mind the fact that TRULICITY is the only fanciful, coined term in the sentence and that "dulaglutide" is, as the record shows, the generic name of a drug, the significance of these sentences can be paraphrased as "This package contains either Trulicity brand dulaglutide or a placebo." The reference to a "placebo" in this sentence somewhat complicates the message conveyed; but in the very special context in which the packaging and label are used (*i.e.*, a clinical trial in which subjects will receive either dulaglutide or a placebo and must remain unaware of which is which), its meaning is readily apparent. (We also bear in mind that the goods packaged in this way are delivered to highly sophisticated users, namely, medical or scientific professionals and subjects who are under the care and instruction of those professionals.[8]) The remainder of the critical sentence conveys exactly the message that a trademark is supposed to convey, *i.e.*, that the package contains Trulicity brand goods.

In re Osterberg, 83 USPQ2d 1220, on which the Examining Attorney relies, is distinguishable. In *Osterberg*, the question was whether an advertisement

[8] *See* Declaration of Michelle R. Smith, Applicant's manager of Clinical Trial Material Manufacturing and Services – Label Management, ¶¶ (b) and (c), filed with Applicant's response of July 14, 2014 at 9-10.

constituted a display associated with the goods, as contemplated by the statutory definition of "use in commerce," 15 U.S.C. § 1127. In the case now before us, the question of whether there is "use" of the designation TRULICITY is not before us; the placement of the designation on labels affixed to product packages is clearly within the statutory definition of "use." *Id*. Rather, the question before us is whether TRULICITY is a mark at all. The *Osterberg* analysis,[9] with its emphasis on "prominence," is not the correct test. Moreover, it is contrary to the guidance of *In re Singer*, 118 USPQ at 310 ("No authority is cited, and none has been found, to the effect that a trademark use requires a display of a design of any particular size or degree of prominence.").

The Examining Attorney has also cited a number of cases that address the issue of a failure to function as a trademark. However, all of them are distinguishable because the marks at issue therein consisted of descriptive or highly suggestive wording, such that they could be perceived merely as information about the goods. *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006) (SPECTRUM used as an item in a list of features of the goods); *In re Gilbert Eisenman, P.C.*, 220 USPQ 89 (TTAB 1983) (IN ONE DAY merely used to convey a key characteristic of the services); *In re Royal Viking Line A/S*, 216 USPQ at 797 (WORLD CLASS, merely laudatory description of the services); *In re Morganroth*, 208 USPQ at 288 (NATUR-ALL-IZE YOUR HAIR COLORING not used as a mark, but as a part of a longer

[9] In determining whether the *Osterberg* specimen constituted a display associated with the goods, the Board considered two factors: (a) whether the advertisement was used at a point of sale; and (b) whether in the advertisement "the mark is displayed in such a way that the customer can easily associate the mark with the goods." *Id.*, 83 USPQ2d at 1223.

advertising message); *In re Dun-Donnelley Publishing Corp.*, 205 USPQ 575 (TTAB 1979) (ENGINEERING CONSTRUCTION WORLD included in list of the titles of predecessor publications).[10] The designation TRULICITY is unlike any of these marks because it appears fanciful, a coinage lacking any relevant meaning as applied to the goods. Even though it may be embedded in other text, there is no danger that this coined term will be interpreted as merely descriptive or informational matter. It is also the *only* coined designation in the text of the label, and is set out with a "TM" symbol, further indicating it is a trademark. As such, its only purpose is to provide a unique identifier to a product that is otherwise identified only by a generic name and technical, explanatory information. Its placement on the product label is sufficient to "make it known to purchasers," and its placement immediately adjacent to the generic name of the goods allows customers to "associate it with the goods." *In re Morganroth*, 208 USPQ at 288. We find that the designation TRULICITY, as so used, sufficiently meets the statutory definition of a trademark, that is, "any word, name, symbol, or device, or any combination thereof — (1) used by a person … to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127. While the display of Applicant's mark may seem understated by comparison to displays in other industries, it is well within the province of Applicant to decide how

[10] We note that the mark in *Osterberg* (CondomToy) was similarly descriptive in nature and, as displayed in the specimen, could be perceived as an explanation that the product was both a condom and an adult toy.

it wishes to display its mark to customers in the scientific research field. We find that the specimen of use demonstrates use of the mark that Applicant seeks to register within the meaning of the Trademark Act.

Decision: The refusal to register is reversed.