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PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Health Science Funding, LLC

Serial Nos. 85255510 and 85255541¹

J. M. Pohl of Pharmaceutical Patent Attorneys, LLC for
Health Science Funding, LLC

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Before Zervas, Kuhlke and Shaw, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Health Science Funding, LLC (applicant) has filed
applications to register PRASTERONE.ORG² and THE PRASTERONE
COMPANY³ in standard characters on the Supplemental Register
for services ultimately identified as "providing a website

¹ Upon motion by applicant, the Board consolidated these
proceedings for final disposition on February 21, 2012.

² Application Serial No. 85255510, filed on March 2, 2011, under
Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based on
allegations of first use and use in commerce on March 2, 2011.

³ Application Serial No. 85255541, filed on March 2, 2011, under
Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based on
allegations of first use and use in commerce on March 2, 2011.

featuring scientific and clinical research information about investigational medical foods, dietary supplements or drugs, namely, prasterone or derivatives or analogs thereof" in International Class 42.

The examining attorney has refused registration under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that applicant's proposed marks are generic and, as such, incapable of distinguishing applicant's services. Applicant appealed the refusals in each application.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See *In re Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question.

H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

Making this determination "involves a two-step inquiry:

First, what is the genus 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 of goods or services?" Ginn, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch*, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

The type of evidence that may satisfy the United States Patent and Trademark Office's (USPTO) burden varies depending on the circumstances presented. In *re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (*SCREENWIPE* held generic as applied to premoistened antistatic cloths for cleaning computer and television screens based on dictionary definitions of the constituent parts and corroborated by applicant's specimens of use). See also Trademark Manual of Examining Procedure (TMEP) § 1209.01(c)(i) (8th ed. 2011). Where marks are more in the nature of a phrase, the USPTO must provide evidence of the meaning of the composite mark as a whole. In *re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (*SOCIETY FOR REPRODUCTIVE MEDICINE*

not generic for association services in the field of reproductive medicine based on lack of evidence showing phrase used as a whole).

In the case of domain names, because top level domains (TLD), such as .com or .org⁴ generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. In re 1800MATTRESS.com IP LLC, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding," and applicant "presented no evidence that '.com' evoked anything but a commercial internet domain"); Hotels.com, L.P., 91 USPQ2d at 1535 (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for

⁴ We take judicial notice of the following definition of .ORG:

[A] suffix intended to indicate that a web or e-mail address belongs to a non-profit organization (in any country, but mostly the United States). Along with .com, .edu, .gov, .int, .net, and .mil, this is one of the original set of Internet top-level domains. Since 2000, .com, .net, and .org have been assigned almost indiscriminately to organizations of all types.

Dictionary of Computer and Internet Terms (Barron's 10th ed. 2009). The Board may take judicial notice of dictionary definitions. In re Red Bull GmbH, 78 USPQ2d 1375, 1378 (TTAB 2006). See also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

others by means of telephone and the global computer network"); In *Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"); and In *re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1791 (TTAB 2002) (BONDS.COM generic for "providing information regarding financial products and services via a global computer network and providing electronic commerce services via a global computer network, namely, investment research, subscription services, market commentary, portfolio analysis, debt instrument conversion..." "Because 'bonds' is the name of one of the financial products which comprise the subject matter of applicant's services, the term is likewise a generic name for the information services and electronic commerce services themselves.") But see In *re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (STEELBUILDING.COM for "computerized on line retail services in the field of pre-engineered metal buildings and roofing systems" held highly descriptive, but not generic).

Finally, "[t]acking a company organizational designation such as "Company," or "Inc." or "Partners" cannot transform a generic name into a protectable

trademark. Such company designations or their abbreviations are themselves generic and have no trademark significance. Thus, one cannot append a generic company designation and magically transform a generic name for a product or service into a trademark, thereby giving a right to exclude others." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 12:39 (4th ed. updated 2012).

We begin by finding that the genus of services at issue in this case is adequately defined by applicant's identification of services, namely, "providing a website featuring scientific and clinical research information about investigational medical foods, dietary supplements or drugs, namely, prasterone or derivatives or analogs thereof." *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration.") This is corroborated by the excerpt applicant submitted from its website shown below.

