

**This Opinion is Not a
Precedent of the TTAB**

Mailed: November 27, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Boehringer Ingelheim Pharmaceuticals, Inc.
—

Serial No. 86852106
—

Scott J. Major of Millen White Zelano & Branigan PC,
for Boehringer Ingelheim Pharmaceuticals, Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.
—

Before Quinn, Wolfson and Adlin,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Boehringer Ingelheim Pharmaceuticals, Inc. (“Applicant”) seeks registration on the Principal Register of the mark BREATHLESS (in standard characters) for “promoting public awareness of idiopathic pulmonary fibrosis, its symptoms, its prevention and its treatment” in International Class 35; and “providing medical information regarding idiopathic pulmonary fibrosis, its symptoms, its prevention and its treatment” in International Class 44.¹

¹ Application Serial No. 86852106 was filed December 17, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging Applicant’s bona fide intent to use the mark in

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's proposed mark, when applied to Applicant's services, is merely descriptive thereof. After the Examining Attorney made the refusal final, Applicant timely appealed and filed a request for reconsideration. The Examining Attorney denied the request and the appeal resumed. Following submission of briefs, Applicant requested remand for consideration of additional evidence. The Examining Attorney treated the request as seeking reconsideration and denied it, while objecting to Applicant's new evidence as untimely.² Thereafter, the appeal again resumed, and Applicant filed a reply brief. We reverse the refusal to register.³

The American Heritage Dictionary defines "breathless" as "[b]reathing with difficulty, gasping" and "excited or tense, often to the point of holding the breath: a breathless audience."⁴ Applying the first definition, Applicant argues that its mark is "a classic example of a suggestive mark"⁵ in that a multi-step reasoning process is required to connect Applicant's promotional awareness and information services with

commerce. On September 6, 2016, Applicant filed an amendment to allege use, alleging first use and first use in commerce dates of February 18, 2016. The amendment to allege use was accepted on September 10, 2016.

² 15 TTABVUE. The objection under Trademark Rule 2.142(d) is overruled. Because the Board granted Applicant's request for remand upon Applicant's showing of good cause, the evidence was not untimely and should have been considered. *See* TBMP § 1207.02 (2017). In any event, the Examining Attorney stated that Applicant did not "provide any new or compelling evidence with regard to the outstanding issue in the final Office action."

³ Applicant preserved its right to seek amendment to the Supplemental register in the alternative, in both classes.

⁴ At <https://www.ahdictionary.com>, attached to September 3, 2016 Office action, TSDR 2-3.

⁵ 10 TTABVUE 3.

the concept that patients with idiopathic pulmonary fibrosis (“IPF”) become “breathless” as a condition of their ailment:

The Applicant believes firmly that it is entitled to registration on the Principal Register in this instance. Its services are the providing of information on and promoting awareness of idiopathic pulmonary fibrosis (IPF); persons with IPF have various symptoms; one such symptom can be shortness of breath; one meaning of the adjective “breathless” is “breathing with difficulty”; and that adjective can be used in reference to persons experiencing “shortness of breath” as a result of IPF. This is a classic, multistep reasoning process that must be performed in order to determine the nature of the services. As such, the mark BREATHLESS clearly is beyond the reach of Section 2(e)(1).⁶

Applying the second definition, Applicant argues that the mark is registrable as a double entendre in that it “is a reference to the excitement and anticipation among IPF patients, their caregivers and loved ones about the progress being made in preventing and/or treating this serious condition.”⁷

The Examining Attorney counters that the mark is merely descriptive of “the subject matter of the information” Applicant provides to promote public awareness of IPF and that “[c]onsumers would immediately understand the mark to describe a symptom of idiopathic pulmonary fibrosis.”⁸ He argues that because shortness of breath is the main symptom of IPF, the proposed mark immediately conveys the idea that Applicant’s services are directed to providing information about and raising public awareness of IPF:

⁶ Request for Reconsideration after Final Action, November 27, 2016, TSDR 1.

⁷ *Id.*

⁸ 12 TTABVUE 5.

The evidence of record clearly indicates that consumers, seeking or otherwise exposed to information regarding pulmonary fibrosis, are conditioned to understand that the wording “breathless” describes a symptom of lung disease.

...