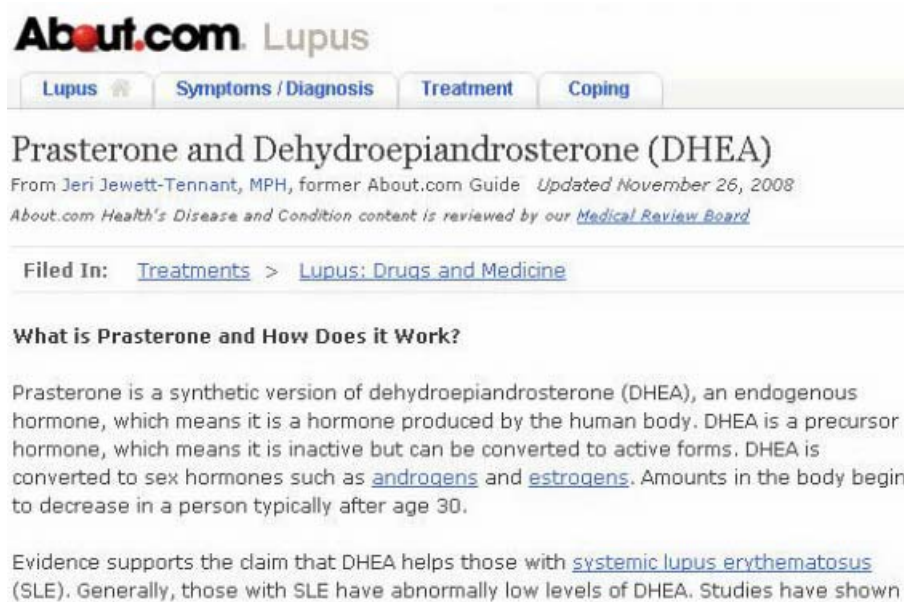


Turning to the second inquiry, the public's understanding of the term, the relevant public consists of the ordinary consumer interested in obtaining information about prasterone or its derivatives or analogs.

As noted above, the evidentiary burden of establishing that a term is generic rests with the USPTO and the showing must be based on clear evidence. *Merrill Lynch*, 4 USPQ2d at 1143. Based on this record, we find that there is clear evidence to support a finding that the relevant public, when they consider PRASTERONE.ORG and THE PRASTERONE COMPANY in conjunction with the identified services, would readily understand the term to refer to the category of services at issue, namely, information services regarding, inter alia, prasterone.

In support of her position that both PRASTERONE.ORG and THE PRASTERONE COMPANY are generic for applicant's services, the examining attorney submitted, inter alia,

excerpts from various third-party websites showing use of the term PRASTERONE in providing general information on PRASTERONE and on its efficacy in medical uses. A few examples are reproduced below:



The screenshot shows the 'About.com' website with the 'Lupus' section selected. The main heading is 'Prasterone and Dehydroepiandrosterone (DHEA)'. Below the heading, it states 'From Jeri Jewett-Tennant, MPH, former About.com Guide Updated November 26, 2008' and 'About.com Health's Disease and Condition content is reviewed by our Medical Review Board'. The page is categorized under 'Filed In: Treatments > Lupus: Drugs and Medicine'. The main text explains that Prasterone is a synthetic version of dehydroepiandrosterone (DHEA), an endogenous hormone produced by the human body. It notes that DHEA is a precursor hormone, inactive but convertible to active forms, and is converted to sex hormones like androgens and estrogens. It also mentions that DHEA levels decrease after age 30. A concluding sentence states: 'Evidence supports the claim that DHEA helps those with systemic lupus erythematosus (SLE). Generally, those with SLE have abnormally low levels of DHEA. Studies have shown 5



The screenshot shows the 'Drugs.com' website. The main heading is 'Prasterone'. Below the heading, it provides 'Pronunciation: PRASS-te-rone', 'Generic Name: Prasterone', and 'Brand Name: Generic only. No brands available.' The page also includes a search bar and navigation links like 'Drugs A to Z', 'Pill Identifier', and 'Interactions Checker'.