In the context of the services provided by the applicant and the evidence demonstrating the common descriptive use of the term breathless, consumers would consider the mark to describe a symptom of idiopathic pulmonary fibrosis (IPF).⁹

A term is merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services for which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). On the other hand, a term which is suggestive is registrable. “If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what characteristics the term identifies, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See In re Shutts*, 217 USPQ at 364-365; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). As has often been stated, there is a thin line between suggestive and merely descriptive marks, with the determination of which side of the line a mark falls on being difficult and often involving subjective judgment. *See, e.g., In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). When the question is mere descriptiveness, to the extent that there is

⁹ *Id.*, at 9, 11.

doubt, it is resolved in favor of the applicant. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994); *see also In re Merrill Lynch*, 4 USPQ2d at 1144 (citing *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972)).

Evidence submitted by the Examining Attorney demonstrates that shortness of breath is a common symptom of IPF and that persons interested in learning about IPF, or who may have IPF, would encounter articles advising them to recognize shortness of breath as a sign or symptom of the illness.¹⁰ However, the evidence fails to demonstrate that the term “breathless” merely describes providing consumers with information about IPF or raising public awareness of IPF. Whether a mark is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used or intended to be used, and here, while breathlessness is an IPF symptom, there is no evidence that it relates to providing information or raising public awareness, even of IPF specifically.

¹⁰ *See, e.g.*, “*What Are the Signs and Symptoms of Idiopathic Pulmonary Fibrosis?*” from the NIH website of the U.S. Department of Health & Human Services. At <http://www.nhlbi.nih.gov/health/health-topics/topics/ipf/signs>, the web page identifies “shortness of breath” as “the main symptom of IPF.” Attached to October 24, 2016 Office Action, TSDR 2. Other websites relied upon by the Examining Attorney refer to this particular symptom of IPF using terms such as “rapid, shallow breathing,” “shortness of breath,” and “difficult, painful breathing” in addition to using the term “breathless.” *See, e.g.*, the U.S. National Library of Medicine PubMed Health website at <http://www.ncbi.nlm.nih.gov>, attached to the September 3, 2016 Office Action, TSDR 5 (“rapid, shallow breathing,” “dry, hacking cough,” “shortness of breath,” “breathless even at rest”); the Pulmonary Fibrosis Foundation website at <http://pulmonaryfibrosis.org>, TSDR 10 (“cough and shortness of breath,” “may become breathless while taking part in everyday activities”); and the U.S. Department of Health and Human Services’ “*Guideline Summary-The diagnosis and management of suspected idiopathic pulmonary fibrosis*” at <http://www.guideline.gov>, TSDR 13 (“persistent breathlessness on exertion.”).

Specifically, BREATHLESS does not identify a feature of the services themselves or convey information about Applicant's promotional and medical information services. We agree with Applicant that a multi-step reasoning process is required to move from the merely descriptive meaning of "breathless" as a word that describes a common symptom of lung disease in general, even of IPF specifically, to an understanding that the proposed mark conveys an immediate idea about providing medical information about IPF or raising public awareness thereof. In fact, some degree of thought or imagination is required to understand that Applicant's services involve promoting public awareness and providing medical information about a disease that makes one "breathless." That is, there is an element of incompleteness making the mark suggestive rather than merely descriptive.

In short, we are not persuaded by the Examining Attorney's evidence that BREATHLESS *per se* is merely descriptive of Applicant's identified medical information and public awareness services.¹¹ While this is a close case and we have doubts, we must resolve that doubt in Applicant's favor, and therefore find that the mark BREATHLESS is not merely descriptive of Applicant's services of "promoting

¹¹ The record reveals that Applicant is a pharmaceutical company. Obviously, our decision is by definition limited to Applicant's identified services, and may very well be different if Applicant had instead of information services identified a pharmaceutical or other treatment for conditions that render patients "breathless." In fact, we recognize the potential competitive need for others in the field to use the term, and harbor reservations that a for-profit provider of medical or pharmaceutical treatments could perceive our decision as entitling it to exclusive rights in the term generally. Our decision does not do that, nor could it. We therefore again stress that this decision is based solely on Applicant's identification of services and the quite limited record presented by the Examining Attorney. Moreover, even with respect to Applicant's identification of information services, the result could very well be different in an *inter partes* case or one with a more complete record, and, obviously, nothing in our decision prevents Applicant's competitors or others from using the term "breathless" descriptively.

public awareness of idiopathic pulmonary fibrosis, its symptoms, its prevention and its treatment” or of “providing medical information regarding idiopathic pulmonary fibrosis, its symptoms, its prevention and its treatment.” Anyone who believes that the term BREATHLESS is, in fact, merely descriptive, may oppose the application and have the opportunity to present a more complete record in an *inter partes* proceeding.

Decision: The refusal to register is reversed. In view thereof, Applicant’s request for Supplemental Register registration in the alternative is moot.