Prasterone is used for:

Possibly helping to treat a number of conditions, including lupus, multiple sclerosis, and Alzheimer disease. It has also been used to help strengthen the immune system, promote weight loss, and increase strength, energy, and muscle mass. It may also be used for other conditions as determined by your doctor. The use of Prasterone for these conditions has not been evaluated or approved by the Food and Drug Administration.

6

⁵ <http://lupus.about.com>, August 19, 2011 Office Action p. 11.

⁶ <http://www.drugs.com>, August 19, 2011 Office Action p. 15.



Applicant concedes that the term PRASTERONE "is the generic designation for 'a type of synthetic DHEA.'" App. Br. p. 3 *quoting* June 13, 2011 Office Action. See also App. Br. p. 4 and printout from the United States National Library of Medicine listing "prasterone" as the generic name for a particular compound, retrieved from <http://chem.sis.nlm.nih.gov/chemidplus>, attached to September 19, 2011 App. Response. However, applicant contends that it is a publisher and while merely descriptive of the subject matter of its services, the terms PRASTERONE.ORG and THE PRASTERONE COMPANY are not generic terms for its services.⁸

⁷ <http://www.webmd.com>, August 19, 2011 Office Action p. 27.

⁸ In its main brief, applicant refers to its services as "publishing services" and then evolves in its reply brief to the description "publishing/information services." There is no question that the identification is for a website that features information about "prasterone or derivatives or analogs thereof" as opposed to "publishing services" that involve "preparation of the works for online publication, not providing the work itself."

Applicant argues that the examining attorney erred in her analysis because she failed to read the marks as a whole, specifically applicant contends that the examining attorney "mutilate[ed] the mark[s] by disregarding" other elements of the marks and arguing that the remaining element PRASTERONE is generic. App. Br. p. 7. In addition, applicant argues that its marks, even if considered only as "PRASTERONE" are not generic for its "publishing services." App. Br. p. 7. We find no such error in the examining attorney's analysis. We further find that the marks are generic for applicant's identified services.

First, because "prasterone" is the generic name of one of the items that is the subject matter of applicant's services, it is likewise generic for the services themselves. Cyberfinancial.Net, 65 USPQ2d at 1791 and cases cited therein. Second, with regard to the examining attorney's analysis, no matter what the factual circumstances (compound word, phrase, or domain name) in the final analysis a proposed mark must be viewed in its entirety. However, it is proper to look at the separate parts of a mark and then determine if their combination

U.S. Acceptable Identification of Goods and Services Manual (10th ed. 2012) (notes attached to online publishing identification).

creates a meaning beyond the generic meaning. Whether or not the type of evidence provided supports the ultimate conclusion varies.

Citing *American Fertility*, applicant characterizes its marks as phrases and thus the absence of evidence of use by third parties of the entire "phrases" is fatal to the examining attorney's case. We find the circumstances of these applications to be distinct from those in *American Fertility*. *PRASTERONE.ORG* without question is not a phrase. At most, it would be considered more in the nature of a compound term as found in *Gould*. With regard to *THE PRASTERONE COMPANY*, we also do not view this as a phrase in the same manner that *SOCIETY FOR REPRODUCTIVE MEDICINE* is a phrase. Rather, the addition of the word *COMPANY* cannot "transform a generic name for a [service] into a trademark." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 12:39 (4th ed. updated 2012).

Moreover, the use of "THE" at the beginning does not transform *THE PRASTERONE COMPANY* into a mark or a designation that is capable of registration. See *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005); *In re The Weather Channel, Inc.*, 229 USPQ 854 (TTAB 1985). On this

See also TMEP § 1301.01(a)(ii) (8th ed. 2011) (collecting information for one's own periodical is not a service).

record, THE PRASTERONE COMPANY has no other significance within the context of these services other than to refer generally to a provider of information on prasterone.

Applicant argues that it uses PRASTERONE.ORG not only as a web address, but also as an identifier of source and relies on *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998) (WWW.EILBERG.COM fails to function as a mark based on manner of use). In *Eilberg*, the manner of use was the issue, not the underlying term itself. EILBERG is a surname, and, as such, registrable upon a showing of acquired distinctiveness. However, in this case PRASTERONE is a generic term and, as such, unregistrable when used in connection with the provision of information about prasterone no matter that it is not used as a web address. Similarly, applicant's example of use of THE PRASTERONE COMPANY is simply a generic term for information services for prasterone.

Applicant argues that for "a term to be generic for the recited service, the term must in fact have been previously used in connection with that service." Reply Br. p. 6. More specifically, applicant argues that if "an applicant is 'the first and only user' of a designation, then that designation is not generic, it's fanciful. If an otherwise-generic designation has never been used in

connection with the recited services, then that designation may be arbitrary, or suggestive, or even descriptive of the recited services, but the designation cannot be generic for those services." Reply Br. p. 7. Applicant relies on 1800Mattress.com, 92 USPQ2d 1682 for this proposition. In that case, the Federal Circuit affirmed the Board's determination that MATTRESS.COM was generic for online retail services featuring mattresses based on the definitions of its constituent parts and that the combination added no new meaning as shown by third-party use of the term for other websites. The Federal Circuit did not set forth a new standard that if an applicant is the first and only user the proposed mark is not generic. Rather, the Federal Circuit simply found that there was substantial evidence to support the Board's decision. The reverse, however, does not apply. Such third-party use is not required to establish that the combination of generic parts does not add any meaning to an otherwise generic designation. In fact, the Federal Circuit quotes a prior case wherein the Federal Circuit made clear that dictionary definitions of the constituent parts may be sufficient to establish that the term as a whole is generic. Id. at 1684 quoting *In re American Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832, (Fed. Cir. 1999) ("[I]f the compound word

would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required." emphasis added). This standard has been in place since at least 1987 when the Federal Circuit issued its decision in Gould Paper Corp., 5 USPQ2d 1110. The Federal Circuit explained that "to refuse registration on the ground that an applicant seeks to register the generic name of the goods, the PTO must show that the word or expression inherently has such meaning in ordinary language, or that the public uses it to identify goods of other producers as well." Id. at 1111 quoting In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 405 (CCPA 1982). The Federal Circuit held in Gould that "the PTO has satisfied its evidentiary burden if, as it did in this case, it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." Id. at 1111-1112. Thus, the fact that an applicant may be the first and only user of a term does not justify registration if the only significance conveyed by the term is that of the category

of services. See *In re Greenliant Systems Ltd.*, 97 USPQ2d 1078, 1084 (TTAB 2010).

Applicant also relies on the case *Steelbuilding.com*, but that case is factually distinct from this one. In *Steelbuilding.com*, the Federal Circuit first found that the Board had not properly defined the genus and then found that there was not substantial evidence to find the term "STEELBUILDING" generic, stating that the "record does not contain any examination of dictionary definitions or other sources that might have indicated that joining the separate words 'steel' and 'building' would create a word that, in context, would be generic. The Board merely cited evidence that showed that when customers or competitors talked about a steel building, they used the phrase 'steel building.' That evidence shows that 'steel building' is generic, but does not address directly the composite term STEELBUILDING." *Id.* at 1423. The Federal Circuit further explained that in "this unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include 'building' or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure."

Id. Here, we do not have a compound word attached to a TLD, rather PRASTERONE is admittedly the generic word for a pharmaceutical. Moreover, the genus is properly defined by the identification. In addition, there is no evidence to find this to be an exceptional circumstance in which a TLD creates a descriptive rather than generic term.

Applicant also points to several third-party registrations in support of its argument that the Office has approved registration of similarly structured marks, i.e., with .ORG, or THE and COMPANY. The examining attorney has objected to certain of these registrations as being untimely, in Application Serial No. 85255541. Citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), applicant counters that the Board may take judicial notice of third-party registrations. While the Federal Circuit exercised its discretion to take judicial notice of a third party's registration in *Chippendales*, it is well-established that the Board does not take judicial notice of third-party registrations. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.12(a) (3d ed. rev. 2012) and cases cited therein. In addition, applicant argues that the examining attorney waived her objection because when it referenced a list of third-party registrations in its response to the office

action, she did not advise applicant that a list does not make the registrations of record. Applicant is correct as to the admissibility of the list. However, the waiver of objection to the list does not open the door for applicant to submit the registrations themselves with its brief.⁹ In re City of Houston, 101 USPQ2d 1534, 1536 (TTAB 2012). See also TBMP § 1207 and cases cited therein. In view thereof, we have considered the list and the information provided during examination.¹⁰ We note that such registrations have limited probative value inasmuch as we are not bound by prior decisions and whether a proposed mark is generic must be determined based on the evidence of record at the time registration is sought. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). We add that the listed third-party registrations present different circumstances on their face. For example Reg. No. 4027282 for the mark THE SAN FRANCISCO OLIVE OIL COMPANY includes a geographic term which is registrable upon a showing of acquired distinctiveness.¹¹

⁹ We note that applicant did not attach the registrations.

¹⁰ Applicant first mentioned Reg. No. 4027282 in its brief, we have, however, considered this example along with the other previously mentioned registrations.

¹¹ In connection with its third-party registration argument, applicant grossly misrepresents Board orders issued in a proceeding involving one of those registrations. Specifically,

Applicant argues that the website provides information about other types of pharmaceuticals and that "[t]he relevant public does not understand PRASTERONE to primarily refer to these numerous hormone derivatives discussed by Applicant's service." App. Br. p. 15. However, when a mark is generic as to part of the services applicant offers under its mark, the mark is unregistrable. See *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd* without pub. Op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought).

applicant states that in the June 29, 2010 order in Opp. No. 91191016 the Board "held the recited use in the application was not generic." App. Br. p. 13. In fact, upon a motion to dismiss a counterclaim, the Board found that because the applicant had only referenced part of the marks it had not "alleged that the marks, as a whole, are generic for the underlying goods and/or services" and, thus, granted the motion to dismiss, allowing applicant time to replead. Applicant continues in his presentation of this case by stating that in the August 22, 2011 order, the Board "re-affirm[ed] that an applicant can register a term which has a generic meaning, as long as the applicant does not try to register that generic use." *Id.* In fact, in that case, the applicant filed an amended counterclaim of genericness against the several pleaded marks and the Board stated that "applicant has sufficiently pleaded his genericness claim" against five of the pleaded registrations. The Board granted the renewed motion to dismiss the genericness claim as to one of the pleaded registrations because it contained a design element combined with the wording. Suffice it to say, the Board did not find that a particular term is not generic, rather the Board granted a motion to dismiss a counterclaim for failure to state a claim and allowed the party to replead its claim of genericness. Upon repleading the Board accepted, in part, the renewed pleading of genericness.

Finally, applicant argues that because no one else can obtain the domain prasterone.org, the examining attorney's argument that the term must be kept free for others to use is misplaced. In 1800Mattress.com, the Federal Circuit affirmed the Board's finding that mattress.com is generic, in part, because the record demonstrated others' need to use the term. In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009). While this record does not contain an example of another entity referring to its information services as PRASTERONE.ORG or including PRASTERONE.ORG as part of a domain name, the need to use PRASTERONE.ORG is demonstrated by the evidence establishing that PRASTERONE is used by others generically in the provision of their information services.¹²

This record establishes that the relevant public would understand PRASTERONE.ORG and THE PRASTERONE COMPANY to refer to a company that provides information about prasterone, and public understanding is critical. 1800Mattress.com, 92 USPQ2d at 1685. These terms are incapable of identifying source for prasterone information services because they are terms a purchaser would understand and could use to refer to the type of company

¹² Conceptually, the facts here present the same issue presented in 1800Mattress.com, to the extent that others should be free to

that provides information on prasterone, and must be left available for use by other such companies providing information on prasterone. As has been found in other cases, marks may not equate to the literal name of the goods or services for which registration is sought, but still be deemed to be "generic." See *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010) and cases cited therein.

Based on this record, the examining attorney clearly established that PRASTERONE.ORG and THE PRASTERONE COMPANY are generic for the identified services and are not "capable of distinguishing the applicant's services." 15 U.S.C. § 1091(c).

Decision: The refusals to register are affirmed.

use the generic designation PRASTERONE.ORG as part of their domain name, for example, MD-PRASTERONE.ORG.